

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HANS MULLER

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Appeal No. 1998-1868  
Application 08/514,377<sup>1</sup>

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HEARD: NOVEMBER 15, 1999

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

DECISION ON APPEAL

Hans Muller appeals from the final rejection of claims 1, 6, 30 and 31.<sup>2</sup> Claims 2 through 5 and 7 through 29, the only

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<sup>1</sup> Application for patent filed August 11, 1995.

<sup>2</sup> The appellant amended claims 1, 6 and 31 subsequent to final rejection via the paper (Paper No. 19) filed with the reply brief (Paper No. 18) on March 19, 1998 . Although the

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other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b). We reverse.

The subject matter on appeal relates to "a method and apparatus for trimming flat products along a predetermined cutting line" (specification, page 2). Claims 1 and 6 are illustrative and read as follows:

1. A method for trimming flat printed products along a predetermined cutting line, comprising the steps of:

continuously feeding the printed products in succession in a feed direction parallel to a plane defined by the printed products;

passing the printed products between two superposed knives having oppositely disposed cutting edges; and

moving the two knives in cutting engagement with one another in a direction that includes a component perpendicular to the plane of the printed products and a movement component that is in the feed direction so that a continuous feed flow of the printed products is maintained during the trimming.

6. An apparatus for trimming flat printed products along a predetermined cutting line, comprising:

conveyor means for continuously feeding the printed products in succession in a feed direction parallel to a plane defined by the printed products;

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examiner did not mention the amendments in the advisory letter (Paper No. 21) acknowledging receipt and entry of the reply brief, he did place a dated and initialed instruction to "Enter" in the page margin adjacent the amendments (which have in fact been clerically inserted into the record).

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at least one cutting device having two superposed knives having oppositely disposed cutting edges, the printed products being passed by said conveyor means between said two knives; and

drive means for moving each of the knives in cutting engagement with the other knife in a direction that includes a component perpendicular to the plane of the printed products and a movement component that is in the feed direction to maintain a continuous feed flow during the trimming.

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

Long et al. (Long)	4,142,430	Mar. 6, 1979
Evans	4,387,614	Jun. 14, 1983

Claims 1, 6, 30 and 31 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1, 6 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Evans.

Claims 1, 6, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Long in view of Evans.

Reference is made to the appellant's main and reply briefs (Paper Nos. 15 and 18) and to the examiner's answer (Paper No. 16) for the respective positions of the appellant

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and the examiner with regard to the merits of these rejections.

Turning first to the 35 U.S.C. § 112, second paragraph, rejection, the examiner considers independent claims 1 and 6, and claims 30 and 31 which depend from claim 6, to be indefinite because

[i]n claims 1 and 6, the tool is described as moving "in a direction that is substantially perpendicular to the plane of the printed products and with a movement component that is in the feed direction". This phrase is confusing because the tools **do not** move "substantially perpendicularly to the plane of the printed product" [answer, page 2].

The phrases in question, however, no longer appear in claims 1 and 6 as a result of the amendments filed with the reply brief (see footnote 2, supra). The examiner has not explained, nor is it apparent, why claims 1 and 6 as amended are still indefinite. Accordingly, we shall not sustain the standing 35 U.S.C. § 112, rejection of these claims or of claims 30 and 31 which depend from claim 6.

As for the standing 35 U.S.C. § 102(b) rejection, Evans discloses a direct drive cut-off machine wherein the cyclic speeds of the cut-off knives are electronically controlled to cut a continuous pre-printed corrugated web into sheets or

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blanks of desired length. The machine includes, inter alia, a glue machine 12, a double facer machine 14, a rotary shear 16 for severing the web into a leader and trailer, a slitter/scorer 18 for slitting and scoring the web and a cut-off machine 20 having rotary knives for cutting the web into the blanks of desired length.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Claim 1 recites a method comprising, inter alia, the steps of passing printed products between "two superposed knives having oppositely disposed cutting edges" and moving the two knives in cutting engagement with one another in a direction that includes a component perpendicular to the plane of the printed products and a

movement component that is in the feed direction. Claim 6 recites an apparatus comprising, inter alia, at least one cutting device having "two superposed knives having oppositely disposed cutting edges" and drive means for moving each of the knives in cutting engagement with the other knife in the same manner as is set forth in claim 1.<sup>3</sup>

The appellant's argument that Evans does not meet these claim limitations (see, for example, page 2 in the reply brief) is persuasive. In this regard, the examiner's determination that Evans' rotary shear 16 and/or rotary knife cut-off machine 20 constitute superposed knives, having oppositely disposed (i.e., facing) cutting edges, which move in the manner recited (see page 2 in the answer) rests on an unreasonably broad interpretation of the limitations in question as they would be viewed by a person of ordinary skill

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<sup>3</sup> Based on the underlying disclosure (see specification pages 2, 5 and 13), we understand the recitations that the cutting edges of the superposed knives are oppositely disposed to mean that these cutting edges face one another. Indeed, claims 1 and 6 as originally presented expressly recited that each cutting edge faced the other cutting edge, but these recitations were replaced with the present corresponding recitations (see Paper No. 8) to overcome a dubious 35 U.S.C. § 112, second paragraph, rejection.

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in the field of the invention.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1 and 6, or of dependent claim 30, as being anticipated by Evans.

We also shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 6, 30 and 31 as being unpatentable over Long in view of Evans.

Long discloses "[a]n envelope opener comprising first, second and third shear stations for shearing three edges of an envelope in sequence one edge at a time" (Abstract). Each of the shear stations 26, 38 and 50 includes a stationary anvil and a rotatable barrel having a pair of shear blades mounted on opposite sides thereof and a longitudinal opening intermediate the blades. Each envelope to be sheared is conveyed into contact with the barrel, cut by one of the blades in conjunction with the stationary anvil and passed through the opening in the barrel (see column 2, line 65 et seq.).

In short, there is nothing in the combined teachings of Long and Evans which would have suggested a method or apparatus meeting the above discussed limitations in

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independent claims 1 and 6 relating to the superposed knives.

The decision of the examiner 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
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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