

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. SIMMONS, Jr, RICHARD O. RATZEL,
and JOSEPH J. HARDING

Appeal No. 2004-0737
Application No. 10/141,443

HEARD: MAY 18, 2004

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

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 37 and 60. Claims 38 through 59 stand withdrawn. These claims constitute all of the claims in the application.

Appellants' invention pertains to a pad production and packaging system. A basic understanding of the invention can be

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derived from a reading of exemplary claim 1, a copy of which appears in "Appendix A" of the main brief (Paper No. 11).

As evidence of obviousness, the examiner has applied the documents listed below:

Duryee et al. (Duryee)	4,890,753	Jan. 2, 1990
Harding et al. (Harding)	5,829,231	Nov. 3, 1998

The following rejection is before us for review.

Claims 1 through 37 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Harding in view of Duryee.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 12), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 11 and 13).

In the main brief (page 13), appellants group the claims as follows:

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claims 1 through 5, 10, 11, 21 through 27, 32
through 34, 36, 37, and 60 stand or fall with claim 1;

claims 6 through 9, 14, 18, 19, 28 through 31, and
35 stand or fall with claim 6;

claims 12 through 16 stand or fall with claim 12; and

claims 17 and 20 do not stand or fall with any
other claims.

In light of appellants' claim groupings and the argument advanced in the briefs, we would focus our attention below upon claims 1, 6, 12, 17, and 20, with the remaining claims standing or falling with the respective selected claim from its group. As it turns out, we need only address independent claim 1.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,¹ the applied teachings,²

¹ Claim 60 depends from independent claim 1 and references "the plunger." However, a plunger is recited in claim 4, not claim 1. For purposes of this appeal, we shall understand claim 60 as being dependent from claim 4. During any further prosecution before the examiner, the noted antecedent basis deficiency for claim 60 should be addressed and resolved.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it
(continued...)

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and the respective viewpoints of appellants and the examiner.
As a consequence of our review, we make the determinations which follow.

We cannot sustain the obviousness rejection of appellants' claims based upon the prior art relied upon by the examiner. Our reasoning appears below.

Independent claim 1, the sole independent claim before us, reads as follows:

A pad production and packaging system comprising:

at least one pad producing machine for producing a dunnage³ pad and supplying the dunnage pad to a pad insertion zone disposed above a pad support, the pad support having an opening over which the pad is supplied; and

²(...continued)
would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

³ The word "dunnage" is commonly known to refer to padding in a shipping container to protect contents against breakage. Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

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at least one pad insertion assembly for inserting the pad from the pad insertion zone through the opening and into a container disposed below the pad insertion zone.

We turn now to the examiner's evidence of obviousness.

The patent to Harding teaches an automated cushioning conversion system that fills a container or box with packaging (cushioning) material.⁴ The patent indicates (column 7, line 63 to column 8, line 19) that the pad placement apparatus 16 of Fig. 8 may be embodied through any number of ways, as will be apparent to a person skilled in the art, and that, for example, a pad placement apparatus 16 may include a pick and place unit 140 for engaging a pad 14.

The Duryee reference discloses a leaflet insertion system for placing informational sheets or leaflets into the neck of a

⁴ As explained in the patent (column 1, lines 34 through 45), while paper in sheet form could possibly be used as a protective packaging material, it is usually preferable to convert sheets of paper into a low density cushioning product (low density cushioning pads or dunnage).

pharmaceutical bottle having a cotton insert⁵ compressing the leaflet. As acknowledged by the patentee (column 3, lines 37 through 44), the leaflet maintains the cotton under compression thereby preventing movement of pills contained within the bottle and protecting the pills from damage during shipping and other handling operations.

The difficulty we have with the examiner's rejection rationale is that we do not discern from the particular teachings of each applied reference that one having ordinary skill in the art would have been motivated to alter a placement apparatus 16 for a cushioning product, such as a pad, in the cushioning producing and filling system of Harding (Fig. 8) based upon an informational leaflet insertion system (the Duryee patent). Thus, based upon the prior art before us, the obviousness rejection of appellants' claim 1, and claims dependent therefrom, cannot be sustained.

⁵ As indicated by the patentee (column 2, lines 29 through 33), the cotton 30 is already in place in the bottle prior to placement of a leaflet, the cotton being placed there in accordance with known systems, such as shown in U.S. Patent No. 2,895,269. In the latter patent, cotton batting C is positioned on batting supports 98 having an opening therebetween (Fig. 1) and above an opening in tube 38 (Fig. 3); the batting is subsequently inserted into the tube (Fig. 7) and then inserted into a container (Figs. 8 and 9).

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REMAND TO THE EXAMINER

Relative to the claimed subject matter, the examiner should evaluate known prior art addressing filler material that protects container contents from damage during transportation, such as is disclosed in U.S. Patent No. 2,895,269 to Lasko et al. (see footnote 5, above) alone, and in combination with the applied Harding patent.

In summary, this panel of the board has not sustained the obviousness rejection on appeal and has remanded the application to the examiner to consider the content of the remand.

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The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JOHN P McQUADE)	
Administrative Patent Judge)	

ICC:psb

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