

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

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY J. RAJALA, PAUL M. NIEMI and DANIEL J. OSHEFSKY

Appeal No. 1998-0853
Application No. 08/381,364

HEARD: October 11, 2000

Before COHEN, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-10, 30 and 68. Claims 19-29, 31-37, 44-53 and 61-67, the only other claims pending in the application, stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention and, thus, are not involved in this appeal.¹

¹ The appellants' indication on page 3 of the brief (Paper No. 14) that claims 19-29, 31-37, 44-53 and 61-67 stand rejected and are involved in this appeal is in error.

BACKGROUND

The appellants' invention relates to a method for receiving discrete parts traveling at a first speed and applying the parts to a web traveling at a different speed (specification, page 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Bosse	3,835,756	Sep. 17, 1974
Schroth et al. (Schroth)	4,608,115	Aug. 26, 1986
Suzuki et al. (Suzuki)	4,626,305	Dec. 2, 1986

Appellants' admitted prior art on page 1, lines 15-24, of the specification (the APA)

The following rejections are before us for review.²

- (1) Claims 1-10 and 30³ stand rejected under 35 U.S.C. § 103 as being unpatentable over Schroth in view of Bosse and the APA.
- (2) Claim 68 stands rejected under 35 U.S.C. § 103 as being unpatentable over Schroth in view of Bosse and the APA, as applied to claim 1 above, and further in view of Suzuki.

² These were new grounds of rejection set forth in the examiner's answer (Paper No. 15).

³ As claim 30 depends from claim 68, it appears that the examiner's rejection of claim 30 as being unpatentable over Schroth in view of Bosse and the APA, rather than as unpatentable over Schroth in view of Bosse, the APA and Suzuki, was an inadvertent error. Thus, we interpret the examiner's rejection of claim 30 as being based upon the combined teachings of Schroth, Bosse, the APA and Suzuki.

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Reference is made to the reply brief (Paper No. 16) and the answer 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 cannot sustain the examiner's rejections.

The examiner finds that Schroth discloses the subject matter of claim 1 except providing a variable angular velocity on the rotating transport assembly in order to synchronizely [*sic*: synchronously] feed the discrete strips onto a transport head (32) of the rotating transfer assembly at a first speed and transfer the discrete strips onto a moving sheet at a second speed [answer, page 5].

The examiner's basis for concluding that the subject matter of claim 1 would have been obvious to one of ordinary skill in the art, as articulated on pages 5 and 6 of the answer, is as follows:

it would have been obvious in the art to provide a variable angular velocity on the rotating transport assembly in order to synchronizely [*sic*: synchronously] feed the discrete strips onto a transport head of the rotating transfer assembly at a first speed and transfer the discrete strips onto a moving sheet at a second speed in the process of Schroth et al because: a) APA discloses that in manufacturing disposal [*sic*: disposable] diapers, it is conventional in the art to feed discrete parts at a speed which is different from the speed of a product moving web (specification, page 1 lines 15-24); and b) Bosse discloses providing a rotating transfer assembly with a variable rotational velocity so that the velocity of a holders (19, 19') can be synchronized with the feeding web (F) speed and the receiving web (32) speed, where the feeding web speed could be different

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from the receiving web speed (col. 1 line 52 to col. 2 line 23; col. 2 lines 39-44; col. 3 lines 48 to col. 4 lines 13).

Most if not all inventions arise from a combination of old elements. See in re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellants. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In this instance, the APA referred to by the examiner on page 1 of the appellants' specification discloses that the speed at which parts are fed into a process often is not the same as the speed of the product web itself and that, in these cases, the speed at which the parts are fed must be changed to match the speed of the product web to properly apply the parts without adversely affecting the process or the finished product (specification, page 1). However, we find in this disclosure nothing to suggest modifying Schroth to feed the ribbons 16, 18 (or discrete ribbon strips 54, 56) at a speed which is different from that of the moving web of material 22 and the examiner has not articulated any rationale as to why one of ordinary skill in the art would have been motivated to do so.

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Bosse discloses a bag-making machine comprising a variable gearing arrangement which causes the angular speed of a transfer drum for feeding handles T and reinforcement sheets B onto a moving web 32 to be altered during rotation of the drum such that the peripheral speed of the drum matches that of the moving web 32 at the point of transfer of a handle T and sheet B to the web (see angular range * in Figure 1), is a mean angular speed over angular ranges " and \$, and is a compensating speed over other angular ranges so as to maintain the cycle of the drum at a predetermined constant regardless of the speed of the moving web. As explained in column 3, line 40, to column 4, line 13, Bosse's variable gearing arrangement permits the apparatus to be used to make different sized bags with a single transfer drum. While Bosse discloses a variable gearing arrangement which could be used in Schroth to achieve the necessary variable angular speed at which the ribbon strips are transferred by the roll 4 from the feed station 57 to the transferring station 59 to accommodate a difference between the speed at which the ribbons are fed to the roll and the speed at which the web 22 travels, we find in Bosse no suggestion to feed the ribbons to the roll at a speed which is different from that of the moving web 22.

As the examiner's rejection of the claims under 35 U.S.C. § 103 rests in part on the determination that it would have been obvious to feed the ribbons of Schroth at a speed which is different from the speed of the web 22 and as we find in the applied references no suggestion

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to do so, we are constrained to reverse the examiner's rejection of claim 1, as well as claims 2-10 which depend from claim 1.

We have reviewed the teachings of Suzuki but find therein no suggestion to feed the ribbons of Schroth at a speed which differs from that of the web. Therefore, we also reverse the examiner's rejection of claims 30 and 68 as being unpatentable over Schroth in view of Bosse, the APA and Suzuki.

REMAND TO THE EXAMINER

We remand this application to the examiner for consideration of the following issues:

(1) Are any of the claims unpatentable over U.S. Patent No. 5,091,039 issued to Ujimoto et al. on February 25, 1992 (hereinafter "Ujimoto")⁴?

Ujimoto discloses a method and apparatus for applying elastic bands 5 onto a moving web 8 in manufacturing garments such as disposable diapers, diaper-covers and training pants (column 1, lines 18-21). The method comprises feeding, at a position \hat{I} , a continuous elastic band to a rotatable transfer means 11 comprising suction members 12 carried by respective rotor elements 26, severing the elastic bands into predetermined lengths to form pieces and transporting the pieces of elastic bands on the suction members at a progressively accelerated speed to a position \hat{O} , at which the continuous web 8 is tangentially brought into contact with the pieces and the pieces are transferred onto the web under synchronization of the transporting

⁴ This reference was cited by the appellants in Paper No. 2 and a copy is of record in the application file.

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speed and the web feeding speed (column 5, lines 37-44). Each of the suction members 12 comprises a front piece 12a and a rear piece 12b which are normally maintained in a linear alignment in the direction of rotation of the transfer means 11. The front piece 12a is movably mounted on an associated base block 26a such that a front end of the front piece 12a may be laterally displaced by the mechanism discussed in column 10, lines 10-16, during rotation of the associated rotor element 26 by pivoting movement around a supporting stud 34 so as to re-orient the pieces of elastic band (see column 7, lines 54-61, and column 2, lines 40-49). The transfer of the elastic band pieces onto the web occurs while the respective suction members maintain at least one of their ends displaced, so one end of each of the respective pieces of elastic band carried on the suction members is obliquely displaced relative to the direction in which the suction members rotate when bonded to the web (column 5, lines 1-12). Ujimoto's disclosure of the combined features of feeding elastic bands onto a rotatable transfer device having a plurality of transport heads (suction members), rotating the transport heads about a first axis in a progressively accelerating manner from a first speed at the feed location to a second speed at a second location at which the bands are transferred to a moving web, with the second speed being the same as that of the moving web, and simultaneously rotating the transport heads about a second axis generally radial with respect to the first axis appears to be particularly pertinent to the subject matter of the claims on appeal. Thus, the application is remanded to the examiner to review the disclosure of Ujimoto in light of the claimed subject

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matter. If, as a result of such review, the examiner determines that any of the claims is unpatentable over Ujimoto, either alone or in combination with other prior art, the examiner should issue an Office action making any appropriate rejections under 35 U.S.C. § 102 or 103.

(2) Claim 1, as well as several of the claims depending therefrom, is directed to a method of taking parts, re-orienting the parts and transferring them to a receiver. Therefore, it appears that a search in the area of conveyors (class 198) is appropriate for the claimed subject matter. A review of the application file reveals that the examiner has not conducted a search in class 198. Accordingly, upon remand, the examiner should additionally search for the claimed subject matter in class 198. While other subclasses may also be pertinent to the claimed subject matter, we note of interest the following subclasses of class 198: 373 et seq. (re-orienting of items); 377.02 et seq. (holder rotates item about axis spaced from the item) and 377.04 (suction grippers); and 459.8 (endless or rotary conveyor having zone of varying speed).

The application is remanded to the examiner for appropriate action with regard to the above-mentioned items.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10, 30 and 68 under 35 U.S.C. § 103 is reversed and the application is remanded to the examiner to take appropriate action with regard to the above-mentioned issues.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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