

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLEN PETKOVSEK

Appeal No. 1999-1584
Application No. 08/579,242

ON BRIEF

Before THOMAS, LALL, and BLANKENSHIP, Administrative Patent Judges

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 to 8 and 10 to 20. Claim 9 has been canceled.

The disclosed invention is directed to a method of fully automating imaging of special service forms and affixing those forms to envelopes. Representative claim 1 is reproduced below.

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1. A method of automating imaging of a form and assembling the form on a corresponding mailpiece wherein the form effects delivery of the mailpiece by a special service, the method comprising the steps of:

providing a mailpiece requiring delivery by a special service;

inserting the mailpiece into a mailpiece handler;

scanning the mailpiece to read information located thereon;

storing data related to the mailpiece;

processing the scanned information to select corresponding imaging data from the stored data related to the mailpiece;

providing a form required to deliver the mailpiece by the special service;

imaging the imaging data onto the form; and

assembling the form with the mailpiece.

The examiner relies upon the following references:

Watson	3,968,350	Jul. 06,
	1976	
Kishi et al. (Kishi)	5,199,084	Mar. 30,
		1993
Perry et al. (Perry)	5,317,654	May 31,
		1994

Claims 1 to 7, 10, 11, 13 to 15 and 17 to 20 stand

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rejected under 35 U.S.C. § 103 as being unpatentable over Watson in view of Perry. Claims 8, 12 and 16 stand rejected as being unpatentable over Watson, Perry and Kishi.

Rather than repeat the arguments of appellant and the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have considered the rejections advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellant's arguments set forth in the brief.

We reverse.

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case

with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative

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persua-siveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147

(CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound

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rule that an issue raised below which is not argued in that court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

ANALYSIS

We consider the two combinations rejecting the claims below.

Watson and Perry

The examiner rejects claims 1 to 7, 10, 11, 13 to 15 and 17 to 20 over this combination at pages 3 to 5 of the examiner's answer. After discussing Watson and Perry individually, the examiner concludes, id. at 3, that: "[i]t would have been obvious . . . for Watson to scan a code on an envelope, as taught by Perry, to [at] least scan a code in different locations, such as an envelope." Further on, the examiner asserts, id. at 4, that:

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Watson is silent to the layout of the labels being special service forms. It would have been obvious . . . to print out labels having special service forms since it is well known in the art that address information comes in various orders, such as special service forms, . . . thus obvious to use in Watson to print addresses on special service forms.

Appellant argues, brief at page 13, that: "[t]he method and system require that a complete, automatically imaged form be provided, imaged, and assembled to the mailpiece. This teaching is nowhere provided in the art." We agree with the appellant's position. Watson is directed to selecting a preprinted label from an array of labels and cutting that label by cutting means 65 and transferring the label onto the article to be mailed at

station 48. There is no provision in Watson for reading the indicia from an article to be mailed. Perry on the other hand may be considered to be capable of scanning the information from the article to be mailed, if the article to be mailed is considered to be the "primary document." However Perry does not disclose or teach the incorporation of the information read from the primary document onto a special form which is

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then placed on the article to be mailed, i.e., an envelope. Therefore, we are not persuaded by the examiner that the combination of Watson and Perry meets the claimed limitations of claim 1.

We also agree with the appellant's position regarding the hindsight reconstruction of the claimed invention using Perry to modify Watson. See brief at page 15. We note that there is no teaching in either Perry or Watson where a mail article is required to be delivered by special delivery and, therefore, there would be no need to have a special form to accomplish the special delivery of a mail article in either system.

Therefore, we do not sustain the rejection of claim 1 over Watson and Perry.

The other two independent claims, namely, claims 10 and 15, also each contain limitations corresponding to the limitations discussed in regard to claim 1. For the same rationale, we do not sustain the rejection of the independent

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claims 10 and 15 over Watson and Perry. Consequently, we do not sustain the rejection of the dependent claims 2 to 7, 11, 13, 14 and 17 to 20 over Watson and Perry.

Watson, Perry and Kishi

Claims 8, 12 and 16 are rejected¹ as being unpatentable over Watson in view of Perry and Kishi at page 5 of the examiner's answer. Kishi is used to verify that the label is correct. Kishi, however, does not cure the deficiency noted above in the combination of Watson and Perry. Therefore, we do not sustain the rejection of claims 8, 12, and 16 over Watson, Perry and Kishi.

CONCLUSION

The decision of the examiner rejecting claims 1 to 8 and

¹ The Examiner's statement of rejection for these claims does not include Perry as one of the references relied upon, however, since these claims depend from independent claims 1, 10 and 15 in whose rejection Perry was used, the rejection of these claims must also include reliance on Perry. Therefore, we consider Perry as one of the references in this combination.

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10 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
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