

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN PETKOVSEK

Appeal No. 2000-0107
Application 08/905,072

ON BRIEF

Before CALVERT, FRANKFORT and BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has filed a timely response to our requirement under 37 C.F.R. § 1.196(d), mailed February 4, 2000 (Paper No. 18). In the response, it is stated that the appellant, Glenn Petkovsek, is the same person as the patentee of Patent No.

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5,573,277. However, appellant also states that all of the subject matter of the '277 patent qualifies as prior art against appellant under the public use and on sale provisions of 35 U.S.C. § 102(b), even if the claims involved in the present appeal were accorded the benefit of the filing date of parent application 08/725,856.

Accordingly, in view of appellant's response, and since it is well settled that public use or sale under § 102(b) is prior art under § 103 and may support an obviousness rejection, In re Corcoran, 640 F.2d 1331, 1333, 208 USPQ 867, 869 (CCPA 1981), we will refer to the '277 patent as a convenient description of the subject matter barred to appellant under § 102(b), and treat the rejection herein as if it were for obviousness over the '277 patent in view of Walz.

The claims on appeal, 1 to 18, are drawn to a continuous assembly of a backer and a plurality of labels (claims 1 to 8), and a method for preparing mailpieces (claims 9 to 18). They are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Walz	5,190,210	Mar. 2,
1993		

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Petkovsek
1996

5,573,277

Nov. 12,

(filed July 28, 1994)

The following reference is referred to in the remand section of this decision, infra:

Tezuka et al. (Tezuka)

4,952,433

Aug. 28, 1990

Claims 1 to 18 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Petkovsek in view of Walz.

After fully considering the record in light of the arguments presented in appellant's brief and the examiner's answer, we conclude that the appealed claims are patentable over the combination of references applied.

With respect to claims 1 and 9, the two independent claims on appeal, the examiner takes the position that it would have been obvious, in view of Walz, to print the mailing forms disclosed by Petkovsek in a continuous assembly, as recited. We agree with this finding by the examiner, especially in view of the fact that Petkovsek discloses at col. 5, lines 9 to 11, that "a particular label/form may be

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infinite in length satisfying the requirements for any number of mailpieces or shipping items requiring special services." This disclosure of a form "infinite in length" would seem to suggest a continuous assembly of a plurality of the forms shown in Figs. 1 and 2 on a continuous backer.

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Claims 1 and 9 further recite that the plurality of labels is

removably secured to the backer wherein each of the plurality of labels is formed in only a single row and each of the plurality of labels has a width defining a maximum width in the single row

Appellant argues that Petkovsek and/or Walz do not teach or suggest this feature, while the examiner asserts (answer, page 5):

One with ordinary skill in the art could easily form a continuous assembly as taught by Walz '210, where the mailing and/or auxiliary portions could be formed in a single or a plurality of rows as necessary. The exact configuration of the mailing and auxiliary portions on the continuous assembly as taught by Walz '210 would depend on factors such as the size of the mailing label needed for a specific type of article to be mailed and the type of information needed to be printed on the label assembly, all of which could be easily determined by one with ordinary skill in the art.

We do not agree with the examiner. In the first phase, sections 14, 14' of the Petkovsek label (the return receipt card sections) are not detachable from the backer, but rather Petkovsek specifically omits the silicone layer 56, 56' from those areas (see Fig. 7) so that the cards 14, 14' will consist of the backer and front and back layers 14 or 14'

permanently adhered together. See Fig. 3, col. 6, lines 45 to 47, and col. 7, lines 17 to 21. In the Petkovsek label/form 1, the plurality of labels which are removably secured to the backer, as called for by claims 1 and 9, are labels 16, 16', 18', 18', 46 and 46'.¹ However, none of these detachable labels are in only a single row, as called for by claims 1 and 9, nor do we find any teaching or suggestion that they be so arranged. Whether a plurality of Petkovsek's label/forms 1 were arranged in a continuous assembly extending vertically or horizontally (with reference to the label/form shown in Fig. 1), the removable labels 16, 16', 18, 18', 46, 46' would not be in only a single row, and it is not apparent, even if they could be so arranged, what in the applied prior art would have motivated one of ordinary skill to do so. Although the examiner states, in the above quotation from the examiner's answer, that "the mailing and/or auxiliary portions [of Petkovsek] could be formed in a single or a plurality of rows as necessary," the mere fact that the prior art could be modified to form the claimed structure would not have made the

¹ This assumes that sections 46, 46' may be called "labels."

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modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). We find no such suggestion in this case.

Accordingly, the rejection of claims 1 and 9, as well as of dependent claims 2 to 8 and 10 to 18, will not be sustained.

Remand to the Examiner

In considering the scope of claims 1 and 9, we note that these claims do not require that the "information" printed on the auxiliary portion be different from the "identifying information" on the mailing portion. Therefore, these claims may be readable on a continuous assembly of labels, similar to appellant's Fig. 1 embodiment, in which "identifying information" such as "certified mail," etc., is printed on all of the labels, so that every two successive labels would correspond to the recited "mailing portion" and "auxiliary portion," respectively.

The embodiment of appellant's Fig. 1 is disclosed in

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parent application 08/725,856, wherein we affirmed² a rejection of the claims based on the Tezuka patent, noting particularly col. 1, lines 18 to 26, and col. 7, lines 17 to 26, thereof. In view of that decision, the present application is remanded to the examiner to consider whether claims 1 to 18, or any of them, should be rejected as unpatentable over Tezuka, alone or in combination with other prior art.

² Decision dated Nov. 29, 1999 (Paper No. 18).

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Conclusion

The examiner's decision to reject claims 1 to 18 is reversed, and the application is remanded to the examiner.

REVERSED and REMANDED

IAN A. CALVERT)
Administrative Patent Judge))
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)) BOARD OF PATENT
CHARLES E. FRANKFORT))
Administrative Patent Judge)) APPEALS AND
))
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JENNIFER D. BAHR))
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