

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte VOLKER SCHÖLZKE

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Appeal No. 2002-1200  
Application No. 09/351,164

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HEARD: DECEMBER 11, 2002

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Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a process and device for packaging a material web roll and more particularly to a process and device for holding a material web roll wherein at least the beginning of a packaging web is held against the

circumference of the material web roll (specification, page 1). An important feature of appellant's invention is the use of detachable pressure-sensitive adhesive for bonding the packaging web to the circumference of the material web roll to hold the packaging web to the roll as the winding of the web around the roll is started. Independent claims 1 and 8 read as follows:

1. A process for packaging a material web roll, the process comprising:

holding at least the beginning of a packaging web against the circumference of the material web roll;

rotating the material web roll; and

detachably bonding the packaging web to the circumference of the material web roll with the aid of a pressure-sensitive adhesive.

8. A device for packaging a material web roll, comprising:  
a packaging web dispenser;

a holding device adapted to hold at least the beginning of a packaging web against the circumference of the material web roll, said holding device comprising:

a) a pressure-sensitive adhesive dispenser;  
and

b) a pressing device; and  
a rotary drive for rotatably driving the material web roll.

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

Zweber	4,546,875	Oct. 15, 1985
Schölzke et al. (Schölzke) (German patent application)	196 524 49	Jul. 02, 1998 <sup>1</sup>

The following rejection is before us for review.

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schölzke in view of Zweber.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 11 and 13) for the appellant's arguments thereagainst.

#### 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. For the reasons which follow, we cannot sustain the examiner's rejection.

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<sup>1</sup> An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

Independent process claim 1 calls for a step of detachably bonding the packaging web to the circumference of the material web roll with the aid of pressure-sensitive adhesive and independent device claim 8 calls for a pressure-sensitive adhesive dispenser, which we interpret as requiring a dispenser supplied with pressure-sensitive adhesive material. The examiner concedes that Schölzke, the jumping off point of the obviousness determination, does not disclose the use of pressure-sensitive adhesive, but contends that Zweber would have suggested such in Schölzke's apparatus and method "to permit the clean detaching of the wrapper from the roll" (answer, page 4).

Schölzke discloses an apparatus for wrapping a material roll 2 with a packaging web 3 comprising a web dispenser 8, calender roll 5 which turns the roll 2 and a second calender roll 4. The web dispenser includes a first or operating adhesive substance application device 15 and a second or final adhesive substance application device 16. The final adhesive substance application device 16 sprays a quick acting [curing] adhesive on the beginning of the packaging web 3 to adhere the upstream end portion of the web to the roll. The application of the quick acting adhesive ends after a short distance and only the operating adhesive substance, which is slower acting but more economical, is sprayed onto the successive portions of the web by the operating adhesive substance application device 15. Quick acting adhesive from the final adhesive substance application device 16 may also be applied for a short distance at

the other end portion of the web. Thus, in accordance with Schölzke's invention, the quick adhesion required for successful holding of the web to the roll at the beginning of winding is accomplished in a relatively efficient and economical manner, because the more expensive adhesive is used only on the ends and not throughout the entire length of the web. Schölzke makes no mention of using a pressure-sensitive adhesive and expresses no concern about providing a detachable bond of the packaging web to the roll.

Zweber discloses a paper coin wrapper treated with a pressure-sensitive adhesive, preferably an isoctylacrylate homopolymer adhesive cast on a paper substrate at a low coating weight, on peripheral edges 36, 38 and along an inner surface 30 thereof in any configuration which will maintain the coins in the desired stack or roll. An exemplary adhesive-paper substrate combination enumerated by Zweber is that found in the 3M brand "POST-IT"<sup>®</sup> notes (column 4, lines 5-7). The adhesive along outside edge 26 generally contacts the coin wrapper itself rather than contacting the coins and serves to maintain the wrapper in the rolled position. The adhesive provides sufficient adhesion that the coin wrapper will remain wrapped but can be easily unwrapped when desired. The adhesive readily and cleanly releases from the coins as the wrapper is removed.

As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

In this instance, neither Schölzke nor Zweber provides any teaching or suggestion that a pressure-sensitive adhesive would be desirable or even suitable for use in Schölzke's apparatus and method for bonding the packaging web 3 to the roll 2. As noted above, Schölzke expresses no concern for providing a detachable bond of the web to the roll to keep the outer surface of the roll intact and undamaged and free of adhesive residue. Rather, Schölzke is concerned with providing an adhesive which acts sufficiently quickly to provide the required timely hold of the web to the roll to resist the tension of the winding process. Neither Zweber nor Schölzke gives any indication that a pressure-sensitive adhesive as taught by Zweber would provide the necessary quick curing action or provide any advantages over the adhesive disclosed by Schölzke when used in the Schölzke apparatus and method. From our perspective, the only suggestion for putting the selected pieces from the references together in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

For the foregoing reasons, we shall not sustain the examiner's rejection of independent claims 1 and 8 or claims 2-7 and 9-16 which depend therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-16 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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