

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM F. CHARRON, EDWARD A. KRUPOTICH,
GEORGE H. BINGHAM and JAMES R. SENCENBAUGH

Appeal No. 97-2547
Application 07/949,042¹

ON BRIEF

Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL AND ON REQUEST FOR RECONSIDERATION

This application is before us for a decision on the

¹ Application for patent filed September 22, 1992. According to appellants, the application is a division of Application 07/695,435, filed May 3, 1991, now U.S. Patent No. 5,156,515, issued October 20, 1992, which is a continuation of Application 07/346,647, filed May 3, 1989, now abandoned.

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appellants' current appeal from the examiner's final rejection of claim 48² and on the appellants' previously filed request for reconsideration of our decision in an earlier appeal wherein we sustained the examiner's rejection of claims 21 and 26. Claims 22 through 25, 27 through 32, 49, 50, 58 through 61, 63, 64 and 66 through 68, the only other claims presently pending in the application, stand allowed.

The invention relates to a "method for extracting contents from envelopes for processing by an operator" (specification, page 1). Independent claims 21 and 48 read as follows:

21. A method of extracting contents from envelopes with an extracting machine and delivering the extracted contents to a work station positioned to one side of the machine, comprising the steps of stacking envelopes to be processed at an input station, feeding the envelopes one at a time from the input station to a cutting station, severing the envelopes along edge portions thereof at the cutting station to provide access to the contents, transporting the envelopes from the cutting station to a separating station, separating the contents from the envelopes at the separating station, and conveying the separated contents from one envelope at a time along a horizontally extending path to the work station at one side of the machine.

48. In a method of extracting contents from envelopes which have been severed along edge portions thereof and

² Claim 48 has been amended subsequent to final action.

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delivering the extracted contents to a work station, the steps of: separating the contents from the envelopes at a separating station, conveying the separated contents along a path which extends between the separating station and a work station positioned to one side of the separating station, the greater portion of the path length being horizontal, and presenting the contents from one envelope at a time at the work station.

The prior art references relied upon by the examiner as evidence of anticipation and obviousness are:

DeHart 1977	4,016,708	Apr. 12,
Russell et al. (Russell) 7, 1978	4,123,890	Nov.

In the earlier appeal, we rendered a decision (Paper No. 20) wherein, inter alia, we sustained the examiner's 35 U.S.C. § 102(b) rejection of claims 21 and 26 as being anticipated by DeHart, refused to sustain the examiner's 35 U.S.C. § 102(b) rejection of claim 48 as being anticipated by DeHart, and entered new 35 U.S.C. § 112, first and second paragraph, rejections of claim 48 pursuant to 37 CFR § 1.196(b). In response, the appellants filed a request for reconsideration pursuant to 37 CFR § 1.197(b) (Paper No. 21) relating to the sustained rejection of claims 21 and 26, and an amendment pursuant to 37 CFR 1.196(b)(1) (Paper No. 22) relating to the new rejections of claim 48. We remanded the application to

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the examiner (Paper No. 23) for consideration of the amendment and indicated that our review of the request for reconsideration would be held in abeyance until the return of the application to this Board. Ultimately, the examiner issued a final action (Paper No. 26) withdrawing the 35 U.S.C. § 112, first and second paragraph, rejections of claim 48 as amended and rejecting this claim under 35 U.S.C. 102(b) as being anticipated by DeHart and under 35 U.S.C. § 103 as being unpatentable over DeHart in view of Russell.³ The appellants then took the instant appeal.

Turning first to the appellants' request for reconsideration of our affirmance in the earlier appeal of the 35 U.S.C. § 102(b) rejection of claims 21 and 26, it is noted as a preliminary matter that the appellants have moved to strike that portion of the examiner's answer (Paper No. 37) filed in connection with the current appeal which comments on the request for reconsideration. According to the appellants,

³ The final action also included a new 35 U.S.C. § 112, second paragraph, rejection of claim 48 as amended. The examiner withdrew this rejection in light of the further amendment of claim 48 subsequent to final action (see the advisory action dated April 8, 1996, Paper No. 31).

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the Examiner lacks standing to make such comments (see page 1 in the reply brief filed in connection with the current appeal, Paper No. 38). This matter, however, is not directly connected with the merits of issues involving a rejection of claims and therefore is reviewable by petition to the Commissioner rather than by appeal to this Board. See In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971). Accordingly we shall not decide or further discuss the appellants' motion to strike.

As for the merits of the appellants' request for reconsideration, we stated in our earlier decision that:

DeHart discloses a method of extracting contents from envelopes with a table top extracting machine. The method includes the steps of stacking the envelopes at an input station 24, feeding the envelopes one at a time from the input station to a cutting station 30, severing the envelopes along edge portions thereof at the cutting station, transporting the envelopes from the cutting station to a separating station 34, separating the contents from the envelopes at the separating station, and conveying the separated contents from one envelope at a time down a chute 38.

The appellants argue that the method recited in claim 21 is not anticipated by DeHart because "[i]n

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DeHart, there is no work station, no conveyance of contents between an extractor and a work station, and no horizontally extending path" (main brief [Paper No. 15], page 6). This line of argument, however, is not persuasive. The area immediately downstream of DeHart's chute 38 constitutes a work station as broadly defined in claim 21. In addition, the lower end of the chute 38, which extends tangentially to the horizontal, would inherently function to convey the extracted contents of each envelope along a horizontally extending path to this work station as broadly claimed. Thus, DeHart does indeed meet the limitations in claim 21 argued by the appellants.

Since the appellants have not challenged the 35 USC 102(b) rejection of claim 26 with any reasonable specificity, this claim falls with parent claim 21 (see In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987)) [Paper No. 20, pages 4 and 5].

In their request for reconsideration, the appellants submit that

Claims 21 and 26 distinguish over DeHart in the following ways: (1) the term work station is a term of art which has an established meaning and cannot be given the broad interpretation suggested by the Board; (2) the work station is defined as being positioned "to one side of the machine"; and (3) DeHart does not show the conveying of contents along a horizontally extending path to a work station [request, page 1].

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The arguments advanced in support of these points (see pages 2 and 3 in the request) are basically rehashes of the arguments advanced in the earlier appeal and are no more persuasive now than they were then. During patent examination, the terms in a claim are to be given their broadest reasonable interpretation consistent with the specification without reading limitations from the specification into the claim. See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The appellants' reliance on their specification and on the 37 CFR § 1.132 declaration of Edward A. Krupotich filed on July 6, 1993 (Paper No. 6)⁴ to read limitations into the term "work station" as employed in claim 21 (see page 2 in the request) is not well taken because neither establishes that "work station" is a term of art having an established specific meaning. Thus, we remain of the view that the area immediately downstream of DeHart's chute 38 constitutes a "work station" as broadly defined in claim 21. Moreover,

⁴ Paper No. 6 actually contains a copy of the Krupotich declaration. The original is of record in parent Application 07/695,435 which has matured into U.S. Patent No. 5,156,515.

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while the appellants are correct in pointing out that this "work station" is in the front of DeHart's machine (see page 2 in the request), it nonetheless meets the requirement in claim 21 that the work station be "at one side of the machine" since the front of DeHart's machine forms one of its four sides. Finally, while the appellants would appear to be correct in asserting that documents sliding off DeHart's chute 38 will drop below the chute (see page 3 in the request), they have not demonstrated or cogently explained why such documents will not move horizontally, at least to a small extent, before doing so. We therefore remain of the view that DeHart, under principles of inherency, meets the rather broad limitation in claim 21 requiring the envelope contents to be conveyed along a horizontally extending path to the work station.

To summarize, we have reconsidered our earlier decision on appeal to the extent indicated above, but decline to make any changes therein.

Turning now to the appellants' current appeal, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim

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48 as being anticipated by DeHart.

Claim 48 recites a method comprising, inter alia, the step of conveying the contents separated from envelopes along a path which extends between a separating station and a work station with "the greater portion of the path length being horizontal." As is readily apparent from Figure 1 in the DeHart reference, the path extending between DeHart's separating station 34 and work station (the area immediately downstream of the chute 38) does not have a length the greater portion of which is horizontal. The examiner's three theories to the contrary (see page 4 and 5 in the final rejection, Paper No. 26, and pages 5 and 6 in the answer, Paper No. 37) are not persuasive because they are based interpretations of DeHart which are completely inconsistent with teachings of this reference.

We shall sustain, however, the standing 35 U.S.C. § 103 rejection of claim 48 as being unpatentable over DeHart in view of Russell.

The method disclosed by DeHart meets all of the limitations in claim 48 except for the one requiring the contents to be conveyed between the separating station and the work station along a path with "the greater portion of the path length being horizontal." The appellants' arguments to the contrary (see pages 3 through 5 in the main brief, Paper No. 36, and pages 1 and 2 in the reply brief, Paper No. 38) are not convincing for the reasons discussed above and in our earlier decision with regard to claim 21.

Russell discloses a method for opening envelopes wherein the envelopes are fed, one at a time, through an apparatus which separates the top and bottom panels of the envelopes along three sides and lays the top panel back so as to expose the contents. The opened envelopes are then sequentially delivered to an elongate conveyor 15 which extends past a series of desks 16 for sorting by personnel positioned at each of the desks (see, for example, column 5, lines 9 through 19; and column 7, line 60 through column 8, line 4). As shown in Figure 1, the conveyor 15 carries the envelopes and their contents from the opening apparatus to the sorting desks along a horizontally disposed path.

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A person of ordinary skill in the art would have readily appreciated Russell's step of conveying envelopes and their contents from an opening machine to sorting desks or work stations along an elongate horizontal path to be an advantageous manner of distributing the contents to areas remote from the machine. This appreciation would have provided such a person with ample motivation or suggestion to add such a step to the DeHart method, thereby arriving at the subject matter recited in claim 48. In this light, the various impermissible hindsight arguments presented by the appellants in the main and reply briefs (Paper Nos. 36 and 38) are not persuasive.

Additionally, it is noted that in the earlier appeal the appellants relied upon the above noted Krupotich declaration, which purportedly demonstrates commercial success and copying, as evidence of non-obviousness. For whatever reason, the appellants have not relied upon the Krupotich declaration in arguing the merits of the standing 35 U.S.C. § 103 rejection of claim 48 in the current appeal. Thus, the declaration is not at issue with regard to this rejection. See 37 CFR § 1.192(a) ("The brief . . . must set forth the authorities

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and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board").

Moreover, even if the Krupotich declaration had been argued, it would be entitled to little, if any, probative value as evidence of non-obviousness. The sales figures discussed in the declaration (see paragraph 18) are somewhat ambiguous and have not been placed in any meaningful context. Bald sales figures such as these constitute minimal evidence of commercial success. See In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); Cable Elec. Prods. Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226 USPQ 881, 887-88 (Fed. Cir. 1985). The declaration is also lacking on the issue of commercial success in that it fails to establish that the alleged sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed subject matter. Id. Finally and as pointed out in footnote 5 on page 10 of our earlier decision (Paper No. 20), the exhibits accompanying the declaration do not include the one relied upon to establish copying (see declaration

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paragraph 15).

In summary:

a) the appellants' request for reconsideration of our earlier decision wherein we sustain the examiner's rejection of claims 21 and 26 is denied; and

b) the decision of the examiner to reject claim 48 in the current appeal is affirmed.

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

Should the appellants elect to file a request for reconsideration pursuant to 37 CFR § 1.197(b) with respect to the sustained rejection of claim 48, this decision will be treated as non-final for purposes of seeking judicial review until such time as the request for reconsideration is disposed of.

JAMES M. MEISTER)
Administrative Patent Judge)
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