

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARK BRESNAN and JAMES M. VALOVICH

Appeal No. 2003-1606
Application No. 09/289,901

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 6, 13 and 14, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claims 1 and 13 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a router instruction processor for use in a digital document delivery system and method (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 6, 13 and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,963,925² to Kolling et al. (Kolling).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied patent to Kolling, and to the respective positions articulated by the appellants and the examiner.³ As a consequence of our review, we conclude that claims 1 to 6, 13 and 14 are not anticipated by Kolling for the reason which follows.

To support a rejection of a claim under 35 U.S.C. § 102(e), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713

² Issued October 5, 1999.

³ The position advanced by the examiner regarding this rejection is set forth in the answer (Paper No. 13, mailed January 14, 2003). The appellants' argument against this rejection is set forth in the brief (Paper No. 10, filed October 28, 2002) and reply brief (Paper No. 14, filed January 31, 2003).

F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

We have reviewed the disclosure of Kolling, especially those portions cited by the examiner in the answer, but failed to find therein any teaching of either (1) a Send Request object containing both a Recipient Preferences element and a Sender Requirements element as set forth in claims 1 to 6, 13 and 14; or (2) any means or step to override the Recipient Preferences element instructions to the extent that these instructions are in conflict with the requirements of the Sender Requirements element as set forth in claims 1 to 6, 13 and 14. Thus, we find ourselves in full agreement with the appellants' argument that Kolling does not disclose all the claimed elements recited in the independent claims on appeal (i.e., claims 1 and 13).

While there is much in common between the claimed subject matter and the teachings of Kolling, as pointed out by the examiner, Kolling does not teach either of the above-noted claimed elements. In that regard, the examiner has not identified, and we have not found, any element in Kolling readable on the Send Request object containing both a Recipient Preferences element and a Sender Requirements element as set forth in claims 1 to 6, 13 and 14. While Kolling does permit the consumer financial institution to present various methods of communications to the consumer and then permit the

consumer to choose one of those methods of communications, Kolling does not disclose a Send Request object containing both a Recipient Preferences element and a Sender Requirements element. Likewise, while Kolling does have a paper option field⁴ which indicates whether a biller still desires to send paper statements through the mail to various of its customers, Kolling does not disclose that this paper option field overrides the Recipient Preferences element instructions contained within the Send Request object.

For the reasons set forth above, the claims 1 to 6, 13 and 14 are not anticipated by Kolling. Accordingly, the decision of the examiner to reject claims 1 to 6, 13 and 14 under 35 U.S.C. § 102(e) is reversed.

⁴ A "no" value in this field indicates that the biller does not wish to continue sending paper statements to its customers, and desires to send electronic statements. A "yes" value in this field indicates that the biller still sends paper statements to various of its customers.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 13 and 14 under 35 U.S.C. § 102(e) is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2003-1606
Application No. 09/289,901

Page 6

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