

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARYL S. MILEAF, STEPHANIE A. LAURETANO,
JASON PARK, PATRICK COWGILL, STANLEY WAKAMIYA,
and CHARLES SHAW

Appeal 2008-4675
Application 10/771,342
Technology Center 3600

Decided: November 12, 2008

Before JENNIFER D. BAHR, LINDA E. HORNER, and STEFAN
STAICOVICI *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Daryl S. Mileaf et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1 and 3 through 9. Claims 2 and 10

have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

THE INVENTION

The Appellants' invention is drawn towards a two-pass sorting method for sorting a batch of mail including deliverable mail, saturation mail (mass mailings), and mail placed on hold, destined for multiple delivery points (destinations) on a plurality of carrier routes (streets) (¶¶ 13, 33, and 39). The method configures the sorting system 100 according to a first-pass sort plan 110 and a second-pass sort plan 111 (¶ 28 and fig. 1) using a mail sorting system 100 having multiple input feeders 101(1), 101(2) and multiple outputs, 102(1) through 102(15) (¶ 26 and fig. 1). The method includes feeding a plurality of mail pieces into the sorting system 100, sorting the plurality of mail pieces according to the first-pass sort plan to form multiple batches, wherein each batch contains mail destined for the same delivery point (address) on each of the carrier routes (street) and an additional, separate batch of mail containing a set of delivery points (destinations) to which mail should not be delivered (mail on hold) (¶¶ 28 and 29 and fig. 3). The method further includes sorting the plurality of mail pieces according to the second-pass sort plan which assigns each batch of mail sorted by the first-pass sort plan to an output corresponding to consecutive delivery points on each delivery route (¶¶ 30 and 35 and fig. 4). To provide saturation mail (mass mailings) at each delivery point along each carrier route, the saturation mail is fed into the mail sorting system immediately after sorting a batch of mail according to the second-pass plan

and immediately prior to feeding a consecutive batch of mail according to the second-pass plan (¶¶ 41-45 and figs. 5A-5C).

Claim 1 is representative of the claimed invention and reads as follows:

1. A method for sorting a batch of mail into delivery point order using a mail sorting system comprising a first output, a second output, and a third output, comprising:

creating a first-pass sort plan, wherein the first-pass sort plan specifies: a first delivery point group comprising a first delivery point on a first carrier route and a first delivery point on a second carrier route, a second delivery point group comprising a second delivery point on the first carrier route and a second delivery point on the second carrier route, and a third delivery point group comprising delivery points on the first and second carrier routes that are on hold;

creating a second-pass sort plan, wherein the second-pass sort plan assigns the first and second delivery points on the first carrier route to the first output and assigns the first and second delivery points on the second carrier route to the second output;

feeding the batch of mail into the mail sorting system;

sorting the batch of mail according to the first-pass sort plan utilizing the first, second and third outputs, thereby forming (1) a first batch of mail comprising mail addressed to the first delivery point on the first carrier route and the first delivery point on the second carrier route; (2) a second batch of mail comprising mail addressed to the second delivery point on the first carrier route and the second delivery point on the second carrier route; and (3) a third batch of mail comprising mail addressed to a delivery point that is on hold;

feeding the first batch of mail into the mail sorting system;

sorting the first batch of mail according to the second-pass sort plan;

feeding one or more pieces of saturation mail into the mail sorting system immediately after sorting the first batch of mail according to the second-pass sort plan;

feeding the second batch of mail into the mail sorting system immediately after feeding the one or more pieces of saturation mail into the mail sorting system; and

sorting the second batch of mail according to the second-pass sort plan.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Steinmetz	US 6,740,835 B2	May 25, 2004
Vanderbles	US 6,741,908 B2	May 25, 2004
Kechel	US 6,762,384 B1	Jul. 13, 2004
Hanson	US 2004/0200761 A1	Oct. 14, 2004
Burns	US 6,953,906 B2	Oct. 11, 2005

The following rejections are before us for review:

The Examiner rejected claims 1, 3, 6, 7, and 9 under 35 U.S.C. § 103(a) as unpatentable over Kechel in view of Vanderbles and in further view of Hanson.

The Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Kechel in view of Vanderbles and Hanson and in further view of Burns.¹

The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as unpatentable over Kechel in view of Vanderbles and Hanson and in further view of Steinmetz.²

THE ISSUES

1. Have the Appellants shown that the Examiner's reading of the teachings of Hanson with respect to the limitation of "saturation mail" is inconsistent throughout the record of the instant application?

2. Have the Appellants shown the Examiner failed to provide an adequate reason to combine the teachings of Kechel and Hanson to reject the appealed claims under 35 U.S.C. § 103(a)?

For the reasons set forth in our discussion below, we are not persuaded by the Appellants' arguments.

Accordingly, we AFFIRM the Examiner's rejection.

¹ Although the Appellants do not specifically address the grounds of rejection of claims 4, 5, and 8, it is apparent that the Appellants intend to contest the rejections of claims 4, 5, and 8 as part of the instant appeal (App. Br. 2), presumably relying on the same argument advanced against the rejection of claim 1 from which they depend.

² When describing the rejections of claims 4, 5, and 8 the Examiner does not mention Hanson explicitly (Amended Answer, mailed March 6, 2008, at 8). Inasmuch as claim 1 stands rejected as unpatentable over Kechel in view of Vanderbles and in further view of Hanson, we understand Hanson to be incorporated in the rejections of claims 4, 5, and 8, which depend from claim 1. We consider the Examiner's omission as a particularity of the Examiner's writing style and credit the rejections as including Hanson.

FINDINGS OF FACT

Kechel

We make the following findings of fact with respect to Kechel:

1. Kechel discloses a multi-pass mail sorting method in which presorted mail (sorted by presort mailers) and non-presorted mail items (deposited into the postal system) are sorted progressively by a sorting system (col. 3, ll. 59-61 and col. 5, ll. 50-55).
2. The mail carrier delivers mail to a plurality of “destinations” (delivery points) on multiple “streets” (carrier routes) (col. 4, ll. 20-23).
3. Kechel teaches presort mailers that provide pre-sorted mail resulting from sorting mail destined to a predetermined list of recipients (col. 5, ll. 5-8 and 35-49).
4. In Kechel’s method, in a first pass the non-presorted mail is sorted into a plurality of bins, wherein each bin contains mail destined to the first “destination” on each “street” (col. 4, ll. 28-33 and col. 5, ll. 55-57).
5. Kechel further discloses merging the mail sorted in the first pass with the presorted mail in a combined batch (col. 5, ll. 57-59).
6. Kechel’s method then sequentially feeds the combined batches into the sorting system and sorts the combined batches in a second pass such that each batch of mail is directed to an output bin corresponding to sequential “destinations” on each “street” (col. 4, ll. 34-46 and col. 5, ll. 63-67).
7. Presorted mail” is defined as “mass mailings of sales materials” (col. 1, ll. 39-41).

Hanson

We make the following findings of fact with respect to Hanson:

8. Hanson discloses a mail sorting method for sorting different types of mail products, *i.e.*, letters and flats (¶ 2).
9. Hanson's method includes sorting a first type of product (letters) into a sequential order for delivery using a two-pass sorting scheme to form a pre-sequenced first product (¶¶ 15 and 32).
10. Hanson's method also includes passing a second type of product (flats) through a first-pass of the two-pass sorting scheme (¶¶ 15 and 32).
11. Hanson's method then intermixes the pre-sequenced first product (letters) during the second-pass sorting of the second type of product (flats) to form a sequentially merged group of the first and the second type of product (letters and flats) for each delivery point (¶¶ 15 and 32).

PRINCIPLES OF LAW

1. To support an obviousness rejection all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).
2. For a prima facie case of obviousness to be established there must be "an apparent reason to combine the known elements in the fashion claimed." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007).

OPINION

Rejection of Claims 1, 3, 6, 7, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Kechel, Vanderbles, and Hanson

The Appellants argue claims 1, 3, 6, and 7 under 35 U.S.C. § 103(a) together as a group. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(vii) (2007), we have selected claim 1 as the representative claim to decide the appeal of the rejection of claims 3, 6, and 7 standing or falling with claim 1. In view of the Appellants' arguments, the rejection of claim 9 will be addressed separately.

Claims 1, 3, 6, and 7

Issue (1)

The Appellants argue that because the “Examiner agreed with the Applicant that ‘Hanson does not explicitly discuss saturation mail’ ... it is [then] impossible for Hanson to disclose ‘feeding one or more pieces of saturation mail into the mail sorting [system]...’ ” (App. Br.³ 8) (underlining in original). In other words, according to the Appellants, the Examiner’s position is inconsistent because, on the one hand, the Examiner acknowledges Hanson does not disclose the limitation of “saturation mail” (Final Rejection at 9), but, on the other hand, the Examiner asserts that “Hanson discloses a similar mail merging operation including feeding one or more pieces of saturation mail into the mail sorting [system]” (Final Rejection at 4) (underlining added). In response to the Appellants’

³ We refer herein to the Appeal Brief (“App. Br.”), filed December 12, 2007, the Reply Brief (“Reply Br.”), filed February 29, 2008, the Examiner’s Answer (“Ans.”), mailed January 24, 2008, the Examiner’s Amended Answer (“Amended Answer”), mailed March 6, 2008, and the Final Rejection (“Final Rejection”), mailed July 12, 2007.

argument, the Examiner clarifies that the teachings of Hanson were used to show a feeding sequence in which different types of mail items (letters and flats) are input into a mail sorting system (Ans. 10). Moreover, the Examiner asserts that Kechel teaches the limitation of “saturation mail” (Ans. 11).

Although we agree with the Appellants that Hanson does not disclose the limitation of “saturation mail,” the Appellants’ argument is unpersuasive because it attacks Hanson individually, rather than the combination of Kechel, Vanderbles, and Hanson. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Kechel specifically defines “presorted mail” as “mass mailings of sales materials” (Finding of Fact 6). The Appellants define “saturation mail” as,

...a mailing that covers at least 75% of all delivery points on the route or 90% of the residential delivery points on the route. For example, a local store may wish to send an advertisement to every residential delivery point on one or more routes (Spec. 13, ¶ 39).

Therefore, just as the Examiner asserted, the limitation of “saturation mail” of claim 1 reads on the disclosed “presorted mail” of Kechel.

Furthermore, when reading the record in its entirety, the Examiner’s position on the teachings of Hanson appears to be consistent. First, the Examiner explicitly acknowledges that Hanson does not disclose the limitation of “saturation mail” (Final Rejection at 9). Second, the Examiner specifically states that “Kechel discloses the saturation mail but does not

disclose feeding it immediately after sorting the first batch of mail” (Ans. 10) (underlining added). Third, the Examiner uses the teachings of Hanson to show a “feeding sequence” (Ans. 10), that is, “Hanson is relied upon for the timing or feed sequence of the different types of mail” (Final Rejection at 9) (underlining added). Finally, the Examiner concludes that,

[i]t would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Kechel to include the specific feed sequence, as taught by Hanson, for the purpose of... (Ans. 5) (underlining added).

Therefore, the Examiner consistently refers to the teachings of Hanson to show the feeding sequence of different types of mail and not to disclose “saturation mail.” In conclusion, we find that the Examiner’s reading of the teachings of Hanson with respect to the limitation of “saturation mail” is consistent throughout the record of the instant application.

Issue (2)

The Appellants argue that the Examiner’s reason to combine the teachings of Kechel and Hanson to provide “a merged set of mail” is not an adequate reason “because the system disclosed in Kechel already produces this result” (Reply Br. 2). The system of Kechel produces a “merged set of mail” (Findings of Fact 1 and 5). Specifically, the system of Kechel merges presorted mail items (saturation mail) (Finding of Fact 3) with mail items sorted in a first-pass of a multi-pass mail sorting method in a combined batch (Findings of Fact 4 and 5). After forming the combined batch, the mail items in Kechel are further sorted in a second-pass to correspond to sequential “destinations” (points of delivery) on a “street” (carrier route)

(Finding of Fact 6). On the other hand, Hanson uses a two-pass sorting scheme to achieve a similar sequential sorting of mail items by points of delivery (destinations) on a carrier route (street) (Findings of Fact 9, 10, and 11) without having to form a combined batch. Therefore, the system of Hanson represents an improvement as compared to the system of Kechel because the need to form a combined batch is eliminated, hence reducing the number of operations. "[I]f 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." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). Therefore, modifying the mail sorting method of Kechel to provide saturation mail immediately after sorting a batch of mail according to the second-pass plan and immediately prior to feeding a consecutive batch of mail according to the second-pass plan as taught by Hanson would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *Id.* at 1741. The improvement appears to be the product not of innovation but of ordinary skill and common sense. A person of ordinary skill in the art would readily appreciate that the benefits gained by feeding saturation mail immediately after sorting the batch of mail according to the second-pass and immediately prior to feeding a consecutive batch of mail according to the second-pass, as taught by Hanson, would achieve similar benefits in the mail sorting method of Kechel. Moreover, the Appellants do not provide any evidence to show that modifying Kechel to feed saturation mail immediately

after sorting a batch of mail according to the second-pass and immediately prior to feeding a consecutive batch of mail according to the second-pass would have been beyond the technical grasp of a person of ordinary skill in the art.

For the reasons discussed above, the Appellants' arguments do not demonstrate error in the Examiner's rejection of claim 1, and claims 3, 6 and 7 standing or falling with claim 1. Accordingly, the rejection of claim 1, and claims 3, 6, and 7 standing or falling with claim 1, is sustained.

Claim 9

Issues (1) and (2)

The Appellants' only argument as to why claim 9 is unpatentable over Kechel in view of Vanderbles and in further view of Hanson is that the "remarks for claim 1 apply to claim 9, because claim 9 requires 'inputting a batch of saturation mail into the sorting system immediately after inputting the first batch of mail into the sorting system'" (App. Br. 8) (underlining in original). For the reasons discussed above, the Appellants have not demonstrated any error in the Examiner's rejection of claim 1 as unpatentable over Kechel in view of Vanderbles and in further view of Hanson. Likewise, the Appellants' argument as to claim 9 fails to demonstrate error in the rejection of claim 9 as unpatentable over Kechel in view of Vanderbles and in further view of Hanson. The rejection is sustained.

Rejection of Claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Kechel, Vanderbles, Hanson, and Burns and Rejection of Claim 8 under

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*35 U.S.C. § 103(a) as unpatentable over Kechel, Vanderbles, Hanson, and
Steinmetz*

Although the Appellants do not specifically address the grounds of rejection of claims 4, 5, and 8, it is apparent that the Appellants intend to contest the rejections of claims 4, 5, and 8 as part of the instant appeal (App. Br. 2), presumably relying on the same argument advanced against the rejection of claim 1 from which they depend. As stated *supra*, we are not persuaded by the Appellants' arguments as to any error by the Examiner in the rejection of claim 1. Accordingly, we are equally not persuaded of any error on the part of the Examiner in the rejections of claims 4, 5, and 8.

DECISION

The decision of the Examiner to reject claims 1 and 3 through 9 under 35 U.S.C. § 103(a) is affirmed.

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) (2007).

AFFIRMED

JRG

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005