

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH A. BERNARDO and BARRY L. NATALE

Appeal No. 96-1032
Application 08/197,443¹

ON BRIEF

Before CALVERT, MEISTER and ABRAMS, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2 to 6, 8, 19 to 21, 23 and 25, all the claims remaining in the application.

Claims 2 to 6, 8 and 23 are drawn to a method for making a distinction or identifying code on an article for automated

¹ Application for patent filed February 16, 1994. According to applicants, the application is a continuation of Application 07/868,525, filed April 15, 1992, now abandoned.

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reading and conversion to a numeric code, while claims 19 to 21 and 25 are drawn to an apparatus ("improvement") for the same purpose.

The references relied on by the examiner are:

Gunn	3,757,942	Sept. 11, 1973
Phipps, Sr. et al. (Phipps)	4,676,162	Jun. 30, 1987
Pusic	5,065,000	Nov. 12, 1991

The claims stand finally rejected under 35 U.S.C. § 103 on the following grounds:

(1) Claims 2 to 6, 8, 20, 21, 23 and 25, unpatentable over Gunn in view of Pusic.

(2) Claim 19, unpatentable over Gunn in view of Pusic and Phipps.

Rejection (1)

The essence of this rejection is stated at pages 3 and 4 of the examiner's answer as follows:

Pusic teaches the conventionality of applying zip code, country code, special request code, and identification code in the form of machine readable bar code on almost all mailings. From the teaching of Pusic, it is apparent that using bar code(s) as a tool to transmit identifying information is a common practice in the postal mail handling operation. See Fig. 7, column 2, lines 14-25 and column 6, lines 19-29 in Pusic for example. In view of the teaching of Pusic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the machine readable bar code for the code guide elements of Gunn to achieve the same result.

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The mere application of a known type of code element for another to achieve the same outcome would have been an obvious matter of design preference determined by those having ordinary skill in the art.

After fully considering the record in light of the arguments presented in appellants' brief and the examiner's answer, we conclude that the rejection should not be sustained.

It is well settled that obviousness cannot be established by combining the teachings of the prior art, absent some suggestion or incentive to make the combination. ACS Hospital Systems, Inc. V. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). We do not find any such suggestion or incentive in the present case. In particular, we find nothing in Pusic which would suggest to one of ordinary skill in the art the use of a bar code in place of the guide elements 20, 21 of Gunn, as the examiner proposes. As the appellants note at page 6 of their brief, guide elements 20 and 21 of Gunn "are only used to adjust the reading orientation of the scanning equipment." The examiner extracts from Pusic a teaching that "using bar code(s) as a tool to transmit identifying information is a common practice in the postal mail handling operation," but even if Pusic's disclosure may be so interpreted, there is no disclosure of using a bar code in order to orient scanning equipment. The most that Pusic might suggest would be to add to Gunn's envelope

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12 a bar code representing the zip code, but that would be simply a duplication of the information provided by markings 18, and would not meet the terms of the claim.

On page 5 of the answer, the examiner concludes that the recitation "mail-sorting equipment . . . predetermined code field" in the last four lines of claim 23 is "just an intended use which is rendered obvious by the teachings of the applied references," but we fail to see where such use is disclosed or taught by any of the references.

The examiner concludes that (answer, page 6):

[W]ith the known and existing mail sorting equipment having the built-in bar code reading capabilities for switching to a manually-written code reading mode and in view of the teachings of the applied prior art references, to merely provide a mail piece with a bar code that would make use the built-in capabilities of the known mail sorting equipment would have been most obvious to those having ordinary skill in the art.

We disagree with this conclusion, because we find no disclosure in either Gunn or Pusic of any mail sorting equipment having "built-in bar code reading capabilities for switching to a manually-written code reading mode." The Gunn apparatus, in particular, has no such switching ability, but determines the zip code solely by reading the manually-applied markings 18.

Accordingly, we will not sustain rejection (1).

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Rejection (2)

Claim 19 adds to parent claim 25 the recitation that the indicia applying means is a rubber stamp having the indicia embossed thereon.² Rejection (2) will not be sustained for the same reasons as rejection (1), since the additional reference, Phipps, does not supply the deficiencies noted with regard to the combination of Gunn and Pusic.

Conclusion

The examiner's decision to reject claims 2 to 6, 8, 19 to 21, 23 and 25 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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JAMES E. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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NEAL E. ABRAMS)	
Administrative Patent Judge)	

² We note that this recited feature is not shown in the drawings, as required by 37 CFR § 1.83(a).

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