

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD P. SANSONE

Appeal 2007-2446
Application 09/817,998
Technology Center 3600

Decided: October 31, 2007

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

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) (2002) of the final rejection of claims 1 through 12 and 15 through 27. For the reasons stated *infra*, we affirm in part the Examiner's rejection of these claims and we enter a new rejection of claim 22.

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 Appellant's 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 would like the mail delivered, said method comprises the steps of:
 - depositing with the carrier mail containing the recipient's name and physical address and the sender's name and address;
 - capturing 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 alphanumerics;
 - translating the name and physical address of the recipient into a telephone number;
 - utilizing the telephone number of the recipient and the translated image alphanumerics to inform the recipient of the expected delivery of the deposited mail via a tactile communication device;
 - notifying the carrier of the manner in which the recipient would like the mail delivered;
 - delivering mail to the recipient in the manner specified by the recipient to the carrier; and
 - charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.

REFERENCES

The references relied upon by the Examiner are:

McKeen	US 4,037,956	Jul. 26, 1977
Lynt	US 5,636,038	Jun. 3, 1997

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Srinivasan	US 6,072,862	Jun. 6, 2000
Gordon	US 6,289,323, B1	Sep. 11, 2001 (filed Jun. 18, 1999)
Busch	US 6,390,921 B1	May 21, 2002 (filed Feb. 7, 2000)
Kuebert	US 2002/0165729 A1	Nov. 7, 2002 (filed Oct. 15, 2001)
Sherwood	US 6,542,584 B1	Apr. 1, 2003

REJECTIONS AT ISSUE

Claims 1 through 11, 15 through 16, 19 through 21, and 23 through 25 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kuebert in view of Lynt and Srinivasan. The Examiner's rejection is set forth on pages 3 through 6 of the Answer.

Claim 12 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kuebert in view of Lynt, Srinivasan, and Sherwood. The Examiner's rejection is set forth on page 6 of the Answer.

Claim 17 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kuebert in view of Lynt, Srinivasan, and McKeen. The Examiner's rejection is set forth on pages 6 and 7 of the Answer.

Claim 18 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kuebert in view of Lynt, Srinivasan, and Gordon. The Examiner's rejection is set forth on page 7 of the Answer.

Claim 22 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kuebert in view of Lynt, Srinivasan, and Busch. The Examiner's rejection is set forth on pages 7 and 8 of the Answer.

Throughout the opinion, we make reference to the Brief (received September 14, 2006), and the Answer (mailed December 1, 2006) for the respective details thereof.

ISSUES

Rejection of claims 1 through 11, 15 through 16, 19 through 21, and 23 through 25 stand rejected under 35 U.S.C. § 103 (a).

Appellant asserts that the combination of the references does not teach the claimed step of charging the recipient for delivering the mail in the manner specified by the recipient to the carrier. (Br. 12). Appellant also argues that the cited patents do not teach that the telephone number of the recipient and the translated image alphanumeric are used to inform the recipient of the expected delivery of the deposited mail via a tactile communications device. Finally, Appellant argues that the Examiner has not explained why the skilled artisan would make the combination.

In response to the Appellant's first point, the Examiner finds that Kuebert teaches that the recipient communicates instructions to the carrier, directed to a new delivery point. (Answer 8). Further, the Examiner states:

As per "charging the recipient" per se, Srinivasan was applied for this feature. Specifically, Srinivasan teaches said method and system for adaptable message delivery, wherein the term "subscriber" suggests charging the recipient for delivering mail to the recipient (column 2, lines 37-58). Merriam-Webster's Collegiate Dictionary defines the term subscription as: "an arrangement for providing, receiving, or

making use of something of a continuing or periodic nature on a *prepayment plan*" (10th ed., Page 1173).
(Answer 9).

In response to the Appellants second point, the Examiner states:

In response to this argument the Examiner points out that Kuebert et al. teach that mail items are scanned by a camera (120) (Fig. 1) to obtain an image of the mailing label, which is then translated by a pattern recognition device (125) to create a database entry including a recipient's name, delivery point and notification channels for communicating with the recipient, such as a recipient's telephone number [0022]; and utilizing the telephone number of the recipient to inform the recipient of the availability of the deposited mail [0036].
(Answer 9-10).

Further, the Examiner finds that Lynt teaches a system where a Braille reader is connected to a telephone for providing tactile representations of speech. (Answer 10).

In response to Appellant's third point, the Examiner states:

The motivation to combine Kuebert et al. with Lynt et al. to include utilization of a tactile communication device for communication with a customer would be to advantageously allow a visually or hearing impaired person to communicate with other persons, businesses or information channels, thereby obtaining information about the world around them that a hearing or sighted person would ascertain through hearing or vision, as specifically stated in Lynt et al. (column 1, lines 43-46; column 2, lines 56-59). And the motivation to combine Kuebert et al. and Lynt et al. with Srinivasan to include charging the customer for delivering mail to the customer would be generating funds for the business to operate.
(Answer 10-11).

Thus, Appellant's contentions present us with three issues.

- a) Whether the Examiner erred in finding that the combination of the references teaches the claimed step of charging the recipient for delivering the mail in the manner specified by the recipient to the carrier.
- b) Whether the Examiner erred in finding that the cited patents teach utilizing the telephone number of the recipient and the translated image alphanumerics to inform the recipient of the expected delivery of the deposited mail via a tactile communications device.
- c) Whether the Examiner erred in holding that the skilled artisan would combine the features of the references.

Rejection of claim 12 under 35 U.S.C. § 103 (a).

Appellant argues, on page 13 of the Brief that the Examiner's rejection of claim 12 is in error. Appellant reasons that:

Sherwood discloses a system in which the arrival of voice mail messages is available in business services for an extra fee. Kuebert, et al., Lynt, et al., Srinivasan and Sherwood do not disclose or anticipate a method in which a recipient is charged for receiving notification of the availability of deposited mail (letters and/or packages).
(Brief 13).

The Examiner responds on page 11 of the Answer, stating that the combination of Kuebert, Lynt, and Srinivasan teaches a method of flexible mail delivery and that Sherwood teaches that a user is charged for notification.

Thus, Appellant's contentions present the issue of whether the Examiner erred in deciding that the combination of the references makes

obvious the limitation of charging the user to receive the notification as recited in claim 12.

Rejection of claim 17 under 35 U.S.C. § 103 (a).

Appellant argues, on page 14 of the Brief that the Examiner's rejection of claim 17 is in error. Appellant reasons that the art cited by the Examiner teaches that the sender pays the fee to keep the mail and not have it destroyed, whereas the claim recites that the recipient notifies the carrier to destroy the mail.

The Examiner responds, on page 12 of the Answer, stating "McKeen, Jr. teaches said method and apparatus for verified mail system, wherein the verified content of the recipient mail is destroyed if the recipient does not want to keep it stored (column 2, lines 28-35)."

Thus, Appellant's contentions present us with the issue of whether the Examiner erred in finding that the combination of the references makes obvious a system where the recipient notifies the carrier to destroy the mail, as recited in claim 17.

Rejection of claim 18 under 35 U.S.C. § 103 (a).

Appellant argues, on page 14 of the Brief that the Examiner's rejection of claim 18 is in error. Appellant reasons that the art cited by the Examiner does not teach that the recipient notifies the carrier to recycle the material comprising the mail.

The Examiner responds, on pages 12-13 of the Answer, stating "Gordon et al. teaches said method and system for a mail delivery including

recycling a postcard after the contents of the postcard was distributed to the recipient via e-mail (column 15, lines 63-65).”

Thus, the contentions of the Appellant present us with the issue of whether the Examiner erred in finding that the combination of the references makes obvious a system where the recipient notifies the carrier to recycle the mail, as recited in claim 18.

Rejection of claim 22 under 35 U.S.C. § 103 (a).

Appellant argues, on page 15 of the Brief that the Examiner’s rejection of claim 17 is in error. Appellant reasons that the art cited by the Examiner does not teach notifying the recipient of mail via television as claimed in claim 22.

The Examiner responds, on page 13 of the Answer, stating “Busch et al. teaches said method and system for sharing information in a network environment, wherein a user receives a message via Web-TV or regular mail delivery (column 4, lines 38-44).”

Thus, Appellant’s contentions present us with the issue of whether the Examiner erred in finding that the combination of the references makes obvious a system where the recipient notifies the recipient of mail via television as claimed in claim 22.

FINDINGS OF FACT

- 1) Kuebert teaches a system where the recipient of a mail item can change the delivery point and or time of delivery. (Para. 0017).
- 2) Kuebert teaches that the system captures an image of the mail item's delivery address and return address. The data in

this image is subject to an Optical Character Reading (OCR). (Para. 0021).

- 3) A database entry is made which includes delivery point (delivery address), recipient name, and notification channels such as e-mail address and phone number. (Kuebert para. 0022).
- 4) The notification information in the database comes from available directories (e.g. phone directory). (Kuebert, para. 0037).
- 5) Notification that the mail piece is in route can be made through communication mediums including via telephone. (Kuebert para. 0036).
- 6) Lynt teaches an apparatus for converting visual or auditory information into tactile representations. (Abstract).
- 7) Lynt teaches that one use of the invention is in connection with a telephone, wherein Braille characters are presented on the device in response to detected speech. (Col. 6, ll. 19-26).
- 8) Srinivasan teaches a system where a user can select how to receive different types of messages. (Abstract).
- 9) Srinivasan teaches that the user of the system is a subscriber to the service. (Col. 2, ll. 37-48).
- 10) The messages in Srinivasan are electronic in nature, i.e. facsimile, voice mail. (Col. 2, ll. 23-35).
- 11) Sherwood teaches that it is known that in some phone voice mail systems, users of the system are charged for receiving a

radio page notifying the user that a voice mail is available.
(Col. 1, ll. 20-25).

- 12) McKeen teaches a verified mail system where copies of mail documents are stored in a central depository.
(Abstract). The postal customer, sender of the verified document, must pay to keep the documents stored for a period of time, if not the documents will be destroyed. (Col. 2, ll. 28-36).
- 13) Gordon teaches a system to pay for goods or services using the postal signal. (Col. 1, ll. 6-17, col. 2, ll. 11-15). In the system the vendor sending a package places a post card on the package with bill payment indicia. The customer initiates payment by putting the postcard back into the system. The post office uses the bill payment information on the card to pay the merchant. (Col. 2, ll. 31-30). The post cards may be returned to the vendor or a compact image of the post cards will be returned to the vendor and the postcards will be recycled. (Col. 15, ll. 60-66).
- 14) Busch teaches a system for use with promotional games where players collect pieces. (Col. 1, ll. 20-40). The system allows users in different geographic areas to combine their pieces and thus increase their chances of winning. (Col. 1, ll. 46-50). In one embodiment the system notifies users via "Web-TV." (Col. 4, ll. 38-45).

PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has recently stated that “the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (U.S. 2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 1740. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742.

ANALYSIS

Rejection of claims 1 through 11, 15 through 16, 19 through 21, and 23 through 25 under 35 U.S.C. § 103 (a).

Appellant’s arguments have not persuaded us that the Examiner erred in finding that the combination of the references teaches the claimed step of charging the recipient for delivering the mail in the manner specified by the recipient to the carrier. We find that Kuebert teaches that the user of the

system can change the delivery point of the e-mail. (Fact 1). We consider it to be a well known principle that services are paid for by the recipient of the service. The Examiner has relied upon Srinivasan as evidence that it is known that users of a service pay for the service. We concur with the Examiner's finding. (Fact 9). While Srinivasan is directed toward paying for forwarding of a different type of mail message (Fact 10), it nonetheless teaches that the user is a subscriber. Accordingly, Appellant's arguments have not persuaded us of error in the Examiner's determination that the combination of the references teaches charging the recipient for delivering the mail in the manner specified by the recipient to the carrier.

Similarly, Appellant's arguments have not persuaded us that the Examiner erred in finding that the cited patents teach utilizing the telephone number of the recipient and the translated image alphanumerics to inform the recipient of the expected delivery of the deposited mail via a tactile communications device. Kuebert teaches that the system captures the address of the recipient and sender as an image and processes the image to alphanumerics. (Fact 2). Performing an OCR on an image is converting the image to alphanumerics. Further, Kuebert teaches that the address is used with a database to determine the recipient's telephone number, and the user is notified by telephone. (Facts 3 through 5). Lynt teaches a tactile communication device which allows telephone communications to be converted into tactile presentation. (Fact 7). Thus, we concur with the Examiner's finding that the combination of the references teaches utilizing the telephone number of the recipient and the translated image alphanumerics to inform the recipient of the expected delivery of the deposited mail via a tactile communications device.

Further, Appellant's arguments have not persuaded us that the Examiner erred in holding that the skilled artisan would combine the features of the references. As discussed *supra*, Kuebert teaches that the user of the mail forwarding system can be notified by telephone, and Lynt teaches a tactile communication device used to receive phone calls. We consider using Lynt's device in the system of Kuebert to be a combination of familiar items to perform their known functions, and that the combination will yield predictable results. Further, as discussed *supra*, we consider the Examiner to have established that it is known that users of a service pay for the service. As the Examiner states, on page 11 of the Answer, this generates revenue for the business providing the service.

For the foregoing reasons, Appellant's arguments have not convinced us of error in the Examiner's rejection of claims 1 through 11, 15 through 16, 19 through 21, and 23 through 25 under 35 U.S.C. § 103 (a).

Rejection of claim 12 under 35 U.S.C. § 103 (a).

Appellant's arguments have not convinced us that the Examiner erred in deciding that the combination of the references makes obvious the limitation of charging the user to receive the notification. We find that Sherwood teaches that it is known in the art to charge for the notification of the existence of a message. (Fact 1). While Sherwood teaches this in conjunction with another type of mail system, voice mail vs. physical mail, we do not consider the distinction in type of mail to be relevant to the underlying fact that Sherwood teaches that it is known to charge for the service of being notified of the existence of a message destined for the user. As discussed above with respect to the rejection of claim 1, we consider the Examiner to have established that it is known that users of a service pay for

a service received for the expected result of generating revenue for the business providing the service. Thus, we are not persuaded by the Appellant's arguments that the Examiner's rejection of claim 12 is in error.

Rejection of claim 17 under 35 U.S.C. § 103 (a).

Appellant has persuaded us of error in the Examiner's rejection of claim 17. Claim 17 recites that "the recipient notifies the carrier to destroy mail." The Examiner finds that McKeen teaches this limitation. We disagree with the Examiner's finding. McKeen teaches that the sender's action of not renewing the storage fee, rather than an instruction by the recipient, results in the destruction of the mail. (Fact 12). The Examiner has not found that the other references of record teach this limitation. We note that Kuebert also discusses destruction of the mail; however similar to McKeen, it is at the request of the sender. (Para. 0055). As we do not find that the references of record teach or suggest this limitation, we reverse the Examiner's rejection of claim 17.

Rejection of claim 18 under 35 U.S.C. § 103 (a).

Appellant has persuaded us of error in the Examiner's rejection of claim 18. Claim 18 recites that "the recipient notifies the carrier to recycle the material comprising the mail." The Examiner finds that Gordon teaches this limitation. We disagree with the Examiner's finding. Gordon teaches that the post office recycles the mail. Gordon does not identify or suggest that the sender's actions result in the recycling of the mail. (Fact 13). As we do not find that the references of record teach or suggest this limitation, we reverse the Examiner's rejection of claim 18.

Rejection of claim 22 under 35 U.S.C. § 103 (a).

Appellant has persuaded us of error in the Examiner's rejection of claim 22. Claim 22 is dependent upon claim 1 which recites "using the telephone number ... to inform the recipient of the expected delivery of the deposited mail via a tactile communication device." Claim 22 further modifies claim 1 by reciting that "the recipient is notified via television of the availability of the deposited mail." While we agree Busch teaches using television to notify users (Fact 14), we do not find that Busch teaches that the television is a tactile communication device or in addition to a tactile communication device.¹ As we do not find that the references of record teach or suggest this limitation, we reverse the Examiner's rejection of claim 22.

NEW GROUNDS OF REJECTION PURSUANT TO 37 C.F.R.
§ 41.50(B).

37 C.F.R. § 41.50(b) states:

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.

¹ As discussed *infra* we find that claim 22 is ambiguous as to whether a television is a tactile communication device or is used in addition to a tactile communication device. Further, we do not find that Appellant's disclosure provides an enabling disclosure of how a television is used as a tactile communication device.

We now enter a new rejection of claim 22 under 35 U.S.C. § 112 first and second paragraphs. As discussed above, claim 22 is dependent upon and further modifies claim 1 by reciting that “the recipient is notified via television of the availability of the deposited mail.” We find that it is ambiguous as to whether the scope of claim 22 requires: a) that the tactile communication device is a television, or b) that the user is notified by tactile communication device and a television. Appellant’s specification sheds no light on the issue as it does not address notification by television.² It is for the later interpretation that we apply the rejection under the first paragraph of 35 U.S.C. § 112.

The test for enablement under the first paragraph of 35 U.S.C. § 112, is whether one reasonably skilled in the art could make or use the claimed invention from the disclosed subject matter together with information in the art, without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). A disclosure can be enabling even though some experimentation is necessary. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986).

Appellant’s Specification on page 10, lines 20 through 22, discuss that the tactile communications device may be a personal computer with a Braille printer. We do not find any disclosure in Appellant’s Specification of using a television as a tactile display device.³ Similarly, there is no evidence of

² We consider the written description requirement to be met as Appellant’s originally filed claim 22 is substantially identical to the current claim 22.

³ We note that we consider claim 19 (recipient notified by e-mail) and claim 21 (recipient notified by facsimile) to be enabled as they both deal with electronic document formats which with minimal experimentation could be printed out with a computer and Braille printer. Further, we consider claim

record to suggest that using a television as a tactile display was known in the art or that one could use a television as a tactile display with only ordinary experimentation. Typically, tactile communication devices provide a Braille presentation of text, i.e. a static presentation. This type of presentation is discussed in Appellant's Specification. Television, on the other hand, is a visual display format which typically provides moving images and, as such, is more dynamic than text. We do not consider that one skilled in the art would know how to apply a tactile notification using a dynamic visual display such as television. Accordingly, we now reject claim 22 under 35 U.S.C. § 112, first paragraph, as not being enabled by Appellant's disclosure.

CONCLUSION

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 1 through 12, 15 through 16, 19 through 21, and 23 through 25. Accordingly we affirm the Examiner's rejections of claims 1 through 12, 15 through 16, 19 through 21, and 23 through 25 under 35 U.S.C. § 103 (a).

However, Appellant's arguments have persuaded us of error in the Examiner's rejection of claims 17, 18, and 22. Accordingly, we reverse the Examiner's rejection of claims 17, 18, and 22 under 35 U.S.C. §103(a).

20 to be within the skill in the art as Lynt teaches that tactile communication of phone calls was known at the time of the filing of the application (see fact 7).

We also enter a new rejection of claim 22 under 35 U.S.C. § 112, first and second paragraphs, as being indefinite and not being enabled by Appellant's disclosure.

ORDER

The decision of the Examiner is affirmed-in-part.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

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AFFIRMED-IN-PART, 37 CFR § 41.50(b)

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