

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. RICHARDS and DAVID C. POLLOCK

Appeal No. 1999-0695
Application No. 08/427,018

ON BRIEF

Before McQUADE, 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 4-12 and 21, copies of which appear in the appendix to the appellants' brief. Claims 1-3 and 13-20, the only other claims pending in this application, stand withdrawn from further consideration under 37

CFR § 1.142(b) as being directed to a non-elected invention. Claims 4 and 21 were amended subsequent to the final rejection (Paper No. 10).¹

BACKGROUND

The appellants' invention relates to a web-fed printing press including a web-up device (a splicing mechanism and a secondary roll of a leader web) disposed downstream of a first print unit between the print unit and a second component. By providing the web-up device in one or more locations in the printing press, web-up (feeding of the material through the components of the press) time is substantially reduced because web-up can proceed simultaneously in several parts of the press. For example, if the web-up device is located between a chill unit and a slitter mechanism, one set of technicians can feed a first web from a roll stand through to the chill unit of the press while a second set of technicians feeds the second web from the secondary web roll through the slitter mechanism and folder of the press. Then, once the first web has reached the output of the chill roll, the splicing mechanism splices the first web to the second web thereby forming a single continuous web from the roll stand through the folder (specification, page 3).

¹ While the advisory action mailed June 25, 1997 (Paper No. 11) indicates that the amendment after final rejection (Paper No. 10) will be entered upon the filing of an appeal, we note that (1) the amendment itself bears what appears to be a notation by the examiner instructing that the amendment not be entered and (2) the amendment has not, in fact, been clerically entered. In light of the examiner's agreement with the appellants' statement of the status of amendments after final rejection in the brief and the examiner's statement that the claims in the appendix to the appellants' brief are correct (answer, page 2), we presume that the failure to clerically enter the amendment was a mere oversight and shall treat the amendment as if it has been entered. This oversight, however, is deserving of correction.

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

Bowen	2,859,923	Nov. 11, 1958
Weiss et al. (Weiss)	4,211,375	Jul. 8, 1980
Winter	5,039,374	Aug. 13, 1991
Benson et al. (Benson) (British patent specification)	1,488,510	Oct. 12, 1977

The appellants' admitted prior art on page 1 of the specification (the AAPA)

The following rejections are before us for review.²

Claims 4, 5 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over the AAPA in view of Benson.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over the AAPA in view of Benson, as applied to claims 4, 5 and 9 above, and further in view of Weiss and Bowen.

Claims 8, 10-12 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the AAPA in view of Benson, as applied to claims 4, 5 and 9 above, and further in view of Winter.

² The rejection under the second paragraph of 35 U.S.C. § 112 set forth in the final rejection (Paper No. 8) was overcome by the amendment in Paper No. 10 (see Paper No. 11).

Reference is made to the brief and reply brief (Paper Nos. 16 and 20) and the answer (Paper No. 19) 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 examiner. As a consequence of our review, we make the determinations which follow.

The AAPA relied upon by the examiner is described on page 1 of the appellants' specification as follows:

In a web-fed rotary printing press, a web of material is fed from a roll stand, through an infeed, then through one or more printing units, a dryer, and a chill roll stand before being cut into a plurality of ribbons by a slitter mechanism. The ribbons, in turn, are fed through an angle bar section, and then into a cutting/folding cylinder section of a folder.

When a web is initially fed through the press (called "web-up"), it is fed sequentially from the roll stand through to the folder. This process generally involves two people manually feeding the web through each component of the press system up to the entrance of the slitter mechanism. Once the web reaches the slitter mechanism; additional personnel are required to process the ribbons, e.g. two additional people per ribbon.

Benson discloses a threading device for threading a thermoplastic film web through a wind-up section 13 (including nip rolls 20, 21, profile gauge 22, tension sensing rolls 23, 24 and reeler 26), the threading device comprising a splicer 28, including nip rolls 31, 32 and an

adhesive nozzle 33, a feeder 27 holding a roll of leader, a dump nip 34, a leader cutter 29 and a waste web cutter 30. The thermoplastic film is produced in a formation section including an extrusion unit 10, forward draw unit 11 and a sideways draw heat setting unit (stenter) 12 and, during normal operation, is drawn through the wind-up section, which winds the film onto reels. Occasional faults, such as tearing, may occur in the production of the film web such that it has to be removed from the wind-up section. In order to correct the fault by re-establishing an untorn web, it is desirable to run the formation section at normal line speed (e.g., 300 m/min or even up to 600 m/min). It is therefore desirable to thread film moving at these speeds through the wind-up section (page 1, lines 28-40). In order to address this problem, immediately after a fault occurs, Benson diverts the film web formed in the formation section, which continues to run at normal line speed, to the dump nip 34 as waste to be removed from the work area while a leader from the feeder 27 is threaded through the wind-up section. After the leader has been threaded through the wind-up section and the wind-up section is brought back up to line speed, the nip roll 32 moves over toward the nip roll 31 so that the leader and film web are pressed together. Next, the nozzle 33 deposits a line of adhesive onto the nip between the rolls 31, 32. The waste web cutter 30 severs the waste web from the dump nip so that the end of the film web is secured to the leader and drawn through the wind-up section. When the film web reaches the reeler 26, the leader cutter 29 severs the leader from the feeder 27, which is braked to a standstill.

As recognized by the examiner, the AAPA does not disclose a web-up device after and adjacent the first print unit comprising a splicing mechanism and a second web roll supplying a second web of material, as required by claim 4. The examiner, however, takes the position that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the AAPA with the web-up device of Benson after the print unit because Benson recognizes that web breaks occur in continuous web feeding operations and because Benson teaches that the claimed web-up device is well-known in the art as a rethread means to correct the situation of a web break (answer, page 4).

In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

While we agree with the examiner that Benson does disclose a splicing mechanism for assisting in rethreading a continuous web through a continuous web-feeding apparatus after the occurrence of a production fault and appreciate that the AAPA is also a continuous web-

feeding apparatus in which one of ordinary skill in the art would have anticipated that faults could occur, we do not agree that the combined teachings of these references would have suggested the modification proposed by the examiner. From our perspective, one of ordinary skill in the art reading the Benson disclosure would have understood that, upon occurrence of a production fault as described therein, the leader from feeder 27 must be threaded, by conventional means known in the art, through the wind-up section and that the splicing mechanism in no way facilitates that procedure. Rather, the function of the dump nip and the splicing mechanism is to permit the formation section to run at normal line speed to establish an acceptable extruded film web while the wind-up section is rethreaded (presumably at a rate significantly slower than normal line speed) with the leader and brought up to the speed of the formation section so that the film web can then be threaded into the wind-up section at normal line speed. As there is no indication in the AAPA that the continuous web therein must be run through the print unit at normal line speed during the web-up or threading process, it is not apparent to us why, without the benefit of the appellants' disclosure, one of ordinary skill in the art would have been motivated by the teachings of Benson to provide a web-up device (splicing mechanism and secondary web roll) downstream of the first print unit for outputting a spliced web to the second component.

For the foregoing reasons, we shall not sustain the examiner's rejection of claim 4 or claims 5 and 9 which depend from claim 4 under 35 U.S.C. § 103 as being unpatentable over

the AAPA in view of Benson. We have reviewed the additional teachings of Weiss, Bowen and Winter but find nothing therein which overcomes the above-noted deficiency of the combination of the AAPA and Benson. Accordingly, we also shall not sustain the examiner's 35 U.S.C. § 103 rejections of claims 6 and 7 as being unpatentable over the AAPA in view of Benson, Weiss and Bowen and claims 8, 10-12 and 21 as being unpatentable over the AAPA in view of Benson and Winter.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4-12 and 21 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 1999-0695
Application No. 08/427,018

Page 10

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