

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC A. BELEC,
MARY-JO F. BRIGANTE,
CHERYL L. PICOULT and
WILLIAM J. WRIGHT

Appeal No. 97-1890
Application 08/338,707¹

ON BRIEF

Before BARRETT, FLEMING and CARMICHAEL, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1 through 5, all of the claims present in the

¹ Application for patent filed November 14, 1994.

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application. Appellants filed an after final amendment amending claim 1. The Examiner in an advisory action, mailed June 25, 1996, stated that upon the filing of an appeal, the proposed amendment, filed June 10, 1996, will be entered. We note that the amendment has been entered into the record and thereby, amended claim 1 is properly before us for our consideration.

Appellants' invention relates to an asynchronous control method and apparatus for insertion devices.

Independent claim 1 is reproduced as follows:

1. A method for controlling an insertion apparatus having a plurality of operations arranged for transporting an envelope and for transporting and inserting a collation into the envelope, said method comprising the steps of providing respective event signals in accordance with selected events associated with the operations, providing a plurality of motor profiles for operation of motors associated with the operations, controlling respective pluralities of motors associated with respective operations of the apparatus in correspondence with selected ones of said plurality of motor profiles for controlling driving of said motors in response to receiving the event signals.

The references relied on by the Examiner are as follows:

Kapp et al. 1988 Francisco 26, 1991	4,733,310 5,003,485	Mar. 22, Mar.
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Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Francisco and Kapp.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 1 through 3 are properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of these claims but we will reverse the rejection of the remaining claims on appeal for the reasons set forth ***infra***.

At the outset, we note that Appellants state on page 4 of the brief that claims 1 through 3 stand or fall together and claims 4 through 5 stand or fall together. We note that Appellants argue each of these groups of claims as a single group in the brief. 37 CFR § 1.192 (c)(7)(July 1, 1996) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was

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controlling at the time of Appellants' filing the brief,
states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, therefore, consider the Appellants' claims 1 through 3 as a group standing or falling together and claims 4 and 5 as a group standing or falling together. In addition, we will treat claims 1 and 4 as representative claims of their respective group.

On pages 2 and 3 of the brief, Appellants argue that Francisco describes asynchronous control between stations, not with each station as in the Appellants' invention. On page 6 of the answer, the Examiner points out that the claims are not limited to control within a single station and that Appellants' claim language reads on Francisco.

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As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Turning to Appellants' claim 1, we note that the claim recites "[a] method for controlling an insertion apparatus having a plurality of operations arranged for transporting an envelope and for transporting and inserting a collation into the envelope ... comprising the steps of providing respective event signals in accordance with selected events associated with the operations." We find that Appellants' claim 1 does not preclude the asynchronous control between stations as disclosed by Francisco.

On page 3 of the brief, Appellants argue that Kapp does not disclose a motor profile. In particular, Appellants submit that a motor control which can be turned on and off in a sequence of up to eight steps and has a reverse direction is not a motor profile. Appellants simply state that the control in Kapp is not what is claimed in the instant application, but does not provide any explanation as to why Appellants' motor profile as claimed is distinguished from the Kapp's motor multiple modes control for a motor.

Turning to Appellants' claim 1, we note that the claim recites "providing a plurality of motor profiles for operation of motors associated with the operation." Turning to Appellants' specification, we note that Appellants have provided little detail as what is meant by a motor profile. For example, on page 10 of the specification, Appellants disclose that upon an event of the envelope having cleared, a deceleration motor profile is selected. On page 11 of the specification, Appellants disclose that backstop software program module 214 provides commands in accordance with a selected profile to the backstop motor M6. Appellants do not provide a special definition of the motor profiles or provide any disclosure that would demonstrate that motor multiple modes or motor sequences are not motor profiles. Thus, we find that Appellants' claim term, "motor profiles" as read in light of Appellants' specification is broad enough to include Kapp's disclosed motor sequences and motor modes.

On page 4 of the brief, Appellants argue that Kapp does not disclose control means for asynchronously controlling the transport of an envelope with respect to a collation or a method of controlling an insertion apparatus having a

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plurality of operations. However, the Examiner is not relying on Kapp for these teachings but instead relies on Francisco.

On pages 4 and 5 of the answer, the Examiner shows that Francisco teaches the method steps of claim 1 except for an express teaching of providing a plurality of motor profiles and controlling the motors in correspondence with selected ones of the plurality of motor profiles. The Examiner shows that Kapp teaches a microprocessor that provides and selects motor profiles to control motors in the envelope path. The Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the Francisco method of controlling an insertion apparatus to have a plurality of operations arranged for transporting an envelope and for transporting and inserting a collation into the envelope by providing a plurality of motor profiles and controlling the respective plurality of motors in correspondence with selected ones of the plurality of motor profiles in order to obtain Kapp's benefit of overcoming motor failure and system jams as recited in Appellants' claim 1. We agree.

We note that the Appellants have not argued why the

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Examiner's reasoning for combining Francisco and Kapp is improper. Appellants have argued that the references do not meet the Appellants invention. As stated by our reviewing court in *In re Baxter Travenol Labs.*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 CFR § 1.192(a) as amended at 60 Fed. Reg. 14518, March 17, 1995, which was controlling at the time of Appellants filing the brief, states as follows:

The brief . . . must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences.

Also, 37 CFR § 1.192(c)(8)(iv) states:

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one

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reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, 37 CFR § 1.192 provides that this board is not under any greater burden than the court which is not under any burden to raise and/or consider such issues.

We have addressed all of these arguments and found that Appellants have not shown that the Examiner has erred in making the rejection. Therefore, we will sustain the Examiner rejection of claims 1 through 3 under 35 U.S.C. § 103.

On page 4 of the brief, Appellants further argue that neither Francisco nor Kapp, alone or in combination, discloses or suggests control means for asynchronously controlling the transport of an envelope wherein the timing of the envelope transport is related to the collation transport only by way of determined events occurring in the transport of each collation and envelope, as set forth in claim 4. Appellants have not provided any arguments as to why Francisco fails to teach this limitation. However, we note that the Examiner relies on Kapp's teaching this actuating of the motors along the transport path as evidence that this limitation is known in

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the art.

Upon a closer review of Kapp, we fail to find that Kapp teaches that the time of the envelope transport is related to the collation transport **only** by way of determined events occurring in the transport of each collation and envelope. Kapp teaches a paper feeder apparatus having only one tray which is capable of accommodating papers of different sizes as well as envelopes using different storage trays which are to be inserted by the operator for each respective use. See column 2, line 50, through column 3, line 11. Kapp does not teach an apparatus that provides both kinds of transports in the same apparatus much less providing the timing as recited in Appellants' claim 4. Therefore, we will not sustain the Examiner's rejection of claims 4 and 5.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 3 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claims 4 and 5 through 23 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED-IN-PART

	LEE E. BARRETT)	
	Administrative Patent Judge)	
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	MICHAEL R. FLEMING)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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