

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

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte BERTRAND J. HAAS

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Appeal No. 2006-1279  
Application No. 10/249,005

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ON BRIEF

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Before THOMAS, KRASS, and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, which constitute all the claims pending in this application.

Appeal No. 2006-1279  
Application No. 10/249,005

The disclosed invention pertains to a system and method for safe mail transmission by reading information from a document from within a protective enclosure. Specifically, the invention involves decontaminating the document's protective enclosure, illuminating the protective enclosure, and detecting an image of the document's content. The content's image may be sent electronically or in hard copy form to the recipient.

Representative claim 1 is reproduced as follows:

1. A method for reading information from a document from within a protective enclosure comprising:

receiving the protective enclosure from a delivery service;

decontaminating the protective enclosure received from the delivery service;

placing the protective enclosure in a detector;

illuminating the protective enclosure using an illuminating source;

detecting the entire document content using a detector sensor;

printing a new hard copy of the entire document using the detector sensor;

transmitting the document content to a recipient; and

sending the new hard copy document to the recipient.

Appeal No. 2006-1279  
Application No. 10/249,005

The examiner relies on the following references:

Berson	5,288,994	Feb. 22, 1994
Fink et al. (Fink)	6,750,461	Jun. 15, 2004 (filed Oct. 2, 2002) <sup>1</sup>
Gilpatrick	4,813,062	Mar. 14, 1989

The following rejections are on appeal before us:

1. Claims 1-4 and 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berson in view of Fink.

2. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Berson in view of Fink and further in view of Gilpatrick.

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

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the prior art rejection. We have, likewise, reviewed and taken into

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<sup>1</sup> The patent claims benefit from U.S. provisional application 60/330,358, filed Oct. 18, 2001, and U.S. provisional application 60/326,868, filed Oct. 3, 2001.

Appeal No. 2006-1279  
Application No. 10/249,005

consideration, in reaching our decision, the appellant's 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 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 set forth in claims 1-3 and 9. We reach the opposite conclusion, however, with respect to claims 4-8. Accordingly, we affirm-in-part.

We first consider the rejection of claims 1-4 and 6-9 under 35 U.S.C. § 103(a) based on Berson and Fink. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to

make the factual determinations set forth in Graham v. John Deere

Appeal No. 2006-1279  
Application No. 10/249,005

Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior

art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in

Appeal No. 2006-1279  
Application No. 10/249,005

the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

Appeal No. 2006-1279  
Application No. 10/249,005

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

As an initial matter, appellant argues that the secondary reference to Fink does not qualify as prior art because the examiner did not provide a copy of the underlying provisional applications to support entitlement to its earlier filing date [brief, page 7]. The examiner responds by citing a memorandum from then-Deputy Commissioner Stephen Kunin dated Oct. 29, 2004 that ended the transitional practice of supplying copies of provisional applications relied upon to give prior art effect under 35 U.S.C. § 102(e) in view of their public availability via the USPTO's Public PAIR (Patent Application Information Retrieval) system [answer, page 4].

We agree with the examiner. Recent enhancements to Public PAIR have obviated the need to supply copies of provisional

Appeal No. 2006-1279  
Application No. 10/249,005

applications relied upon to give prior art effect under 35 U.S.C. § 102(e) to references applied in rejections. In a notice published in the USPTO's Official Gazette on Nov. 23, 2004, Stephen G. Kunin, then-Deputy Commissioner for Patent Examination Policy, stated the following:

Due to the recent enhancement to Public PAIR, the Office has ended the transitional practice of supplying with Office actions a copy of any provisional application relied upon to give prior art effect under 35 U.S.C. 102(e) to a reference applied in a rejection. The purpose of the transitional practice, which began in December of 2003, was to make it easier for applicants to see the contents of such provisional applications. Now that such provisional applications can be viewed and/or printed using the Public PAIR website, the transitional practice is no longer needed.

See "Most Publicly Available Provisional Applications Can Now be Viewed Over the Internet," 1288 Off. Gaz. Pat. Office 169 (Nov. 23, 2004).

For U.S. patents that properly claim benefit under 35 U.S.C. § 119(e) to a provisional application, the critical reference

Appeal No. 2006-1279  
Application No. 10/249,005

date under 35 U.S.C. § 102(e) is the filing date of the provisional application if the provisional application properly supports the subject matter relied upon to make the rejection in accordance with 35 U.S.C. § 112, first paragraph. MPEP § 2136.03(III). See also MPEP § 706.02(V) (D).

Once the examiner prima facie established that the Fink reference qualified as prior art under 35 U.S.C. § 102(e), the burden then shifted to appellant to show why the reference did not qualify as prior art under that section (i.e., why the subject matter relied upon in Fink was not entitled to the filing date of its underlying provisional application). Apart from arguing that a copy of the provisional application of Fink was not provided, appellant did not provide any evidence showing why the reference was not otherwise entitled to its earlier filing date. As noted above, the examiner was not required to provide a copy of the underlying provisional application to establish

Fink's earlier filing date. Accordingly, on the record before us, the Fink reference is entitled to its earlier filing date and

Appeal No. 2006-1279  
Application No. 10/249,005

therefore qualifies as prior art under 35 U.S.C. § 102(e).

Turning to the merits of the rejection, the examiner essentially argues that Berson discloses all of the subject matter of claims 1-4 and 6-9 except for decontaminating the mail [answer, page 3]. The examiner cites Fink as teaching decontaminating mail to protect against chemical and biological agents. The examiner finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Fink with the mail reading apparatus of Berson "to protect mail handlers, readers and others from danger such as terrorism" [answer, pages 3 and 4].

Appellant argues that the cited references do not teach detecting the entire document content using a detector sensor as claimed [brief, page 10, emphasis added]. Appellant notes that Berson does not teach reading the entire content of the document

because the envelope is not opened when read, but opened later [brief, page 10]. The examiner responds that Berson's repeated

Appeal No. 2006-1279  
Application No. 10/249,005

references to "the content" of the sealed envelope throughout the patent reasonably suggests that the envelope's entire content is detected -- not just portions of the content [answer, pages 3, 6, and 7, emphasis added].

We will not sustain the examiner's rejection of claims 1-3 and 9. We disagree with the examiner that Berson teaches or suggests detecting the entire document content using a detector sensor as claimed in independent claims 1 and 9.

Berson teaches directing a light source through a sealed envelope and detecting printed matter 42 on an insert in the envelope with an optical detector. Printed matter is in the form of a shape, code, or an address block [Berson, col. 3, lines 39-49 and Fig. 2]. Following detection, image detector and analysis system 28 then determines whether a predetermined form, code, or address block was detected. In one embodiment, a printer is controlled to print the address on the sealed envelope that matches the address on the envelope's contents [Berson, col. 3, line 65 - col. 4, line 7]. In another embodiment, the image

detector and analysis system determines whether the envelope's contents represent a check, a reply, or an urgent message based

Appeal No. 2006-1279  
Application No. 10/249,005

upon the code or form printed thereon. If such priority mail is determined, the mail piece is outsourced accordingly for more rapid handling [Berson, col. 4, lines 8-18].

In either embodiment, Berson's detection of (1) a predetermined form, code, or address block, or (2) the code or form printed on a check, reply, or urgent message hardly guarantees detection of the entire document content as claimed. Rather, Berson's system determines the type of document based on certain information on the document -- not necessarily the entire document content. In short, the examiner's contention that Berson detects the entire document content is, at best, a strained reading of Berson and therefore speculative on the record before us.

Furthermore, we fail to see how the system of Berson could detect the entire document content and print a new hard copy of the entire document if the document within the sealed envelope is folded such that the document's text is superimposed. On the

other hand, we can envision Berson's system detecting relevant portions of the content such as forms, codes, address blocks,

Appeal No. 2006-1279  
Application No. 10/249,005

etc. to distinguish high priority mail as taught in the reference even when the document within the envelope is folded.

Core factual findings in patentability determinations must point to some concrete evidence in the record to support the findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). In addition, obviousness rejections must be based on evidence comprehended by 35 U.S.C. § 103. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (emphasis added). See also In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.").

On this record, the examiner's finding that Berson detects the entire document content using a detector sensor is speculative and therefore lacks sufficient evidentiary support.

Because independent claims 1 and 9 both recite detecting the entire document content with a detector sensor, we will not

Appeal No. 2006-1279  
Application No. 10/249,005

sustain the examiner's rejection of those claims as well as claims 2 and 3 dependent on claim 1.

We reach a different conclusion, however, with respect to independent claim 4. Unlike independent claims 1 and 9, claim 4 does not require detecting the entire document content. Rather, claim 4 merely calls for, in relevant part, (1) an illuminating source for illuminating the entire document in the protective enclosure, (2) an image detector for receiving illumination from the illuminating source, (3) a printer for printing a new hard copy version of the document (emphasis added), and (4) an image transmitter for transmitting a detected document to a recipient.

We first note that the examiner rejected claim 4 on the same grounds as claims 1 and 9 [answer, page 7]. Appellant did not separately argue the limitations of claim 4, but merely underlined certain limitations of the claim in connection with the argument pertaining to claim 5 [brief, page 12]. By not

separately arguing the limitations of claim 4, appellant has not persuasively rebutted the examiner's prima facie case of

Appeal No. 2006-1279  
Application No. 10/249,005

obviousness.

Nevertheless, all of the limitations of claim 4 fully read on Berson except for the decontamination system. We first note that Berson's system is capable of illuminating the entire document within the envelope even if the document is folded. Also, the printer of Berson that prints the address and other information on the mail piece is capable of printing a "new hard copy version" of the document given the limitation's broadest reasonable interpretation. In short, printing a new hard copy version of a document does not necessarily require printing the entire document content, but rather merely a new version of the document that could include differing amounts of the original document content. Thus, a new version of the document could be merely a portion of the document's content, such as the address or other information on the mail piece as taught by Berson.

Furthermore, the image transmitter of Berson is capable of transmitting a detected document to a recipient as claimed given the term's broadest reasonable interpretation. We agree with the examiner that the term "recipient" does not necessarily mean

"addressee," but includes "any person, company, agency, or other entity that receives the content" [answer, page 5]. Moreover,

Appeal No. 2006-1279  
Application No. 10/249,005

the image analysis capabilities of Berson that include the optical detector, image detector and analysis system, and interface reasonably suggest the image transmitter limitation of claim 4.

Although Berson does not disclose a decontamination system, we agree with the examiner that Fink is reasonably combinable with Berson for the reasons stated by the examiner [see answer, pages 3 and 4]. We note that the examiner has cited ample motivation to combine Fink with Berson on Pages 4 and 6 of the answer. We agree with the examiner that the skilled artisan would have reasonably relied on Fink for the teaching of decontaminating mail in the mail handling system of Berson. The examiner's obviousness rejection of claim 4 is therefore sustained.

Furthermore, since appellant has not separately argued the patentability of dependent claims 6-8, these claims fall with independent claim 4. The rejection of claims 6-8 is therefore sustained.

We now consider the rejection of claim 5 under 35 U.S.C. § 103(a) based on Berson, Fink, and Gilpatrick. The examiner essentially finds that the claim differs from Berson and Fink in calling for the use of soft x-rays. The examiner cites

Appeal No. 2006-1279  
Application No. 10/249,005

Gilpatrick as teaching forming x-ray readable information on a substrate that is later concealed and detected with an x-ray system. The examiner finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to use x-rays in the device of Berson to enable reading a document through almost any envelope or package [answer, page 4]. Appellant responds that Gilpatrick is non-analogous art and not properly combined [brief, pages 8 and 12].

"Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." In re Bigio, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004). See also In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); and In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

In determining the appropriate scope of the field of the inventor's endeavor, we must refer to "the invention's subject

Appeal No. 2006-1279  
Application No. 10/249,005

matter in the patent application, including the embodiments, function and structure of the claimed invention." Bigio, 381 F.3d at 1325, 72 USPQ2d at 1212. Furthermore, we must assess the level of ordinary skill in the art and consider "the reality of the circumstances—in other words, *common sense*—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." Id. at 1326, 72 USPQ2d at 1212 (quoting In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992) (emphasis in original)). Ultimately, we "must consider the 'circumstances' of the application—the full disclosure—and weigh those circumstances from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor." Id. at 1326, 72 USPQ2d at 1212-13.

The disclosed invention includes an x-ray illuminating source 42 and an x-ray detector 44 that uses x-ray properties

Appeal No. 2006-1279  
Application No. 10/249,005

to contrast the markings 12, 14 with the substrate 10, envelope 18, and protective enclosure 20. The detected image is then sent in electronic form or printed [see Fig. 1 and specification, ¶ 0016].

Gilpatrick relates to marking objects that are later inspected using x-ray techniques, such as textile substrates, yarns, or other objects, to locate defects or identify components that are otherwise difficult or impossible to detect visually [Gilpatrick, col. 1, lines 4-12]. Gilpatrick notes that manufactured fabric or yarn is typically wound on rolls and marked during the inspection process. The marks on all but the outermost portion of the rolls are hidden from view [Gilpatrick, col. 3, lines 11-26]. Detection of these otherwise undetectable marks is made possible by directing x-rays through the object using a conventional x-ray device and examining the resulting x-ray images on a video display [id.; col. 3, line 55 - col. 4, line 5].

We conclude that Gilpatrick is in the same field of endeavor as the invention. Both the claimed invention and Gilpatrick

Appeal No. 2006-1279  
Application No. 10/249,005

pertain to identifying markings on articles that are concealed from view by directing radiant energy through the article and detecting images of the concealed markings. The structural and functional similarities of Gilpatrick to the claimed invention would reasonably lead the skilled artisan -- an electrical engineer with substantial industry experience -- to consider marker detection systems using x-rays such as the system disclosed by Gilpatrick.

But even if Gilpatrick was somehow not in the same field of endeavor, the reference's teachings are nevertheless reasonably pertinent to the inventor's problem -- namely illuminating an object with x-rays to detect markings on the object that are hidden from view. The skilled artisan would reasonably refer to the teachings of Gilpatrick when confronted with the problem of detecting hidden markings on objects using x-rays. The reference therefore constitutes analogous art. Moreover, we agree with the examiner that the skilled artisan would reasonably rely on the

teachings of Gilpatrick in utilizing an x-ray source in Berson's device essentially for the reasons stated by the examiner. The

Appeal No. 2006-1279  
Application No. 10/249,005

examiner's rejection of claim 5 is therefore sustained.

In summary, we have not sustained the examiner's rejection with respect to claims 1-3 and 9 on appeal. We have, however, sustained the examiner's rejection with respect to claims 4-8. Therefore, the decision of the examiner rejecting claims 1-9 is affirmed-in-part.

Appeal No. 2006-1279  
Application No. 10/249,005

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
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Appeal No. 2006-1279  
Application No. 10/249,005

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