

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN W. BODIE

Appeal No. 2002-2258
Application 09/134,977

ON BRIEF

Before THOMAS, HAIRSTON, and DIXON, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 15 to 19 and 21 through 27.

Representative claim 15 is reproduced below:

15. A method for controlling an inserter system to regenerate misprocessed mailpieces, comprising the steps of:

- a) identifying said misprocessed mailpiece;

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b) writing a record identifying said misprocessed mailpiece in a common data store accessible by a data processing system;

c) inputting said record to said data processing system;

d) said data processing system regenerating a control document associated with said misprocessed mailpiece in accordance with said record, said control document specifying assembly of said misprocessed mailpiece;

e) inputting said regenerated control document to said inserter system;

f) said inserter system assembling another mailpiece substantially in accordance with specifications for said misprocessed mailpiece on said regenerated control document.

The following references are relied on by the examiner:

Schneiderhan	5,067,088	Nov. 19, 1991
Baker et al. (Baker)	5,175,691	Dec. 29, 1992

In what we shall consider as a first stated rejection, claims 15, 19, 21 through 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Baker. In a second stated rejection, this reference is used to reject claims 15, 19 and 21 through 27 under 35 U.S.C. § 103. In a third stated rejection, the examiner utilizes Schneiderhan to reject under 35 U.S.C. 102(b) claims 15 through 18, 21 and 24. Schneiderhan in turn is used as the basis to reject claims 15 through 18 and 21 through 25 under 35 U.S.C. § 103. Finally, in a fifth stated

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rejection, claims 15, 19 and 21 through 27 stand rejected under 35 U.S.C. § 103 as being obvious over Baker in view of Schneiderhan.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse all rejections of the claims on appeal.

At the outset, we observe that the subject matter the examiner sets forth in the statements of the rejections beginning at page 3 of the answer does not comport with the actual subject matter of the presently identified claims on appeal.

Nevertheless, considering the five basic rejections set forth earlier, we are mindful of the examiner's positions with respect to each feature actually recited in the claims on appeal.

Each claim on appeal relates to so-called "control documents" and the regeneration of them. Each claim also relates to "mailpieces" which are defined at specification, page 1, lines 11 and 12 to mean "items intended to be delivered by a postal service or private courier service." Appellant's prior art Figure 1, as described at the middle of the specification

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page 1, identifies each group of documents shown there as a particular mailpiece to include at least control document CD, each of which includes code BC, the more complex version of which serves as a pointer to a mailpiece record which in turn contains information for controlling a physical inserter of the documents. In association with appellant's contribution in the art shown in Figure 2, element 46 comprises a printed document set discussed at specification, page 7, lines 22 to 33. Document set 46 includes control documents CD and associated documents P. Control Documents are marked with bar code pointers to mailpiece records in the same manner as discussed earlier as a part of the prior art.

The focus of the claimed invention is set forth briefly at specification, page 7, line 44 through page 8, line 3 where it is indicated that the data processing system 42 of Figure 2 is programmed with an Automatic Print Regeneration program APR which monitors a common data store 62 to "identify misprocessed mailpieces and control system 42 to regenerate the associated document set [46], including the control document for the misprocessed mailpiece." In association with the description of Figures 3A, B and C, it is noted at specification, page 9, lines 10 through 15, that the data processing system 42 generates

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document sets 46 for mailing, where each of sets 46 corresponds to a particular mailpiece and includes a control document CD and any associated pages P. Page 13, lines 1 through 7 of the specification discusses briefly the flow chart functional block element 178 (Figure 3B) which indicates that the APR program 43 causes a data processing system 42 to retrieve the original data for document sets 46 associated with misprocessed mailpieces and regenerates such document sets 46. Lines 27 through 32 of page 13 teaches that the control document can be a freight bill used to control conventional automated picking systems to assemble small items or packages to form a package for delivery.

With all of this in mind, it is apparent to us that the "control document" of the claims on appeal comprises a tangible or physical document associated with tangible, physical mailpieces in claims 15 through 19 and 21 through 26. In claim 27, the control documents relate to an assembled group instead of mailpieces per se. The systems of all claims on appeal relate to specifications or information "on" regenerated control documents as a control functionality.

As noted by appellant at the bottom of page 4 of the reply brief, specification page 5, lines 19 and 20 state "[a]s used

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herein the term regenerate as applied to control documents means reprinting or otherwise recreating control documents. . . .”

When all of this is considered in context, it is apparent that generation of the control documents as required by each claim on appeal requires the reprinting or some form of recreation of a physical or tangible document called a control document once a misprocessed mailpiece has been determined to exist.

As to the first two stated rejections of various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 relying upon Baker, appellant’s basic urging in the brief and reply brief is that Baker expressly teaches away from using control documents.

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” In re Gurley, 27 F.3d 551, 553, 21 USPQ2d 1130, 1131 (Fed. Cir. 1994). (Brackets in original.) Para-Ordnance Mfg. V. SGS Importers Int’l, 73 F.3d 1085, 1090, 37 USPQ 1237, 1241 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996).

We generally agree with this assessment of Baker. The examiner appears to clarify his position with respect to control

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documents at the bottom of page 13 of the answer where he repeats his urging that a control document is a sheet as discussed according to column 2, lines 11 through 47 of Baker in his assessment of the prior art, as well as an "electronic document" that Baker appears to discuss according to his specific teachings.

Baker's discussion of prior art control documents at column 2 is consistent with appellant's usage of the term in the disclosed and claimed invention as well as appellant's own assessment of the prior art. Baker's column 2 discussion indicates that a control document is transported from station to station of an inserter system where, at selected stations therein, pre-printed inserts may be accumulated with the control document where eventually the entire accumulated set is inserted into a preformed envelope.

On the other hand, Baker's own approach is not consistent with this in the sense of utilizing a tangible, physical control document. Consistent with the examiner's apparent view of Baker's specific teachings or contribution in the art relating to electronic control documents, the rejection cannot be sustained because of the earlier-noted requirements of the claims on

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appeal. Appellant's mention of the teachings at columns 8 and 10 of Baker at page 7 of the principal brief on appeal is well-taken. It is clear from these discussions alone that Baker does not contemplate the physical or tangible use of a control document as known in the art. The user generates, through the use of the control application program in Baker, data structures which are utilized for the actual configuration of the mailpiece discussed. The control architecture, control systems and data structures in Baker appear to us to be what the examiner regards as an electronic document. Even though Baker's discussion of Figures 10G and 10H at the top of column 15 relating to error determinations and recovery states, and further as to the statement at lines 14 and 15 that "the data structure defining the configuration for the mail run is reset . . .", this resetting or apparent regeneration of a physical control document (i.e., the data structure) is not anywhere taught in Baker to be related to a prior art control documents discussed at column 2.

In other words, the artisan within 35 U.S.C. § 102 and 35 U.S.C. § 103 would not, in our view, have considered what the examiner considers to be an electronic control document to be a control document that is reset or regenerated in accordance with

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the claims on appeal. Overall, Baker's aim is to overcome the known disadvantages of tangible control documents discussed at column 2 essentially by not using them according to his specific teachings. Therefore, as urged by appellant, Baker effectively teaches away of the use of the control documents of the types set forth in the claims on appeal. Because of this, their regeneration as set forth in the claims on appeal is not taught or otherwise contemplated or suggested in Baker as well.

In view of these findings, we cannot sustain the examiner's rejection of various claims, including each independent claim on appeal, as being anticipated by or obvious over Baker alone.

We turn next to the third and fourth stated rejections of various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 as being anticipated by or obvious over Schneiderhan alone.

To simplify our consideration of the issues with respect to this reference, we find ourselves in general agreement with the urgings of appellant at pages 8 and 9 of the principal brief and at pages 5 and 6 of the reply brief. The examiner appears to urge that the alpha-numeric sequence indicators 52 through 58 in Figure 2 of Schneiderhan correspond to the so-called control documents of the claims on appeal. We read this reference

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essentially in the same manner as noted by appellant at pages 8 and 9 of the principal brief on appeal where it appears that the system will stop automatically if there is some kind of a mismatch determined by the overall system and the operator implicitly must manually put the documents into a proper order rather than the system performing automatically any kind of regeneration of apparently misprocessed mailpieces. The misprocessing or mismatching occurs when the correct documents collected according to the alpha-numeric sequence indicators are determined to be out of sequencing order. To the extent the examiner's views may be considered to be correct that an alpha-numeric sequence indicator is some kind of a control document, there appears to be no teaching or suggestion in this reference of the regeneration of them in accordance with the requirements of the claims on appeal. As such, we must reverse the rejection of various claims on appeal as being anticipated by or rendered obvious over Schneiderhan alone.

Lastly, we consider this rejection under 35 U.S.C. § 103 of claims 15, 19 and 21 through 27 as being obvious over the combined teachings and showings of Baker in view of Schneiderhan. It should be apparent to the reader that there is thus no basis,

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in accordance with our previous discussion of these references individually, that can be found among their collective teachings and showings to have rendered obvious the subject matter of each independent claim 15, 21 and 27 on appeal. Thus, this rejection as well is reversed.

In summary, we have reversed each of the examiner's stated rejections of the claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103. Therefore, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOSEPH L. DIXON)	
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