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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRAD DAVIES and ANDREW R. ZINK

Appeal No. 2003-0063
Application No. 09/201,919

ON BRIEF

Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-17, which are all of the claims pending in the present application.

The claimed invention relates to a method and apparatus for printing postage in which print software is decoupled from print data permitting the changing and updating of print image data without requiring updating of the printer software. The print

function is partitioned between the postage meter and the print head controller with tables being used to store image and font data formats.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of printing using a postage evidencing device comprising:

(a) storing a data structure and data definitions in a nonvolatile memory, the data structure including data for generating a print image and creating a data message and the data definitions corresponding to the data for generating a print image;

(b) retrieving the data structure and the data definitions from the nonvolatile memory;

(c) processing with a microprocessor the data structure and data definitions to create the data message;

(d) sending the data message to a printer control device, the control device capable of retrieving a corresponding image in nonvolatile memory;

(e) retrieving the image corresponding to the data message from the nonvolatile memory;

(f) sending the image to a printing apparatus; and

(g) printing the image with the printing apparatus.

The Examiner relies on the following prior art:

D'Andrea et al. (D'Andrea)	5,729,461	Mar. 17, 1998
Beer et al. (Beer)	6,085,180	Jul. 04, 2000 (filed Dec. 23, 1997)

Claims 1, 2, 4, 6-9, 11, 12, and 14-17 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Beer. Claims 3, 5, 10, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beer in view of D'Andrea.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 9) and Answer (Paper No. 10) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the Beer reference does not fully meet the invention as set forth in claims 1, 2, 4, 6-9, 11, 12, and 14-17. With respect to the Examiner's obviousness rejection, we are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art

the obviousness of the invention as recited in claims 3, 5, 10, and 13. Accordingly, we reverse.

We consider first the rejection of claims 1, 2, 4, 6-9, 11, 12, and 14-17 under 35 U.S.C. § 102(e) as being anticipated by Beer. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1, 2, 7, and 8, the Examiner attempts to read the various limitations on the disclosure of Beer. In particular, the Examiner directs attention (Answer, pages 3 and 4) to the illustrations in Figures 1 and 2 of Beer along with the accompanying description beginning at column 2, line 66.

Appellants' arguments in response assert a failure of Beer to disclose every limitation in independent claims 1, 2, 7, and 8 as is required to support a rejection based on anticipation. At pages

17-19 of the Brief, Appellants' arguments focus on the contention that, unlike the present claimed invention, there is no disclosure in Beer of the processing of a stored data structure and data definitions which are used to create a data message which is sent to a printer control device.

After reviewing the Beer reference in light of the arguments of record, we are in general agreement with Appellants' position as expressed in the Brief. We find no disclosure in Beer of any processing of stored data definitions or data structure to develop a print data message, let alone the particular relationship among the data structure, data definitions, data message and print images set forth in independent claims 1, 2, 7, and 8. Although the Examiner suggests the inherency of providing data definitions to "automatically produce consistent and accurate data according to USPS specifications" (Answer, page 7), we find no evidence on the record to support such an assertion. To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however,

may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. citing Continental, 948 F.2d at 1269, 20 USPQ2d at 1749.

Further, although we do not necessarily disagree with the Examiner's generalized assertion that print data needs to be defined to produce a consistent result, such a generalization does not address the specific print data relationships recited in each of the appealed independent claims. We would also point out that, contrary to the Examiner's contention that the feature of using data structure and data definitions to create a data message is not in certain appealed claims (Answer, page 8), we find such a data creation feature in all of the independent claims.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Beer, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 2, 7, and 8, nor of claims 4, 6, 9, 11, 12, and 14-17 dependent thereon.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 3, 5, 10, and 13 based on the combination of Beer and D'Andrea, we do not sustain this rejection as well. In addressing the limitations in these

dependent claims, which are directed to a bit map image feature, the Examiner looks to D'Andrea to remedy this deficiency in Beer (Answer, page 5). For all of the reasons discussed supra, however, the Examiner has failed to establish a prima facie case of obviousness since we find no teaching or suggestion in D'Andrea that would overcome the innate deficiencies of Beer in disclosing the particular claimed relationship of stored data structure and data definitions that are used for the creation of data messages, a feature present in each of independent claims 1, 2, 7, and 8.

In summary, we have not sustained either of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-17 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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