

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. TRAISE and MICHAEL S. KALISIAK

Appeal No. 1998-0797
Application No. 08/470,706

ON BRIEF

Before CALVERT, FRANKFORT, and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 5 and 79 to 81. The other claims remaining in the application, 6 to 12 and 53 to 78, have been indicated as allowable subject to being rewritten in independent form.

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The appealed claims are drawn to an integrated system for folding, inserting, and pressure sealing mailer type business forms, and are reproduced in the appendix of appellants' brief.¹

The references applied in the final rejection are:

| | | |
|------------------------------------|-----------|----------|
| Neill et al. (Neill) 1977 | 4,033,807 | Jul. 5, |
| Vijuk 1990 | 4,905,977 | Mar. 6, |
| Brigante et al. (Brigante) 1992 | 5,082,255 | Jan. 21, |
| Kalisiak et al. (Kalisiak) 1992 | 5,169,489 | Dec. 8, |

The admitted prior art on pages 1 to 4, 11 and 18 of appellants' specification (APA).

The claims on appeal stand finally rejected under 35 U.S.C. § 103 as unpatentable over the following combinations of references:²

(1) Claim 1, Neill in view of APA and Kalisiak;

¹ We note that in claim 1 in the appendix, "mounted" in line 3 should be --mounting--.

² In stating the rejections in the Examiner's Answer, the examiner did not include claims 79 to 81, but inasmuch as appellants have argued the rejections of those claims in their brief and reply brief, they do not appear to have been prejudiced by this inadvertent omission.

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(2) Claims 2, 3, 5, 79 and 80, Neill in view of APA, Kalisiak and Vijuk;

(3) Claims 4 and 81, Neill in view of APA, Kalisiak, Vijuk and Brigante.

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Rejection (1)

The Neill reference discloses a system including a folder FS for folding paper sheets having pressure activated adhesive A₁, A₂, etc., to form pre-mailers; an inserter IS for inserting elements into the pre-mailers; a pressure sealer 29, 30 for the pre-mailers (col. 7, lines 33 to 36; col. 8, lines 35 to 41); and a stacker for the sealed mailers (Fig. 8 and col. 8, line 42). Neill differs from the apparatus recited in claim 1 in that there is no disclosure that the folder, inserter, etc., are mounted in or on "a common housing mounted on movable elements." However, the examiner considers the subject matter of claim 1 to have been obvious notwithstanding this difference, basing this conclusion on the teaching of Kalisiak, as stated at page 4 of the answer:

Because Kalisiak teaches the use of a common housing for a business form sealer it would have been obvious to one having ordinary skill in the art to incorporate a similar housing for the device of the combined references [i.e., Neill and APA]. Also, to mount movable elements onto a housing is notoriously well known throughout the mechanical arts.

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Kalisiak discloses a system in which, mounted on frame 34, 35 are two vertically-spaced sealing devices 11, 12, which are used to seal the pressure-sensitive adhesive on business forms 55. According to the patent, the two pressure sealing

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devices are mounted in a vertically stacked orientation so that they take up a minimum of floor space and can be monitored by a single operator (col. 1, lines 30 to 36).

After fully considering the record in light of the arguments presented in appellants' brief and reply brief, and in the examiner's answer, we conclude that rejection (1) is not well taken.

We do not agree with appellants that "[t]he applied references have nothing to do with the invention" (brief, page 7). Nevertheless, we do not consider that it would have been obvious, in view of Kalisiak, to locate the folder, inserter, pressure sealers and stacker disclosed by Neill all in a single common housing. While it might have been obvious, in view of Kalisiak, to mount Neill's sealers 29, 30 vertically above each other in a common housing or frame, we do not consider that one of ordinary skill would derive from Kalisiak any teaching or suggestion of mounting the folding stage, insert stage and stacker all in the same housing along with the sealers. Any such suggestion would appear to come not from

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the prior art, but to be based on improper hindsight gleaned from appellants' disclosure.

Accordingly, rejection (1) will not be sustained.

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Rejections (2) and (3)

Rejections (2) and (3) likewise will not be sustained, since the additional references applied therein do not supply the deficiencies in the applied prior art as discussed above with regard to rejection (1).

Conclusion

The examiner's decision to reject claims 1 to 5 and 79 to 81 under 35 U.S.C. § 103 is reversed.

REVERSED

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| JOHN P. MCQUADE |) | |
| Administrative Patent Judge |) | |

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REVERSED

Prepared: December 11, 2000