

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY BUSSEY, III
and HARRY BUSSEY, JR.

Appeal No. 2001-1381
Application 08/826,741

ON BRIEF

Before STAAB, MCQUADE, and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 1.197(b), Harry Bussey, III et al. request rehearing (i.e., reconsideration) of our decision on appeal rendered September 20, 2001 to the extent that we sustained the examiner's 35 U.S.C. § 103(a) rejection of independent claims 1 and 26 as being unpatentable over U.S.

Appeal No. 2001-1381
Application 08/826,741

Patent No. 2,345,072 to Rosenleaf et al. (Rosenleaf) in view of U.S. Patent No. 5,207,138 to Sato et al. (Sato).¹

At issue is whether the combined teachings of Rosenleaf and Sato would have suggested a machine meeting the limitations in claims 1 and 26 requiring a base roll for supporting the conveyed web during passage through the perforating or severing station. In the decision, we concluded that they would "because the web passing through Rosenleaf's machine is necessarily supported by the lower rotor [base roll] 16 via one of its knives 17-20 during the perforating or severing operation In this regard, the limitations at issue do not require direct contact between the base roll and the conveyed web" (page 8). Essentially repeating arguments earlier made in their briefs, the appellants dispute that the web passing through the Rosenleaf machine is so supported by rotor 16. According to the appellants,

¹ In the decision, we also sustained the examiner's 35 U.S.C. § 103(a) rejection of dependent claims 3, 9 through 11, 13, 28 and 31 through 34 as being unpatentable over Rosenleaf in view of Sato.

[t]he knives easily slice through [Rosenleaf's] plaster board [web] without giving any support to the plaster board.

As noted in Appellant's [sic] Reply Brief at page 2, if a knife 17-20 on the rotor 16 of Rosenleaf cuts or perforates the plaster board, it cannot be said that the knife also supports the plaster board. The terms "cutting" and "perforating" each means that there is a relative [vertical] movement between the knife and the plaster board. The term "support" means that there is no relative [vertical] movement between the knife and the plaster board.

As soon as a knife 17-20 of Rosenleaf contacts the web of plaster board, the cutting edge of the knife (shown serrated in Fig 1) cuts into the plaster board. As such, the knife and particularly the serrated knife edge cannot support the web [request, page 4].

Before addressing the substance of this argument, we find it necessary to remark on the following passage in the appellants' request:

[i]t appears that the decision has not agreed with the Examiner's reasons for rejecting claims 1 and 26 as being unpatentable over Rosenleaf in view of Sato. That is to say, the BPAI agrees that it would not have been obvious to one of ordinary skill in the art to eliminate the cradle frame 112 of Rosenleaf and to provide the Rosenleaf device with a base roll moving means for moving the base roll vertically out of position with the upper perforator roll during a non-cutting phase in order to insure that there is no interference between the lower base roll and the web. Instead, the decision appears to hold that Rosenleaf alone teaches that the plaster board is supported by the rotor 16 during a perforating or cutting operation, i.e. when the

Appeal No. 2001-1381
Application 08/826,741

cradle frame 112 is lowered out of the orbit of the knives 17-20. This was not the issue of the Final Rejection [page 3].

The foregoing takes great liberties with what we actually stated. As pointed out on page 6 in the decision, the appellants did not challenge the propriety of the proposed combination of Rosenleaf and Sato. Hence, we found it unnecessary to comment on same, and did not in fact do so. As indicated above, the issue on appeal with respect to claims 1 and 26 was, and is, whether the combined teachings of Rosenleaf and Sato respond to the base roll web-supporting limitations in these claims. Given Rosenleaf's status as the primary reference in the proposed combination and the character of the unchallenged modifications advanced by the examiner in view of Sato, this question boils down to whether Rosenleaf's rotor 16 meets the subject limitations. The examiner's position that rotor 16 does meet these limitations appears in both the final rejection and answer (Paper Nos. 17 and 20).

As for the merits of the examiner's determination, we remain of the view that "the web passing through Rosenleaf's machine is necessarily supported by the lower rotor 16 via one

Appeal No. 2001-1381
Application 08/826,741

of its knives 17-20 during the perforating or severing operation" (decision, page 8). Even if the appellants' bald assertion that Rosenleaf's knives easily slice through the plaster board web is taken at face value, it simply does not follow that the knives fail to provide at least some support to the web. The nature of plaster board and the engagement of the knives with the bottom thereof provide reasonable factual support for concluding that the knives, and hence the rotor or roller 16 mounting the knives, support the web however fleetingly. Contrary to the appellants' contention, there is nothing in claims 1 and 26 or in the ordinary and accustomed meaning of the term "support" which excludes the relative vertical movement between Rosenleaf's knives and the web which admittedly occurs during the perforating or severing operation. Simply put, this argument, and the appellants' position as a whole that Rosenleaf's rotor 16 does not respond to the web supporting limitations in claims 1 and 26, rest on an improper attempt to read limitations from the specification into these claims.

Appeal No. 2001-1381
Application 08/826,741

In summary, we have reconsidered our decision to the extent indicated above, but decline to make any changes therein.

DENIED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Appeal No. 2001-1381
Application 08/826,741

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