

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN SHERIDAN RICHARDS

Appeal No. 2002-0072
Application No. 08/956,912

HEARD: June 12, 2002

Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 7 and 8. Claims 4-6 and 9 have been withdrawn as being directed to a non-elected invention.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a device for forming a longitudinal fold in signatures¹ being conveyed by a conveyor system. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Odeau	4,549,728	Oct. 29, 1985
Kobler	4,720,091	Jan. 19, 1988

Claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kobler.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobler in view of Odeau.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 22) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 21) and Reply Brief (Paper No. 24) for the appellant's arguments thereagainst.

¹A "signature" is a printed, cut and folded paper product formulated from a web of blank paper.

²A rejection of claims 1-3, 7 and 8 under 35 U.S.C. § 112, second paragraph, was withdrawn in the Answer.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1

A device for forming a longitudinal fold in signatures being conveyed by a conveyor system, comprising:

a delay mechanism selectively processing individual signatures from a stream of signatures to form at least one signature grouping,

a folding blade disposed downstream of the delay mechanism and parallel to a direction of forward travel of the at least one signature grouping; and

a folding mechanism disposed below the folding blade, the folding mechanism receiving each signature of the at least one signature grouping and longitudinally folding all the signatures of the at least one signature grouping simultaneously, wherein the folding blade is driven between a first position and a second position, the folding blade in the second position urging the signatures of the at least one signature grouping toward the folding mechanism.

The Rejection Under Section 102

Independent claim 1 and dependent claims 2, 7 and 8 stand rejected as being anticipated by Kobler. Of course, anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and

every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

Kobler is directed to an apparatus for folding signatures, therein referred to as substrates. As shown in Figure 3, first and second signatures are conveyed on a belt 17 toward a folding mechanism. Kobler explicitly teaches that “selected” (column 5, line 37) first signatures, for example, those with odd numbers, are deflected by a tongue 40 of a delay mechanism so that they travel a longer path, via belts 18 and 19, than the even numbered second signatures, which remain on belt 17. Thus, contrary to the appellant’s argument (Brief, pages 6 and 7; Reply Brief, pages 1 and 2), it is our view that Kobler’s delay mechanism “selectively” processes individual signatures, as is required by claim 1. The result of the selective processing of some signatures by the delay mechanism is that a first signature is deposited on top of each second signature at the downstream end of the delay mechanism, in edge alignment, thereby creating a “signature grouping,” as also is required by claim 1. Then, as shown in Figure 1, a folding blade 14 cooperating with a folding mechanism 13 longitudinally folds the signatures in each signature grouping simultaneously. While the “selective processing” and the “signature grouping” in the Kobler system differ from those disclosed in the appellant’s specification, anticipation does not require that the reference teach the appellant’s invention, but only that the claim on appeal “read on” something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See Kalman v.

Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

As explained above, it is our opinion that all of the subject matter recited in claim 1 “reads on” the forming device disclosed by Kobler. Therefore claim 1 is anticipated by this reference and we will sustain the Section 102 rejection thereof.

Claim 2 adds to claim 1 the requirement that the signature grouping operated upon by the folding blade “include a head-to-tail pairing of two adjacent signatures.” Such an arrangement is not disclosed or taught by Kobler, and thus claim 2 is not anticipated by Kobler and this rejection will not be sustained.

The separate patentability of dependent claim 7 was not argued in the Briefs, and therefore this claim falls with claim 1, from which it depends. See 37 CFR § 1.192(c)(7) and Section 1206 of the Manual of Patent Examining Procedure.

As for claim 8, we agree with the examiner that the folding blade of Kobler has a length “corresponding to” the length of the signature grouping, in that it must be of such length as to cause the signature grouping to be folded longitudinally. The rejection of claim 8 therefore is sustained.

The Rejection Under Section 103

Claim 3 stands rejected as being obvious in view of the combined teachings of Kobler and Odeau, the latter being cited for its teaching of using a headstop to impede the forward motion of at least one of the signatures.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is the examiner's view that it would have been obvious to modify the Kobler apparatus by replacing the disclosed belt delay mechanism with a headstop delay mechanism, as shown in Odeau. We do not agree. The examiner has not set forth any reason why one of ordinary skill in the art would have been motivated to substitute the Odeau headstop for the belt system of Kobler, and we fail to perceive any teaching,

suggestion or incentive to do so. Moreover, the examiner has provided no evidence that a headstop system could cause the signatures to be placed one atop the other, as is required by Kobler, and in any event the proposed modification would necessitate a wholesale reconstruction of the Kobler mechanism, which in our view would be a disincentive to the artisan to make the modification.

Thus, the combined teachings of Kobler and Odeau fail to establish a prima facie case of obviousness with regard to the subject matter of claim 3, and we will not sustain the rejection.

SUMMARY

The rejection of claims 1, 7 and 8 as being anticipated by Kobler is sustained.

The rejection of claim 2 as being anticipated by Kobler is not sustained.

The rejection of claim 3 as being unpatentable over Kobler in view of Odeau is not sustained.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

NEA/LBG

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APPEAL NO. 2002-0072 - JUDGE ABRAMS
APPLICATION NO. 08/956,912

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DECISION: **AFFIRMED-IN-PART**

Prepared By: Lesley Brooks

GAU: 3600

OB/HD

DRAFT TYPED: 12 Sep 03

FINAL TYPED: