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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CLARE E. WOODMAN, DENIS J. STEMMLE,  
JOHN W. SUSSMEIER, ERIC A. BELEC, BORIS ROZENFELD,  
GREGORY P. SKINGER, and MICHAEL J. CUMMINGS

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Appeal 2011-000202  
Application 11/803,555  
Technology Center 3700

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Before LINDA E. HORNER, JOHN C. KERINS, and  
BEVERLY M. BUNTING, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Clare E. Woodman et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1, 2, 8, 9, and 11. Claims 3-7, 10, 12, and 13 have been objected to as being dependent

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upon rejected base claims. Claims 14-20 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

#### THE INVENTION

Appellants' claimed invention "relates generally to a mail creation system that uses an input of a single web of paper to create content and envelopes for creation and mass-production of [] finished mailpieces."

Spec. 1, ll. 5-7. Claim 1, reproduced below, is the sole independent claim and is illustrative of the subject matter on appeal.

1. A method for creating mailpieces from a single web of printed material, wherein the web of printed material includes printed matter to be used as envelopes, and other printed matter to be used as mail content to be included in the envelopes, the mail content of mailpieces having varying numbers of pages, wherein mailpieces with mail content having more than a predetermined number of pages are large mailpieces, and mailpieces with mail content having less than or equal to the predetermined number of pages are small mailpieces, the method comprising:

cutting consecutive sections of the web into separated sheets, some of the sheets comprising envelope sheets including envelope printed matter, and some of the sheets comprising mail content sheets including mail content printed matter, the step of cutting further including cutting variable sized sheets depending on whether a sheet is a mail content sheet, or an envelope sheet, the step of cutting variable sized sheets further including cutting larger sized envelope sheets for large mailpieces and smaller envelope sheets for small mailpieces;

accumulating mail content sheets belonging to a same mailpiece;

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enclosing the accumulated mail content sheets in a corresponding envelope sheet, the larger sized envelope sheets forming larger envelopes and the smaller sized envelope sheets forming smaller envelopes.

#### THE EVIDENCE

The Examiner relies upon the following evidence:

Helm	US 4,136,591	Jan. 30, 1979
Silverschotz	US 5,137,304	Aug. 11, 1992
Murphy	US 5,398,867	Mar. 21, 1995
Madrzak	US 6,427,938 B1	Aug. 6, 2002

#### THE REJECTIONS

Appellants seek review of the following rejections:

1. Claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over Murphy and Helm;
2. Claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Murphy, Helm, and Madrzak; and
3. Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Murphy, Helm, and Silverschotz.

#### ISSUE

The issue presented by this appeal is whether the Examiner has adequately shown how the combined teachings of Murphy and Helm would have led one of ordinary skill in the art to the method for creating mailpieces from a single web of printed material, as set forth in claim 1, including the steps of: (1) cutting larger size envelope sheets for mailpieces having more than a predetermined number of pages and smaller envelope sheets for mailpieces having less than or equal to the predetermined number of pages;

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and (2) enclosing accumulated mail content sheets for a mailpiece in a corresponding larger or smaller sized envelope sheet.

#### ANALYSIS

Claim 1 defines large mailpieces as mailpieces with mail content more than a predetermined number of pages and small mailpieces as mailpieces with mail content less than or equal to the predetermined number of pages. Claim 1 calls for the cutting step to include “cutting consecutive sections of the web into separated sheets . . . including cutting variable sized sheets . . . including cutting larger sized envelope sheets for large mailpieces and smaller envelope sheets for small mailpieces.” Claim 1 further recites the step of “enclosing the accumulated mail content sheets in a corresponding envelope sheet, the larger sized envelope sheets forming larger envelopes and the smaller sized envelope sheets forming smaller envelopes.”

The Examiner found that Murphy discloses the claimed method including creating mail pieces, which include both mail content and envelopes, from a single web of printed material. Ans. 3. The Examiner found that Murphy discloses the mail content can have varying numbers of pages. *Id.* The Examiner also found that Murphy discloses:

separating the variable sized sheets based on whether it is an envelop[e] or content sheet through the use of perforations, accumulating mail content sheets belonging to a same mail piece and enclosing the[] accumulated mail content sheets in a corresponding envelope sheet, the larger sized envelope sheets forming larger envelopes and the smaller sized envelope sheets forming smaller envelopes.

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Ans. 3-4 (citing “entire document” of Murphy). The Examiner acknowledged that “Murphy does not disclose . . . cutting of variable sized envelopes based on the number of mail pieces.” Ans. 4.

The Examiner found that Helm teaches an envelope cutting process that allows for variable sized envelopes “where larger sized envelope sheets are cut for large mail pieces and smaller envelope sheets for small mail pieces for the purpose of manufacturing envelopes which can accommodate various sizes of mail pieces.” *Id.* (citing Helm, figs. 1, 3, 4, and col. 4, ll. 15-43). The Examiner concluded that it would have been obvious “to have provided the modified invention of Murphy with the envelope processing means as taught by Helm[’s] mail pieces for the purpose of manufacturing envelopes which can accommodate various sizes of mail pieces.” *Id.*

Appellants argue that the rejection should be reversed because neither reference discloses cutting variable sized envelopes based on the number of content pages. Br. 6. In particular, Appellants argue that “Murphy teaches nothing about having the potential for variable sized envelopes that are cut to different sizes as may be necessary to accommodate different quantities of content sheets.” *Id.* Appellants argue that “[t]he relevance of Helm to the present invention is simply that there is a machine that can be adjusted to make different sized envelopes” but that “[s]uch disclosure still fails to support the cutting of variable sized envelopes based on the number of content pages that the Examiner admitted was missing from Murphy.” *Id.* Appellants contend that “[b]oth Murphy and Helm are not germane to the

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dynamic aspect of the invention of claim 1 whereby high page mail pieces can be processed in line with the rest of the mail.” *Id.*

Murphy relates to:

[A]n arrangement of envelopes and letters prepared on a continuous sprocket fed single paper web, and in particular an arrangement to be printed in a sprocket feeding printer connected to a computer for printing letter information on letter panels and address information on adjoining envelope panels, and wherein tear lines are provided for separating envelopes and letters.

Murphy, col. 1, ll. 7-14. The object of Murphy is “to provide an arrangement that makes it possible to prepare letters and envelopes from single ply paper stock that can be handled in computers and printers as are commonly used in offices wherein large specially adapted machines are not readily available.” *Id.* at col. 1, ll. 48-53. Murphy discloses in one embodiment that the paper web has two pages of letter panels for printing either a two-page letter or printing a file copy of the original letter. *Id.* at col. 5, ll. 3-6; fig. 7. Contrary to the Examiner’s findings, Murphy does not disclose enclosing accumulated mail content sheets in a corresponding envelope sheet, the larger sized envelope sheets forming larger envelopes and the smaller sized envelope sheets forming smaller envelopes. *See* Ans. 4. Murphy makes no mention of envelope size or the need for different sized envelopes based on the number of mail content sheets. Murphy also does not disclose a process by which both large and small size mailpieces can be processed in-line from the same paper web.

Helm relates to an “apparatus for changing the length of envelope blanks cut from a continuous roll of web material.” Helm, col. 1, ll. 9-11. Helm also does not mention the size of the envelope being dictated by the number of mail content sheets to be placed therein. Helm discloses only that “the envelope must be constructed with a throat dimension that is capable of accommodating the selected insert.” *Id.* at col. 1, ll. 21-23. Helm discloses that the dimension of the throat is “the distance between the closure fold and the edge of the bottom flap.” *Id.* at col. 1, ll. 16-17. *See also id.* at col. 5, ll. 28-31 (“When the bottom flap **26** is folded, the transverse edge is spaced a preselected dimension, A, from the closure flap **20** to form a throat, generally designated by the number **30**.”). As such, Helm discloses adjusting the size of the throat of the envelope to ensure that when the closure flap is folded, it overlaps the bottom flap so that the closure flap adhesive strip does not contact the inserted material. *Id.* at col. 1, ll. 17-24.

Even if one were to apply the teaching of Helm to the method of Murphy, the combined teachings would not result, absent hindsight, in a process by which both large and small size mailpieces can be processed in-line from the same paper web. Rather, because Murphy relates to an arrangement for printing letters and envelopes in an office environment on a continuous web that has been previously perforated, the Examiner’s proposed modification to Murphy to use different sized envelopes for different sized inserts, as taught by Helm, would have led one of ordinary skill in the art at most to use multiple webs, one with larger envelopes for larger mailpieces and one with smaller envelopes for smaller mailpieces.

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The Examiner has failed to adequately explain why one of ordinary skill in the art would have been led to modify Murphy to result in the claimed method in which larger and smaller envelope sheets are processed in-line from the same continuous web based on the number of pages for each mailpiece.

#### CONCLUSION

The Examiner has not adequately shown how the combined teachings of Murphy and Helm would have led one of ordinary skill in the art to the method including the cutting and enclosing steps as set forth in claim 1.

#### DECISION

We REVERSE the decision of the Examiner to reject claims 1, 2, 8, 9, and 11.

REVERSED

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