Commissioner=s Decision #1295

Décision de la Commissaire #1295

TOPICS: O00

SUJETS: O00

Application No : 2,312,221

Demande no : 2,312,221

COMMISSIONER'S DECISION SUMMARY

C.D. 1295 App'n No. 2,312,221

The application relates generally to a method of confirmation of delivery of a mailpiece within a mailing system. By the claimed method, information concerning Avalue-added services@, such as address information of the mailer, necessary in order to provide a return receipt, is incorporated into a digital postage mark which is printed on a mailpiece. Upon delivery, this address information is read and captured and a return receipt confirming delivery is generated and sent back to the mailer.

All of the claims in the application were rejected by the Examiner as being obvious. The Board found that the claims would not have been obvious and recommended that the Examiner=s rejection be reversed.

The Commissioner agreed with the Board=s recommendation and the application was returned to the Examiner to proceed to allowance.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,312,221 having been rejected under Subsection 30(4) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the decision of the Commissioner are as follows:

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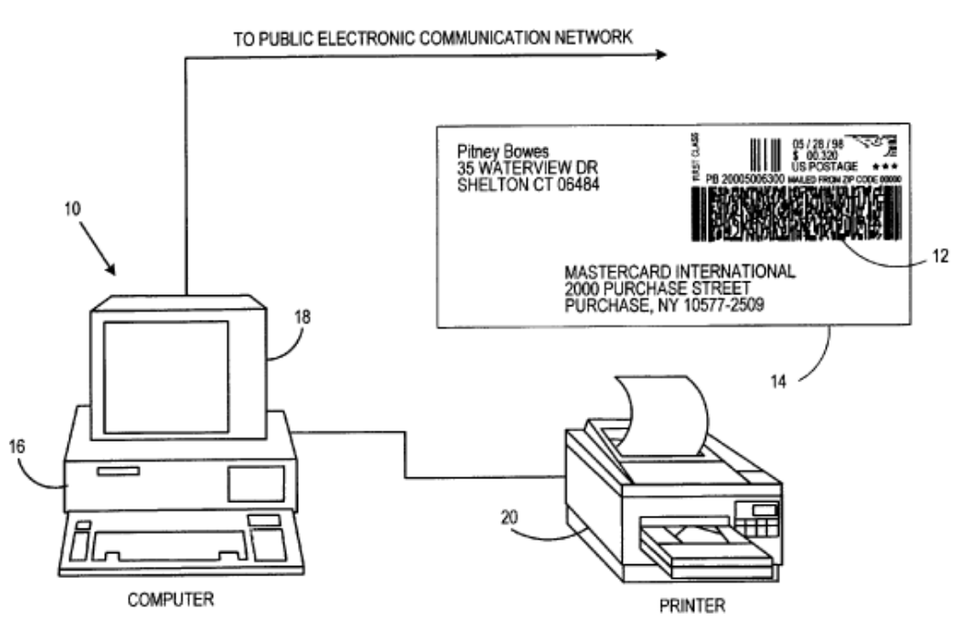
INTRODUCTION

[1] This decision deals with a request that the Commissioner of Patents review the Examiner=s Final Action on patent application no. 2,312,221 entitled ASYSTEM AND METHOD FOR EMPLOYING DIGITAL POSTAGE MARKS AS PART OF VALUE-ADDED SERVICES IN A MAILING SYSTEM@. The Applicant is PITNEY BOWES INC. The inventors are Leon A. Pintsov, Theresa Biasi, Shirish S. Joshi, and Frederick W. Ryan, Jr.

[2] The invention relates to a method of providing confirmation relating to the distribution of a mailpiece within a mailing system. In this method, information concerning evidence of proper postage payment and information concerning Avalue-added services@, such as addressing information for a return receipt to be sent to the originating party, are combined and made part of what is commonly known as a digital postage mark (DPM), which is to be printed on a physical mailpiece. According to the application a DPM is usually comprised of computerized information printed or otherwise attached to a mail item by a sender to provide evidence of payment to a verification authority (e.g. United States Postal Service). A

FIG. 1



2-Dimensional barcode may be used as the format of a DPM, which can be read by a scanner. Upon receipt of a mailpiece the DPM can be read and the information regarding the value-added

services captured, whereby the information can be used to send a return receipt to the mailer. Figure 1 of the application, reproduced below, shows an example of a system which can be used to create such a DPM on amailpiece, aa mailpiece, and such a mailpiece.

[3] As disclosed in the paragraph bridging the bottom of page 2 and the top of page 3, such a process has been traditionally accomplished by having the mail recipient sign a physical receipt card and then the postal service would mail the receipt card back to the mailer. This process was inherently expensive, as it required specialized handling of the physical proofs of acceptance and delivery.

[4] Applicant proposes to incorporate information regarding the sender into the DPM (e.g. the sender=s e-mail address), so that such information can be read and captured upon delivery and a return receipt (e.g. in the form of an e-mail) can be sent back to the sender. As disclosed, the use of an e-mail receipt reduces costs to the postal service, which savings can be passed on to the sender.

BACKGROUND

[5] This application was filed in Canada on June 22, 2000 and claims priority from a US application filed on June 24, 1999. It was rejected by the Examiner on May 6, 2004 in a Final Action. In the Final Action, the Examiner rejected claims 1 and 4 as being obvious in view of European Patent Application No. 0 878 778 (Sansone), published November 18, 1998, and rejected claims 2, 3, 5, and 6 as being obvious in view of Sansone and United States Patent No. 5,826,034 (Albal), issued May 16, 1999, taken together. This represents the rejection of all of the pending claims.

[6] In response to the Final Action, the Applicant made a minor amendment to the language of claim 4 and amended the description in a similar manner, none of which amendments have been opposed by the Examiner.

[7] On September 1, 2005, the application was forwarded to the Patent Appeal Board for review. The Board forwarded the Summary of Reasons of the Examiner to the Applicant on September 12, 2005. On July 13, 2007, after being contacted regarding the opportunity to have an oral hearing, the applicant=s agent, Mr. Matthew Powell of the firm Sim & McBurney, advised the Board that the applicant wished to proceed without an oral hearing. Consequently, the Board conducted a review based on the material on file.

THE ISSUES

[8] The specific questions to be answered in this case are quite clear from the record. In accordance with the objections in the Final Action, and the arguments presented in Applicant=s response, the Board must answer the following questions:

(1) Would claims 1 and 4 have been obvious at the claim date in view of Sansone?
(2) Would claims 2, 3, 5, and 6 have been obvious at the claim date in view of Sansone and Albal?

THE CLAIM LANGUAGE

[9] Before the Board engages in a comparison of the prior art with the claims, it is necessary to review the language of the claims themselves. As stated in *Whirlpool Corp. v. Camco Inc.* (2000), 9 C.P.R. (4th) 129 at 146 (S.C.C.), Binnie J. highlighted the fact that:

> Claims construction is antecedent to consideration of both validity and infringement issues.

[10] Independent claim 1, the features and terminology of which is typical of the only other independent claim, 4, reads as follows:

> A method for providing confirmation relating to the distribution of mailpieces within a mailing system, the method comprising:
> determining postal data required for postage evidencing of a physical

mailpiece originated by a mailer;

combining the postal data with other data related to value-added services desired for the mailpiece, the value-added services data including addressing information for a return receipt to the mailer;

creating a digital postmark on the physical mailpiece, the digital postmark including the postal data and the value-added services data;

reading the digital postmark off the physical mailpiece when the physical mailpiece is delivered;

capturing the value-added services data from the read digital postmark; and

sending a return receipt message to the mailer in accordance with the addressing information.

[11] In claim 1 the feature Adetermining postal data required for postage evidencing ...@ is included. As per page 1, line 30 to page 2, line 19, it is clear that such data relates to verification of payment evidence to be provided to a verification authority (e.g. the United States Postal Service).

[12] The term Avalue-added services data@, although possibly including many types of data, is limited by claim 1 in that such data must include addressing information related to the mailer (i.e. sender).

[13] Coming to the term Adigital postmark@, which includes the Apostal data@ and the Avalue-added services data@, and which according to the description is also known as Adigital indicia@ (see page 2, line 1), this is taken to mean Acomputerized information, printed or otherwise attached to a mail item@ (see page 2, lines 1-3), which information is traditionally used to provide evidence of payment. One example of how this information may be presented is in the form of a 2-Dimensional barcode (see page 2, lines 9-15).

[14] It seems evident that the Areading@ and Acapturing@ steps are accomplished by means of some sort of electronic device, given that information is to be read and captured from a Adigital postmark@, as per claim 1. This view is reinforced by the discussion on page 2 of the conventional systems which use some type of Acomputer-driven scanners@, and the typical encryption of DPM data.

[15] The scope of the last step of claim 1, namely Asending a return receipt message to the mailer in accordance with the addressing information@, seems evident at first glance. However, although the description generally refers to the generation and sending of a return receipt using electronic means, there is no such limitation in claim 1. In fact, looking at claim 2, where it is specified that:

> wherein the addressing information is an electronic communication location identifier

it becomes clear that claim 1 is not limited to an Aelectronic communication location identifier@. Such an interpretation is consistent with the principle of Aclaim differentiation@ as set out in *Halford v. Seed Hawk Inc.*, 2004 FC 88 at para. 93, 31 C.P.R. (4th) 434; aff=d 2006 FCA 275 at paras. 28-33, 54 C.P.R. (4th) 130, where Pelletier J. reviewed the question of claim construction when dealing with independent and dependent claims:

> In its simplest form, claim differentiation requires that Alimitations of one claim not be >read into= a general claim@.

[16] Taking these factors into consideration the Board will look to the prior art and the arguments presented by the Applicant and Examiner in order to assess the obviousness of the claims.

WOULD CLAIMS 1 AND 4 HAVE BEEN OBVIOUS IN VIEW OF SANSONE?

Examiner=s Position

[17] In the Final Action at page 2, in relation to the objection to claim 1 as being obvious, the Examiner contended that:

> By Sansone=s method, a mailer must determine the postal data required for evidencing a mail piece (figure 4; column 3, line 46, to column 4, line 22). The mailer then combines this postal data with other data related to value added services desired for the mail piece to create an indicia to be printed on the mail piece (figures 3 and 4; column 3, lines 16 to 18 and 38 to 45; column 5, lines 39 to 47). The value-added service may be a request for a return receipt (column 7, lines 20 to 24).

[18] Firstly, looking to the passages cited by the Examiner with respect to the inclusion of value-added services in the indicia, the first portion, namely column 3, lines 16-18, makes no

mention of any data concerning value-added services being included in the indicia 14. In fact, the later portions of this paragraph make it clear that the value-added service, namely certified mail, is included as a graphic separate from the indicia 14. Lines 38-45 of col. 3, contrary to the Examiner=s contention, give no indication that value-added services data is incorporated into the indicia 14, and again, this passage makes it clear that the information concerning certified mail and the indicia are quite separate. Regarding the Examiner=s statement that the value-added services may include a return receipt, while this may be true in general, there is no indication that data in relation to such a service is part of the indicia 14.

[19] The Examiner goes on to say:

> Of course, when the mail piece is delivered, the indicia will be read from it, the data (request for a return receipt) will be captured from it, and the recipient will send a return receipt message to the mailer (figures 14 and 15).

[20] Again there appears to be no basis for such a statement, as the examiner has not pointed to any indication that data concerning a return receipt is printed on the mailpiece and read and captured in order to create a return receipt. Further discussing the Sansone reference, the Examiner states (our emphasis added):

> Sansone teaches that the mailer addressing information is printed on one side of a return receipt card, but it is held to be obvious that it would be included in the indicia on the face of the mail piece if so desired by the mailer. In any case, mailer address information *does* form part of the digital postage indicia proposed by Sansone (figure 4; column 3, line 46, to column 4, line 22) and in accordance with IBIP. It is also held to be obvious that part or all of the indicia would take the form of a digital postmark if so desired by the mailer and permitted by the postal authorities.

[21] Since an important component of the claimed invention seems to be the incorporation of mailer addressing information into the digital indicia, which then provides for using this information to generate a return receipt upon delivery, it is difficult to dismiss it as being obvious without any additional evidence or detailed line of reasoning from the applied prior art. In

addition, contrary to the Examiner=s assertion, there is no evidence in the passages alluded to by the Examiner that mailer address information forms part of the digital postage indicia proposed by Sansone. The passages that the Examiner points to indicate that a bar code 30 is included, derived from address field 12, which is in fact the recipient=s address, not the mailer=s address. A full discussion of what is disclosed by Sansone is found later in the Analysis section of this recommendation at paras. 42-54.

[22] The remaining arguments of the Examiner in relation to claim 4, are consistent with those already noted, and therefore need not be repeated.

[23] On page 3 of the Final Action, the Examiner, in relation to the previous correspondence from the applicant, states:

> The correspondence (page 3, lines 16 to 20) goes on to state that Sansone teaches the continued use of return receipts, whereas the present subject matter obviates the need for return receipts. This aspect does not appear in the present claims.

[24] The Board agrees with this statement, as such an aspect does not appear in claims 1 and 4 and therefore cannot be used to distinguish the claims over the Sansone reference. Further, as is seen from the earlier discussion of the scope of claim 1, the return receipt is not limited to one of electronic form.

[25] The Examiner=s position as set out in the Summary of Reasons is consistent with that set out above and need not be repeated.

Applicant=s Position

[26] In the response of November 8, 2004 to the Final Action, the Applicant stated in part that:

> Firstly, as Examiner is no doubt aware, the subject matter of the primary Sansone reference is commonly owned with the present application. Accordingly, Applicant is in the rather unique position of having additional insight into the teachings of Sansone than would be had by an ordinary person of skill in the art.

[27] The prior art must and will be construed as it would be by the

ordinary person skilled in the art. The Board cannot use extrinsic information supplied by the Applicant to alter the meaning that the prior art would have to the skilled person. The Applicant goes on to state:

> The central issue under appeal is whether Sansone teaches or suggests the inclusion of any mailer addressing information in the data related to value-added services desired for the mailpiece. Specifically, Applicant respectfully submits that Sansone does not teach or suggest Athe value-added services data including addressing information for a return receipt to the mailer@, Acreating a digital postmark .. including the value-added services data@, Areading the digital postmark@, Acapturing the value-added services data@, or Asending a return receipt message to the mailer in accordance with the addressing information@, as recited in claim 1. Similarly, Applicant respectfully submits that Sansone does not teach or suggest Aa digital postmark including ... addressing information for a return receipt to the mailer@, Areading the digital postmark@, Acapturing the addressing information@ or Asending a return receipt message to the mailer in accordance with the addressing information@, as recited in claim 4.

[28] After quoting from the Examiner=s arguments, the Applicant goes on to quote the passages from Sansone dealing with figure 4 of that reference, namely col. 3, line 46 to col. 4, line 22. The Applicant had the following to say about these passages:

> A reading of the cited passage shows that **there is no teaching or suggestion of any mailer addressing information in the postal indicia 23 or the bar code 30.** The Aplace 27 that mailpiece 11 was mailed@ refers to the zip code assigned to the postage meter that generated the postal indicia (which by US regulation is the post office where the mail piece is inducted into the post). It does not in any way refer to mailer addressing information other than if the mailer=s address has the same postal zip code as the one assigned to the postage meter. The Aplace 27 that mailpiece 11 was mailed@ is included in the postage indicia because it allows the post to allocate funds from that meter to the postal facility where the mailpiece is inducted. That is why only the zip code is needed. **The Aplace 27 that mailpiece 11 was mailed@ does not, in any way, mean the mailer Aaddressing information@, as used in the claims of the present application.** For greater certainty, Applicant encloses Exhibit A, which is a copy of pages A-3 and A-4 of the IBIP specification referred to in Sansone. Please be advised that only draft specifications have ever been published. As seen in Table A-1 in the attached specification, the IBIP indicium contains only the zip code in the bar code and the city, state and zip in the human readable data. At page A-4, the specification provides that the data listed in Table A-1 shall be included in the indicium. The format of each human-readable data element shall be specified in the DMM. For the Originating Address field, the data elements are: City, State, ZIP Code, which represents the city, state and 5 digit ZIP Code

> for the licensing post office. Thus, clearly, the Aplace 27" in Sansone represents the 5-digit zip code for the licensing post office.
>
> Furthermore, even assuming that the mailer addressing [information] was in the digital postage indicia, **no where in Sansone or Albal is there any teaching or suggestion of reading the digital postmark when the mailpiece is delivered.** The digital postage indicia 23 and bar code 30 of Sansone (which individually or collectively may be the digital postmark) are separate from the certified mail symbol 24. Thus, Sansone does not teach or suggest reading the digital postmark (i.e. digital postage indicia 23 and/or bar code 30), when the physical mailpiece is delivered. Nonetheless, in the final Office Action, Examiner concludes as follows:
>
> > AOf course, when the mailpiece is delivered, the indicia will be read from it, the data (request for a return receipt) will be captured from it, and the recipient will send a return receipt message to the mailer (figures 14 and 15)@.
>
> The only support the Examiner gives for his conclusion that the indicia will be read from the mailpiece, the value-added services data will be captured from the read digital post mark, and a return receipt message will be sent to the mailer in accordance with the addressing information, is figures 14 and 15. These figures merely show the front and back side of a return receipt card containing information printed by printer 72 under control of computer 71. More particularly, in figure 15, field 462 is a space for the sender address field 13. Nonetheless, there is no teaching or suggestion of any of the foregoing, that the mailer addressing information is contained in the value-added services data forming the digital postmark, which is the essence of Applicant=s claimed invention.

[29] As discussed previously in relation to the position of the Examiner, it seems clear from the cited passage (col. 3, line 46 to col. 4, line 22 of Sansone) that mailer address information is not part of the information contained in the digital indicia of Sansone, but a more detailed review of Sansone will follow. The IBIP specification referred to by the Applicant in order to clarify the disclosure of Sansone will be addressed in the subsequent review and analysis of the prior art.

Obviousness: Legal Principles

[30] Section 28.3 of the *Patent Act* sets out the conditions under which a claim may be found to be obvious:

> **28.3** The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim

> date to a person skilled in the art or science to which it pertains, having regard to
>
> (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
>
> (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[31] The classic guide for assessing obviousness in Canada is the one recited by Hugessen J. in *Beloit Canada Ltd. v. Valmet Oy* (1986), 8 C.P.R. (3d) 289 at 294 (F.C.A.); rev=g (1984), 78 C.P.R. (2d) 1 (F.C.T.D.):

> The test for obviousness is not to ask what competent inventors did or would have done to solve the problem. Inventors are by definition inventive. The classical touchstone for obviousness is the technician skilled in the art but having no scintilla of inventiveness or imagination; a paragon of deduction and dexterity, wholly devoid of intuition; a triumph of the left hemisphere over the right. The question to be asked is whether this mythical creature (the man in the Clapham omnibus of patent law) would, in light of the state of the art and of common general knowledge as at the claimed date of the invention, have come directly and without difficulty to the solution taught by the patent. It is a very difficult test to satisfy.

[32] In *Novopharm Limited v. Janssen-Ortho Inc.* (2007), 59 C.P.R. (4th) 116 at 123, the Federal Court of Appeal endorsed an edited list of factors enunciated by Justice Hughes to be considered when assessing obviousness. They were stated as follows:

> **Principal Factors**
>
> 1. The invention
> 2. The hypothetical skilled person referred to in the Beloit quotation
> 3. The body of knowledge of the person of ordinary skill in the art
> 4. The climate in the relevant field at the time the alleged invention was made
> 5. The motivation in existence at the time the alleged invention to solve a recognized problem
> 6. The time and effort involved in the invention

> **Secondary factors**
>
> These factors may be relevant but generally bear less weight because they relate to facts arising after the date of the alleged invention.
>
> 7. Commercial success
> 8. Meritorious awards

[33] Lacking the benefit of expert testimony, and being largely dependent on evidence in the form of patents, applications for patents and printed publications, some of the aforementioned factors, such as climate in the field and common general knowledge, may not be given significant consideration by the Board.

[34] Sharlow J., in *Janssen-Ortho*, *supra*, cautioned against slavishly following any rigid factual analysis in determining whether an invention would be obvious or not:

> There is no single factual question or a set of questions that will determine every case, or any particular case.

[35] More recently, in *Sanofi-Synthelabo Canada Inc. v. Apotex Inc.,* 2008 SCC 61, 69 C.P.R. (4th) 251, Rothstein J. adopted the approach to assessing obviousness updated by Jacob L.J. in *Pozzoli SpA v. BDMO SA*, [2007] F.S.R. 37, [2007] EWCA Civ 588. In particular, the assessment of obviousness now involves the following four steps:

> (1) (a) Identify the notional "person skilled in the art";
>
> (b) Identify the relevant common general knowledge of that person;
>
> (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
>
> (3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
>
> (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

with the possibility of an Aobvious to try@ test at step 4.

[36] Rothstein J. considered an Aobvious to try@ test to be appropriate A[i]n areas of endeavour where advances are often

won by experimentation@ and gave as an example the pharmaceutical industry. The present case does not seem to be one which fits within the category contemplated by the Supreme Court, and therefore we will not engage in a discussion of whether the invention was Aobvious to try@. However, it is noted that there are many similarities between the *Janssen-Ortho* factors and the four-step approach used in conjunction with the obvious to try considerations outlined in *Sanofi*. Indeed, in *Apotex Inc. v. Adir and Servier Canada Inc.*, 2009 FCA 222, Justice Layden-Stevenson, writing for the Court noted:

> The question of obviousness is largely a factual inquiry. The trial judge applied the framework articulated in *Janssen-Ortho*. Subsequently, the Supreme Court of Canada issued its decision in *Sanofi*. The *Janssen-Ortho* framework is not inconsistent with that described in *Sanofi*.

[37] Although we are now bound to follow the *Sanofi* four-step approach, one must still, at the end of the day, answer the question AWas the invention obvious?@ at step four. The *Janssen-Ortho* factors are certainly still useful in this regard. We also note that in *Sanofi*, Rothstein J. did not rule out use of the guidance from *Beloit*, but merely stated that he did not

> A... think that Hugessen J.A. in *Beloit* intended that the rather colourful description of obviousness that he coined be applied in an acontextual manner applicable to all classes of claims@.

[38] In *Sanofi*, Rothstein J., at para. 65, equates obvious with Avery plain@. This interpretation has been noted by the Federal Court of Appeal in *Pfizer Canada Inc. v. Apotex Inc.*, 2009 FCA 8 at para. 29, 72 C.P.R. (4th) 41.

Analysis under the *Sanofi* Four-step Approach

(1)(a) The person skilled in the art

[39] In this case, the person skilled in the art would most likely be a technician or engineer with experience in the field of mailing and communication systems, particularly experience in

systems which use postage meters which evidence postage payment using digital postage marks.

(1)(b) The relevant common general knowledge

[40] The common general knowledge of this person would include knowledge of mail processing systems and methods, plus knowledge of electronic communication systems.

(2) The inventive concept

[41] We view the inventive concept as, based on claims 1 and 4 and the discussion of the invention in the specification, the steps of incorporating mailer addressing information into a digital postmark, reading and capturing such information upon delivery and using it to generate a return receipt which is sent back to the mailer. It must also be borne in mind that we have reviewed the scope of these steps when we looked at the language of claim 1 earlier.

(3) Differences between the Astate of the art@ and the inventive concept

[42] Based on the Final Action of the Examiner and Applicant=s response, there seems to be a fairly significant difference of opinion as to what is disclosed by the Sansone reference, particularly in regard to what information forms part of the digital postage indicia. Looking to Sansone, in general, this reference seeks to avoid the prior art practice of using Agummed service stickers and the completion by hand of special forms and cards for specialty mail@ (see col. 1, lines 33-34). Instead Sansone proposes to print such graphic images on a mailpiece and to use a personal computer and printer to fill out and print the special forms required by specialty mail services (see col. 1, lines 36-54 and col. 4, lines 49-54), such as certified and registered mail.

[43] In regard to figure 4, Sansone discusses an embodiment of a printed digital indicia on an envelope, which embodiment would appear to be the most relevant to the presently claimed subject

matter, as evidenced by the debate between the Examiner and Applicant on its content. The relevant passages are reproduced below for convenience:

> Fig. 4 is a drawing of a mail piece 11 containing a Information - Based Indicia and other mail service graphics that have been requested by the mailer. Mail piece 11 has a recipient address field 12 and a sender address field 13. Mail piece 11 also contains a USPS Information - Based Indicia (IBI) 23 and a certified mail symbol 24. Certified mail symbol 24 includes a serial number 32. The United States Postal Service Engineering Center recently published a notice of proposed specification that describes a Information Based Indicia. The title of the specification is Information Based Indicia Program Postal Security Device Specification, dated June 13, 1996, herein incorporated by reference. The Information Based Indicia Program specification includes both proposed specifications for the new indicium and proposed specifications for a postal security device (PSD). The postal indicia 23 contains a dollar amount 25, the date 26, that the postal indicia was affixed to mail piece 11, the place 27 that mail piece 11 was mailed, the postal security device serial number 28, a FIM code 29 and a 2D encrypted bar code 30. Serial number 32 may be derived from bar code 30 or be equal to bar code 30. Bar code 30 is a unique number that is derived from address field 12 and information contained in the postal security device that affixed IBI 23. The manner in which bar code 30 is obtained is disclosed in the Sansone, et al. United States Patent No. 4,831,555 entitled "UNSECURED POSTAGE APPLYING SYSTEM," herein incorporated by reference. Mail piece 11 also contains an indication 31 of the class of mail piece 11. Certified mail symbol 24 includes a serial number 32. The manner in which symbol 24 is affixed to mail piece 11 will be more fully described in the description of Fig. 10. An advertising slogan 20 is also affixed to mail piece 11.

[44] As disclosed, the AUSPS Information - Based Indicia (IBI) 23" is separate from the Acertified mail symbol 24". Looking to figure 4, the IBI is contained within a dotted outline. It is

the information in this area which would be equated to Applicant=s disclosed and claimed digital postmark, the mark which provides payment evidencing information, and which would be scanned and read by the postal authority. Col. 4, lines 4-16 discuss what is to be included in the indicia. Here, the Aplace 27 that mailpiece 11 was mailed@ does not represent the mailer=s address, but instead some postal facility where the mailpiece is to be processed. Were the alternative to be true, it would seem logical that the illustration of figure 4 would show the same address for the sender address portion and the address which is part of the IBI. It is also noted that in the above passage the bar code is derived from Aaddress field 12 and information contained in the postal security device that affixed IBI 23". Referring to figure 4, Aaddress field 12" represents the recipient=s address, not the sender=s address. How the barcode is derived, as per Sansone, must be taken from US Patent No. 4,831,555. In this reference at col. 4, lines 14-30, where the information on a label to be affixed to an envelope is described, it is stated that:

> The first line 38 of the label would have information relative to the amount of postage and the customer number. The second line 40 contains the date of the mailing, the time the postage is imprinted and the class of mail. The third line 42 contains an encrypted combination of numbers and letters that may be derived from the information on the first two lines as well as information from the address of the recipient of the mail that follows this third line and information contained in the metering unit 14. For example, the first encrypted message B7C14 could relate to the postage amount and date, the second group 45647 to zip code, the third group 66646 to the customer number and transaction number and the last group 40028 to the class of mail. Following these three lines 38, 40 and 42 are the name and address of the mail piece recipient which is printed by the printer 30.

[45] The >555 reference does not appear to disclose formation of a barcode, as suggested in Sansone, but only an encrypted alphanumeric code. While information regarding the customer number may be part of the encrypted code, there is no suggestion here that the addressing information of the mailer be included in the encoded information on the label, as required in Applicant=s claims.

[46] Referring back to Sansone, a USPS Information Based Indicia specification dated June 13, 1996 is referred to at col. 3, lines

56-59, which document is incorporated-by-reference into the specification to illustrate how the indicia of figure 4 is formed. This document, a portion of which was provided to the Board by the Examiner with the Summary of Reasons, indicates in Table 3-1 the data elements to be included in the proposed indicium. One of these is the AOriginating Address@. The city, state, and ZIP code relating to the Originating Address are to be presented in AHuman-Readable@ form, whereas the ALicensing ZIP Code@ is to be part of a AComputer-Based Bar Code@. Subsequent to an inquiry by the Board, the Examiner provided the complete version of the abovementioned document. At page 5-1 of this document it is stated in relation to the indicium composition that:

> The human-readable information shall consist of, as a minimum, the city, state, and 5-digit ZIP Code of the licensing post office, the PSD Device ID/Type number, the date (if required), and the amount of the applied postage. As an alternative, the indicium may display the ZIP Code rather than the city/state designation. In this case, the words AMailed From ZIP Code@ and the mailer=s delivery address ZIP Code must appear in place of the city designation and state, respectively.

[47] In conjunction with Table 3-1, this reveals that the city, state and ZIP Code to be presented in the indicium are those of the licensing post office and not that of the mailer, unless as the Applicant has stated, the mailer happens to live in the same ZIP Code. Since this is what is meant by AOriginating Address@, then the ALicensing ZIP Code@, which is presented in relation to the AOriginating Address@ of Table 3-1, which is to be part of the barcode, is also the ZIP Code of the licensing post office.

[48] As quoted earlier, in response to the Final Action, the Applicant included certain pages from a later version of this document in order to clarify what information was to be included in the digital indicia, namely pages A-3 and A-4 of the later specification. This document also specifies that the AOriginating Address@ consisting of ACity, State, ZIP Code@ be included in the indicium. Page A-4 defines what is meant by these fields and specifies for AOriginating Address@:

> This field represents the city, state, and 5-digit ZIP Code for the licensing post office. The indicium may display the ZIP Code rather than the city/state designation. In this case, the words AMailed from ZIP Code@ and the mailer=s delivery address ZIP Code must appear in place of the city designation and state, respectively.

[49] The above information is consistent with the June 13, 1996 version. In any case, we have relied on the original June 13, 1996 version for our analysis.

[50] From the above, it is evident that the address information to be included in the proposed IBIP indicium did not include mailer address information, but instead related to addressing information relative to the licensing post office (i.e. the post office licensing the meter). This would also seem to have been the case for the indicia proposed in Sansone, given its reference to this specification and its illustration of the information contained in the indicium, as previously stated.

[51] Referring again to the USPS Information Based Indicia specification referred to in Sansone, this document at page 2-3 specifies that when the IBIP is fully implemented Anew >value-added= services can be supported by creative use of the data carried in the indicium@ and that AAs necessary, additional data fields will be defined in the indicium to support the value-added services.@. The USPS specification also states that Acustomers may have the opportunity to add a limited amount of data to the indicium to support their own needs. Customers may be able to obtain access to data collected during the USPS scan of their mail@.

[52] Based on the above, the USPS specification suggests the inclusion of data related to Avalue-added@ services in the proposed indicium. It also suggests that during the USPS scan of a mailpiece, information contained in the indicium will be read and captured, and that such information may be made available to customers, customers in this sense being someone who uses a meter capable of generating the new indicum, in accordance with the overall discussion of the ASystem Context@, starting at page 2-1. This document, however, does not discuss what the value-added services might be or how the information

which is collected from the indicium during the USPS scan might be used. It is also noted that there is no disclosure in the IBIP specification of the indicium being scanned upon delivery in order to generate a return receipt to be sent to the mailer.

[53] The Board must agree with the Applicant, that Sansone does not disclose the inclusion of mailer address information in the Information - Based Indicia mentioned therein, at least as far as the embodiment of figure 4 is concerned. The Board will look to the remainder of the Sansone reference in order to determine what other relevant features were disclosed therein. At col. 4, lines 49-54, Sansone discloses that a printer is used to print the forms to be attached to a mailpiece, such as receipts for certified mail, insured mail, etc. At col. 5, lines 42-45, this is also discussed and return receipt cards are mentioned. Therefore, Sansone does disclose the provision of the sender receiving a return receipt card, however, the card is printed to be attached to the mailpiece and later sent back to the mailer, upon delivery to the recipient. Figures 14 and 15 illustrate the layout of a return receipt card. Contrary to the Examiner=s assertion in the Final Action, the Board cannot say that information that is read and captured from the postage indicia upon delivery is used to send a return receipt to the mailer.

[54] In summary, Sansone does not disclose or suggest the idea of including mailer address information in the digital indicia, nor does this reference teach or suggest reading the postmark upon delivery, capturing the information, and then generating a return receipt to be sent back to the mailer.

(4) Would the differences have been obvious?

[55] Can one say that it would have been obvious to include mailer addressing information in the digital postmark and then to read and capture that information upon delivery in order to generate a return receipt to be sent back to the mailer? Would these changes have been Avery plain@? In the case of claims 1 and 4, the state of the art is represented by Sansone, which has been shown to be defective in pointing the skilled person

towards the claimed invention.

[56] Regarding the climate in the field, in the Background of the Invention section of the present application the Applicant talks about the known modes of communication, including electronic (e.g. email) and hardcopy (e.g. traditional physical mailpieces), as well as what they consider to be mixed forms of communication, including traditional facsimile and hybrid mail. Some advantages and disadvantages of the above are highlighted, such as the speed and economics of electronic communication, which at the same time lacks the universal coverage of traditional mail, along with some security and legal concerns. It is discussed how hardcopy mail is slower but covers the majority of the population and offers the legal proof of communication that may be desired.

[57] Regarding existing motivation at the time of the invention, on page 3 of the application, the Applicant discusses the traditional use of return receipts and how these are Aeconomically inefficient and time-consuming@. While this indicates a desire to make these processes more efficient, it does not point the skilled person toward a particular solution to this problem, such as incorporating mailer addressing information into a DPM and reading and capturing that information upon delivery in order to generate and send a return receipt to a mailer. The applicant also discusses on page 3 the increased prevalence of electronic mail, but also points out that, at that time, electronic communications were viewed as Aan alternative form of communication to the physical delivery of mail@. These circumstances would not point the skilled person towards combining aspects from each system to somehow arrive at the invention.

[58] Referring back to the USPS Information Based Indicia specification referred to in Sansone, it was acknowledged that this document teaches the inclusion of Avalue-added@ service data in the proposed indicium and the USPS scanning and capturing of such data. While one could then argue that it was possible to include mailer address information in the digital indicium, and that such information could have been read and

captured by the USPS during their scan, this does not explain why it would have been obvious or Avery plain@ for someone to do so prior to the claim date. As stated earlier, there was a general desire to make the process of utilizing return receipts more efficient, but this does not provide direction to utilize specific information encoded in a digital postmark, to then read and capture such information at the delivery stage, and then generate and send a return receipt back to the mailer.

[59] In the Final Action the Examiner stated that (our emphasis added):

> it is held to be obvious that [mailer addressing information] would be included in the indicia on the face of the mail piece if so desired by the mailer.

[60] The Examiner has not pointed to any evidence of such desire or motivation to take the step of including such information in the indicia, nor to use such information in the manner claimed by the Applicant.

[61] It is important to note that the abovementioned USPS indicium is referred to within the Sansone reference applied by the Examiner. While the IBIP specification may have provided for the possibility that information related to value-added services could have been added to the indicium, which information then could have been read and captured, the IBIP specification is referred to in the context of the invention disclosed by Sansone. As previously discussed, Sansone described a system which utilized physical return receipt cards. Therefore, while the IBIP specification provides for the possibility of certain features of Applicant=s claimed invention, it is referred to in Sansone to illustrate how a digital indicia would be formed in the context of a system which utilizes physical return receipts, printed and sent with the mailpiece to be sent back to the mailer upon delivery. The person skilled in the art therefore, would not have been motivated to include mailer address information in the indicium for the purposes of implementing a value-added service such as providing return receipts, since Sansone is concerned with physical forms printed and sent with a mailpiece, there being no reason in such a case to put mailer address information into

the indicium. Sansone=s system is much like the traditional receipts and use thereof referred to by the Applicant in the present application.

[62] In relation to the time and effort involved, the Board has not been presented with any information relevant to this topic. It is clear that some modification of existing devices would be required. However, we would take from the lack of technical description that such modification would not be difficult. In any case, the lack of technical difficulty would not be determinative in the absence of any direction towards the proposed method from the prior art. Secondary factors such as commercial success and meritorious awards are not at issue here.

[63] Given the above discussion, it is difficult to say that the differences (i.e. introducing mailer address information into the DPM, reading and capturing this data upon delivery of the mailpiece, and then sending a return receipt to the mailer in accordance with the data) are obvious, absent some impetus or motivation directing the skilled person towards introducing them. The Board has no additional evidence of the common general knowledge of the skilled person, other than perhaps some background discussion in the prior art and the subject application. This background information has been discussed in our analysis of the prior art and in relation to the climate in the field and existing motivation, which background information does not fill in the gaps. Therefore, it is difficult to argue that the differences would be expected to be introduced by persons skilled in the art.

[64] For the reasons given above, the Board cannot agree that the subject matter of claims 1 and 4 would have been obvious in view of Sansone.

WOULD CLAIMS 2, 3, 5, AND 6 HAVE BEEN OBVIOUS IN VIEW OF SANSONE AND ALBAL?

Examiner=s Position

[65] In relation to claims 2 and 3, the Examiner states in the Final Action (emphasis added):

> Claims 2 and 3 are dependent on claim 1 and fail to overcome the objections made for that claim; it makes no patentable difference what the content of the information printed on the envelope is - that content is non-functional descriptive matter. In any case, Albal already teaches a message delivery method that takes advantage of different media and automatically notifies the sender that a message has been delivered (abstract; figures 1 and 10). The message can be a mail piece, and the notification can be sent via email (claim 10; figure 10; column 9, line 43, to column 10, line 14).

[66] We have already found that claim 1 does not differ from Sansone solely in relation to the content of information to be included in the digital postmark. Sansone does not teach or suggest the added functionality of reading and capturing mailer address information in order to generate a return receipt, which functionality is made possible by the inclusion of the mailer address information within the digital postmark.

Applicant=s Position

[67] The only comments that the Applicant makes in regard to the Albal reference in the response to the Final Action are as follows:

> Furthermore, even assuming that the mailer addressing [information] was in the digital postage indicia, **no where in Sansone or Albal is there any teaching or suggestion of reading the digital postmark when the mailpiece is delivered.**
> .....
> As discussed above, Albal does not provide any further teaching or suggestion of including addressing information in the digital postmark for a return receipt to the mailer, as recited in Applicant=s independent claims 1 and 4.

Analysis

[68] The Albal reference was only applied in combination with the reference to Sansone in relation to claims 2, 3, 5, and 6. However, the Board will review the Albal reference to determine

if it provides any additional support for the obviousness rejection of claims 1-6 because logically, if the dependent claims would have been obvious in view of Sansone and Albal, so too would have been the independent claims.

[69] At col. 2, lines 8-15, the general idea of the Albal system is given:

> The present invention provides for a system and method for end-to-end ubiquitous payload delivery that is essentially the electronic equivalent to registered mail with the advantages of speed, configurability, convenience, resource conservation, timeliness, but without the drawbacks of the manual system used with registered mail, e.g., paperwork, delay, time utilization, and geographic limitation of applicability

and at col. 2, lines 29-31, some additional features are highlighted, namely:

> Further, the sender can designate events that trigger notification during delivery of the payload so that the sender is able to keep track of the delivery and receipt of the payload.

[70] It is clear therefore, that Albal does provide for an electronic return receipt being generated for a payload which is delivered by the system. The typical characteristics of such a payload are given at col. 3, lines 24-28:

> For purpose of the present disclosure, a payload can take the form of any digital compilation of data, such as but not limited to a fax, voice mail, paging message, or e-mail (may comprise one or more of the following: text data, image data, video data, audio data, or any combination thereof).

[71] Regarding notification of delivery, the following possibilities are highlighted at col. 4, lines 55-63:

> As a part of the present invention, notifications that the recipient could receive are that the recipient has received the payload, that delivery by a specified media has not been successful, or that a media conversion was performed. The sender, on the other hand, not only may receive the same notifications as those provided to the recipient, the sender is preferably always given notification of delivery so that the sender is guaranteed that the payload has been received by the recipient.

[72] At this point, although the generation of a return receipt upon delivery of a payload is clearly contemplated, it is also clear

that Albal is primarily focussed on an electronic payload delivery system, such as email, as opposed to the delivery of a physical piece of mail using a conventional delivery system. Within Albal=s delivery system there may be conversion from one format to another, when delivery of the electronic payload by the preferred method is not possible (e.g. see col. 2, lines 15-28), however, there is no reading or capturing of data from a physical mailpiece in order to generate a return receipt, as in claims 1 and 4 and the claims that depend from them, since there would not be an originating physical mailpiece to be delivered. There is also no digital postmark used in which to possibly include addressing information which is later read and captured.

[73] At col. 8, lines 41-44, it is however, specified that one method of delivery is delivery to a postal address, in which case the user specifies a specific carrier, such as the United States Postal Service, etc. How this option is implemented is clarified at col. 9, lines 43-51 as follows:

> If the message is for delivery to a postal address, based on the carrier specified in the recipient's address, the output manager determines the carrier's point of presence (POP) and proximity to the recipient. Then an e-mail or fax is sent to this point of presence where manual delivery to the recipient is effectuated. In the case of manual delivery, a sender is notified when the delivery is done, not when the carrier receives the e-mail or fax.

[74] This passage states that, in the case of delivery to a postal address, an electronic communication is first sent to a carrier who then manually delivers the payload or message. Later at col. 9, lines 55-64, it is explained that what is delivered by hand is a specific type of form containing a message, where a seal must be broken to read the message. There is no indication that there is any type of digital postmark from which information is obtained to generate and send a return receipt. It is clear that the sender is notified of delivery, but it is not clear how.

[75] While Albal may disclose a system and method for delivering messages, which messages originate in electronic form, but which may be converted and delivered, possibly manually, and

the sending of a notification of delivery back to the sender, this reference does not add anything to the explanation of why it would have been obvious to include sender address information in a digital postmark, to then read and capture this information from such a mark, and generate and send a return receipt, as in the pending claims. There is no evident reason, based on the record before us, why a person skilled in the art would have combined the teachings of Sansone, which uses a conventional mail system of delivery, with that of Albal, which is concerned with electronic message delivery, to arrive at the presently claimed invention. Recently, in *Les Laboratoires Servier v. Apotex Inc.*, 2008 FC 825 at para. 254, 67 C.P.R. (4th) 241; aff=d 2009 FCA 222, Justice Snider reiterated that (our emphasis added):

> As acknowledged by Servier, a mosaic of prior art may be assembled in order to render a claim obvious. Even uninventive skilled technicians would be presumed to read a number of professional journals, attend different conferences and apply the learnings from one source to another setting or even combine the sources. However, in doing so, the party claiming obviousness must be able to demonstrate not only that the prior art exists but how the person of ordinary skill in the art would have been led to combine the relevant components from the mosaic of prior art.

[76] Note that the above quote uses the word Awould@ and not Acould@ in relation to how obviousness is to be assessed.

[77] Albal does disclose the use of electronic receipts, but does not provide any further impetus to modify the Sansone system, which uses a conventional digital postmark and return receipt forms printed prior to delivery, to arrive at Applicant=s claimed invention. There is simply no basis from the record to selectively take features from one delivery system and incorporate them into the other, such as the use of electronic return receipts in a Sansone system, along with making the modifications of introducing mailer information into a DPM and reading and capturing that data upon delivery, to arrive at the claimed invention. That the individual pieces of the technology used existed in various documents and that there were no apparent difficulties in putting them together in the particular arrangement proposed by the invention (as indicated by the lack of technical disclosure in the present application),

are insufficient grounds to establish that the process proposed by the claimed invention was obvious. As stated by Thorson P. in *R. v. Uhlemann Optical Co.* (1949) [1950] Ex. C. R. 142; aff=d [1952] 1 S.C.R. 143:

> Invention may, therefore, be present notwithstanding the fact that there was no difficultly in putting the idea into effect once it had been conceived.

[78] The Board cannot agree that claims 2, 3, 5, and 6 would have been obvious in view of Sansone and Albal. Nor would claims 1 and 4 have been obvious in view of this combination of references.

RECOMMENDATIONS

[79] In summary, the Board recommends that:

(1) the Examiner=s rejection of claims 1 and 4 as being obvious in view of Sansone be reversed, and
(2) the Examiner=s rejection of claims 2, 3, 5 and 6 as being obvious in view of Sansone and Albal be reversed.

Stephen MacNeil Member | Paul Fitzner Member | Paul Sabharwal Member

[80] I concur with the Patent Appeal Board=s findings and their recommendations that:

(1) the Examiner=s rejection of claims 1 and 4 as being obvious in view of Sansone be reversed, and
(2) the Examiner=s rejection of claims 2, 3, 5 and 6 as being obvious in view of Sansone and Albal be reversed.

Given that the outstanding issues have been addressed, this application complies with the *Patent Act* and *Rules* and should proceed to allowance.

Mary Carman
Commissioner of Patents

Dated at Gatineau, Quebec,
this 2 day of November, 2009