

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOKUJI WATANABE

Appeal No. 97-3990
Application 08/531,069¹

ON BRIEF

Before CALVERT, MEISTER and CRAWFORD, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

Tokuji Watanabe (the appellant) appeals from the final rejection of claim 9, the only claim remaining in the application.

We REVERSE and, pursuant to our authority under the

¹ Application for patent filed September 20, 1995. According to appellant, the application is a continuation-in-part of Application 08/165,474, filed December 13, 1993, now abandoned.

Appeal No. 97-3990
Application 08/531,069

provisions of 37 CFR § 1.196(b), enter a new rejection of claim 9.

The appellant's invention pertains to an apparatus for manufacturing paper cushioning members that are useful as a packing material for objects which are to be shipped or transported. To this end, sheets of paper or other packing material are fed to cutting members that form a plurality of intermittent or spaced slits in the sheet. Thereafter, the sheet is fed into a wave forming guide where it is "crumpled." The "crumpled" sheet may, due to the intermittent or spaced slits, thereafter be stretched so as to form a cushioning member that is softer than one formed from a sheet not having such slits.

A copy of claim 9 may be found in the appendix to the brief.

The references relied on by the examiner are:

Curtis	671,915	Apr. 9, 1901
Parker (Parker '972)	5,088,972	Feb. 18, 1992
Parker (Parker '013)	5,134,013	Jul. 28, 1992
Parker (Parker '352)	5,173,352	Dec. 22, 1992
Parker (Parker '259)	5,403,259	Apr. 4, 1995

Appeal No. 97-3990
Application 08/531,069

Broden et al. (Broden) 576,412
(Canadian Patent)

May 26, 1959

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Curtis in view of Parker '259, Parker '352, Parker '013 or Parker '972 and further in view of Broden.

The examiner's rejection is explained on pages 4-7 of the answer. The arguments of the appellant and examiner in support

of their respective positions may be found on pages 6-10 of the brief, pages 1-4 of the reply brief and pages 8-12 of the answer.

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and reply brief and by the examiner in the answer, it is our conclusion that the above-noted rejection is not sustainable.

According to the examiner it would have been obvious to make the link forming recesses of Curtis extend entirely

Appeal No. 97-3990
Application 08/531,069

across the projections in a horizontal direction in view of the teachings of Broden. The examiner is further of the opinion that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Curtis with the teachings of Parker [sic, Parker '259, Parker '352, Parker '013 or Parker '972] in order to reliably [sic, reliably] crumple thin bands of paper cushioning members cut by roller members (i.e., adding [sic] inserting at least one sheet of work paper between cutting rollers, feeding said work paper through a wave-forming guide and forcibly compressing said work paper inside said wave-forming guide to Curtis), since Parker [sic, Parker '259, Parker '352, Parker '013 or Parker '972] teaches that manufacturing thin bands of crumpled paper cushioning members by inserting at least one sheet of work paper between cutting rollers, feeding said work paper through a wave-forming guide and forcibly compressing said work paper inside said wave-forming guide in order to finely crumple said thin bands was old and well known at the time the invention was made. [Answer, pages 5 and 6.]

In response to the appellant's argument that the device of Curtis is directed to a metal slitting apparatus that is not properly combinable with the paper folding and crimping device

Appeal No. 97-3990
Application 08/531,069

of either Parker '259, Parker '352, Parker '013 or Parker '972, the examiner states that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim" (answer, page 12).

We will not support the examiner's position. Even if we were to agree with the examiner that it would have been obvious to make the link forming recesses of Curtis extend entirely across the projections in a horizontal direction in view of the teachings of Broden, we cannot agree that it would have been obvious to combine the teachings of Curtis, as modified by Broden, with those of either Parker '259, Parker '352, Parker '013 or Parker '972 in the manner proposed. The mere fact that the device of Curtis has the capability of being employed to form cuts in paper does not serve as a proper motivation for combining the teachings of Curtis and the various references to Parker as the examiner apparently believes. Instead, in order to establish obviousness under 35 U.S.C. § 103, it is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. **See, e.g.,**

Appeal No. 97-3990
Application 08/531,069

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) and **Interconnect Planning Corp. v. Feil**, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985). Here, we find no such suggestion.

The device of Curtis is directed to a completely disparate type of device from that of any of the Parker references. That is, Curtis discloses an apparatus for forming spaced slits in a metal sheet (see Fig. 7) that is subsequently intended to be expanded into a mesh-like sheet (see Fig. 8) and is in no way concerned with manufacturing packing materials. On the other hand, each of the Parker references is directed to an apparatus for forming resilient bulk packaging material from sheets such as paper or cardboard. To this end, the sheets are fed to a plurality of cutters which slit the sheets into narrow strips that are then fed into a device (which the examiner considers to be a "wave forming guide") where the narrow strips are folded, crimped and compressed into a generally zig-zag configuration. Absent the appellant's own teachings, we are at a complete loss to understand why one of ordinary skill in

Appeal No. 97-3990
Application 08/531,069

this art would have been motivated to feed Curtis' sheet having spaced cuts therein (that is intended to subsequently be expanded into a mesh-like **sheet**) into a "wave forming guide" as taught by the Parker patents (wherein narrow strips are folded, crimped and compressed so as to form a **resilient packing member of a generally zig-zag configuration**). As the court in **Uniroyal**, 837 F.2d at 1051, 5 USPQ2d at 1438 stated: "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

Moreover, even if the references were combined in the manner proposed by the examiner, there is nothing in the relied on prior art which suggests "waste-collecting members" or strippers having **projections and recesses formed on edge portions thereof** as expressly required by claim 9. With respect to this limitation the examiner relies on "waste-collecting members 240,244,248,250 (best shown in '352 or '259 Figures 10 and 12" While the examiner is correct in noting that these elements function as waste collecting members or strippers, they do not have projections and

Appeal No. 97-3990
Application 08/531,069

recesses formed on edge portions thereof as claimed. That is, these elements are simply a **plurality of plate-like members** (having openings 245 therein for accommodating the cutter shaft) that are mounted on supporting shafts 246 in such a manner that they are **interleaved between** the cutting discs.

In view of the foregoing, we will not sustain the rejection of claim 9 under 35 U.S.C. § 103 as being unpatentable over Curtis in view of Parker '259, Parker '352, Parker '013 or Parker '972 and further in view of Broden.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. This claim sets forth "a top-pressing member and a bottom-receiving member" and "a wave-forming guide" as though they were two separate elements when in fact they are at least partially the same. Note in particular the preliminary amendment filed on September 20,

Appeal No. 97-3990
Application 08/531,069

1995 (Paper No. 11) wherein the addition to page 11 (between lines 12 and 13) states: "[t]he wave-forming guide 18 comprises an upper pressing member 18₁ and a lower receiving member 18₂." We also observe that "recesses" in the second and third lines from the end of claim 9 have no clear antecedent basis since both "circumferential" recesses and "link-portion forming" recesses have been previously set forth.

In summary:

The rejection of claim 9 under 35 U.S.C. § 103 is reversed.

A new rejection of claim 9 under 35 U.S.C. § 112, second paragraph, has been made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR

Appeal No. 97-3990
Application 08/531,069

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

Appeal No. 97-3990
Application 08/531,069

IAN A. CALVERT)
Administrative Patent Judge))
)
)
) BOARD OF PATENT
JAMES M. MEISTER)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
MURRIEL E. CRAWFORD)
Administrative Patent Judge)

GREENBLUM & BERNSTEIN, P.L.C.
1941 Roland Clarke Place
Reston, VA 20191