

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEE A. BAETLEIN

Appeal No. 98-0009
Application No. 08/538,414¹

ON BRIEF

Before MEISTER, ABRAMS and CRAWFORD *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-6, which constitute all of the

¹Application for patent filed October 2, 1995.

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claims of record in this application.

The appellant's invention is directed to a declipper assembly for removing a clip from the end of a sausage package. The subject matter on appeal is illustrated by reference to claim 1, which reads as follows:

A declipper assembly for removing a clip from the end of a sausage package which is adaptable to a universal power head, said assembly comprising a pair of plates pivotally mounted in a parallel spaced relation on the power head and an end plate having a curved cutting edge interconnecting the ends of the plates and a cutter blade mounted on the power head for pivotal motion between said plates, said cutter blade having a cutting edge which matingly engages the cutting edge on the end plate to cut the clip from the end of the package.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Hoffman	4,214,492	Jul. 29,
1980		
LaBounty	4,558,515	Dec. 17,
1985		

THE REJECTIONS

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoffman in view of LaBounty.

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Claims 1-6 also stand rejected under 35 U.S.C. § 103 as being unpatentable over LaBounty.

The rejections are explained in the Examiner's Answer.

The appellant's arguments are set forth in the Brief.

OPINION

We have evaluated the rejection on the basis of the following guidelines provided by our reviewing court: The examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025,

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226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

The Rejection On The Basis Of Hoffman And LaBounty

The declipper assembly set forth in claim 1 requires a pair of plates pivotally mounted in parallel spaced relation, and an end plate having a curved cutting edge connecting the

two. A cutter blade pivotally mounted between the two plates has a cutting edge "which matingly engages the cutting edge of the end plate."

Hoffman, the primary reference, discloses a declipping system in which two pairs of scissors-type pivotal blades coincidentally cut the end rings from the facing ends of two adjacent sausage packages. While the two sets of blades are parallel to each other, they are not connected by end plates, much less having a curved cutting edge carried by end plates. Whereas in the claimed system the package is cut with a blade positioned on the end of the two blades, where they are joined, in Hoffman the package is cut by a conventional scissors technique. This can be appreciated by comparing Figure 5 of the application with Figure 1 of Hoffman. Hoffman therefore lacks a showing of the claimed end plate interconnecting the ends of the parallel plates, the curved cutting edge on the end plate, and the cutter blade mounted for pivotal motion between the plates.

LaBounty is directed to an apparatus for attachment to the end of a backhoe or the like, its purpose being to grapple rubble and debris such as fallen trees on a construction site,

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and to cut these members into shorter lengths. Nonetheless, the structure of its cutter has much in common with the appellant's device. In the embodiment of Figures 7 and 9, LaBounty discloses a pair of plates (127 & 128) pivotally mounted in parallel spaced relation and attached together by an end plate (130). Another plate (114) is pivotally mounted for movement in the space between the two parallel plates. However, unlike the claimed invention, there is no cutting edge on end plate 130 or on plate 114, and therefore there is no cutting edge on the end of plate 114 to "matingly engage" the cutting edge of end plate 130, as is required by claim 1. This is clear from the description of the LaBounty invention, and is graphically illustrated in Figures 9 and 11. In LaBounty, all of the cutting edges are located on the sides of the various plates, and thus the LaBounty apparatus cuts in the same fashion as a conventional pair of scissors.

Therefore, even if one were to concede, *arguendo*, that it would have been obvious to combine the teachings of the two references, the result would not have been the claimed structure. From our perspective, however, one of ordinary skill in the art would not have been motivated to combine the

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teachings of the two references in the first place. First, basic to the Hoffman system is the initial lateral movement apart of the two sets of blades (Figures 4-6), which would be destroyed if the ends of the blades were to be attached together. Thus, to convert to the LaBounty system would destroy the Hoffman invention. Second, considering that LaBounty does not teach cutting with the end plate that connects the two parallel plates, there would be no purpose in providing a pair of scissor blades attached together to cut out each of the package end clips, in place of the single pair of blades disclosed by Hoffman.

For the above-stated reasons, it is our conclusion that the combined teachings of Hoffman and LaBounty fail to establish a *prima facie* case of obviousness with regard to the subject matter

recited in claim 1, and therefore we will not sustain this rejection of claims 1-3.

Claim 4 is broader than claim 1, in that it does not require that the ends of the parallel plates be attached together by an end plate upon which a cutting edge is mounted.

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However, it is our view that this combination of references fails here, too, because of the lack of suggestion for the artisan to combine their teachings in the manner proposed by the examiner, for the reasons explained above with regard to claim 1.

We therefore also will not sustain this rejection of claims 4-6.

The Rejection On The Basis Of LaBounty

As we explained above, LaBounty fails to disclose an end plate having a curved cutting edge which is matingly engaged by the cutter blade that passes between the spaced parallel plates. For this reason the teachings of LaBounty, here considered alone, fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 1.

This rejection of claims 1-3 therefore cannot be sustained.

We reach a different conclusion, however, with regard to this rejection of independent claim 4. The preamble of this claim states that it is directed to a "declipper assembly for

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removing a clip from the end of a sausage package," and we begin our analysis by pointing out that generally a preamble does not limit the scope of a claim if it merely states the invention's purpose or intended use. See *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). Where the limitations following the preamble set forth a description of structure which is self-contained and does not depend upon the language of the preamble for completeness, as we believe to be the case here, the preambular recitations do not constitute limitations of the claims. See *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951). The purpose of the LaBounty device is cutting, which is the same purpose as that of the device which is described in claim 4, and we do not believe that the LaBounty device would undergo a metamorphosis to a new apparatus by simply affixing a new named use to it. See *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). It therefore is our conclusion that the recitation of "removing a clip from the end of a sausage package" in the preamble of claim 4 is merely a statement of intended use which may not be relied upon to distinguish structure from the prior art. See, for example,

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In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974).

It is important to focus upon the fact that, unlike claim 1, claim 4 does not require the cutting edge to be on the spacer which supports the plates in parallel spaced relation. Claim 4 merely recites "a cutter blade pivotally mounted in the space between the blades," and such an arrangement is taught by LaBounty. Cutter blades 122 and 123 are carried by a pivotal upper plate 121 and, as can be seen in Figures 7-9, the cutting edges lie in the space between the lower plates.

It therefore is our opinion that LaBounty establishes a *prima facie* case of obviousness with regard to the subject matter of claim 4, and we will sustain this rejection. In view of the appellant's decision to group claims 5 and 6 with claim 4 (Brief, page 4), this rejection of those two claims also is sustained.

We have, of course, carefully considered all of the appellant's arguments, as they may apply to the rejection which we have sustained. However, we are not convinced that, as to this rejection, the examiner's decision was in error.

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Our position with respect to the various arguments should be apparent. LaBounty is not from nonanalogous art because, in our view, it is related to cutting with power operated oppositely pivoting elements, one of which moves between a spaced pair of the others in scissor-like motion, and therefore logically would have commended itself to the inventor's attention.² The rejection we have sustained is not based upon hindsight reasoning, in that all of the structure recited in claim 4 is found in LaBounty, as we have pointed out.

SUMMARY

The rejection of claims 1-6 as being unpatentable over Hoffman in view of LaBounty is not sustained.

The rejection of claims 1-3 as being unpatentable over

²The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. See *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. See *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

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LaBounty is not sustained.

The rejection of claims 4-6 as being unpatentable over
LaBounty is sustained.

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

AFFIRMED-IN-PART

JAMES M. MEISTER)
Administrative Patent Judge)
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) BOARD OF PATENT
NEAL E. ABRAMS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)

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