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10/996,275	11/23/2004	Wojciech M. Chrosny	F-819	1189
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PITNEY BOWES INC. INTELLECTUAL PROPERTY & PROCUREMENT LAW DEPT. 37 EXECUTIVE DRIVE MSC 01-152 DANBURY, CT 06810			POUNCIL, DARNELL A	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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7 *Ex parte* WOJCIECH M. CHROSNY and KAREN D'ANDREA

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10 Appeal 2011-003609
11 Application 10/996,275
12 Technology Center 3600
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16 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
17 MICHAEL W. KIM, *Administrative Patent Judges*.

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19 FETTING, *Administrative Patent Judge*.

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22 DECISION ON APPEAL

STATEMENT OF THE CASE¹

Wojciech M. Chrosny and Karen D’Andrea (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-15, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented a way of printing information on a mail piece, and, in particular, to a system and method for automatically selecting advertising slogans to be printed on a mail piece. (Spec., para. 0001).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of printing an ad slogan on a mail piece, comprising:
 - [1] establishing one or more date ranges and one or more pre-selected ad slogans, each of said one or more date ranges having one of said one or more pre-selected ad slogans corresponding thereto;
 - [2] determining a current date, said current date being a date on which an ad slogan is to be printed on said mailpiece [sic, mail piece];
 - [3] determining whether said current date falls within a particular one of said one or more date ranges;
- and

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed May 3, 2010) and the Examiner’s Answer (“Ans.,” mailed September 15, 2010).

1 [4] if said current date falls within a particular one of said one
2 or more date ranges,
3 printing on said mail piece
4 the one of said one or more pre-selected ad slogans
5 that corresponds to said particular one of said one or
6 more date ranges.

7
8 The Examiner relies upon the following prior art:

9 Ryan US 6,816,838 B1 Nov. 9, 2004

10 Claims 1-4 stand rejected under 35 U.S.C. § 101 as directed to non-
11 statutory subject matter.

12 Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as anticipated by
13 Ryan.

14 Claims 13-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable
15 over Ryan.

16 ISSUES

17 The issue of statutory subject matter turns primarily on whether
18 affixing an advertisement to a mail piece is insignificant post solution
19 activity. The issues of novelty and obviousness turn primarily on whether
20 the claims require a one to one correspondence.

21 FACTS PERTINENT TO THE ISSUES

22 The following enumerated Findings of Fact (FF) are believed to be
23 supported by a preponderance of the evidence.

24 *Facts Related to the Prior Art - Ryan*

25 01.Ryan is directed to putting ads on mail pieces and subsidizing this.

26 Ryan 1:15-18.

27 02.Ryan improves the effectiveness of third party advertising on mail
28 pieces by facilitating the selection and application of third party
29 messages for printing on envelopes. Various restriction data,

1 based upon user preferences, third party advertiser preferences,
2 recipient parameters, non-addressee parameters or some
3 combination of the above, may be employed during the message
4 selection process. The document includes a control code and the
5 inserter includes a scanner located adjacent the path of travel for
6 reading the control code on the document and a printer for printing
7 a selected message on the envelope corresponding to the control
8 code. A third party advertiser database has plural ad data profiles
9 where each of the ad data profiles includes message data and
10 restriction data. The message data is representative of a message,
11 respectively, for printing on the envelope. The control system
12 uses the restriction data from the plurality of ad data profiles in
13 combination with the recipient address to identify a subset of
14 messages available for printing, and receives an indication of the
15 selected message from the subset of messages authorized for
16 printing on the envelope; and incorporates within the control code
17 an indication of the selected message. Ryan 3:55 – 4:20.

18 03. The date restriction data provides an indication of what dates the
19 third party advertiser wants to advertise on. For example,
20 expiration dates could be established beyond which the message
21 will not be dispensed. As another example, periodic cycles could
22 be established during which the message is available for printing.
23 Ryan 10:40-48.

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ANALYSIS

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Claims 1-4 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We are persuaded by the Appellants' argument that these claims are directed to more than an abstract idea without significant transformational activity. These claims automatically select an advertisement, and then, most significantly actually print that advertisement on a mail piece.

We can see how the Examiner might have considered this a close case as merely printing something in general is insignificant post solution activity. Thus, in view of the prior art rejection as well, raising this statutory subject matter issue as a subsidiary issue, cumulative to the art rejection, was reasonable for essentially requesting a dispositive resolution of the issue.

But here the whole invention is automatically putting the appropriate advertisement on an actual mail piece. In this context, we find this to be more than an abstract concept.

Claims 1-12 rejected under 35 U.S.C. § 102(e) as anticipated by Ryan.

We are not persuaded by the Appellants' argument that "the claim positively recites a one-to-one correspondence of an ad slogan with each particular non-overlapping date range as would be necessary with an automatic selection of an ad slogan based upon the date." Appeal Br. 10. As Examiner pointed out at Answer 9, this is not the case. The actual claim limitation is "each of said one or more date ranges having one of said one or more pre-selected ad slogans corresponding thereto." This expresses a many to many relationship, and not a one to one relationship as argued. First, each date range may explicitly have plural (many) corresponding slogans. The phrase "having one" means there exists at least one, not that there is a limit

1 of exactly one; it requires existence rather than uniqueness. To one of
2 ordinary skill in the programming arts, this is floor on the number of slogans
3 and not a ceiling. Second, there is no restriction on how many of the date
4 ranges may correspond to any particular slogan. Thus there is a many to
5 many relationship implied.

6 There is additionally an argument that “the cited reference apparently
7 describes overlapping date ranges since each third party slogan is associated
8 with date ranges not associated with the other stored slogans.” *Id.*
9 However, again as Examiner pointed out at Answer 9, there is no such claim
10 limitation disallowing overlapping ranges. It may be that Appellants are
11 referring to the limitation “determining whether said current date falls within
12 a particular one of said one or more date ranges,” but this does not mention
13 whether such ranges overlap, and to the extent the limitation refers to falling
14 with a particular range, this simply determines whether there is at least one
15 such range. It does not exclude additional ranges. Those of ordinary skill in
16 the art of programming routinely provide tie breaking schemes or protocols
17 when plural ways of satisfying a condition are met.

18 *Claims 13-15 rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan.*

19 Each of these claims simply add the limitation of ad slogans from an
20 authorized agency. In the method claim 13 this requires having the ad
21 slogans entered into the data somehow. The step is exactly the same
22 irrespective of the source of the data. Further, any source from which data
23 successfully enters is a source or agency that the software recognizes as
24 authorized to interact with it.

25 As to system claims 14 and 15, it is only required the system have the
26 capacity for entering data from an authorized agency. “[A]pparatus claims

1 cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v.*
2 *Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). *See also In re*
3 *Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (functional language
4 does not confer patentability if prior art structure has capability of
5 functioning in the same manner). Therefore, the issue is whether Ryan
6 teaches a system that has structures that are capable of being operated to
7 perform these functions

8 In fact, these claims are ambiguous hybrid claims that the Examiner
9 should review for definiteness. *See Rembrandt Data Techs., LP v. AOL,*
10 *LLC*, 641 F.3d 1331, 1339 (Fed. Cir. 2011) (“reciting both an apparatus and
11 a method of using that apparatus renders a claim indefinite under section
12 112, paragraph 2”) (internal citation and quotations omitted).

13 Thus, we are not persuaded by the Appellants’ argument that the
14 Examiner’s official notice of the use of authorized sources is notorious is
15 improper.

16 CONCLUSIONS OF LAW

17 The rejection of claims 1-4 under 35 U.S.C. § 101 as directed to non-
18 statutory subject matter is improper.

19 The rejection of claims 1-12 under 35 U.S.C. § 102(e) as anticipated
20 by Ryan is proper.

21 The rejection of claims 13-15 under 35 U.S.C. § 103(a) as
22 unpatentable over Ryan is proper.

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DECISION

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The rejection of claims 1-15 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) (2011).

AFFIRMED

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