UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILLES NAUCHE

Appeal 2007-0933
Application 10/310,733
Technology Center 2800

Decided: November 26, 2007

Before HUBERT C. LORIN, ANITA PELLMAN GROSS, and JENNIFER D. BAHR, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellant filed a Request for Reconsideration (Jun. 25, 2007) of the Decision on Appeal (mailed Apr. 25, 2007).

In the Decision on Appeal, the Board affirmed a rejection of claims 1-6 under 35 U.S.C. § 103 (a) over Bresnan (U.S. Patent No. 5,873,073) in view of Bucci (U.S. Patent No. 5,655,089).

In the Request for Rehearing, Appellant argued that there is no motivation to combine the disclosures of Bresnan and Bucci because (1) "the combination would be unsatisfactory as intended" (p. 3) and (2) the "Bucci reference teaches away from the combination" (p. 4). We find the arguments unpersuasive as to error in the decision.

DISCUSSION

"The combination would be unsatisfactory as intended"

Appellant argued that the element in the claim which calls for "means upstream of the printer to select the process for franking the cover by recto-verso printing the documents at will based upon the threshold determination" is not taught in the combination of Bresnan and Bucci. (Req. 3). This argument was made in the original brief and we responded by finding that "one of ordinary skill in the art would understand that if, as Bresnan discloses, the initiating node includes a means for the system operator to select whether to print a document on one or two sides, then the system operator is in a position to decide, at will, whether to recto-verso print documents on the recto-verso capable printer. (Decision 7). We further stated:

> Given that the Bresnan printer is capable of recto-verso printing a document at will, it is necessarily capable of recto-verso printing a document if the determination is made to do so. One of ordinary skill in the art reading Bresnan would foresee the system operator determining to recto-verso print documents on the printer for any number of reasons. Among the conventional reasons for recto-verso printing a document is to fit more text on a set number of pages. [ ].
>
> Another reason, one suggested by Bucci, is to reduce the cost of mailing a document. The Bucci passage the Examiner relied upon to

> overcome the difference between Bresnan and the claimed invention evidences the common knowledge that mail is priced according to weight, with each succeeding incremental weight representing a postal threshold. [ ]. Bucci indicates that, in the context of mailing monthly bills and statements, the postal threshold is "now between 23 [cents] and 29 [cents] depending upon the class of mail" (Bucci, col. 1, ll. 29-30) and a "1 oz. [rate]" (Bucci, col. 1, l. 42). Bucci also indicates that, with respect to mailing monthly bills and statements, "[a]nalysis has also revealed that these types of mailings produce an unnecessary expense for postage … " (Bucci, col. 1, ll. 31-33). As one solution to this problem, Bucci suggests "by printing on both sides of said sheet, one can effectively transmit by hard-copy mail 10 pages of information in a single 1 oz. mailing" (Bucci, col. 1, ll. 39-41). One of ordinary skill in the art reading Bucci would understand that in order not to exceed a given postal threshold value one can retro-verso print a document and thus keep the weight of the document below the postal threshold value. (Decision 7-8).

Appellant challenged this reasoning on the ground that the proposed combination, i.e., Bresnan and Bucci, "would be unsatisfactory." (Req. 2). "In Bresnan '073, there are optional inserts such as FIG 5C. Accordingly, it would not be possible to determine postal rates based upon simplex or duplex printing of the main document." (Req. 2). According to Appellant, "Bresnan '073 teaches optional inserts at FIG 5C that would affect total envelope weight and thus franking calculations, so it does not follow that the referenced element is inherent and known in the combination. It would not be possible to estimate postage based upon a hypothetical decision to select duplex printing." (Req. 3-4). However, as Appellant appeared to recognize, Bresnan's inserts are optional and thus they would not impede one of ordinary skill from conducting recto-verso printing of documents to meet a postal threshold.

The question is simply whether the combination of Bresnan, which teaches recto-verso printers, and Bucci, which teaches postal thresholds, would lead one of ordinary skill to the claimed franking by recto-verso printing documents based upon a threshold determination. We see nothing in the references which would lead one of ordinary skill *not* to frank by recto-verso printing documents based upon a threshold determination. We find instead that one of ordinary skill with Bresnan in hand has only two options, to print single-sided or print recto-verso. Given the knowledge that postal thresholds exist (i.e., Bucci), "[o]ne of ordinary skill in the art reading Bucci would understand that in order not to exceed a given postal threshold value one can retro-verso print a document and thus keep the weight of the document below the postal threshold value." (Decision 8).

> When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007).

We have carefully considered the arguments that Appellant has set forth under the topic of the combination being unsatisfactory as intended (Req. 2-4) but, for the foregoing reasons, do not find them persuasive as to error in the decision to affirm the rejection of the claims under 35 U.S.C. §103(a) over Bresnan in view of Bucci.

"Bucci reference teaches away from the combination"

Appellant argued that "Bucci '089 does not teach or suggest a decision to apply duplex printing for documents exceeding 5 pages as suggested by the Examiner. Rather, Bucci '089 teaches the use of duplex printing in all cases and teaches away from single sided printing for environmental reasons." (Req. 4).

The argument is unpersuasive because (a) the claim is not limited so as to require the documents to exceed 5 pages and thus that part of the argument is not commensurate in scope with what is claimed, *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982), and (b), in conceding that Bucci teaches recto-verso printing, Appellant necessarily agreed with the Board's position that Bucci suggests printing both sides of a document. To the extent Appellant meant to argue that Bucci's promotion of double-sided over single-sided printing teaches away from conducting a prior step of *selecting* double-sided over single-sided printing, a reference does not teach away from a conclusion of obviousness simply because it shows the claimed alternative to be less desirable. *Cf. In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

We have carefully considered the arguments that Appellant has set forth under the topic of Bucci teaching away from the combination (Req. 4-5) but, for the foregoing reasons, do not find them persuasive as to error in the decision to affirm the rejection of the claims under 35 U.S.C. §103(a) over Bresnan in view of Bucci.

CONCLUSION

Appellant's arguments have been considered but we find them unpersuasive as to error in affirming the rejection of claims 1-6 under 35 U.S.C. § 103 (a) over Bresnan in view of Bucci.

DENIED

JRG

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000