The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. SIMMONS, Jr. and RICHARD O. RATZEL

Appeal No. 2001-0553
Application 09/218,910

ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 30, which are all of the claims pending in this application.

As noted on page 1 of the specification, appellants'

invention relates to a cushioning conversion system and method for converting sheet stock material into a low density cushioning dunnage product and, more particularly, to an improvement in the mechanisms for feeding the sheet stock material into the system for conversion into the dunnage product. The improvement includes a stock roll cart (14) for supporting a supply roll of sheet stock material and a dancer roller assembly carried on the stock cart for helping to maintain a greater uniformity of tension on the sheet material being fed through the conversion assemblies. A first embodiment of appellants' stock cart is seen in Figure 3 of the application drawings, wherein the dancer roller (82) rides up and down in guideways (86) as tension on the stock sheet material increases or decreases, respectively, during unwinding of the sheet material from the stock roll (74). A second embodiment of the stock cart is seen in Figure 6, wherein the dancer roller (102) is supported on pivotally mounted swing arms (104). Independent claims 1 and 15 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix A of appellants' brief.

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

Block	3,971,695	Jul. 27, 1976
Stanford	4,040,043	Aug. 2, 1977
Armington	4,650,456	Mar. 17, 1987

Claims 1 through 24, 25 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Armington in view of Stanford.

Claims 26 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Armington in view of Stanford as applied above, and further in view of Block.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the Office action mailed December 27, 1999 (Paper No. 5), the final rejection (Paper

No. 7) and the examiner's answer (Paper No. 10, mailed October 18, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 9, filed September 22, 2000) and reply brief (Paper No. 11, filed December 27, 2000) for the arguments thereagainst.[1]

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a

[1] The Manual of Patent Examining Procedure (MPEP) § 1208 (page 1200-17) states that examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. In this case, the examiner has not followed the sage advice and guidance provided by the MPEP. The examiner's answer refers us to Paper No. 7 (the final rejection), however, Paper No. 7 itself refers back to "paragraph 4 of the last office action." In the future, to avoid any confusion, the examiner should adhere to the precepts set forth in the MPEP.

consequence of our review, we have made the determination that the examiner's above-noted rejections will not be sustained. Our reasons follow.

After having reviewed the applied prior art references to Armington and Stanford, we are of the opinion that there is no teaching, suggestion or incentive in such references, or otherwise specified by the examiner, which would have led one of ordinary skill in the art at the time of appellants' invention to modify the stock roll cart of Armington in the manner urged by the examiner. The examiner's assertions (answer, page 4) that a

dancer roller is "notoriously well known in the art to measure the tension of a feeding web" and that a dancer roller is "inherently going to be providing substantial uniform constant tension as the dancing roller adjusts to accommodate different tensions," may generally be true, but do not provide any reason, suggestion or motivation for attempting a modification of the stock roll cart in Armington based on the entirely

different film sensing, feeding and braking apparatus of the wrapping machine in Stanford.

Like appellants, we consider that the modification of Armington's stock roll cart urged by the examiner is merely a hindsight reconstruction based on the impermissible use of appellants' own disclosure and teachings as a blueprint for piecing together the relied upon prior art. In that regard, we are in general agreement with appellants' arguments as presented in their brief (pages 16-20) and reply brief. Thus, we will not sustain the examiner's rejection of claims 1 through 24, 25 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Armington in view of Stanford.

We have also reviewed the patent to Block applied by the examiner along with Armington and Stanford against claims 26 through 29 on appeal, but find nothing therein that provides for the deficiencies we have found in the examiner's attempted

combination of Armington and Stanford. Thus, the examiner's rejection of claims 26 through 29 will also not be sustained.

In accordance with the foregoing, the decision of the examiner rejecting claims 1 through 30 of the present application under 35 U.S.C. § 103(a) is reversed.

We additionally find it necessary to REMAND this application to the examiner for a decision on the record as to whether or not a rejection of one or more of the claims on appeal in this case would be appropriate based on Armington (4,650,456) in view of the Ratzel patent (5,713,825) cited by the examiner in the Office action mailed December 27, 1999 (Paper No. 5), but not previously applied. More particularly, the examiner should determine if it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide the supply roll cart of Armington with a dancer (damper) roller assembly like that seen at (70, 71) of Ratzel to help in maintaining a greater uniformity of tension on the sheet material being fed from the cart, or

alternatively whether it would have been obvious to replace the stock supply assembly (32) of Ratzel with a separate mobile cart following the teachings of Armington, while providing for use of a dancer roller assembly like that of Ratzel on the cart so as to gain the advantages of such an assembly as set forth in column 5, line 61 through column 6, line 10 of Ratzel.

REVERSED AND REMANDED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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