Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOSEPH J. HARDING
and RICHARD O. RATZEL

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Appeal No. 1999-2095
Application 08/475,624

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HEARD: April 19, 2000

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Before CALVERT, Administrative Patent Judge, MCCANDLISH, Senior Administrative Patent Judge and PATE, Administrative Patent Judge.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 7 through 18 and 25 through 29. The only other claims still pending in the application have been withdrawn from consideration as being directed to a non-elected invention.

Appellants' invention relates to a method of making cushioning products which are used in shipping containers to protect shipped articles. According to claim 7, the only independent claim on appeal, the method comprises the steps of using a cushioning conversion machine to convert a sheet-like stock material into the cushioning products, monitoring the operational status of the machine, generating signals in accordance with the operational status, storing the generated signals and retrieving the stored signals for diagnostic purposes.

A copy of the appealed claims, except for claim 18, is appended to appellants' brief. A copy of claim 18 is found in the examiner's answer.

The following reference is relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Tieden et al. (Tieden)	4,017,831	Apr. 12, 1977

The examiner additionally relies on the admitted prior art (hereinafter APA) described on pages 1-6 of appellants' specification.

Appealed claims 7 through 18 and 25 through 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over the APA in view of Tieden. The examiner concludes in substance that the teachings of Tieden would have made it obvious to store the signals generated by the programmed controller described on page 5 of appellants' specification and to later retrieve the stored signals for the reasons discussed on pages 7, 8 and 10 of the answer. Reference is made to the examiner's answer for further details of the rejection.

With regard to the APA, appellants concede that the prior art controllers monitor the operational status of the conversion machines for various events, including jamming of the machine (see page 15 of the main brief). Appellants nevertheless maintain that the prior art monitoring step is not performed for the purpose of storing the generated signals. Appellants thus argue that the APA lacks a teaching

of the steps of storing the generated signals and, consequently, retrieving the stored signals.

With regard to the Tieden patent, appellants' main argument is that this reference "does not show or suggest the use of any diagnostic system (which stores information for later retrieval) in a cushioning conversion machine" (main brief, page 15).

We have carefully considered appellants' arguments supporting patentability of claims 7 through 11 and 25 through 29 over the combined teachings of the APA and Tieden. However, we are not persuaded that the rejection of these claims is improper.

Although Tieden's illustrated embodiment relates to so-called numerically controlled machines (see, for example, column 1, lines 6-11), appellants do not expressly contend that this reference constitutes non-analogous art. In any case, appellants' invention and Tieden's invention relate to the same basic problem. In appellants' case, the problem

arises from the failure of the APA to store information pertaining to certain events such as jams in the machine. Thus, absent an oral or written report by the operator of the machine, that information is not available to service personnel in a subsequent service session as discussed on page 15 of the main brief. The Tieden patent likewise is concerned with the lack of a system for recording or otherwise storing information pertaining to the operation of a machine such that absent a written or oral communication by the operator of the machine, the information is not available to service personnel in a subsequent service session. See, for example, column 1, lines 20-30 and lines 55-57 of the Tieden specification. Thus, the Tieden reference is reasonably pertinent to the particular problem with which appellants were involved, to satisfy the second part of the test for analogous art in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

Appealed claim 7 is not limited to any particular operational status of the conversion machine. Thus, the monitoring step recited in this claim is broad enough to cover

the on-off status of the machine (i.e., whether the machine is turned on or off). The on-off status is understood to be implicitly monitored by the controllers of the APA. In any case, appellants concede on page 15 of the main brief and then again on page 3 of the reply brief that "when a prior art cushioning conversion machine determined that a cutting jam was occurring, this information was used to alert the operator and/or de-energize the cutting motor." Thus, with particular regard to
dependent claims 9 through 11, the APA is conceded to monitor jams, which are understood to amount to a relatively common operational error.

Based on the foregoing analysis, the APA lacks an express disclosure of the storage and retrieval steps recited in claim 7. Tieden, however, teaches the art to provide an operator module 37 for transmitting signals pertaining to the operational status of an operator-attended machine to a computer 45 (also described as a CPU in column 6, line 45 and elsewhere) at a remote control room. The transmitted signals may include a variety of conditions (see column 3, lines 52-

54, and column 4, lines 21-32), including the signals indicating whether the machine is in an operating or non-operating condition (see column 4, line 24) or is simply deactivated (see column 3, line 54). The computer interrogates and thus monitors the transmitted signals (see column 4, lines 13-16 and also column 2, lines 6-8, which expressly refers to monitoring control systems). The computer includes a storage system (see column 4, line 30) for storing the transmitted signals so that they may be retrieved "to produce reports and/or store report information" (column 4, lines 30-31). The signal information may also be stored in a buffer (which is a

signal storage device) for displaying signal information as described in column 9, lines 35-44. The storage system may even be equipped with a punch tape (see column 4, line 30) which stores signals and a tape reader (column 9, line 26) which functions to retrieve the stored signal information. The signal information may also be transmitted to a maintenance room for use by service personnel (see column 8, lines 28-32).

Based on the forgoing analysis of Tieden, this reference teaches a system in which signals pertaining to the operational status of a machine are generated and are transmitted to a signal-monitoring computer for storage and subsequent retrieval to avoid need for the operator to make oral or written reports (see column 1, lines 53-57) in order to preserve information useful for operating and servicing the machine. Appellants even concede that Tieden teaches "certain different ways of improving a diagnostic system, . . ." (main brief, page 15). That teaching coupled with the other teachings discussed supra would have been ample motivation for one of ordinary skill in the art to equip the conversion machine of the APA with a system corresponding to Tieden's improved diagnostic system.

Needless to say, a prima facie case of obviousness does not require Tieden to suggest such an improved diagnostic system expressly for a cushioning conversion machine as appellants seem to argue on page 15 of the main brief. Instead, to warrant a conclusion of obviousness, it is sufficient, as in the case at bar, that the combined teachings

of the applied references would have suggested the subject matter of claims 7 through 11 and 25 through 29 to one of ordinary skill in the art under the test set forth in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). With particular regard to claims 9 through 11, one of ordinary skill in the art would have appreciated the desirability of storing signals pertaining to jams because jams are recognized in the APA to be relatively common to require the machine to be monitored for jams. In this regard, skill in the art is presumed, not the converse. In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

For the foregoing reasons, we will sustain the § 103 rejection of claims 7 through 11 and 25 through 29, it being noted that dependent claims 25 through 29 have not been argued separately of claim 7. See In re Nielson, 816 F.2d 1567, 1572, 2

USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Burckel, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

However, we will not sustain the § 103 rejection of claims 12 through 18. The examiner has made no showing of an objective teaching in the prior art or knowledge in the prior art that would have led the skilled artisan to store signals pertaining to the number of cuts (claim 12) and other features defined in claims 13 through 18. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The examiner's decision rejecting the appealed claims is affirmed with respect to claims 7 through 11 and 25 through 29, but is reversed with respect to claims 12 through 18.

AFFIRMED-IN-PART

IAN A. CALVERT Administrative Patent Judge	)
	) BOARD OF PATENT
	) APPEALS AND
HARRISON E. MCCANDLISH Senior Administrative Patent Judge	) INTERFERENCES
WILLIAM F. PATE, III Administrative Patent Judge	)

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