

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NIKOLAOS GEORGITSIS and NILS ROSE

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Appeal No. 1998-1912  
Application No. 08/780,744

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HEARD: May 3, 2000

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Before MCCANDLISH, STAAB, and GONZALES, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-22, all the claims pending in the application.

Appellants' invention pertains to a method of transferring successive severed blanks into discrete



Appeal No. 1998-1912  
Application No. 08/780,744

appellants and the examiner regarding the merits of these rejections.

*The § 102 Rejection*

Knudsen discloses a method and apparatus for producing foil inserts for sealing the rims of containers such as jars, bottles and tubs. At a first station (see Figures 10 and 11(a)), a set of punches 64 moves horizontally relative to a die plate 54 to simultaneously cut a set of three side-by-side inserts 14 from a sheet S of foil material. The punches 64 with the severed inserts 14 move horizontally to the right (as seen in Figures 11(b) to 11(e)) to a station where the set of inserts are transferred into respective lids of a set of three container lids C carried side-by-side within pockets 32 of a holder 24 of an indexable table 22. During transfer of the inserts to the lids, tabs 16 initially situated in the plane of the inserts are folded over 180° (see Figures 1 and 11(a) to 11(e)) to a position where they lie next to the main bodies of respective lids. This is accomplished primarily by folding arms 156 and cooperating elements 176, the movements of which can be discerned upon inspection of Figures 11(a) to 11(f). Upon transfer of the inserts to the lids C, punches 64 return

Appeal No. 1998-1912  
Application No. 08/780,744

to their initial positions, the table 22 indexes another set of container lids into position, and the process is repeated.

With regard to the standing 35 U.S.C. § 102(b) rejection of claim 1, the examiner considers that Knudsen's inserts 14, pockets 32, and table 22 having holders 24 meet, respectively, the blanks, discrete receptacles, and conveyor limitations of claim 1, and that Knudsen's table indexing step (column 4, lines 7-15), insert punching step, and insert transferring step meet the advancing, separating and transferring steps of claim 1. In addition, the examiner considers (answer, pages 5-6) that the statement "which are convertible into component parts of packets for smokers' products" found in the preamble of claim 1 is a statement of intended end use of the blanks that does not distinguish over the inserts of Knudsen.

Appellants argue, inter alia, that (1) the preamble recitation noted by the examiner has not been given proper weight, and that when said recitation is given proper weight it serves to distinguish over Knudsen, (2) the foil inserts 14 of Knudsen are not introduced into receptacles of a conveyor as called for in the claims, and (3) Knudsen does not disclose

Appeal No. 1998-1912  
Application No. 08/780,744

separating successive blanks for a body of coherent blanks and transferring said successive blanks into discrete receptacles.

Anticipation is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221, USPQ 385, 388 (Fed. Cir. 1984). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). Nor is it required that the reference teach what the applicant is claiming, but only that the claim on appeal "reads on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

Given these principles, the examiner's determination that the subject matter recited in claim 1 is anticipated by

Appeal No. 1998-1912  
Application No. 08/780,744

Knudsen is well founded, and appellants' position to the contrary is not. Concerning argument (1)<sup>2</sup>, the preamble statement of claim 1 that the blanks "are convertible into component parts for smoker's products" is quite broad, as recognized by the examiner, and does not serve to distinguish over Knudsen when given it proper weight. The preamble statement in question describes a future condition of the blanks which may or may not later happen; however, what may or may not happen is not part of the claimed invention. *In re Venezia*, 530 F.2d 956, 958-59, 189 USPQ 149, 152 (CCPA 1976). Here, claim 1 does not contain any present structural limitation of the blank that is not met by Knudsen. In this regard, the foil inserts of Knudsen reasonably appear to be capable of being "convertible" into a component part of a packet for smokers' products. In any event, since the unillustrated containers (i.e., jars, bottles or tubs) of Knudsen reasonably appear to be capable of use in packaging a

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<sup>2</sup>Appellants' companion argument to the effect that Knudsen is non-analogous art fails at the outset with respect to the standing anticipation rejection because "the question of whether a reference is analogous art is irrelevant to whether that reference anticipates." *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Appeal No. 1998-1912  
Application No. 08/780,744

loose product such as pipe tobacco, Knudsen's foil inserts can properly be considered "component parts" of packets for smokers' products even without "conversion" or modification.

As to argument (2), Knudsen's lids C are held in discrete pockets (receptacles) 32 defined by backing block 30, retaining plate 38, guide bars 34 and pins 36 (column 4, lines 23-45). In the process of being introduced into lids C held in pockets 32, Knudsen's inserts 14 pass through the circular apertures 40 of the retaining plate and are therefore necessarily introduced into the pockets (receptacle) 32 of the table (conveyor) 22. Hence, appellants' argument that Knudsen's foil inserts 14 are not introduced into receptacles of a conveyor is simply wrong.

Concerning argument (3), appellants' claims are drafted in open "comprising" format and therefore do not preclude the presence of elements or steps in addition to those set forth in the claims. Accordingly, the fact that Knudsen simultaneously cuts and transfers three inserts at a time in side-by-side fashion does not mean that Knudsen's method does not include the step of separating successive blanks from a body of coherent blanks and transferring successive separated

Appeal No. 1998-1912  
Application No. 08/780,744

blanks into receptacles. In this regard, a first of Knudsen's inserts of a first set of inserts and a corresponding one of Knudsen's inserts of the next set comprise "successive" inserts within the meaning of the appealed claims.

In light of the foregoing, we will sustain the standing § 102 rejection of claim 1 as being anticipated by Knudsen. We will also sustain the standing § 102 rejection of independent apparatus claim 9 for the reasons set forth *supra*.

The anticipation rejection of dependent claim 4 will be sustained because the table (conveyor) 22 of Knudsen is indexable about a vertical axis (column 4, lines 9-10). The requirement of claim 5 that the blanks are deformed in the course of the transferring step is met by Knudsen's step of deforming tab 16 during the transfer of the blanks (see Figures 11(a) to 11(e)). Likewise, the requirement of claim 12 that the apparatus includes means for deforming during the transfer of the blanks is met by Knudsen's folding arms 156 and cooperating elements 176.

The anticipation rejection of claims 6 and 7 will be sustained because elements 48 and 50 of Knudsen constitute a stationary mouthpiece through which the blanks move during the

Appeal No. 1998-1912  
Application No. 08/780,744

deforming step. Appellants' argument in the reply brief to the effect that elements 48, 50 of Knudsen do not function to fold Knudsen's tabs 16 is noted. This argument fails at the outset because claims 6 and 7 do not require that the mouthpiece perform any deforming function.

The anticipation rejection of claim 18 will be sustained because the transfer rod 76 of Knudsen includes vacuum holding means for retaining the inserts during transfer (column 6, lines 7-17).

We reach an opposite conclusion with respect to the anticipation rejection of claims 2, 13, 14, 16, 19 and 20. Claim 2 calls for the stations to be "at different levels" (i.e., at different elevations). Since the locations of Knudsen that correspond to the first and second stations are at the same level (elevation), Knudsen does not meet this claim limitation and the anticipation rejection thereof fails. For similar reasons<sup>3</sup>, the anticipation rejection of claims 16,

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<sup>3</sup>Claim 16 depends from claim 15, which requires that the deforming means is located "at a level above" the second station. Claim 19 sets forth that the transferring means moves between a "lower position" and a "higher position" during transfer operations. Claim 20 sets forth that the second station is disposed "at a level below" the first

Appeal No. 1998-1912  
Application No. 08/780,744

19 and 20 will not be sustained. The anticipation rejection of claim 13 will not be sustained because Knudsen's deforming means 156 and 176 would not be considered by the artisan to comprise a "mouthpiece," especially when that term is read in light of appellants' disclosure. Similarly, the anticipation rejection of claim 14 will not be sustained because Knudsen's deforming means 156 and 176 are not stationary.

*The § 103 Rejection*

A threshold issue in this appeal with respect to the standing § 103 rejection is appellants' implicit argument that Knudsen is non-analogous art. In an obviousness determination under 35 U.S.C. § 103, art which is non-analogous is too remote to be treated as prior art. *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). There are two criteria for determining whether art is analogous: (1) whether the art is from the field of the inventor's endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether

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station. Thus, each of claims 16, 19 and 20, in effect, requires that the first and second stations are at different levels or elevations.

Appeal No. 1998-1912  
Application No. 08/780,744

the reference is reasonably pertinent to the particular problem with which the inventor is involved. *Id.*

We are informed in the paragraph spanning pages 2 and 3 of appellants' specification that a particular problem of prior art devices for severing and manipulating blanks that can be used to form parts of cigarette packages is that the blanks must be advanced along a complex path on their way into the receptacle of a turntable, and that this increases the likelihood of misalignment, undesirable deformation of the blank, etc. Appellants' solution to this problem is to transfer the blanks along a substantially straight path (specification, page 6, lines 9-15). In that an objective of Knudsen is to transfer the severed lids along a substantially straight path as they are severed, manipulated and introduced into lids (see Figures 11(a) to 11(e)), Knudsen is reasonably pertinent to the particular problem addressed by appellants. Thus, Knudsen constitutes analogous art under at least the second criteria of the *Clay* test, and was properly considered by the examiner in evaluating the obviousness of the subject matter on appeal.

Appeal No. 1998-1912  
Application No. 08/780,744

Looking first at claim 3, this claim depends from claim 1 and adds that the path of movement in the transferring step is along a substantially vertical path. The examiner recognizes that the path of movement in the transferring step of Knudsen is along a substantially horizontal path. Nevertheless, the examiner considers that it would have been obvious to one of ordinary skill in the art

to rearrange the orientation of the transfer device [of Knudsen] since [appellants'] specification fails to disclose solving any specific problem by vertically transferring the severed blank and it appears that either orientation works equally well as the other. [Answer, page 5.]

Considering Knudsen, while it is true that the drawing figures thereof illustrate the path of movement of the inserts in the transferring step to be horizontal, Knudsen does not appear at any point to indicate that this orientation is of an particular significance. As to appellants' method and apparatus, we are told at several places in the specification that disposing the first (receptacle) station at a level above the second (severing) station, and providing a path of movement in the transferring step that is substantially vertical is merely a *preferred* way of orienting the apparatus.

Appeal No. 1998-1912  
Application No. 08/780,744

See, for example, page 7, lines 5-8 (emphasis added) ("In accordance with a presently *preferred* embodiment of the improved method, the first station is disposed at a level above the second station, and the path is at least substantially vertical."), and page 8, lines 13-17 (emphasis added) ("The means for transferring can comprise means for pneumatically holding successive blanks during transfer along the aforementioned path, *preferably* along a vertically upwardly extending path (i.e., the second station is *preferably* located at a level below the first station)."). Thus, based on the record before us, the claimed vertical path of movement during the transferring step does not solve any particular problem as compared to, for example, a horizontal path of movement during the transferring step.

Based on these facts, we consider that the orientation of appellants' apparatus is merely a matter of convenience based on considerations such as the available space in the assembly line and/or the orientation of existing upstream and downstream machinery with which the apparatus is to interface. Accordingly, we conclude, as did the examiner, that the

Appeal No. 1998-1912  
Application No. 08/780,744

claimed vertical path of movement of blanks in the transferring step would have been an obvious matter of engineering choice to one of ordinary skill in the art, such that the subject matter of claim 3 as a whole would have been obvious in view of Knudsen. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975) (where use of particular connection in lieu of those used in the reference solves no stated problem, particular connection held to be obvious matter of design choice within the skill in the art); *In re Dailey*, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966) (configuration of claimed disposable plastic nursing container held to be obvious matter of choice absent persuasive evidence that the particular configuration was significant). It follows that we will sustain the standing § 103 rejection of claim 3 as being unpatentable over Knudsen.

Concerning claim 11, orienting Knudsen's device so that the path of movement of the inserts is vertical would result in the cutting edges for severing Knudsen's inserts being substantially horizontal. As to claims 8 and 17, orienting

Appeal No. 1998-1912  
Application No. 08/780,744

Knudsen's device such that the first (receptacle) station is above of the second (severing) station is further considered to be an obvious matter of engineering choice. In the matter of claim 15, when Knudsen's device is oriented so that the path of movement of the inserts is vertical, Knudsen's deforming means 156 and 176 are located above

the second (severing) station for at least a portion of the transfer stroke. In view of the above, we also will sustain the standing rejection of claims 8, 11, 15 and 17 as being unpatentable over Knudsen.

Claim 10 requires that the conveyor is indexable about a substantially vertical axis and that the path of movement of the blanks during the transfer step is substantially vertical. Claims 21 and 22 contain similar limitations. Thus, these claims in effect require that the path of movement of the blanks during the transfer step is substantially parallel to the indexing axis of the conveyor. In contrast, the path of movement of Knudsen's inserts is substantially perpendicular to the indexing axis of table 22. Accordingly, even if Knudsen's device were to be oriented such that the path of

Appeal No. 1998-1912  
Application No. 08/780,744

movement of the inserts during transfer is vertical, the subject matter of claims 10, 21 and 22 would not result. Further, it would require a major reconstruction of Knudsen's device to attain the claimed relationship. For these reasons, the § 103 rejection of claims 10, 21 and 22 as being unpatentable over Knudsen will not be sustained.

*New Ground of Rejection*

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 16, 19 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Knudsen. For the reasons discussed *supra* in our affirmance of the standing § 103 rejection of claims 3, 11, 15 and 17, it would have been obvious to orient the device of Knudsen such that the first (receptacle) station is above the second (severing) station, and with the deforming means located above the second (severing) station for at least a portion of the transfer stroke. The result would be an apparatus that corresponds to the subject matter of claims 16,

Appeal No. 1998-1912  
Application No. 08/780,744

19 and 20 in all respects. Specifically, the pneumatic holding means of claim 16 is met by transfer rod 76 of Knudsen which has vacuum holding means for retaining the inserts during transfer (column 6, lines 7-17); the recessed surface and retractable suction head of claim 19 is met by Knudsen's suction head 74 retractable into recess 134 in punch 64; and the indexable turntable having an annulus of pockets is met by Knudsen's table 22 having indexable holders 24 arrayed about the periphery thereof.

*Summary*

The § 102 rejection of claims 1, 2, 4-7, 9, 12-14, 16 and 18-20 based on Knudsen is affirmed with respect to claims 1, 4-7, 9, 12 and 18, but is reversed with respect to claims 2, 13, 14, 16, 19 and 20.

The § 103 rejection of claims 3, 8, 10, 11, 15, 17, 21 and 22 based on Knudsen is affirmed with respect to claims 3, 8, 11, 15 and 17, but is reversed with respect to claims 10, 21 and 22.

Appeal No. 1998-1912  
Application No. 08/780,744

Pursuant to our authority under 37 CFR § 1.196(b), a new rejection of claims 16, 19 and 20 has been entered.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, 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. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR

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

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants,

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 (37 CFR § 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

Appeal No. 1998-1912  
Application No. 08/780,744

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. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

Appeal No. 1998-1912  
Application No. 08/780,744

§ 1.136(a).

*AFFIRMED-IN-PART; 37 CFR § 1.196(b)*

HARRISON E. MCCANDLISH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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Appeal No. 1998-1912  
Application No. 08/780,744

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Appeal No. 1998-1912  
Application No. 08/780,744

APJ STAAB

APJ GONZALES

APJ MCCANDLISH

DECISION: AFFIRMED IN PART/37 CFR § 1.196 (b)  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s):  
Prepared: June 5, 2001

Draft                  Final

3 MEM. CONF.    Y                  N

OB/HD                  GAU

PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT