

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. PATTON and ALLEN K. TSAUR

Appeal 2007-2959
Application 09/799,843
Technology Center 3600

Decided: January 28, 2008

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and
JENNIFER D. BAHR, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Patton, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 57-59, 61, 62, and 64. Claims 1-56, 60, and 63 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM but denominate the rejection as a new ground of rejection under 37 C.F.R. § 41.50(b).¹

THE INVENTION

The Appellants' claimed invention "relates to a system used for ordering and printing of customized official postage from a central authorizing computer and printing system." (Specification 1:8-10). Referring to Fig. 1, the system 10 comprises a computer 20 communicatively connected to an authorizing computer 12, an image scanner 24, a customer order entry device 14 for creating customized postage incorporating a scanned image and a device for providing a receipt. (Specification 7:26-8:23). In operation, from computer 20, the customer uploads customized postage created by the customer order entry device 14 to the authorizing computer for placement of an order for the customized postage from where it is printed for delivery to the customer. (Specification 8:11-9:27).

Sole independent claim 64, reproduced below, is representative of the subject matter on appeal.

¹ Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Jun. 30, 2006), the Examiner's Answer ("Answer," mailed Aug. 28, 2006), and Reply Brief ("Reply Br.," filed Oct. 2, 2006).

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64. A kiosk for ordering customized postage comprising:

a computer for communicating with a central authorizing computer system over a communication network;

a device for obtaining a personal image by scanning film, scanning a hard copy document or from a computer file,

a customer order entry device for creating a customized postage incorporating said personal image, said computer allowing uploading of said customized postage to said authorizing computer system and placement of an order for said customized postage from said authorizing computer system over said communication network where said order is either approved or not approved; and

a device for providing a customer receipt with respect to said approved order.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Brasington	US 5,923,406	Jul. 13, 1999
Beasley	US 2002/0149195 A1	Oct. 17, 2002
Ramsden	US 5,656,799	Aug. 12, 1997
Mellgren	US 6,085,126	Jul. 4, 2000

The following rejections are before us for review:

1. Claims 57-59, 62, and 64 are rejected under 35 U.S.C. § 103(a) as unpatentable over Brasington, Beasley, and Ramsden.
2. Claim 61 is rejected under 35 U.S.C. § 103(a) as unpatentable over Brasington, Beasley, Ramsden, and Mellgren.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 57-59, 62, and 64 as unpatentable over Brasington, Beasley, and Ramsden and claim 61 as unpatentable over Brasington, Beasley, Ramsden, and Mellgren. This issue turns on whether the prior art would have led one having ordinary skill in the art to a system for uploading a customized postage to an authorizing computer system and placement of an order for the customized postage where the order is either approved or not approved.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Brasington is directed to a vending machine for printing personalized postage stamps. Col. 1, ll. 6-7. Upon a user pressing a

button and providing payment (col. 9, ll. 41-48), the machine takes an image which can be downloaded from, for example, a smart card (col. 7, ll. 27-32) and via a display and microprocessor queries a user as to whether the image is to be used as part of the stamp (col. 7, ll. 41-45), and, if the answer is yes, a device (e.g., a printer) produces the personalized postage stamps (col. 4, ll. 14-15). If a credit card is used for payment, the machine communicates with a credit card center (col. 3, ll. 55-62).

2. Beasley is directed to methods of making personalized postage stamps [0002]. The process comprises obtaining an image remotely by, for example, email [0032], processing and printing the personalized postage stamps using the image [0034]. Beasley [0017] discloses “a regulating process which prevents obscene photos, copyright and trademark infringement problems before the image is placed on the personalized postage stamps.” Techniques for authentication [0036] include using “a known device for detecting the presence of a genuine stamp and for canceling the stamp” [0037].
3. Ramsden is directed to an automated package shipping machine which provides a verified receipt (col. 2, l. 25-26; see also element 714 on Fig. 20).
4. Mellgren is directed to a system for creating custom designed imprintable media involving kiosks and a central computer. Fig. 1.

Custom designs are created at the kiosk and transmitted to the central computer (col. 5, ll. 1-3) for processing. The central computer verifies transmission of the custom design. Col. 6, ll. 5-9.

5. It is well known that a series of instructions performed by a single computer is the same as performing each instruction on separate computers serially communicating with each other.

Any differences between the claimed subject matter and the prior art

6. The claimed invention separates the functions of creating/ordering a customized postage and placing/approving the order that are combined in Brasington's kiosk.

The level of skill in the art

7. Neither the Examiner nor Appellants has addressed the level of ordinary skill in the pertinent arts of tracking items and data formatting. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Secondary considerations

8. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18.

ANALYSIS

Rejection of claims 57-59, 62, and 64 as unpatentable over Brasington, Beasley, and Ramsden.

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The Appellants argue claims 57-59, 62, and 64 as a group (App. Br. 3-7). We select claim 64 as the representative claim for this group, and the remaining claims 57-59 and 62 stand or fall with claim 64. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Brasington “discloses a kiosk for ordering customized postage comprising: a computer for communicating with a central authorizing computer system over a communication network [col. 3, lines 24-27 and 55-62]; a device for obtaining a personal image by scanning film, scanning a hard copy document or from a computer file [col 7, lines 27-32], a customer order entry device creating a customized postage incorporating said personal image [col 3, lines 14-15].” Answer 4. The Examiner fairly described the scope and content of Brasington. See FF 1. In order to meet the claimed limitation of a computer “uploading of said customized postage to said authorizing computer system and placement of an order for said customized postage from said authorizing computer system over said communication network where said order is either approved or not approved,” which the Examiner conceded Brasington did not disclose (Answer 4), the Examiner relied on Beasley to show “a method for obtaining customized postage stamps in which a user’s personal image is uploaded to an authorizing computer system over a communication network [0032] where the order is approved or disapproved [0036]” (Answer 4). The Examiner fairly described the scope and content of Beasley. See FF 2. In order to meet the claimed limitation of a “device for providing a customer

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receipt with respect to said approved order,” which the Examiner conceded Brasington does not show (Answer 5), the Examiner relied on Ramsden as disclosing “a kiosk for shipping packages in which remote payment for a purchase is made and the customer is issued a receipt [col 29, lines 7-22].” Answer 5. The Examiner fairly described the scope and content of Ramsden. FF 3.

The Examiner determined that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of [Brasington] to include the method disclosed by Beasley ... [to prevent] obscene photos, copyright, and trademark infringement problems before the image is placed on a customized stamp” (Answer 4). The Examiner also determined that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Brasington to include the method disclosed by Ramsden [so that] the customer [is provided] with a printed receipt [for] verification of the transaction” (Answer 5).

The Appellants argued that the cited references do “not disclose, expressly or inherently, at least uploading a customized postage to an authorizing computer system and placement of an order for the customized postage where the order is either approved or not approved” (App. Br. 3-4 with respect to Brasington; App. Br. 4-5 with respect to Beasley (see also Reply Br. 1-2); and, App. Br. 6 with respect to Ramsden and Mellgren).

We do not find Appellants’ argument persuasive.

The claimed apparatus comprises two computers communicating with each other, one for creating and ordering a customized postage and the other for placing and approving the order. Brasington combines these two functions in a single vending machine that employs a computer to process these steps in a sequential manner. However, one of ordinary skill in the art would have known that a series of instructions sequentially performed by a computer is the same as performing each instruction on separate computers that serially communicate with each other. FF 5.

Also, Brasington discloses the vending machine communicating with a computer at a postal authority (for postal transactions). See col. 5, ll. 54-56 and Fig. 4, element 91. The computer in Brasington's vending machine includes an instruction allowing the vending machine to communicate with an external computer via the postal authority's postage transaction data center (element 49, Fig. 4) whereby prior approval of a credit card is obtained and without which ordering of customized postage cannot be done (see FF 1 and also col. 3, l. 55 to col. 4, l. 4). Furthermore, it was well known in the art at the time the application was filed that postal authorities (e.g., the United States Postal Service) issued stamps and that a consumer could electronically order stamps from postal authorities. It was also known that postal authorities were concerned about improper images. That concern, as Beasley suggests, extended to concerns about copyright and the content for the images used on postage. Given all this, it would have been obvious to one of ordinary skill in the art to modify the computer in Brasington's

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vending machine to include an instruction allowing the vending machine to communicate with the postal authority for approval of the customized postage prior to ordering the customized stamps. This would include giving the vending machine the capability of uploading the questionable customized postage to the postal authority as well as, where the consumer sought customized stamps issued by the postal authority, to communicate placement of an order for such stamps with the postal authority.

Rejection of claim 61 as unpatentable over Brasington, Beasley, Ramsden, and Mellgren.

The Appellants have not separately argued the rejection of claim 61. Claim 61 is included in the discussion of claims 57-59, 62, and 64. See App. Br. 3-7. Accordingly, the Appellants appear to have rested on their arguments as to the rejection of claims 57-59, 62, and 64. Since we have found those arguments unpersuasive as to error in the rejection of claims 57-59, 62, and 64, we reach the same conclusion with respect to the rejection of claim 61.

CONCLUSIONS OF LAW

We conclude that the Appellants have failed to show that the Examiner erred in rejecting claims 57-59, 62, and 64 as unpatentable over Brasington, Beasley, and Ramsden, and failed to show that the Examiner

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erred in rejecting claim 61 as unpatentable over Brasington, Beasley, and Ramsden, Mellgren.

DECISION

The decision of the Examiner to reject claims 57-59, 61, 62, and 64 is affirmed but, because our rationale is substantially different from that used by the Examiner, we denominate this as new grounds of rejection under 37 C.F.R. § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 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

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED; 37 C.F.R. § 41.50(b)

vsh

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