

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

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRENT E. GOODWIN, THOMAS P. KELLER and MARK W. MOORE

Appeal No. 1999-2147
Application No. 08/881,935

HEARD: November 15, 2000

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 16, 18 and 19.¹ Claim 15, the only other claim pending in this application, has been objected to as depending from a non-allowed claim.

We REVERSE and enter a new rejection pursuant to 37 CFR

¹ Claim 1 was amended subsequent to the final rejection.

§ 1.196(b).

BACKGROUND

The appellants' invention relates to the art of printing and applying labels (specification, p. 1). A substantially correct copy of the claims under appeal is set forth in the appendix to the appellants' brief.²

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

Hamisch, Jr. 1986 (Hamisch)	4,624,733	Nov. 25,
Sato et al. 1989 (Sato)	4,820,064	Apr. 11,
Weaver et al. (Weaver)	Des. 308,865	June 26, 1990
Christopher et al. 1993 (Christopher)	5,227,617	July 13,
Matsushita et al. 1995 (Matsushita)	5,401,352	Mar. 28, (filed May 25, 1993)

² Minor errors in claims 1 and 16 are set forth on page 3 of the Examiner's Answer.

An additional reference of record relied on by this panel
of the Board is:³

Shepard et al.
21, 1992
(Shepard)

5,107,100

Apr.

³ This reference was cited by the appellants in Paper No. 2 and a copy is of record in the application file.

Claims 16, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Christopher in view of Sato, Matsushita, and Weaver.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Christopher in view of Matsushita, Weaver, Sato and Hamish.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed February 22, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed December 21, 1998) for the appellants' arguments thereagainst.

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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 16, 18 and 19 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, 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). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require "a keyboard disposed at a rear portion of the housing." In addition, claims 1 and 16 recite that the scanner is mounted to a housing section which is movable between open and closed positions. However, these limitations are not suggested by the applied prior art. While Weaver does teach an electronic bar code reader having a keyboard disposed at a rear portion of its housing, it is our opinion that Weaver would not have suggested modifying Christopher's hand-held label applicator to include a keyboard disposed at a rear portion of its housing. Additionally, while Matsushita does teach a label printer having a pivoted cover, it is our opinion that Matsushita would not have suggested modifying Christopher's hand-held label applicator to include a scanner mounted on the pivotable cover. In short, we see no suggestion or motivation in the applied prior art to make the selections made by the appellants and thus arrive at the presently claimed subject matter. It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive

supporting the combination. In our view, the only suggestion for modifying Christopher in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1, 16, 18 and 19.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellants' claims 18 and 19:

Claims 18 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Shepard in view of Sato and Christopher.

Shepard discloses a scanning head 10 including a keyboard 38 and a display 40 respectively mounted at rear and front

regions of the head. The outgoing laser beam of a scanner and/or the returning portion of the reflected light pass through a window 60 positioned between the keyboard and the display and travels unobstructedly exteriorly of and past the front region of the scanning head over the display. A printer 100 is mounted in the scanning head. The printer includes a thermal printhead 102 operative for thermally imprinting graphical markings on a journaled roll 104 of paper labels, each printed label being torn off the roll by being urged against tear-off edge 106 at the front of the scanning head. The label preferably has a pressure-adhesive backing so that it can be applied directly on the product, either as an original label or adjacent to, or preferably as an overlay to, an existing label on the product.

Shepard teaches (column 4, lines 9-35) that his invention proposes mounting the keyboard at a rear region of the head, and mounting the display at a front region of the head with a window provided on an intermediate region of the housing between the keyboard and the display. The placement of the keyboard behind the window insures that no fingers or hands of

the operator blocks or interferes with the scanner operation (i.e., reading of symbols). To enhance visibility of and access to the keyboard, Shepard teaches that the keyboard is mounted on an inclined upper wall that rises in elevation in a direction from the rear towards the front region of the scanning head.

Sato discloses an electronic hand labeler. As shown in Figure 1, the electronic hand labeler includes a printer-labeler unit 1 that is suited for single-hand operation; a separate, self-contained, control unit 100 which is connected by a cable 2 to printer-labeler unit 1; and a pen scanner 4 which is connected to control unit 1 by cable 5. Control unit 100 includes keyboard 103, display 104, batteries 105, and a holder 7 for holding pen scanner 4.

As shown in Figure 3A of Sato, the printer-labeler unit 1 includes a label web holder 13 for holding a continuous roll 95 of thermal-labels; a thermal print head 36; a platen roller 51; bending pin 54; a traction roller 71; and label applicator

91. Sato teaches (column 4, lines 3-14) that information is imprinted on thermal labels 96 as platen roller 51 both moves and presses the labels against thermal print head 36. At the tip of the platen roller 51, backing sheet 97 bends sharply around bending pin 54 to cause thermal labels 96 to peel off backing sheet 97. The mechanical interconnection of motor M to platen roller 51 and traction roller 71 is illustrated in Figure 5. Thus, rotation of motor M is transmitted to platen roller 51 through rotation of motor gear wheel 42 whose rotation is in turn communicated via intermediate gear wheels 43 and 44 which mesh with a gear wheel 45 with which platen roller 51 is coaxially mounted. Traction roller 71 is also rotated by motor M because the motor is coupled thereto via belt 47 which is mounted on pulleys 46a and 46b . The belt 47 rotates gear wheel 48 which in turn rotates traction roller gear wheel 49 of traction roller 71. Sato teaches (column 4, line 67, to column 5, line 5) that

[i]t is desired that traction roller 71 be driven at a higher speed than platen roller 51. This is needed in order to apply extra traction to backing sheet 97 downstream of platen roller 51. Stated differently, the section of the backing sheet 97 between platen roller 51

and traction roller 71 must be taut to reliably separate labels 96 from backing sheet 97.

Christopher discloses a hand-held labeler 10 with an integrally formed optical scanner 12. A keyboard 14 is provided to initiate various operations of the labeler 10, such as selective data retrieval wherein information identifying the coded records stored in the labeler's memory is depicted on a display 16. When the display 16 is displaying information identifying a particular coded record to be printed, the user initiates the printing and label applying operation of the labeler 10 by actuating a trigger switch 18. As shown in Figure 2, the labeler 10 includes a frame or housing 22 and a label supply roll R is mounted on the housing 22, the roll R being shielded from ambient conditions, such as dust, by a cover 24. The roll R is comprised of a composite label web C shown by both a solid line representing a full roll R and phantom lines representing a nearly depleted roll. The composite web C includes a carrier web W having a coating of release material

such as silicone wherein the labels, such as a label L, are releasably secured to the carrier web W by a pressure sensitive adhesive.

Christopher teaches (column 4, lines 30-59) that in response to actuation of the trigger switch 18, an electric motor 28 rotates a driving roll 30 coupled thereto wherein the driving roll 30 cooperates with an idler roll 32 to advance the composite web C past a print head 34. The print head 34 prints information on the leading label L as it passes thereby. More particularly, as the composite web C is paid out from the roll R, the web C passes between a pair of guides only one 36 of which is shown. Rollers 38 guide the composite web C around a curve where the composite web C passes between the printhead 34 and a cooperating platen 40. A delaminator 42 includes a peel roller positioned closely adjacent to the line of pressure contact between the printhead 34 and the platen 40. The carrier web W passes about a portion of the delaminator 42 to effect delamination of the leading label L. The leading label L is then passed into

label applying relationship with respect to an applicator roll 44 so that the leading label L may be applied to an article. From the delaminator 42, the carrier web W again passes into contact with the platen 40 from which it is guided by a roll 46 to the driving roll 30 and the idler roll 32, the web W passing there between. The web W then moves past an optical sensor 26 and is pushed along guides 48 and 50 to an exit opening 52 in the housing 22.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Shepard and claims 18 and 19, it is our opinion that the following limitations are not taught by Shepard: (1) a label roll composed of a composite label web having a series of labels releasably adhered to a carrier web, (2) a driven platen roll cooperable with the print head,

(3) a delaminator for delaminating printed labels from the carrier web, (4) an applicator for applying delaminated labels, (5) a feed roller driven at a peripheral speed slightly greater than the peripheral speed of the platen roll for advancing the carrier web, the carrier web being movable along a path for the label roll to between the print head and platen roll, about the delaminator and to the feed roller, and (6) gearing driven by an electric motor for driving the platen roll and the feed roller.

With regard to these differences, it is our conclusion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Shepard's portable scanner to (1) accommodate a label roll composed of a composite label web having a series of labels releasably adhered to a carrier web as suggested and taught by Sato's labeler and Christopher's applicator in view of the applied prior art establishing that the two different types of label rolls are well-known alternatives, and (2) drive the traction roller at a higher speed than the platen roller as suggested and taught by Sato to reliably separate the labels

from the backing sheet as taught by Sato. Thus, in view of the teachings of Sato and Christopher, it would have been obvious to have modified Shepard to include (1) a label roll composed of a composite label web having a series of labels releasably adhered to a carrier web, (2) a driven platen roll cooperable with the print head, (3) a delaminator for delaminating printed labels from the carrier web, (4) an applicator for applying delaminated labels, (5) a feed roller driven at a peripheral speed slightly greater than the peripheral speed of the platen roll for advancing the carrier web, the carrier web being movable along a path for the label roll to between the print head and platen roll, about the delaminator and to the feed roller, and (6) gearing driven by an electric motor for driving the platen roll and the feed roller.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 16, 18 and 19 under 35 U.S.C. § 103 is reversed and a new rejection of claims 18 and 19 under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 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)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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JOSEPH J. GRASS
MONARCH MARKING SYSTEMS INC
PO BOX 608
DAYTON, OH 45401

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