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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ERB, NATHAN	
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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* MICHAEL J. AMATO

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Appeal 2015-003944  
Application 10/474,435<sup>1</sup>  
Technology Center 3600

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Before HUBERT C. LORIN, KENNETH G. SCHOPFER, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 2, 4–8, 10–13, and 15–31. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

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<sup>1</sup> The Appellant identifies United States Postal Service as the real party in interest. Appeal Br. 3.

### ILLUSTRATIVE CLAIM

1. A method for notifying an addressee about an item having an address and being processed by a delivery service, comprising:

performing a plurality of sorting operations on the item;

capturing an image of the item during each of the plurality of sorting operations, each image including at least the address of the sender of the item;

determining, by a computer system, a communication channel for the addressee using the address from the item;

determining, by the computer system, that the addressee has requested to receive image notifications of items received by the delivery service; and

sending the plurality of images of the item to the addressee of the item via the communication channel.

### CITED REFERENCES

The Examiner relies upon the following references:

O’Hair	US 5,315,668	May 24, 1994
Uno et al. (hereinafter “Uno”)	US 5,535,127	July 9, 1996
Moore	US 5,917,925	June 29, 1999
Lopez	US 2002/0029202 A1	Mar. 7, 2002
Wheeler et al. (hereinafter “Wheeler”)	US 2002/0032623 A1	Mar. 14, 2002
Smith et al. (hereinafter “Smith”)	US 2002/0095306 A1	July 18, 2002
Gifford et al. (hereinafter “Gifford”)	US 2002/0131561 A1	Sept. 19, 2002
Robbins	US 6,931,388 B2	Aug. 16, 2005

## REJECTIONS

I. Claims 1, 2, 5, 6, 10–13, 15, 18, 22, 23, and 26–31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Smith, and Wheeler.

II. Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Smith, Wheeler, and O’Hair.

III. Claims 7 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Smith, Wheeler, and Gifford.

IV. Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Smith, Wheeler, and Lopez.

V. Claims 16, 17, 24, and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Smith, Wheeler, and Robbins.

VI. Claims 20 and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Moore, Smith, Wheeler, and Uno.

## ANALYSIS

The Appellant alleges error in the rejection of independent claim 1 (Appeal Br. 12–15; Reply Br. 3–5) and relies upon this argument as to the other independent claims and dependent claims (Appeal Br. 15, 17–22; Reply Br. 5–7), but also presents a separate argument regarding dependent claim 5 (Appeal Br. 15–17).

As to claim 1, the Appellant argues that Wheeler does not teach or suggest the following limitation:

determining, by a computer system, a communication channel for the addressee using the address from the item.

According to the Appellant, the claimed determination of a communication channel using “the address from the item” requires using *the sender’s* address. Appeal Br. 13.

The Examiner maintains that “the address” used to determine the communication channel, in claim 1, must be *the recipient’s* address — not that of the sender, as the Appellant contends. Answer 3–14.

Notably, the cues provided by the indefinite (“an”) and definite (“the”) articles, which commonly are employed to indicate and interpret the antecedent bases of claim elements, *see NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005), do not resolve whether the claims require the communication channel to be determined using the sender’s address or the recipient’s address.

Claim 1 refers to “an item having an address,” in the preamble, then (in the claim body) recites “an image of the item . . . including at least the address of the sender,” and goes on to state that the communication channel is determined “using the address.” Arguably, this suggests that the *sender’s* address is used to determine the communication channel.

However, the preamble of claim 10 recites “informing an addressee having an address about a mail piece having the address,” and goes on to recite “storing the communication channel information based on the address.” Thus, claim 10 arguably uses the *recipient’s* address to determine the communication channel. Claim 10 further confuses the matter, by reciting an image of the mail piece with “at least the address of the sender” and retrieving the communication channel information “based upon the mail piece’s address” — an expression that could refer to either of, but does not clearly signify, the recipient’s address (which is used to store the communication channel information) or the sender’s address (which appears in the image of the mail piece).

Because it is unclear whether the claimed communication channel is determined, by using the recipient's address or the sender's address, claim 1 and the other claims on appeal violate the definiteness requirement of 35 U.S.C. § 112, ¶ 2. *See In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014) (per curiam); *see also Ex Parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential) (“[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.”)

Before a proper review of the rejection under § 103(a) can be conducted, the subject matter encompassed by the claim must be reasonably understood without resort to speculation. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language); *see also In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (“If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious — the claim becomes indefinite”). Therefore, we do not assess the merits of the rejections of claims 1, 2, 4–8, 10–13, and 15–31 under 35 U.S.C. § 103(a); rather, pursuant to our authority under 37 C.F.R. § 41.50(b), we reverse, *pro forma*, the claim rejections under 35 U.S.C. § 103(a) and enter a new ground of rejection of the claims as being indefinite under 35 U.S.C. § 112, ¶ 2. This determination does not reflect on the merits of the underlying rejection based upon 35 U.S.C. § 103(a).

DECISION

We REVERSE the Examiner's decision rejecting claims 1, 2, 4–8, 10–13, and 15–31 under 35 U.S.C. § 103(a).

We ENTER A NEW GROUND OF REJECTION for claims 1, 2, 4–8, 10–13, and 15–31 under 35 U.S.C. § 112, ¶ 2.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

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Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

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

REVERSED; 37 C.F.R. § 41.50(b)