

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD C. SECOR,
RONALD M. RENDLEMAN,
and
PAUL D. COPENHAVER

Appeal No. 1998-1052
Application No. 08/683,600

ON BRIEF

Before STAAB, McQUADE, and GONZALES, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 5, 6, 18 and 20-31, all the claims currently pending in the application.

Appellants' invention pertains to a dryer which utilizes radiant heat and forced air flow for drying freshly printed

Appeal No. 1998-1052
Application No. 08/683,600

sheets before they are stacked or run back through a printing press for a second time. The claims on appeal are reproduced in the appendix of appellants' brief.

The references applied by the examiner in the final rejection are:

Bubley et al. (Bubley) 1984	4,434,562	Mar. 6,
Wimberger et al. (Wimberger) 1992	5,092,059	Mar. 3,
Anderson 31, 1992	5,099,586	Mar.

The following rejections are before us for review:¹

(a) claims 1, 5, 6 and 21-28, rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;²

¹The final rejection of claims 5, 6, 20 and 31 under 35 U.S.C. § 112, first paragraph, has been overcome by the amendment submitted April 6, 2000 (see Paper No. 18). The final rejection of claims 1, 5, 6, 18 and 20-31 under the judicially created doctrine of obviousness-type double patenting has been overcome by the terminal disclaimer submitted April 6, 2000 (see Paper No. 20).

²Although the statement of this rejection was not repeated in the examiner's answer, it is clear from the record as a whole (answer, paragraph spanning pages 6-7; brief, pages 5-7 (issue 2 and discussion thereof)) that both the examiner and appellants consider this ground of rejection to be maintained on appeal. Accordingly, the failure of the examiner to provide a statement of this rejection in the answer is considered to be a harmless oversight.

Appeal No. 1998-1052
Application No. 08/683,600

(b) claims 1 and 21-24, rejected under 35 U.S.C. § 103, as being unpatentable over Anderson;

(c) claims 5, 6, 18, 20, 25-29 and 31, rejected under 35

U.S.C. § 103, as being unpatentable over Anderson in view of Bublely; and

(d) claim 30, rejected under 35 U.S.C. § 103, as being unpatentable over Anderson in view of Bublely and Wimberger.

Reference is made to the final rejection and examiner's answer (Paper Nos. 4 and 7) for a statement of the examiner's position, and to the brief and reply brief (Paper Nos. 6 and 9) for a statement of appellants' arguments thereagainst.

Preliminary Matters

Appellants have questioned whether it was appropriate for the examiner to make final the office action mailed November 19, 1996. This matter is not directly connected with the merits of issues involving a rejection of claims and therefore is reviewable by petition to the Director rather than by appeal to this Board. *Compare In re Hengehold*, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971). Accordingly, we shall

Appeal No. 1998-1052
Application No. 08/683,600

not review or further discuss the examiner's action in this regard.

Rejection (a)

Looking first at the rejection of claims 1, 5 and 6 as being indefinite, the examiner contends that these claims do not pass muster under the second paragraph of 35 U.S.C. § 112 because the

"multiple air flow apertures" recited in the last paragraph of claim 1 "are inferential[ly] recited" (final rejection, page 3). We agree with appellants, however, that the recitation in claim 1 of a "reflector plate being intersected by multiple air flow apertures" is a proper recitation of the structure being claimed that would be readily understood by an artisan. Hence, the rejection of claims 1, 5 and 6 under 35 U.S.C. § 112, second paragraph, shall not be sustained.

Concerning the 35 U.S.C. § 112, second paragraph, rejection of claims 21-28, appellants make the following statement:

Applicants agree with the Examiner's rejection

Appeal No. 1998-1052
Application No. 08/683,600

of Claim 21 in line 14 where the phrase "air flow apertures" should be --multiple discharge ports--.

Applicants will make this change if the claims are allowed under 35 U.S.C. § 103. Applicants respectfully disagree with the Examiner's rejection of Claims 23 and 24 as the "air flow apertures" are properly recited in Claim 23, line 4 as being part of the reflector plate. [Brief, page 7.]

In that appellants have acquiesced in the examiner's rejection of independent claim 21 under 35 U.S.C. § 112, second paragraph, we shall summarily sustain this rejection. Further, since appellants have not argued the merits of this rejection as it applies to claims 22 and 25-28, which depends either directly

or indirectly from claim 21, we also shall summarily sustain the § 112, second paragraph, rejection of claims 22 and 25-28. Concerning dependent claims 23 and 24, while we appreciate that claim 23, and claim 24 through its dependence on claim 23, properly recites the "air flow apertures" as being part of the reflector plate, these claims depend, either directly or indirectly, from claim 21 and therefore include all of the

Appeal No. 1998-1052
Application No. 08/683,600

subject matter of that base claim. Accordingly, the circumstance that claim 23 properly recites the "air flow apertures" as being part of the reflector plate does not cure the deficiency of base claim 21 which improperly recites pressurized air jets flowing through "the air flow apertures" in the air distribution manifold. For this reason, we likewise shall sustain the 35 U.S.C. § 112, second paragraph, rejection of claims 23 and 24.

In treating the standing 35 U.S.C. § 103 rejections of claims 21-28 on the merits, *infra*, we interpret the term "the air flow apertures" found in the third paragraph of claim 21 as "the multiple discharge ports."

Rejection (b)

Claim 1 is directed to a dryer comprising a dryer head defining an air distribution manifold having an inlet port for receiving pressurized air and discharge port means facing the

substrate travel path, a radiant heat lamp assembly comprising multiple heat lamps disposed within the dryer head between the substrate travel path and the air distribution manifold, and

Appeal No. 1998-1052
Application No. 08/683,600

a reflector plate disposed *intermediate* the air distribution manifold and the heat lamp assembly, the reflector plate being intersected by multiple air flow apertures disposed in air flow communication with the discharge port means of the air distribution manifold, and the air flow apertures being oriented for directing jets of pressurized air *through the heat lamp assembly* onto the processed side of a substrate moving along the travel path. [Emphasis added.]

With reference of Figure 6 of Anderson, it appears that the examiner considers the portion of Anderson's dryer between fan 6 and the tops of reflectors 15' as corresponding to the air distribution manifold, the lamps 12' as corresponding to the radiant heat lamp assembly, and the holes 35' in the channel bottoms 33', 34' of the reflector plate 15' as corresponding to the air flow apertures of the reflector plate. Our first difficulty with this reading of the claim language on Anderson is that it requires the channel bottoms 33', 34' of Anderson's reflector plate 15' to be considered part of the reflector plate. However, if this is so, then Anderson's reflector plate cannot be fairly regarded as being *intermediate* the air distribution manifold and the heat lamp assembly, as called for in claim 1, because a significant portion of Anderson's reflector plate would

Appeal No. 1998-1052
Application No. 08/683,600

lie below the level of the heat lamp assembly. More importantly, the holes 35' of Anderson's reflector clearly are not oriented for directing jets of pressurized air *through* the heat lamp assembly 12' because Anderson's holes 35' are located below the heat lamps. Therefore, even if we were to agree with the examiner that it would have been obvious to modify Anderson in the manner proposed,³ the subject matter of claim 1 would not result. It follows that the standing rejection of claim 1 as being unpatentable over Anderson is not sustainable.

We reach an opposite conclusion with respect to the standing § 103 rejection of claim 21. At the outset, we observe that claim 21 is broader than claim 1 in the sense that it is silent as to the presence or absence of a reflector plate. Thus, claim 21 does not require any reflector plate whatsoever, much less a reflector plate that (1) is disposed intermediate the air distribution manifold and the heat lamp assembly, or (2) includes air flow apertures for directing jets of pressurized air through the heat lamp assembly.

³It is the examiner's position that Anderson does not disclose a heat lamp assembly including multiple heat lamps, but that it would have been obvious to one of ordinary skill in the art to so modify Anderson.

Appeal No. 1998-1052
Application No. 08/683,600

Appeal No. 1998-1052
Application No. 08/683,600

With reference once again to Figure 6 of Anderson, we find, as did the examiner, that the portion of Anderson's dryer between fan 6 and the tops of reflectors 15' constitutes an "air distribution manifold," said manifold having an "inlet port" directly below the fan and "multiple discharge ports" in the form of entrance ways 76' defined by flanges 72', 73' that are oriented for directing pressurized jets of air (denominated "Gas Flow" in Figure 6) toward the travel path of the web. Thus, Anderson teaches an air distribution manifold as claimed. Moreover, the pressurized air flowing from the air discharge ports 76' of Anderson's air distribution manifold is directed to air flow apertures 35' where it exits to form an "air blanket," as broadly claimed. As to the claimed radiant heat lamp assembly, we note that appellants have not specifically challenged the examiner's position that it would have been obvious to provide a plurality of Anderson's lamps 12' in an assembly to thereby arrive at a radiant heat assembly "including multiple [radiant] heat lamps" as claimed. In any event, we note that the ends of Anderson's lamps 12' are mounted in lamp holders 11 (see

Appeal No. 1998-1052
Application No. 08/683,600

Figure 1 and column 3, lines 32-36). In our view, this construction responds to the claim language calling for a radiant heat assembly "including multiple [radiant] heat lamps" supported

intermediate the travel path and the air distribution manifold, as called for in claim 21. Thus, Anderson appears to be sufficient to establish obviousness within the meaning of 35 U.S.C. § 103 of the claimed subject matter.

Appellants argue that claim 21 "recites a radiant heat lamp assembly supported intermediate the travel path and the air distribution manifold. In Anderson, the lamps 12' are spaced further apart from the web than from the holes 35'" (brief, page 8). This argument appears to misapprehend the examiner's reading of the claim language on Anderson. Although appellants seem to be of the view that the examiner considers holes 35' of Anderson as corresponding to the multiple discharge ports of the air distribution manifold, it is clear that the examiner reads this claim limitation on the

Appeal No. 1998-1052
Application No. 08/683,600

entrance ways 76' defined by Anderson's flanges 72', 73',⁴
such that Anderson's air distribution manifold

does *not* extend all the way down to the holes 35', but instead ends at entrance ways 76'. When considered in this manner, it is clear that Anderson's lamp assembly is supported intermediate the travel path and the air distribution manifold. Appellants also argue (reply brief, page 2) that the pressurized air in Anderson does not define an air blanket, however, it is not clear why the air flow impinging on Anderson's web cannot be considered an "air blanket" as broadly claimed.

For the reasons discussed above, we conclude that appellants' arguments are not persuasive that the examiner has

⁴See, for example, the sentence spanning pages 4-5 of the answer, wherein the examiner states:

The inlet port for the air distribution manifold is located at the top of the manifold as seen in Fig. 6 where the air enters the manifold from the fan 6 and a discharge port means 76 [*sic, 76'*] located at the bottom of the manifold where the air passes from the manifold [to] the heat lamp assembly. [Emphasis added.]

Appeal No. 1998-1052
Application No. 08/683,600

failed to adduce evidence sufficient to establish obviousness of the subject matter of claim 21. We shall therefore sustain the standing § 103 rejection of claim 21.

Claim 22 depends from claim 21 and adds that each discharge port of the air distribution manifold is centered with respect to a pair of adjacent heat lamps, whereby each pressurized air jet is directed through the longitudinal spacing between a pair of heat lamps. Clearly, this is not the case in Anderson, where discharge ports 76' are aligned directly over the respective heat lamps 12' (see Figure 6). Since the examiner has not explained how Anderson teaches or suggests this claim feature, and since it is not otherwise apparent to us how the Anderson reference

renders obvious the subject matter of claim 22, the standing § 103 rejection thereof shall not be sustained.

The standing § 103 rejection of dependent claims 23 and 24 shall not be sustained. These claims call for a reflector plate disposed *between* the air distribution manifold and the heat lamp assembly, with the reflector plate having multiple air flow apertures for directing pressurized jets of air

Appeal No. 1998-1052
Application No. 08/683,600

through the heat lamps and onto a substrate travel path. For the reasons explained above in our discussion of claim 1, Anderson fails to teach or suggest this arrangement.

Accordingly, the standing

§ 103 rejection of claims 23 and 24 is not sustainable.

Rejections (c) and (d)

Claim 5 depends from claim 1 and adds to claim 1 that the dryer thereof includes an extractor head positioned below the travel path of the substrate for collecting and extracting moisture laden air. The examiner cites Bublely for its teaching of a curing apparatus having a vacuum chamber 80 located below the articles to be cured and takes the position that it would have been obvious to one of ordinary skill in the art to provide a vacuum chamber below the travel path of Anderson's web. However, Bublely does nothing to cure the deficiencies of Anderson

regarding the lack of any teaching or suggestion of providing

a

Appeal No. 1998-1052
Application No. 08/683,600

reflector plate *intermediate* the air distribution manifold and the heat lamp assembly having air flow apertures oriented for directing jets of pressurized air *through* the heat lamp assembly, as required by the last paragraph of base claim 1. Accordingly, even if we were to agree with the examiner's position regarding the proposed modification of Anderson in view of Bublely, the subject matter of claim 5 would not result. It follows that the standing § 103 rejection of claim 5, and claim 6 that depends therefrom, is not sustainable.

Independent claim 18 is directed to a dryer comprising a dryer head defining an air distribution manifold having an inlet port and discharge port means, a radiant heat lamp assembly comprising multiple heat lamps, and a support plate facing the radiant heat lamps for guiding a freshly processed substrate as it travels beneath the heat lamp assembly. In rejecting this claim as being unpatentable over Anderson in view of Bublely, the examiner observes (answer, page 5) that "the top surface 82 of the extractor head of Bublely et al. acts as a support for the substrate" and that "the vacuum chamber [of Bublely] holds [articles] on the belt." The examiner then concludes (answer, page 5) that it would have

Appeal No. 1998-1052
Application No. 08/683,600

been obvious "to supply the dryer of

Anderson with a support plate on the back side of the substrate to support the substrate as taught by Bublely et al." While we appreciate that the extractor head 80 and conveyor belt 30 of Bublely act to support articles being cured, we do not agree with the examiner's conclusion that these teachings would have suggested the provision of a support *plate* in Anderson. First, the top surface 82 of Bublely's extractor head comprises a porous surface like, for example, Bublely's baffle means 64 (column 4, lines 6-16). This construction, in our view, cannot reasonably be considered a support "plate" based on any appropriate definition of the word "plate" of which we are aware.⁵ Similarly, Bublely's endless porous conveyor belt 30 cannot reasonably be considered a support "plate" as that word is used by appellants. Accordingly, appellants' argument (brief, page 9) to the effect that

⁵We note, for example, that the word "plate" may mean "[a] flat, smooth, relatively thin, rigid body of uniform thickness" or "[a] flat piece of metal forming a machine part." *Webster's II New Riverside University Dictionary*, copyright © 1984 Houghton Mifflin Company.

Appeal No. 1998-1052
Application No. 08/683,600

neither of the applied references teach or suggest a support "plate" is well taken. Therefore, the standing rejection of claims 18, as well as claim 20 that depends therefrom, is not sustainable.

Claim 25 depends from claim 21 and adds to claim 21 that the dryer thereof includes an extractor head positioned below the travel path of the substrate for collecting and extracting moisture laden air. As noted above, Bublely pertains to a curing apparatus having a vacuum chamber 80 located below the articles to be cured. More specifically, Bublely discloses a curing device that is similar to Anderson's in that both include a radiant heat lamp assembly to cure articles (infrared or ultraviolet lamps 12' of Anderson, ultraviolet lamp 28 of Bublely) and both include a source of pressurized air that forces air past a lamp assembly to cool the lamps (fans 6 of Anderson, fans 28 of Bublely). In addition, Bublely provides a vacuum extractor 80, 82 "[whereby] ozone that is normally generated within the system is automatically withdrawn and prevented from exiting into the surrounding atmosphere" (column 4, lines 4-6).

Appeal No. 1998-1052
Application No. 08/683,600

Taking into account that Anderson may utilize ultraviolet lamps for drying and/or curing the coated substrate, it is our view that it would have been obvious to provide a vacuum extractor head of the type disclosed by Bublely in Anderson in order to achieve Bublely's stated purpose of preventing any harmful ozone from escaping into the atmosphere. In this regard, we note that one of the inherent problems associated with the use

of ultraviolet light to cure articles is that the curing apparatus outputs ozone (Bublely, column 3, lines 37-42).

Appellants argue (brief, page 9) that there is no incentive to combine Anderson and Bublely because Anderson does not disclose any concern regarding ozone. Appellants also note (brief, page 9) that in their dryer the extraction head is used to extract moisture laden air from the exposure zone, and imply that this circumstance is significant because it is not expressly taught by the references. Appellants further argue (reply brief, page 2) that Anderson uses reflectors on both sides of the web and that this construction teaches directly away from the use

Appeal No. 1998-1052
Application No. 08/683,600

of an extractor as taught by Bublely. None of the above arguments are persuasive.

As to the first argument, it is not a requirement for obviousness that the motivation to combine references be found exclusively in the primary reference. Instead, the requisite motivation to combine may stem from teachings, suggestions or inferences in the prior art *as a whole* or from the knowledge generally available to one of ordinary skill in the art. *See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). In the present case, the motivation to combine comes

from Bublely's recognition of a problem associated with the use of ultraviolet light to cure articles and with Bublely's solution to

that problem. Concerning the second argument, so long as some motivation or suggestion to combine the references is provided by the prior art taken *as a whole*, the law does not require that the references be combined for the reasons contemplated

Appeal No. 1998-1052
Application No. 08/683,600

by the inventor. *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(*en banc*), *cert. denied*, 500 U.S. 904 (1991). Here, when Anderson utilizes ultraviolet lamps to cure the substrate, the incentive to provide an extraction head to prevent the escape of ozone into the atmosphere is found in *Bubley*. Moreover, it reasonably appears that the extractor head of the modified Anderson would also collect and extract any moisture laden air, as called for in claim 25. With regard to appellants' third argument, Anderson teaches (column 1, last three lines) that the radiating structure may be used on either one side or both sides. In light of the foregoing, we shall sustain the standing § 103 rejection of claim 25.

Claim 26 requires that the dryer includes a face plate facing the radiant heat lamps. For the reasons given above in

Appeal No. 1998-1052
Application No. 08/683,600

our discussion of claim 18, the applied references do not disclose or suggest a support plate for the substrate. Accordingly, the standing § 103 rejection of claim 26, as well as claim 27 that depends therefrom, is not sustainable.

Claim 28 calls for the dryer of claim 25 to include a first extractor manifold along one side of the travel path and a second extractor manifold along the laterally opposite side of the travel path. The examiner has not explained, and it is not apparent to us, where the applied references teach or suggest this feature. Accordingly, the standing § 103 rejection of claim 28 is not sustainable.

Claim 29 is directed to a dryer comprising a dryer head positioned in facing relationship to the processed side of a substrate, a heat lamp assembly "disposed within the dryer head," and a reflector plate "disposed intermediate the dryer head and the heat lamp assembly." In that the heat lamp assembly is required to be "disposed within" the dryer head, it is not understood how the reflector plate can be "disposed intermediate" the heat lamp assembly and the component (i.e.,

Appeal No. 1998-1052
Application No. 08/683,600

the dryer head} within which the heat lamp assembly is positioned. While we might speculate as to what is meant by this claim language, our uncertainty provides us with no proper basis for making the

comparison between that which is claimed and the prior art, as we are obligated to do. Rejections based on 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejection of claim 29, as well as claim 30 that depends therefrom, under 35 U.S.C.

§ 103. We hasten to add that this reversal is not based upon any evaluation of the merits of the standing § 103 rejection of these claims as being unpatentable over the applied

Appeal No. 1998-1052
Application No. 08/683,600

references and does not preclude the examiner's advancement of a rejection predicated upon that art against a definite claim.

Claim 31 is similar to claim 25, but adds further details about the extractor head. Specifically, the extractor head is stated to include a housing having inlet port means coupled in flow communication with the exposure zone and a discharge port for exhausting air from the printing press. Clearly, Bublely's

Appeal No. 1998-1052
Application No. 08/683,600

extractor head includes inlet port means 82 and a discharge port

adjacent vacuum source 84, as called for in the claims.

Accordingly, for the reasons given in our discussion of claim

25

above, we also shall sustain the standing § 103 rejection of claim 31.

New ground of rejection

Pursuant to our authority under 37 CFR § 1.196(b), we reject claims 29 and 30 under 35 U.S.C. § 112, second paragraph, as being vague and indefinite. As explained above in our discussion of claims 29 and 30, it is not understood how the reflector plate can be disposed intermediate the heat lamp assembly and the component (i.e., the dryer head) within which the heat lamp assembly is positioned.

Summary

The rejection of claims 1, 5, 6 and 21-28 under 35 U.S.C. § 112, second paragraph, is reversed as to claims 1, 5 and 6, but is affirmed as to claims 21-28.

The rejection of claims 1 and 21-24 as being unpatentable

Appeal No. 1998-1052
Application No. 08/683,600

over Anderson is reversed as to claims 1 and 22-24, but is affirmed as to claim 21.

Appeal No. 1998-1052
Application No. 08/683,600

The rejection of claims 5, 6, 18, 20, 25-29 and 31 as being unpatentable over Anderson in view of Bublely is reversed as to claims 5, 6, 18, 20 and 26-29, but is affirmed as to claims 25 and 31.

The rejection of claim 30 as being unpatentable over Anderson in view of Bublely and Wimberger is reversed.

With respect to claims 29 and 30, we reiterate that our reversal of the § 103 rejections thereof is a procedural reversal rather than one based on the merits of these rejections.

Pursuant to 37 CFR § 1.196(b), a new ground of rejection of claims 29 and 30 has been made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of

Appeal No. 1998-1052
Application No. 08/683,600

the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

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

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

LAWRENCE J. STAAB)
Administrative Patent Judge)
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) BOARD OF PATENT
JOHN P. McQUADE)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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JOHN F. GONZALES)

Appeal No. 1998-1052
Application No. 08/683,600

Administrative Patent Judge)

LJS:hh

Appeal No. 1998-1052
Application No. 08/683,600

LOCKE, LIDDELL & SAPP, LLP
Intellectual Property Section
2200 Ross Ave., Suite 2200
Dallas, TX 75201-6776