

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WATARU OUCHI, TAIZO MORITA and SHINYA TAGAWA

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Appeal No. 97-1621  
Application 08/073,586<sup>1</sup>

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ON BRIEF

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Before STAAB, McQUADE and CRAWFORD, Administrative Patent Judges.  
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 4 and 6 through 16, all of the claims pending in the application.

The invention relates to "a continuous cutter for severing pieces of equal length from a coiled elongate article, for example an extruded aluminum tubular article used to prepare heat

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<sup>1</sup> Application for patent filed June 8, 1993.

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exchanger tubes" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A continuous cutter for severing pieces of equal length from a coiled elongate article, the cutter comprising:

an uncoiler for carrying the elongate article wound thereon so as to be drawn therefrom;

a movable stand disposed downstream of the uncoiler for reciprocating movement;

a drive mechanism for causing the movable stand to reciprocate a given distance;

a shiftable clamp carried by the movable stand so as to clamp and unclamp the elongate article;

a cutter blade mounted on the movable stand downstream of the shiftable clamp;

a fixed clamp interposed between the uncoiler and the movable stand so as to clamp and unclamp the elongate article;

the shiftable clamp being kept in its clamping state with the fixed clamp simultaneously being in its unclamping state during the downstream movement of the movable stand, the fixed clamp being kept in its clamping state with the shiftable clamp simultaneously being in its unclamping state during the upstream movement of the movable stand;

the cutter blade severing each piece from the elongate article being drawn off the uncoiler during each downstream movement of the movable stand; and

a stretcher disposed between the fixed clamp and the uncoiler, the stretcher including upper rollers arranged stationary at given intervals and lower rollers each interposed between two adjacent upper rollers and movable up and down, so that the elongate article from the uncoiler advances through the stretcher while successively turning around the lower rollers in a meandering manner, and the lower rollers can be raised against their weight during the intermittent advancement of the elongate

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article drawn off the uncoiler.

The references relied upon by the examiner as evidence of obviousness are:

Suarez et al. (Suarez)	4,724,733	Feb. 16, 1988
Sato	4,771,621	Sept. 20, 1988
Wallis	4,939,967	Jul. 10, 1990
Stroup, Jr. (Stroup)	5,143,268	Sept. 1, 1992

The appealed claims stand rejected under 35 U.S.C. § 103 as follows:

a) claims 1, 3, 6 through 13, 15 and 16 as being unpatentable over Stroup in view of Suarez and Sato; and

b) claims 2, 4 and 14 as being unpatentable over Stroup in view of Suarez and Sato, and further in view of Wallis.

Stroup discloses an apparatus "for separating flat heat exchanger tubing into predetermined lengths" (column 1, lines 6 through 8). As described by Stroup,

[t]he apparatus 10 includes a conventional uncoiler assembly 12, which uncoils the stock upon demand, a stock feed roller assembly 14, a straightening and sizing assembly 16, a clamping assembly 18 for incrementally feeding the stock, a clamping assembly 20 for stabilizing the stock during a scoring and parting operation, a scoring assembly 22, and a clamping assembly 24 for parting the stock by impact [column 2, lines 37 through 45].

Figures 1 and 2 illustrate the manner in which these elements are arranged.

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Suarez also discloses an apparatus for separating tubing into predetermined lengths. As described by Suarez,

[t]he apparatus includes drive rollers to feed the workpiece, horizontal and vertical straightener rollers, and a movable carriage assembly which moves in a parallel path of travel to the workpiece. The free end of the workpiece contacts the carriage assembly and imparts movement to the assembly. The carriage assembly includes a cutter assembly for severing the workpiece, a stripper assembly for breaking the article from the workpiece, and a kick-out for sending the article to a storage bin [Abstract].

Sato discloses a system for the continuous processing of an elongate steel plate. The system includes a central processing unit having loopers positioned at its entrance and exit ends to control the traveling speed of the plate. Each of the loopers consists of a plurality of fixed upper rollers and a plurality of lower rollers mounted on a vertically adjustable carriage.

Wallis discloses a machine for cutting tubing into predetermined lengths wherein cutting assemblies are reciprocated longitudinally in synchronism with the tubing by a motor-driven gear and crank assembly.

With regard to the standing 35 U.S.C. § 103 rejection of independent claim 1, the examiner finds that the apparatus disclosed by Stroup meets all of the limitations in this claim except for those requiring a cutter blade mounted on a movable stand and a stretcher having movable rollers (see page 9 in the

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answer, Paper No. 16). With regard to these deficiencies, the examiner concludes that it would have been obvious to one of ordinary skill in the art "to have substituted a movable carriage carrying both a clamp and an upstream cutter for Stroup, Jr's movable clamp for the advantage of continuously (instead of incrementally) feeding the coiled tubing stock as taught by Suarez et al" (answer, page 9) and "to modify [sic, modify] the stretcher of Stroup, Jr. to have movable lower rollers for the purpose of maintaining a constant web velocity as taught by Sato" (answer, page 10).

We agree with the appellants, however, that this proposed combination of references is unsound (see pages 5 through 18 in the main brief, Paper No. 15).<sup>2</sup> Given the disparate natures of the machines disclosed by Stroup, Suarez and Sato, it is apparent that the examiner has engaged in an impermissible hindsight reconstruction of the appellants' invention by using claim 1 as a template to selectively pick and choose from among isolated disclosures in the prior art. Moreover, even if the references were combined in the manner proposed by the examiner, the

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<sup>2</sup> The record (see Paper Nos. 18 and 21) indicates that the examiner has refused entry of the reply brief filed by the appellants on February 10, 1997 (Paper No. 17). Accordingly, we have not considered the arguments advanced in the reply brief in reviewing the merits of this appeal.

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resulting apparatus would not meet the limitation in claim 1 requiring "a fixed clamp interposed between the uncoiler and the movable stand so as to clamp and unclamp the elongate article." The examiner's finding that this recitation is met by Stroup's rollers 42 (see page 9 in the answer) is not well taken. These rollers, which Stroup describes as being part of the straightening and sizing assembly 16, do not constitute a "clamp" under any reasonable definition of this term.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 103 rejection of independent claim 1, or of dependent claims 3, 6 through 13, 15 and 16, as being unpatentable over Stroup in view of Suarez and Sato.<sup>3</sup>

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of dependent claims 2, 4 and 14 as being unpatentable over Stroup in view of Suarez and Sato, and further in view of Wallis. In short, the teachings of Wallis do not overcome the above noted deficiencies of the basic Stroup, Suarez and Sato combination with respect to the subject matter recited in parent claim 1.

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<sup>3</sup> Claim 6 depends from canceled claim 5. Based on the record before us, we assume that claim 6 is intended to depend from independent claim 1. In the event of further prosecution before the examiner, appropriate action should be taken to rectify this matter.

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Therefore, the decision of the examiner to reject claims 1 through 4 and 6 through 16 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	
	)	
JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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