

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN H. KEMP

Appeal No. 97-1442
Application 08/353,631¹

HEARD: MAY 4, 1998

Before MEISTER, MCQUADE and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-3 which are the only claims pending in the application.

¹ Application for patent filed December 12, 1994. According to appellant, this application is a division of Application 08/254,525, filed June 6, 1994, now U.S. Patent No. 5,400,711, granted March 28, 1995, which is a division of Application 08/172,253, filed December 23, 1993, now U.S. Patent No. 5,345,865, granted September 13, 1994, which is a continuation of Application 08/044,215, filed April 7, 1993, now abandoned.

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Appellant's claimed subject matter is a lithographic press which includes a gear connection between the first ink roller and the second ink roller. Claim 1 is exemplary of the subject matter on appeal and recites:

1. In a lithographic press, the combination comprising:
 - (a) a plate cylinder having a plate surface;
 - (b) a first ink roller supported on a first shaft and having a surface in contact with the surface of said plate cylinder;
 - (c) a second ink roller supported on a second shaft and having a surface in contact with the surface of said plate cylinder; and
 - (d) a connection between said first ink-roller and said second ink roller which includes:
 - (i) a first gear secured to said first shaft;
 - (ii) a second gear secured to said second shaft; and
 - (iii) an idler gear in driving engagement with said first gear and said second gear.

THE REFERENCES

The following references were relied on by the examiner in support of the rejection under 35 U.S.C. § 103:

Domotor	3,467,008	Sept. 16, 1969
Shepherd	3,581,658	June 1, 1971

THE REJECTIONS

Claims 1-3 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-10, 16 and 22-24 of U.S. Patent No. 5,345,865.

Claims 1-2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Domotor in view of Shepherd.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 14) for the examiner's complete reasoning in support of the rejections and the appellant's brief (Paper No. 13) and reply brief (Paper No. 15) for the appellant's arguments thereagainst.

OPINION

We have carefully reviewed the appellant's claimed subject matter as described in the specification, the appealed claims, the prior art references applied by the examiner, the evidence submitted by the appellant and the respective positions advanced by the appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the rejection under the judicially created doctrine of obviousness-type double patenting based on claims 9-10, 16 and 22-24 of U.S. Patent No.5,345,865. We note that

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the instant application is a divisional application of application Serial No. 08/254,525, now U.S. Patent No. 5,400,711. Application Serial No. 08/254,525 is in turn a divisional application of application Serial No. 08/172,253, now U.S. Patent No. 5,345,865. During the prosecution of the 08/172,253 application the examiner made a restriction requirement between apparatus and method claims and an election of species requirement between the apparatus claims directed to embodiments depicted in Figures 2 and 4 in the event the apparatus claims were elected. In response to these requirements, the appellant elected apparatus claims with traverse and further elected the species of the embodiment depicted in Figure 2 (Paper No.2 in 08/172,253). As such, the claims directed to the method claims and the apparatus claims of the embodiment of Figure 4 were withdrawn from consideration (Paper No.3 in 08/172,253). Claims 11-13 which were directed to the embodiment of Figure 4 were subsequently cancelled to place the case in condition for allowance. The application was allowed and among the allowed claims were claims 8 and 10 which also correspond to the embodiment of Figure 4.

A divisional application Serial No. 08/254,525 was filed and another restriction requirement was made between method claims and apparatus claims which correspond to the embodiment depicted in Figure 4. The appellant elected the method claims with traverse and

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later filed the instant application whose only claims are claims which are directed to the subject matter recited in claims 11-13 of application 08/172,253. The instant obvious-type double patenting rejection was subsequently made.

The appellant asserts that the restriction requirement made by the examiner in application Serial No. 08/172,253 was never withdrawn as to claims 11-13 and as such a double patenting rejection in this application is improper. The appellant has submitted (Paper No. 11) an affidavit of Jack A. Kanz, the attorney responsible for the prosecution of the 08/172,253 application. Mr. Kanz states:

On May 24, 1994, I received a telephone call from Examiner Ren Yan regarding Application Serial No. 08/172,253. . . . Examiner Yen stated that he would withdraw the restriction requirement as to Claims 19, 26 and 27 and allow claims 1-10 and 14-27. I requested that the restriction requirement be withdrawn as to all claims. Examiner Yan refused and stated that claims 8-13 and 28-29 could only be prosecuted in divisional applications. We agreed that claims 8-13 and 28-29 could be cancelled by the Examiner but would be the proper subject of divisional applications. [Affidavit of Jack A. Kanz at page 1]

The statement in the Kanz affidavit concerning the conversations between the examiner and appellant's attorney has not been refuted by the examiner. In view of the examiner's verbal refusal to withdraw the restriction requirement, we can not sustain this rejection.

We turn next to the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103 as being unpatentable over Domotor in view of Shepherd. We find that Domotor discloses and depicts in Figures 1 and 2 a lithographic press having a plate cylinder 2, a first ink roller 42 and a second ink roller 43. Domotor also discloses positively driving the first ink roller 42 at a surface speed which is different from the surface speed of the plate cylinder 2 to eliminate printing blemishes (Col. 1, line 63 through Col. 2, line 20; Col. 3, lines 56-62).

Shepherd discloses a duplicating machine in which the rotation of an exit advancing roller 28 for the work piece is synchronized with the rotation of an entrance advancing roller 27 by gears so that the peripheral velocity of the exit roller 28 is slightly in excess of that of the entrance roller 27 (Col. 4, line 65 - Col. 5, line 6). It is the examiner's position that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the two inking rollers of Domotor with gears of proper diameters and a meshing idler gear as taught by Shepherd to achieve the surface speed differential between the two ink rollers as desired. The mere application of a known mechanical gearing arrangement over another by those having ordinary skill in the art based upon its well known properties and intended use for the purpose of obtaining an expected outcome would involve no apparent unobviousness. [Examiner's Answer at page 4].

We cannot agree. In contrast to statements made by the examiner (Examiner's Answer at page 7), Domotor discloses rotating one ink roller at a different surface speed than the plate cylinder (see col. 3, lines 56-62). There simply is nothing in Domotor which discloses, teaches or suggests

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rotating the two ink rollers at different speeds. Shepherd does not cure the deficiencies of Domotor in that Shepherd discloses driving an exit and advance roller for a workpiece, rather than two ink rollers, at different speeds. In view of the foregoing, we will not sustain the examiner's 35 U.S.C. § 103 rejection of claims 1 and 2.

The decision of the examiner is reversed

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
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