

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THYAGARAJ SARADA

Appeal No. 96-1903
Application 08/263,368¹

ON BRIEF

Before KRASS, BARRETT and LALL, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection² of Claims 1, 5 to 7, 9 to

¹ Application for patent filed June 20, 1994.

² Two amendments after the final rejection were filed, papers no. 6 and 12 on February 13, 1995 and September 18, 1995 respectively, and were entered in the record.

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11, and 14 to 20. Claims 2, 3, 4, 8, 12 and 13 have been canceled.

The disclosed invention pertains to printing of information on a mail piece. In conventional systems, the printing of a postage indicia and the printing of an address and other information on a mail piece are performed by different printing mechanisms. The invention provides for a postage meter that has a single printer that is capable of printing both the postage indicia and the other information within the postal logo area. The invention is further illustrated by the claims below.

Representative claims 1 and 9 are reproduced as follows:

1. A postage meter having a housing, a keypad supported by the housing, a microprocessor 16 supported within the housing and in connection with a keypad, a matrix character generator, in communication with the microprocessor, a meter memory unit in communication with a microprocessor and a printer supported by said housing and in connection with said matrix character generator for printing a postage indicia, said printer comprising:

a) a housing, first and second printheads of an ink jet printer spaced from one another and supported by said housing, each of said printheads having a plurality of elements located within the area defined by a postage indicia; wherein said microprocessor includes means for controlling said first printhead for printing a postage indicia logo and said second printhead to print optical character recognition readable information both within the indicia area;

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b) a red fluorescent ink in confluence with said first printhead;

c) a black ink in communication with said second printhead, and means causing said first and second printheads to applying therein respective inks directly to a mail piece to form a mail indicia, that contains fixed and variable information.

9. A postage meter printer for printing a postage indicia, comprising:

a) means for printing a postage logo with a fluorescent ink directly within the area defined by the postage indicia; and

b) means for printing a line of optical character recognition readable information with high contrast ink directly within the area defined by the postage indicia, that contains fixed and variable information.

The Examiner relies on the following reference:

Hubbard 1975	3,869,976	Mar. 11,
Calvi 1986	4,580,144	Apr. 1,
Pastor 1991	5,073,935	Dec. 17,
Auslander et al. 1992 (Auslander)	5,114,478	May 19,

Admitted Prior Art (APA): Appellant's Disclosure

Claims 1, 5 to 7, 9 to 11, and 14 to 20 stand rejected under 35 U.S.C. § 103 as being obvious over various combinations of Hubbard, Calvi, Pastor, Auslander and APA.

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Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs³ and the answers⁴ for the respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellant's arguments set forth in the brief.

It is our view that claims 9, 10, 11, 14, 15 and 18 are obvious over various combinations of Hubbard, APA, Auslander, Calvi and Pastor, while claims 1, 5 to 7, 16, 17, 19 and 20 are not obvious over the suggested various combinations of Hubbard, APA, Auslander, Calvi and Pastor. Accordingly, we affirm in part.

In our analysis, we are guided by the general

³ Two reply briefs, papers no. 11 and 19, were filed on July 17, 1995 and December 17, 1998 respectively.

⁴ An Examiner's answer, [paper no. 10], was filed with a new ground of rejection which replaced the final rejection. A supplemental answer, [paper no. 13] was filed with yet another new ground of rejection which in turn replaced the new ground of rejection in the Examiner's answer.

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proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Rejection of Claims 1, 9, 10, 14 to 16, 18 and 19 under 35 U.S.C. § 103

These claims are rejected as being obvious over Hubbard in view of APA, Auslander and Calvi. We first consider claim 9 which is the broadest claim. We have reviewed the Examiner's final position on the rejection of these claims [supplemental answer, pages 2 to 5] and Appellant's argument [second reply brief, pages 2 to 3]. We agree with the Examiner that Hubbard shows means for printing

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a postage logo, 28 and 30 and roller 102, and means to print a line of variable information, ink jet printing element 40. APA discloses the use of fluorescent ink for postage indicia and the other ink for printing other data to be machine readable, [disclosure, page 1, lines 25 to 27]. Furthermore, Auslander teaches that, in postage, the use of fluorescent inks is common. We also take note that Calvi, like Hubbard, discloses the use of a microprocessor to generate the variable postage information. Therefore, it would have been obvious, to one of ordinary skill in the art at the time of the invention, to use, in Hubbard, the fluorescent ink to print the postage logo and the machine readable ink to print the date and postage information in view of the above teachings of APA and Auslander. We, therefore, sustain the Examiner's rejection of claim 9 over Hubbard, APA, Auslander and Calvi. Since Appellant has not argued separately claims 10, 14, 15 and 18 which depend from this claim, their obviousness rejection over Hubbard, APA, Auslander and Calvi is also sustained.

Next, we consider the independent claim 1. After our review of the Examiner's rejection of claim 1, [supplemental

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answer, pages 2 to 5], and Appellant's argument [second reply brief, pages 2 to 3], we are in agreement with the Appellant that Hubbard's two printing means 28, 30 and 102, and 40 can not be obviously combined with APA's two print heads ink jet printer as asserted with the Examiner. The Examiner contends that "The mere substitution of one known type of printhead for an equivalent another by those having ordinary skill in the art in order to achieve the same printing function would have involved no apparent unobviousness." [Supplemental answer, page 3]. We disagree. The printing mechanisms 28, 30 and 102, of Hubbard is of different type than an ink jet printer and works on a different principal. To replace it and the other printer 40 in Hubbard with a single printer with two printheads would not have been obvious without using Appellant's disclosure as a blue print. That is impermissible. Neither Calvi nor Auslander cures this deficiency. Thus, the obviousness rejection of claim 1 over Hubbard, APA, Auslander and Calvi is not sustainable. Since the dependent claims 16 and 19 each contain at least the limitation of the parent claim 1, the obviousness rejection of claims 16 and 19 is also not sustainable.

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Rejection of claims 5 and 20 under 35 U.S.C. § 103

Claim 5 is rejected as being obvious over Hubbard in view of APA, Auslander, Calvi and Pastor. Claim 5 depends on claim 1 and contains at least the limitations of claim 1. Pastor does not cure the deficiencies of the combination of Hubbard in view of APA, Auslander, Calvi that was used to reject claim 1. Therefore, the obviousness rejection of claim 5 over Hubbard in view of APA, Auslander, Calvi and Pastor is not sustainable.

Claim 20 is rejected as being obvious over Hubbard in view of APA, Auslander, Calvi and "applicant's another [sic] admission" [supplemental answer, page 7]. Claim 20 depends on claim 1 and contains at least the limitations of claim 1. The "applicant's another [sic] admission", which refers to another page of the specification, namely: page 1, lines 12 to 21, does not cure the deficiencies noted in the suggested combination of Hubbard in view of APA, Auslander and Calvi in regard to claim 1. Therefore, the obviousness rejection of claim 20 over Hubbard in view of APA, Auslander, Calvi and "applicant's another [sic] admission" is not sustained.

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Rejection of Claims 6 and 17 under 35 U.S.C. § 103

Claims 6 and 17 are rejected as being obvious over Hubbard in view of APA and Calvi. We take the independent claim 6 as an example. After considering the Examiner's position [supplemental answer, pages 5 and 6] and Appellant's argument [second reply brief, page 4], we are of the view that the Examiner's suggested combination of Hubbard, APA and Calvi does not meet the limitations of claim 6, for example, limitations: "a first ink ... indicia" (item b); "a first ..." (item c); and "second ... " (item d). As we discussed Hubbard before in regard to claim 1, Hubbard does not have the structure of the two printing mechanisms of a nature from which the claimed structure can be realized without the impermissible use of the blue print of the claimed invention. Therefore, the obviousness rejection of claim 6 over Hubbard, APA and Calvi is not sustainable. Since claim 17 depends on claim 6 and thereby contains at least the same limitations as discussed above, the obviousness rejection of claim 17 over Hubbard, APA and Calvi is also not sustainable.

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Rejection of Claim 7 under 35 U.S.C. § 103

Claim 7 is rejected as being unpatentable over Hubbard in view of APA, Calvi and Auslander. We have considered the Examiner's position [supplemental answer, pages 6 to 7] and Appellant's argument [second reply brief, page 5]. Since claim 7 depends on claim 6 and contains at least the limitations discussed above in regard to claim 6. Auslander does not cure the deficiencies noted in the combination of Hubbard, APA and Calvi to reject claim 6. Therefore, the obviousness rejection of claim 7 over Hubbard in view of APA, Calvi and Auslander is not sustained.

Rejection of Claim 11 under 35 U.S.C. § 103

Claim 11 is rejected as being unpatentable over Hubbard, APA, Auslander, Calvi and Pastor. We have sustained above the obviousness rejection of claim 9 over Hubbard, APA, Auslander and Calvi. Claim 11 depends on claim 9 and contains the additional limitation: "including means for ... encrypted number ... indicia." (Lines 1 to 3). We have considered the

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Examiner's position [supplemental answer, page 7] and Appellant's argument [second reply brief, pages 5 to 6]. We agree with the Examiner's reasoning that if one were desirous of securing a communication, one would have looked to the art on methods to secure communication. One such art reference would have been the Pastor patent. Pastor discloses the use of encrypted numbers for alphanumeric characters, see Abstract. We, therefore, sustain the obviousness rejection of claim 11 over Hubbard, APA, Auslander, Calvi and Pastor.

In summary, we have affirmed under 35 U.S.C. § 103 the obviousness rejection of claims 9, 10, 14, 15 and 18 over Hubbard, APA, Auslander and Calvi and claim 11 over Hubbard, APA, Auslander, Calvi and Pastor. However, we have reversed under 35 U.S.C. § 103 the obviousness rejection of claims 1, 16 and 19 over Hubbard, APA, Auslander and Calvi; claim 5 over Hubbard, APA, Auslander, Calvi and Pastor; claims 6 and 17 over Hubbard, APA and Calvi; claim 7 over Hubbard, APA, Calvi and Auslander; and claim 20 over Hubbard, APA, Auslander, Calvi and "applicant's another [sic] admission".

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In conclusion, the decision of the Examiner rejecting Claims 1, 5 to 7, 9 to 11, and 14 to 20 under 35 U.S.C. § 103 is affirmed in part.

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

AFFIRMED IN PART

	ERROL A. KRASS)	
	Administrative Patent Judge)	
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	LEE E. BARRETT)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	PARSHOTAM S. LALL)	
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