

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUKO TOMITA, SATO MASAYOSHI,
TAKASHI IIJIMA and HIDEO OHTA

Appeal No. 1998-1020
Application No. 08/381,423¹

HEARD: November 1, 1999

Before COHEN, NASE, 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 2, 6, 21 and 24. In an amendment after final rejection (Paper No. 26, filed August 1, 1996), which has been entered (advisory action, Paper No. 27), claims 4, 5

¹ Application for patent filed January 31, 1995. According to the appellants, the application is a division of Application No. 08/101,488, filed August 3, 1993, now abandoned.

and 25 through 27 were canceled and claims 6 and 21 were amended. Claims 7 through 20 and 22, the only other claims pending in the application, have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.²

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to a printing system comprising a plurality of printing sections and a web width adjusting device arranged between two of the printing sections and to a web width adjusting method used in such a printing system. The purpose of the web width adjusting device and method is to offset lateral expansion of the web caused by a preceding printing station (specification, page 5).

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

Huck	3,147,898	Sep.
8, 1964		
Fischer	4,414,896	Nov. 15,
1983		

² The amendment after final rejection filed June 3, 1996 (Paper No. 21) has not been entered.

Miyoshi 1986	4,589,650	May 20,
Barkley 1987	4,696,230	Sep. 29,
Okamura et al. (Okamura) 6, 1992	5,152,222	Oct.
Yamashita 6, 1992	5,152,522	Oct.

References made of record by this panel of the Board are:

Iijima et al. (Iijima patent) 15, 1997 ³	5,619,921	Apr.
Kotterer 1986 ⁴ (German laid open application)	3,513,319	Oct. 23,

The following rejections are before us for review.⁵

³ This patent issued on Application No. 08/380,155 (discussed by the appellants on page 5 of Paper No. 26 and on page 19 of the brief), filed January 30, 1995, which is a continuation of Application No. 08/041,195, filed April 1, 1993, now abandoned.

⁴ This is the document discussed by the appellants on page 5 of Paper No. 26 and on page 19 of the brief. An English language translation of this reference, prepared for the Patent and Trademark Office, is appended hereto.

⁵ The examiner indicated in Paper No. 27 (advisory action mailed August 15, 1996) that the rejection under the first paragraph of 35 U.S.C. § 112 set
(continued...)

- A. Claims 2, 6 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barkley in view of Okamura and each of Miyoshi, Huck and Yamashita.
- B. Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Barkley in view of Okamura et al. and each of Miyoshi, Huck and Yamashita, as applied above, further in view of Fischer.⁶

Reference is made to the brief (Paper No. 29) and reply brief (Paper No. 32) and the answer (Paper No. 30) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

⁵(...continued)
forth in the final rejection had been overcome by the amendment of Paper No. 26. The answer, at page 2, states that the rejection under the second paragraph of 35 U.S.C. § 112 was also overcome by the amendment of Paper No. 26.

⁶ We note that the 35 U.S.C. § 103 rejections of claims 6, 21 and 24 set forth in the examiner's answer differ from those set forth in the final rejection in that the examiner is no longer relying on the teachings of Shiba.

examiner. As a consequence of our review, we make the determinations which follow.

Barkley discloses web bustling devices adjustably mounted between successive printing units of a multi-color printing press to offset the web fanout effect discussed in column 1, lines 22-44. The bustling devices form bustles or ridges in the web (see Figure 12) to effectively shrink the web back to its original width so that the previously printed image is brought into precise registration with the next color image (abstract). The bustling devices comprise air nozzles (30) supplied with compressed air from a compressed air source (12) and bustle wheels (134) which are adjustable in position toward and away from the web to adjust the depth of the bustles or ridges. Either wheel bustling or air bustling or a combination of both air and wheel bustling may be employed, as explained in column 9, lines 19 to 24.

While the examiner considers the use of dampening water to be inherent in Barkley, the examiner alternately contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize printing units which function to leave the web in a dampened

mode, in view of the teachings of Huck and Okamura (answer, page 5). The appellants do not challenge the examiner's position with regard to the use of dampening water.

The examiner also implicitly concedes that Barkley lacks a means or step for applying counter pressure to the other side of the paper web at a second location along the paper web traveling direction, as required by the claims on appeal, but takes the position that the use of a counter pressure cylinder in Barkley for producing a wavy surface on the web would have been obvious "in view of the teachings and for the reasons as disclosed by each of" Huck, Yamashita and Miyoshi (answer, page 5). For the following reasons, we cannot agree.

Miyoshi discloses a paper sheet feeding device comprising top and bottom conveyor rollers (9, 10) disposed on opposite sides of the paper sheet feeding path which, as shown in Figure 4, are offset relative to each other in a direction transverse to the direction of sheet travel and rotatably mounted on two shafts (18, 19) spaced a distance less than the sum of the radii of the rollers (9, 10) such that the paper sheet passing therebetween assumes a wavy pattern. As explained in column 4, lines 35-42, the conveyor rollers (9,

10) are designed to permit passage of a first sheet (G1) therebetween while preventing advancement of a second sheet (G2) which may have been conveyed together with the first sheet. Specifically, the roller (10) rotates in a direction such that the top peripheral face thereof travels in the upstream direction to halt a second sheet (G2). While the clamping between the rollers (9, 10) does effect a wavy contour of the conveyed sheet (G1), as illustrated in Figure 4, the disclosed arrangement is specifically designed for advancement of sheets one at a time and thus would not, in our opinion, have commended itself for use with a continuous web width adjusting bustle device as disclosed by Barkley.

Yamashita discloses opposed, laterally offset rollers (2) fixedly mounted on drive shafts (1, 1) which engage opposite sides of a sheet-like article (4), forming a wavy pattern in the article, so as to obtain sufficient gripping force to convey the sheet-like article (column 3, lines 41-46). While Yamashita does illustrate an arrangement of laterally offset rollers disposed on opposite sides of a moving sheet material forming a wavy pattern in the web, we find no teaching in either Yamashita or Barkley which would have suggested the use

of an arrangement as taught by Yamashita in a web width adjusting device such as the one taught by Barkley, which need not grip the paper web. Moreover, even if Barkley and Yamashita were combined as proposed by the examiner, Yamashita would not have suggested disposing the counter pressure rollers at a different location along the travel direction than that of the pressure applying rollers, as required by the claims.⁷

Huck discloses a different type of registration device for use in a multiple stage printing device to solve the same fanout problem addressed by Barkley. The Huck registration device comprises rollers (14, 15) disposed on opposite sides of a moving web, the rollers being moved laterally outward or inward to control lateral tension in the web without causing wrinkling of the web (column 10, lines 1-4). The purpose of the opposing rollers used in Huck is to grip the web to

⁷ In making this determination, we interpret "at a second location along said paper web traveling direction . . . different than said first location" as used in the claims on appeal as requiring that the pressure and counter pressure applying means or steps be offset from one another along the web traveling direction (i.e., one is located downstream of the other in the direction of travel of the web). In our opinion, this limitation would not be met merely by offsetting the pressure and counter pressure applying means or steps only in a direction transverse to the web traveling direction, as suggested by the examiner (answer, page 8).

stretch or compress it laterally as needed. As such gripping is not required in the Barkley bustling device, it is not apparent to us why one of ordinary skill in the art would have been motivated to provide counter pressure rollers on the side of the web opposite the bustling wheels and rollers of Barkley. Further, even if the teachings of Barkley and Huck were combined as proposed by the examiner to provide counter pressure applying rollers on the Barkley device, Huck would not have suggested providing such counter pressure applying rollers at a different location along the web traveling direction as required by the claims.

For the foregoing reasons, we do not find the references applied by the examiner sufficient to have suggested the subject matter of claims 2, 6 and 24. Accordingly, we shall not sustain the examiner's rejection of these claims.

As to the examiner's rejection of claim 21, we have reviewed the additional teachings of Fischer, but we find nothing therein which overcomes the deficiencies of the combination of Barkley, Okamura, Miyoshi, Huck and Yamashita discussed above. Thus, it follows that we shall also not sustain the examiner's rejection of claim 21.

REMAND TO THE EXAMINER

This application is remanded to the examiner for consideration of the following issues:

1. Whether claims 2, 6, 21 and 24 are unpatentable under 35 U.S.C. § 103 over Kotterer in view of other prior art.

Kotterer discloses a device comprising air nozzles (5) for correcting the print material side register of a band of paper (4) passing through a series of three printing units (1,2,3) by causing the paper to arch along its width to compensate for widening of the band of paper during printing. The examiner should particularly note that the air nozzles may be located "beneath and/or above the band of paper (4)" (translation, page 4). With nozzles disposed both above and beneath the band, as disclosed by Kotterer, it appears to us that the device comprises a pressure applying means (the nozzles disposed between printing units 1 and 2 beneath the band) at a first location along a paper web traveling direction and a counter pressure applying means (the nozzles between the printing units 2 and 3 above the band) at a second location along the web traveling direction that is different from the first location, with both the pressure applying means

and the counter pressure applying means being arranged between two printing units (1 and 3).

2. Whether claims 2, 6, 21 and 24 are unpatentable under 35 U.S.C. § 102(e) or 103 over the Iijima patent, either alone or in combination with other prior art.

The Iijima patent discloses in claims 1 through 13 therein that the first and second wave forming means (or first and second plurality of ejectors) are located in "substantially the same position in a longitudinal direction of the paper web." As this claim language is explicitly broader than "the same position in a longitudinal direction of the paper web," the examiner should consider whether this teaches or suggests locating the first and second wave forming means in different positions in the longitudinal direction (the web travel direction).

3. Whether claims 2, 6, 21 and 24 should be rejected under the judicially created doctrine of double patenting as being unpatentable over any of claims 1-13 of the Iijima patent, either alone or in view of other prior art.⁸

⁸ A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c)
(continued...)

The judicially created doctrine of double patenting is grounded in public policy (a policy reflected in the patent statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent by prohibiting the issuance of claims in a second patent not patentably distinct from the claims of the first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985).

In particular, in determining whether the appellants' claims are patentably distinct from patent claims 1-13, the examiner should consider whether the recitation in patent claims 1-13 "substantially the same position in a longitudinal direction of the paper web" would have suggested to one of ordinary skill in the art placement of the wave forming means at somewhat different positions along the longitudinal direction of the web (the web traveling direction).

⁸(...continued)
may be used to overcome an actual or provisional obviousness-type double patenting rejection provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 6, 21 and 24 under 35 U.S.C. § 103 is reversed. Additionally, the application is remanded to the examiner for consideration of the issues discussed above.

REVERSED and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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