

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

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7 UNITED STATES PATENT AND TRADEMARK OFFICE

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10 BEFORE THE BOARD OF PATENT APPEALS
11 AND INTERFERENCES

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14 *Ex parte* RONALD P. SANSONE,
15 ROBERT A. CORDERY, and DONALD G. MACKAY

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18 Appeal No. 2007-0678
19 Application No. 09/818,792
20 Technology Center 3600

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23 Decided: March 27, 2007

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26 Before TERRY J. OWENS, ANITA PELLMAN GROSS, and
27 ROBERT E. NAPPI *Administrative Patent Judges*.

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29 NAPPI, *Administrative Patent Judge*.

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32 DECISION ON APPEAL

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34 This is a decision on appeal under 35 U.S.C. § 134 of the final
35 rejection of claims 1 through 35. For the reasons stated *infra* we will not
36 sustain the Examiner's rejection of these claims.

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INVENTION

The invention is directed to a method of notifying people that they will receive letters or packages prior to physical delivery. See page 3 of Appellants' specification. Claim 1 is representative of the invention and reproduced below:

1. A method that enables a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail delivered, said method comprises the steps of:

depositing by a sender with the carrier mail containing the recipient's name and physical address and a sender's name and address;

capturing by the carrier the name and physical address of the recipient and the sender in the form of an image;

transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumerics;

translating by a data center the name and physical address of the recipient into an e-mail address;

notifying by the data center to the recipient of the expected delivery of the deposited mail and indicating the selected alphanumerics of the translated image;

notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered;

notifying by the data center to the carrier of the manner in which the recipient wants the mail delivered; and

delivering mail by the carrier to the recipient in the manner specified by the recipient to the carrier.

REFERENCES

The references relied upon by the Examiner are:

Higgins US 5,754,671 May 19, 1998

Smith (Smith '808) US 2002/0042808 A1 Apr. 11, 2002
(effectively filed Sep. 29, 2000)

Smith (Smith '306) US 2002/0095306 A1 Jul. 18, 2002
(effectively filed Sep. 29, 2000)

REJECTION AT ISSUE

Claims 1 through 35 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Smith ('306 or '808) in view of Higgins. The Examiner's rejection is set forth on pages 3 through 6 of the Answer. Throughout the opinion we make reference to the Brief (filed May 10, 2006), and the Answer (mailed July 7, 2006) for the respective details thereof.

ISSUES

Appellants contend that the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103 (a) is in error. Appellants argue on page 18 of the brief:

Appellants do not claim a method in which a sender printed personal ID code is added to each mailpiece, and the ID code is captured by the post. Appellants claim a method in which the carrier captures the name and physical address of the recipient and sender in the form of an image and the translation by a data center of the name and physical address of the recipient into an e-mail address.

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1 The Examiner contends that the rejection is proper and states on page
2 6 of the Answer:

3 Smith et al. does include the essential method steps of capturing',
4 transmitting', translating', and notifying to enable a recipient to inform
5 a carrier of the manner in which the recipient wants some or all of
6 their mail. Furthermore, the appellant never expressly claims a
7 particular approach (e.g. using the user ID or not requiring the ID) to
8 capture the mail piece to patentably distinguish from the prior art.
9 Accordingly, the difference between the appellant's invention and
10 Smith et al, would be obvious.

12 Thus, the contentions present us with two issues a) is the scope of
13 claim 1 limited to using a particular ID code and if so b) does Smith teach or
14 suggest the claimed ID code.

FINDINGS OF FACT

16 Smith ('306) teaches a mail tracing and tracking system. See abstract.
17 A user of the system accesses a web page and is able to see mail or packages
18 that are to be delivered to the user. The user can also obtain information
19 about the mail or packages. See figure 3 and paragraph 0010. The system
20 allows a user to see an image of the mail; the image may be created by
21 scanning the mail by the Post Office. See figure 6 and paragraph 0038.
22 Smith ('306) teaches that the additional information displayed to the user is
23 supplied directly from the sender through machine readable code, pre-coded
24 delivery labels, or electronic mailings. See paragraph 0040. The system
25 makes use of a database which links user physical address, e-mail, and user
26 ID. See paragraph 0049. The user ID is used by the system to identify the
27 user and provides access to the system. See paragraph 0054. Smith ('306)

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1 incorporates by reference the disclosure of Smith ('808). See paragraph
2 0020.

3 Smith ('808) discloses that the tracking system can be used to perform
4 selected actions with the mail such as change delivery method or location.
5 See paragraph 0015. Further, Smith ('808) teaches that the system can use
6 identifiers other than physical address of the user to determine the identity of
7 the individual to whom the letter or package is destined. Smith ('808)
8 discusses addressing physical letters using an identifier such as an e-mail
9 address; this address can then be correlated with the individual's current
10 physical address. See paragraph 0025. Further, Smith ('808) teaches that
11 the identifiers can be machine read from the letter, and the current physical
12 address is then printed on the letter for physical delivery. See paragraphs
13 0026 and 0027. We find no discussion in Smith ('808) of scanning in a
14 physical address and translating it to an e-mail address.

15 Higgins teaches a system for recognition of an address on a letter
16 which has been hand written in cursive. See abstract. We find no discussion
17 in Higgins of scanning a physical address and translating it to an e-mail
18 address.

19 PRINCIPLES OF LAW

20 Office personnel must rely on Appellants' disclosure to properly
21 determine the meaning of the terms used in the claims. *Markman v.*
22 *Westview Instruments, Inc.*, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed.
23 Cir. 1995). “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be
24 confused with adding an extraneous limitation appearing in the specification,
25 which is improper.’” (emphasis original) *In re Cruciferous Sprout*

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1 *Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002)
2 (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.*, 12 USPQ2d 1474,
3 1476 (Fed. Cir. 1989)

ANALYSIS

Independent claim 1, recites “capturing . . . the name and physical address of the recipient and the sender in the form of an image . . . the image is processed by translating the image consisting of text and graphics to selected alphanumerics . . . translating by a data center the name and physical address of the recipient into an e-mail address.” Thus, we find the scope of claim 1 includes that an image of the letter which contains a physical address is captured, and the physical address is translated into an e-mail address.

12 As discussed *supra*, we do not find that either of the Smith references
13 teaches translating a physical address to an e-mail address, nor do we find
14 that Higgins teaches this step.

CONCLUSION

16 We consider the Examiner’s rejection under 35 U.S.C. § 103(a) to be
17 in error as we do not find that the combination of the references applied by
18 the Examiner teaches all of the limitations of independent claim 1.
19 Accordingly we will not sustain the Examiner’s rejection of independent
20 claim 1 or dependent claims 2 through 35 under 35 U.S.C. § 103(a).

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1 ORDER

3 For the forgoing reasons, we will not sustain the Examiner's
4 rejections of claims 1 through 35, under 35 U.S.C. § 103. The decision of the
5 Examiner is reversed.

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REVERSED

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vsh

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