

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT SCHONMEIER, PETER HOFFMANN,
HARTMUT DROPCZYNSKI and REINHARD SCHONEN

Appeal No. 96-1678
Application 08/322,731¹

HEARD: FEBRUARY 4, 1998

Before McCANDLISH, *Senior Administrative Patent Judge*, COHEN and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 19, 21 and 26. Claims 20, 22-25 and 27-32, the only other claims remaining in the application, stand withdrawn from

¹ Application for patent filed October 13, 1994. According to appellants the application is a continuation of Application 07/849,022, filed April 21, 1992, now abandoned.

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consideration by the examiner pursuant to 37 CFR § 1.142(b).

Appellants' invention pertains to a winding machine for winding a web onto a core. A basic understanding of the invention can be derived from a reading of exemplary claim 19, a copy of which is appended to appellants' main brief.

In rejecting appellants' claims under 35 U.S.C. § 103, the examiner has relied upon the references listed below:

| | | |
|------------------------------------|-----------|---------------|
| Voss et al. (Voss) | 3,497,151 | Feb. 24, 1970 |
| Salmela et al. (Salmela) | 4,895,315 | Jan. 23, 1990 |
| Scheuter | 4,969,609 | Nov. 13, 1990 |
| Sackenreuter et al. (Sackenreuter) | 4,993,310 | Feb. 19, 1991 |
| Röder ² (German Patent) | 1,047,001 | Dec. 18, 1958 |

The following rejections are before us for review:

(a) claims 19, 21 and 26 under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (answer, page 4);

(b) claim 19 under 35 U.S.C. § 103 as being unpatentable over Röder in view of Scheuter and Salmela;

² Our understanding of this German language reference is derived from a translation prepared in the Patent and Trademark Office, a copy of which is appended to this opinion.

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(c) claim 21 under 35 U.S.C. § 103 as being unpatentable over Röder in view of Scheuter and Salmela, and further in view of Voss;

(d) claim 26 under 35 U.S.C. § 103 as being unpatentable over Röder in view of Scheuter and Salmela, and further in view of Sackenreuter.

The rejections are explained in the examiner's answer (Paper No. 29) and the supplemental examiner's answer (Paper No. 35).

The opposing viewpoints of appellants are set forth in the main brief (Paper No. 27) and the reply brief (Paper No. 33).

The 35 U.S.C. § 112, second paragraph, rejection

The examiner's § 112 rejection is founded upon three alleged deficiencies in independent claim 19. Specifically, the examiner considers that (1) claim 19, lines 32-36 ("said guide means being spaced axially from said longitudinal ends of said upper wedge-shaped gap . . .") is inaccurate because the opposite is true, i.e., the sealing elements are axially spaced from the gap, (2) claim 19, lines 17-18 ("to enable insertion of a cutter for said web through said lower wedge-shaped gap") is a statement of intended use, and (3) the word "transverse" in claim 19, line 37-38 ("means mounting said sealing elements for displacement

transverse to an axis of said roll . . .") is inaccurate.³

With respect to (1), we simply disagree with the examiner that the terminology of claim 19, lines 32-36 is inaccurate. As pointed out in the substitute specification at page 10, line 25 through page 11, line 1, and as clearly illustrated in Figures 2 and 3, the guide means (incorrectly numbered element 1 in Figures 2 and 3) is axially offset relative to the upper wedge-shaped gap in order to accommodate therebetween sealing element 18 when the sealing element is in its operative (solid line) position.

Concerning (2), it is our view that the terminology found objectionable by the examiner is not merely a statement of intended use, but rather a part of the means-plus-function limitation found in lines 15-18 of the claim ("means for lowering . . . through said lower wedge-shaped gap"). In any event, even if the terminology in question was merely a statement of intended use, there is nothing intrinsically wrong with the technique of claiming something in terms of what it does rather than what it is. *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971).

³ The examiner no longer maintains that the last three lines of claim 19 are inaccurate. See page 3 of the supplemental answer.

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As to (3), the substitute specification at page 13, lines 22-26, states with respect to the Figure 3 embodiment that "[t]he axial movement of the sealing elements 18 at the utmost ends of the air distributor 15 require then only a subsequent *lowering* . . . which creates the required free space for the sliding carriage 9" (emphasis added). Consistent with the above, Figure 3 shows in phantom lines a first axially displaced position of the sealing element 18 relative to its operative (solid line) position, and a second *transversely lower* position thereof relative to its operative position. In light of this disclosure, we cannot accept the examiner's position that the word "transverse" in line 39 of claim 19 is inaccurate.

In light of the above, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of the appealed claims.

The 35 U.S.C. § 103 rejections

We take up next for consideration the standing § 103 rejection of claim 19. Like the examiner, we appreciate that Röder discloses a first arrangement in the form of air distributor 5-8 and sealing elements 10, 11 for controlling contact pressure between support rollers 1, 2 and wound roll 4. We also appreciate that Scheuter discloses a second arrangement

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in the form of core gripping pins 17, carriages 18 riding on guides 19, and thrust motors 20 for controlling the contact pressure between support rollers 11, 12 and wound roll 14. In addition, we are in accord with the examiner (answer, page 8) that both of these arrangements perform substantially the same function. Where we part company with the examiner, however, is in the examiner's assertion that it would have been obvious to the ordinarily skilled artisan to provide the arrangement of Scheuter in Röder as a supplement thereto because "[o]ne of ordinary skill in the art would have recognized the limitation in the upward force created by the air pressure and the effectiveness of the sealing elements [of Röder] if the roll size increases beyond a certain size" (answer, page 9).

The examiner has pointed to nothing in the collective teachings of the references themselves, nor provided a logical line of reasoning, to support the proposition that the ordinarily skilled artisan would have found the Röder arrangement to be ineffective for its stated purpose. Accordingly, the examiner's position as to the motivation for supplementing the contact pressure control arrangement of Röder with that of Scheuter is sheer speculation. From our perspective, Röder and Scheuter merely teach alternative arrangements for accomplishing a given

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result, rather than an enhancement of one arrangement in view of the other. As to the examiner's additional reliance on Salmela, we have reviewed this reference but find nothing therein which makes up for the deficiencies of Röder and Scheuter in this regard. This constitutes a first reason necessitating reversal.

In addition, the examiner concedes that Röder does not disclose means for lowering the air distributor 5-8 vertically, as called for in claim 19. The examiner has taken the position, however, that "[t]o movably dispose the air distributor 5-8 so that it may be moved out of the operating position would have been obvious to a person having ordinary skill in the art seeking to facilitate maintenance and repair" (answer, page 6).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.* Here, the examiner has failed to advance any factual basis to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify Röder

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in the manner proposed. The mere fact that Röder could be so modified is not sufficient in this respect. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). This constitutes an additional reason necessitating reversal.

In light of the above, we shall not sustain the § 103 rejection of claim 19. With respect to the § 103 rejections of claims 21 and 26, we have also reviewed the Voss and Sackenreuter references applied, respectively, thereagainst but find nothing therein to make up for the deficiencies of Röder, Scheuter and Salmela noted above. Therefore, we also shall not sustain the § 103 rejections of claims 21 and 26.

New rejections pursuant to 37 CFR § 1.196(b)

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejections.

Claims 19, 21 and 26 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellants regards as the invention.

Claim 19, lines 15-17, calls for "means for lowering said air distributor at least in part from said lower wedge-shaped gap," while claim 19, lines 37-38, calls for "means mounting said

sealing elements for displacement transverse to an axis of said roll” Because the function recited in lines 37-38 is not recited as being an additional function of the “means” of lines 15-17, but instead is attributed to an apparently different means, a fair reading of appellants’ claim terminology is that the “means” of lines 37-38 is separate and distinct from the “means” of lines 15-17. This circumstance results in an inability to determine precisely what disclosed structure in the elected species of Figures 2-3 corresponds to the “means” of lines 37-38. In this regard, it is clear that the lifting cylinder 17 lowers the air distributor 15 from the lower wedge-shaped gap between the support cylinders 2, 3, as called for in lines 15-17 of claim 19. However, lifting cylinder 17 would also appear to be the only disclosed structure in Figures 2-3 capable of performing the function of displacing the sealing elements 18 transverse to the axis of the wound roll 6, as called for in lines 35-37 of claim 19.⁴ Accordingly, we are left to speculate as to precisely what disclosed structure corresponds to the “means mounting said sealing elements for displacement transverse

⁴While we appreciate that certain embodiments of appellants’ invention have the seal elements 18 mounted for transverse movement independent of the air distributor 15, this does not appear to be the case with respect to the elected species of Figures 2-3.

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to an axis of said roll . . ." (claim 19, lines 37-39).

Further, the means-plus-function limitation of claim 19, lines 37-39, reads in full "means mounting said sealing elements for displacement transverse to an axis of said roll out of paths of said heads *as said heads are lowered toward said upper wedge-shaped gaps*" (emphasis added). Our review of appellants' specification reveals no disclosure whatsoever of any structure for providing a condition responsive relationship between displacement of the sealing elements 18 transverse to the axis of the wound roll 6 and lowering of the heads 9, 10 toward the wedge-shaped gaps between the support cylinders 2, 3. This circumstance increases our difficulty in determining precisely what disclosed structure corresponds to the "means" of lines 35-37.

As stated by our present court of review in *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994):

Although paragraph six [of 35 U.S.C. § 112] statutorily provides that one may use means-plus-function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, *the applicant has in effect failed to particularly point out and distinctly claim the invention as*

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required by the second paragraph of section 112.
[emphasis added]

This is precisely the case here, in our view.

Claims 19, 21 and 26 are also rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that fails to comply with the description requirements of this section of the statute.

The test for determining compliance with the description requirement found in the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. *Id.* Because the disclosure as originally filed does not disclose mounting the sealing elements 18 for displacement transverse to the axis of the wound roll 6, wherein said transverse displacement is conditioned upon the heads being lowered toward the upper wedge-shaped gap between the support cylinders 2, 3, the limitation

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calling for "means mounting said sealing elements for displacement transverse to an axis of said roll out of paths of said heads *as said heads are lowered toward said upper wedge-shaped gaps*" (claim 19, lines 37-39; emphasis added) lacks descriptive support.

Summary

The examiner's rejections of claim 19, 21 and 26 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103 are reversed.

New rejections of claims 19, 21 and 26 under 35 U.S.C. § 112, first and second paragraphs, have been made pursuant to our authority under 37 CFR § 1.196(b).

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of

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rejection to avoid termination of proceedings (§ 1.197(c)) as to
the rejected claims:

(1) Submit an appropriate amendment of the claims
so rejected or a showing of facts relating to the
claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

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

REVERSED, 37 CFR § 1.196(b)

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| HARRISON E. McCANDLISH |) | |
| Senior Administrative Patent Judge |) | |
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| |) | |
| IRWIN CHARLES COHEN |) | BOARD OF PATENT |
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