

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER A. BAKER,
DOUGLAS B. QUINE, and
CORTLAND D. STARRETT

Appeal 2008-3701
Application 10/738,941
Technology Center 3600

Decided: August 29, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JENNIFER D. BAHR, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Christopher A. Baker, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 6-15. Claims 1-5 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

“The present invention relates to a method for tracking a mailpiece in a postal processing system. More particularly, the present invention relates to a method for providing a unique PLANET code identifier to a mailpiece that is used for tracking the mailpiece through a postal processing system.” Specification [0002]. “It is an object of the present invention to provide a process that generates a unique destination CONFIRM service code for each mailpiece” Specification [0021]. “Even though the PLANET code service offering [of the United States Postal Service] is advantageous to mailers for enabling them to track outgoing (destination CONFIRM) and incoming (origin CONFIRM) mailpieces, it does have shortcomings. Notably, destination CONFIRM only currently provides the mailer with a four (4) digit field for providing a unique ID for each mailpiece being sent. Thus, and especially on large volume mailings, the mailer cannot ensure uniqueness for mailpieces being delivered to the same address or addresses having the same POSTNET, and the customer ID suggestion can often cause duplicate PLANET codes from being delivered to the same customer across different mailings of the mailer and possible jeopardize a customers confidentiality by identifying the customer with a static customer ID.” Specification [0009]. “An object of the present

¹ Our decision will make reference to the Appellants’ Appeal Brief (“Br.,” filed Nov. 1, 2007) and the Examiner’s Answer (“Answer,” mailed Dec. 13, 2007).

invention is to overcome the noted shortcomings of a PLANET service code mailpiece by providing uniqueness to each mailpiece having a destination CONFIRM PLANET code delivered to recipients having a common POSTNET service code.” Specification [0011]. “The above object of the present invention is accomplished by providing a method for generating a PLANET service code for a batch of mailpieces with the PLANET service code having assignable digits. The method includes the steps of altering the assignable digits in a PLANET service code so as to provide a unique tracking number for each mailpiece determinative upon whether a POSTNET service code is known for each mailpiece in the batch of mailpieces, and if known, whether that POSTNET service code was applied to a previous mailpiece in the batch of mailpieces.” Specification [0012].

Claim 6, reproduced below, is illustrative of the subject matter on appeal.

6. A method for generating a PLANET service code for a batch of mailpieces, said method comprising:
retrieving assignable digits for a PLANET service code;
prescribing said assignable digits with a first PLANET service code;
associating the first PLANET service code with a first mailpiece from the batch of mailpieces, the first mailpiece having a POSTNET service code;
and
for each subsequent mailpiece in the batch:
 comparing a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code;

associating the first PLANET service code with the subsequent mailpiece where the subsequent POSTNET service code is different from each previous POSTNET service code; and

changing the assignable digits, prescribing the changed assignable digits with a subsequent PLANET service code, and associating the subsequent PLANET service code with the subsequent mailpiece where the subsequent POSTNET service code is the same as a previous POSTNET service code.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Pickering	US 6,557,755 B1	May 6, 2003
Tuchler	US 6,980,969 B1	Dec. 27, 2005

The following rejection is before us for review:

1. Claims 6-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pickering and Tuchler.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 6-15 under 35 U.S.C. § 103(a) as being unpatentable over Pickering and Tuchler. The issue turns on whether the cited prior art would have led one of ordinary skill in the art to “compar[e] a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code;” “associat[e] the first PLANET service

code with the subsequent mailpiece where the subsequent POSTNET service code is different from each previous POSTNET service code;” and “chang[e] the assignable digits, prescribing the changed assignable digits with a subsequent PLANET service code, and associating the subsequent PLANET service code with the subsequent mailpiece where the subsequent POSTNET service code is the same as a previous POSTNET service code.” (Claim 6).

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) 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).

Claim construction

1. The claims refer to a PLANET service code and a POSTNET service code.
2. According to the Specification, PLANET service codes and POSTNET service codes are barcodes placed in an address block of a mailpiece. See Fig. 1 of the Specification reproduced below. “Such an address block can either be printed on the outside of an envelope or on a mailpiece inserted in an envelope such that address block 100 is visible through a window in the envelope.” Specification [0020].
3. Fig. 1 is depicted below.

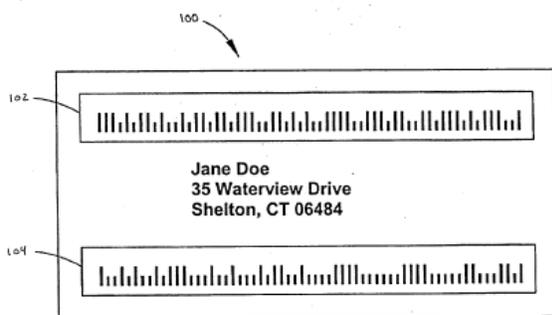


Fig. 1

Fig. 1 is said to depict “an illustration of a mailpiece having a POSTNET [102] and PLANET [104] service barcodes [of address block 100].” Specification [0014].

4. “Mailpieces have traditionally used barcodes to control mailpiece inserting and sorting operations. Barcodes are also used on a mailpiece to facilitate delivery of the mailpiece.” (Specification [0003]).
5. “A POSTNET barcode typically is formed by either a 9 or 11 digit zip code that corresponds to a specific geographic region designated by the United States Postal Service for facilitating mailpiece delivery. Thus, all mail recipients in such a specific geographic region may be assigned a common POSTNET.” (Specification [0003]). Accordingly, a POSTNET service code is a barcode that encodes a combination of digits indicative of a geographic location.

6. “Recently, the United States Postal Service has implemented the use of PLANET codes to track mail electronically once the mailpiece enters the mail stream.” (Specification [0004]).
7. “PLANET service code 102 is a bar code in which bars of varying height are used to encode any suitable information, such as a service type, a customer ID or mailing and subscriber ID and a checksum. The first two digits of the PLANET code typically indicate a desired service type. For example, according to the current United States Postal Service standards, the digits 21 indicate origin CONFIRM [incoming mailpiece] and 22 indicates destination CONFIRM [outgoing mailpiece] service.” (Specification [0020]). See also (Specification [0009]).
8. Claim 6 is drawn to a method “for generating a PLANET service code for a batch of mailpieces.”
9. The method of claim 6 comprises steps of associating a PLANET service code to a first mailpiece in the batch having a POSTNET code and to each subsequent mailpiece in the batch.
10. The claimed steps for associating a PLANET service code to each subsequent mailpiece in the batch involves comparing the POSTNET service code of the subsequent mailpiece with each previous mailpiece in the batch.
11. If the POSTNET service code of the subsequent mailpiece is different from the POSTNET code of each previous mailpiece in the batch, the PLANET service code associated with the first mailpiece is associated with the subsequent mailpiece.

12. If the POSTNET service code of the subsequent mailpiece is the same as a POSTNET code for a previous mailpiece in the batch, a subsequent PLANET service code is associated with the subsequent mailpiece.

The scope and content of the prior art

13. Pickering relates to methods and systems for tracking and controlling mailpiece processing using POSTNET and PLANET codes.
14. Pickering states: "FIG. 9 illustrates exemplary steps that may be performed by a mailer in performing outgoing and return mailpiece tracking. Referring to FIG. 9, in step ST1, the mailer generates a unique POSTNET and PLANET code combination for an outgoing mailpiece. Table 1 shown below illustrates an example of such combinations that may be generated by the mailer" (col. 12, ll. 61-67).
15. Pickering Fig. 9 is depicted below:

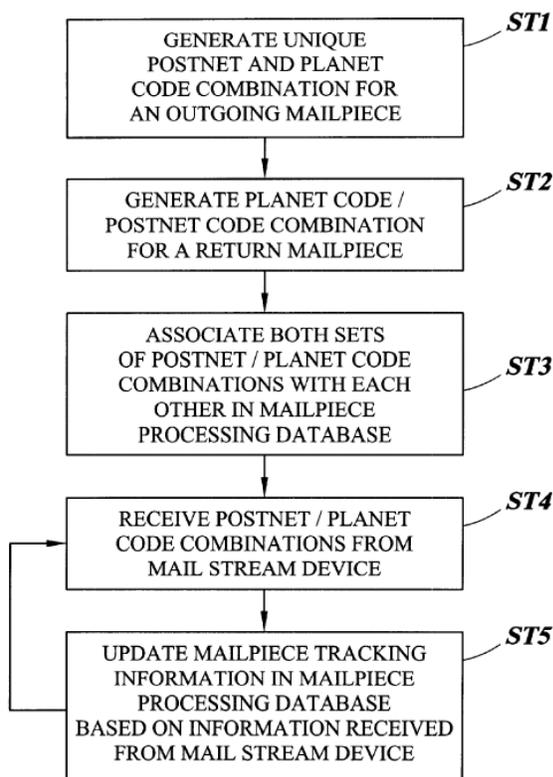


FIG. 9

Pickering Fig. 9 is said to depict “a flowchart illustrating exemplary steps that may be performed by a mailer in performing outgoing and return mailpiece tracking according to an embodiment of the present invention.” (Col. 3, ll. 22-25).

16. Pickering Table 1 is depicted below.

TABLE 1

<u>POSTNET and PLANET Codes for Outgoing Mailpieces</u>		
POSTNET	PLANET	INDEX
23516-1234-12	22-12345-0001	1
23516-4321-12	22-12345-0001	2
23516-4321-12	22-12345-0002	3
23516-1234-12	22-12345-0001	1
23516-4321-12	22-12345-0001	2
23516-4321-12	22-12345-0002	3

Pickering Table 1 is said to depict combinations of POSTNET and PLANET codes for outgoing mailpieces.

17. Tuchler relates to methods and apparatus for allowing Internet-enabled purchases based on a temporary credit card number.
18. Col. 6, ll. 33-38 of Tuchler states: “For example, if the temporary credit card number is a sixteen digit number, a random sixteen digit number may be generated in a well known manner. Preferably, the new number is checked for validity before activation (e.g., if the generated number has been used in the past, a new number is generated, etc.)”

Any differences between the claimed subject matter and the prior art

19. The claimed subject matter differs from the prior art in that the (claim 6) steps of “comparing a subsequent mailpiece with each previous POSTNET service code;” “associating the first PLANET service code with the subsequent mailpiece where the subsequent POSTNET service code is different from each previous POSTNET service code;” and “changing the assignable digits, prescribing the changed assignable digits with a subsequent PLANET service code, and associating the subsequent PLANET service code with

the subsequent mailpiece where the subsequent POSTNET service code is the same as a previous POSTNET service code” are not explicitly disclosed.

The level of skill in the art

20. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent art of tracking a mailpiece in a postal processing system. 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’”) (“[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

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

PRINCIPLES OF LAW

Obviousness

“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 17-18.

ANALYSIS

The Appellant argued claims 6-15 as a group (Br. 10). We select claim 6 as the representative claim for this group, and the remaining claims 7-15 stand or fall with claim 6. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The issue we must address with respect to obviousness is the scope and content of the prior art; specifically, whether the prior art describes or discloses the following steps of claim 6:

- “comparing a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code;”
- “associating the first PLANET service code with the subsequent mailpiece where the subsequent POSTNET service code is different from each previous POSTNET service code;”

- “changing the assignable digits, prescribing the changed assignable digits with a subsequent PLANET service code, and associating the subsequent PLANET service code with the subsequent mailpiece where the subsequent POSTNET service code is the same as a previous POSTNET service code.”

The particular step in question is the comparing step. According to the Appellants, Pickering does not disclose the “comparing” step and thus necessarily further does not disclose the subsequent “associating” and “changing” steps. (Br. 11-12).

The Examiner conceded that “Pickering does not explicitly disclose comparing a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code.” (Answer 4). However, according to the Examiner, it would have been obvious to “compar[e] a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code” (claim 6) for two reasons: (1) Pickering inherently does so and (2) it would have been obvious to do so in view of Tuchler. (Answer 8-9.)

According to the Examiner, Pickering inherently compares a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code because Pickering discloses a step of generating of a unique POSTNET and PLANET code combination for each outgoing mailpiece. The Examiner found Pickering to disclose a step of generating a unique POSTNET and PLANET code for each outgoing mailpiece at col. 12, ll. 61-67, col. 13, ll. 1-35, and Table 1 of Pickering. Col. 12, ll. 61-67, of Pickering, for example, does in fact describe a step of generating a unique POSTNET and PLANET code for each outgoing

mailpiece. (FF 14). According to the Examiner, Pickering’s steps of generating a unique POSTNET and PLANET code, “suggests [to the Examiner] that a comparison is made to determine whether potential codes for a present mailpiece have been used on a previous mailpiece.” (Answer 8).

Comment [JDB1]: Doesn’t this seem reasonable? How else does Pickering ensure that the combination of codes is unique?

The Appellants disagreed. According to the Appellants, “without a comparison, it is impossible to determine whether the POSTNET service codes are “different,” as claimed.” (Br. 11-12). The Appellants are referring to the “associating” step of claim 6 which calls for associating the PLANET code assigned to the first mailpiece in a batch of mailpieces to a subsequent mailpiece in the batch if the POSTNET code of the subsequent mailpiece is *different* from the POSTNET code of each previous mailpiece in the batch. Determining whether POSTNET codes on previous mailpieces are different from the POSTNET code on a mailpiece subsequent to the first mailpiece in the batch necessarily requires comparing their POSTNET codes. The Appellants also discussed Table 1, cited by the Examiner as evidence that Pickering discloses a step of generating a unique POSTNET and PLANET code for each outgoing mailpiece. According to the Appellants:

As shown in Table 1, the POSTNET code of the fourth mailpiece (namely, 23516-1234-12) is *different* from the POSTNET code of the third mailpiece (namely, 23516-4321-12). Nonetheless, the PLANET code of the fourth mailpiece (namely, 22-12345-0001) is *not the same* as the PLANET code of the third mailpiece (namely, 22-12345-0002). Thus, although the POSTNET code changed from the third to the fourth mailpiece, the PLANET code *did not* stay the same.

Br. 12 (emphasis in original).

We have reviewed the evidence and agree with the Appellants that Pickering does not suggest “comparing a subsequent mailpiece with each previous POSTNET service code” (claim 6).

The Examiner takes the position that Pickering suggests “comparing a subsequent mailpiece with each previous POSTNET service code” because Pickering discloses generating a unique POSTNET and PLANET code. (Answer 8). In effect, the Examiner is arguing that Pickering’s step of generating a unique POSTNET and PLANET code necessarily, or inherently, requires comparing the POSTNET codes of all the previous mailpieces. We disagree.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). The fact that Pickering assigns a unique POSTNET and PLANET code to each mailpiece does not necessarily mean that any comparison is being made with the POSTNET codes of previously assigned mailpieces. It simply means that a mailpiece receives a unique POSTNET and PLANET code. As the Appellants correctly observe, Table 1 shows mailpieces in a batch each with a unique POSTNET and PLANET code. But Table 1 shows a mailpiece in the batch having been assigned a POSTNET code (fourth mailpiece) that is different from the one assigned to the previous mailpiece (third mailpiece) and, yet, they also have different

PLANET codes. Claim 6 is very specific: if the POSTNET code of the subsequent mailpiece in the batch is different than the POSTNET codes of all previous mailpieces in the batch, the subsequent mailpiece is assigned the same PLANET code assigned to the first mailpiece (and if the POSTNET codes are the same, the subsequent mailpiece is assigned a different PLANET code). Pickering's result is one that the claimed method does not and cannot achieve. Accordingly, although Pickering assigns a unique POSTNET and PLANET code to each mailpiece, it does not necessarily mean that any comparison is being made with the POSTNET codes of previously assigned mailpieces. As Pickering Table 1 shows, Pickering's method does not necessarily achieve the results of the claimed "assigning" and "changing". Accordingly, Pickering cannot necessarily, or inherently, perform the claimed "comparing" step.

Accordingly, we do not find the evidence sufficient to support the Examiner's position that it would have been obvious to "compar[e] a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code" (claim 6) on the ground that Pickering inherently does so.

As to the Examiner's other argument - that it would have been obvious to "compar[e] a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code" (claim 6) in view of Tuchler - we are compelled to find the argument un rebutted. The entirety of the Appellants' position is presented via this statement: "Tucker, cited for its teaching of "comparing a new credit card number with a list of previously generated numbers," fails to overcome the deficiencies of Pickering discussed above." (Br. 13). In our view, this statement simply

alleges that Pickering fails to disclose or suggest, principally, the claimed comparing step and that Tuchler does not overcome that failure. But the Appellants do not explain why Tuchler does not overcome the deficiency in Pickering. Accordingly, the statement amounts to a general allegation that the combination of Pickering and Tuchler does not disclose or suggest any of the claim limitations. Such an allegation does no more than merely point out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

Moreover, the Examiner argued that Pickering describes all the claimed steps but conceded that “Pickering does not explicitly disclose comparing a subsequent POSTNET service code of the subsequent mailpiece with each previous POSTNET service code.” (Answer 4). The Examiner relied upon Tuchler, col. 6, ll. 33-38, to show “comparing a new credit card number with a list of previously generated numbers.” (Answer 4). The Examiner concluded therefrom that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Pickering to have included comparing a subsequent service code of a subsequent transaction with each previous service code as disclosed by Tuchler for the advantage of minimizing fraudulent transactions by identifying situations where the same identification number is assigned to two parties.” (Answer 4).

The Examiner’s characterization of the scope and content of the prior art and the differences between the claimed subject matter and the prior art appear to be correct. (FF 13-19). All the factual inquiries for a determination of obviousness having been addressed (FF 13-21) and the

Examiner appears to have provided an apparent reason with logical underpinning for the legal conclusion of obviousness. Accordingly, we find that a prima facie case of obviousness has been established.

As a result, the burden of coming forward with evidence or argument shifts to the Appellants. *In re Oetiker*, 977 F.2d, 1443, 1445, (Fed. Cir. 1992). In that regard, all we have been given is the statement quoted above. The statement does not address the merits of the prima facie case of obviousness. Given little in the way of argument or evidence, the Appellants are in effect inviting the Board to provide the elaboration needed to support their desire that we determine that the Examiner failed to establish a prima case of obviousness. We decline the invitation. "It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). *Cf. Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 112 (2d Cir. 1999) ("Appellant's Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation."). This argument challenging the prima facie case of obviousness having been found unpersuasive as to error in the rejection and there being no secondary considerations of nonobviousness for our consideration, we will sustain the rejection.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 6-15 as unpatentable under 35 U.S.C. § 103(a) over Pickering and Tuchler.

DECISION

The decision of the Examiner to reject claims 6-15 is affirmed.

AFFIRMED

JRG

Pitney Bowes Inc.
Intellectual Property & Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484