

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(2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE M. CROSS

Appeal No. 2000-0116
Application 08/950,539

ON BRIEF

Before CALVERT, ABRAMS and BAHR, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 8, 11 to 14 and 16 to 20. The examiner has indicated on page 4 of the examiner's answer that the other claims in the application, 9, 10 and 15, would be allowable if rewritten in

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independent form.

The appealed claims are drawn to a method of advancing a confidential sheet within a document security apparatus, and an apparatus for advancing a confidential sheet. They are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Aronsen 1994	5,335,478	Aug. 9,
Kramer 1994	5,341,625	Aug. 30,
Underwood 20, 1996	5,547,181	Aug.
Lee 1996	5,566,528	Oct. 22,

The claims on appeal stand finally rejected under 35 U.S.C. § 103 as unpatentable over the following combinations of references:

(1) Claims 1 to 6, 11 to 14 and 16 to 19, Lee in view of Underwood and Aronsen.

(2) Claims 7, 8 and 20, Lee in view of Underwood, Aronsen and Kramer.

Rejection (1)

In the final rejection (Paper No. 7), the examiner states the basis of this rejection on page 2 as follows:

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Lee substantially shows the claimed subject matter as discussed in paragraph 2 of the last office action. Lee does not show moving the sheets with a scuffer wheel and Lee does not show advancing the sheets after creating a pocket as claimed. Underwood teaches the basic concept of feeding sheets with a scuffer wheel and Aronsen shows the concept of creating a pocket and then subsequently advancing sheets into the pocket. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Lee with scuffer advancing means and pocket forming means as taught by Underwood and Aronsen respectively to provide an efficient and accurate process.

After fully considering the record in light of the arguments presented in the appellant's brief and the examiner's answer, we conclude that rejection (1) should not be sustained. While it seems evident that, as a general proposition and as disclosed by Underwood, it is well known to use a scuffer to advance media sheets, and would have been obvious to use a scuffer in the Lee apparatus to advance the pages from machine 10 and the packaging (enclosure) sheets 36, we do not consider that it would further have been obvious to modify the Lee apparatus in view of Aronsen in the manner proposed by the examiner.

Aronsen discloses an arrangement for packaging a product such as towelettes in a dispenser pouch. In brief, the pouch

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is formed by folding a first web 10 to form the two outer walls 38, 40 of the pouch, while inserting a second web 44 therebetween (Fig. 4A). The first and second webs are sealed together at the edges 54, 56 and at the fold line 58, thereby producing a pouch having two compartments 62, 64 (Fig. 5A). Two stacks of towelettes 66, 84 are then sequentially inserted, one stack into each of the compartments (Fig. 5A, 6A), and the open end of the pouch 92 is sealed (Fig. 7a).

The examiner argues with regard to Aronsen that (answer, pages 5 and 6):

The combination of Aronsen is deemed within [sic] one of ordinary skill in the art as it is well known to either form a pocket and inset the product as taught by Aronsen or to form the envelope simultaneously with the product enclosed as primary reference Lee shows.

Primary reference, Lee teaches the basic concept of enclosing confidential materials with enclosure sheets but Lee does not show the claimed transporting means to transport the confidential sheets into the enclosure means and does not show the envelope forming means being created prior to the insertion means. As stated supra, it is known to either form an envelope and then fill it or form the envelope simultaneously with the product. Secondary reference, Aronsen, teaches the basic concept of forming envelopes and subsequently filling the envelopes. Therefore, it would have been obvious modification to one of ordinary skill in the art to provide Lee with envelope forming means prior to filling as taught by Aronsen to

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provide the well known means of filling a pre-formed envelope.

We do not agree with this argument, but rather agree with appellant that there is no teaching or suggestion which would support the combination of Lee and Aronsen. Assuming arguendo that one of ordinary skill would consider Aronsen to be pertinent to the problem of enclosing confidential sheets within an enclosure, we do not consider that one of ordinary skill would

find any suggestion in Aronsen to modify the Lee apparatus to form an enclosure (envelope) and then insert the pages from the facsimile machine 10 thereinto, nor any teaching as to how such a

modification should be accomplished, the Aronsen apparatus being fundamentally different from that of Lee in that in Aronsen, as discussed above, the enclosure is initially formed by folding a web, whereas in Lee the enclosure is formed from separate sheets.

It is evident that, at a minimum, modification of the Lee apparatus to insert the pages into a preformed enclosure

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(envelope) would require changing the apparatus so that (1) the top and bottom enclosure sheets 48, 56 would be advanced into position together, (2) the adhesive at the leading edges of the enclosure sheets would be activated by heating elements at 110a, (3) a means (such as vacuum 86 of Aronsen) would be provided to hold sheets 48, 56 apart while the pages were inserted therebetween, and (4) the other heating elements (at 110 b, c, d) then would be activated to seal the enclosure. However, while these modifications could be made it is fundamental that the mere fact that the prior art could be modified to form the claimed structure or perform the claimed process would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); In re Fritch, 972 F.2d 1260, 1266, 23 USPQ 1780, 1783-84 (Fed. Cir. 1992). In the present case, we find no teaching or suggestion in the applied prior art which would have motivated one of ordinary skill to make such extensive modifications of the Lee apparatus. The examiner seems to indicate in the final

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rejection, supra, that there would be motivation to modify Lee in order "to provide an efficient and accurate process," but it is not apparent what there is in the prior art that would suggest to one of ordinary skill that modifying Lee would make the Lee apparatus any more efficient and accurate than before. In our view, the examiner's reason for combining the references was not based upon a suggestion in the prior art of the desirability of making the combination, but upon improper hindsight gleaned from appellant's own disclosure.

Accordingly, rejection (1) will not be sustained.

Rejection (2)

Rejection (2) will likewise not be sustained, since Kramer, the additional reference applied, does not overcome the deficiencies of the combination of references applied in rejection (1).

Conclusion

The examiner's decision to reject claims 1 to 8, 11 to 14 and 16 to 20 is reversed.

No time period for taking any subsequent action in

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connection with this appeal may be extended under
37 CFR § 1.136(a).

REVERSED

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IAN A. CALVERT))
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JENNIFER D. BAHR)	
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