

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HENRY T. MASTALSKI

Appeal No. 2001-1213
Application No. 09/209,854

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, 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 to 7 and 9, which are all of the claims pending in this application.¹

BACKGROUND

The appellant's invention relates generally to a belt steering system and more particularly concerns a device to steer a belt to maintain proper belt tracking characteristics while at the same time eliminating or minimizing edge stress induced on the belt which causes belt failure (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Wafler	5,580,044	Dec. 3, 1996
Tawara	JP 9-12173 ²	Jan. 14, 1997
Hiroaki ³	JP 9-297469 ⁴	Nov. 18, 1997

Claims 1, 3, 4, 6, 7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tawara in view of Hiroaki.

Claims 2, 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tawara in view of Hiroaki and Wafler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed October 2, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, mailed July, 28, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant 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 to 7 and 9 under 35 U.S.C. § 103. Our reasoning for this determination

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).

Claims 1 to 6

We will not sustain the rejection of claims 1 to 6 under 35 U.S.C. § 103.

Independent claims 1 and 4 read as follows:

1. An apparatus for controlling and driving a web moving along a predetermined path, comprising:
a plurality of rolls for supporting and driving said web, including a web steering roll for supporting the web, each of said plurality of rolls being adapted for driven rotational movement about a first axis and said web steering roll being adapted for driven rotational movement about a first axis and tilting movement about a second axis transverse to the first axis, each of said plurality of rolls comprising a cylindrical member supported for rotational movement about its longitudinal axis wherein each end of said cylindrical member comprises a

4. An electrophotographic printing machine of a type having an endless photoreceptor belt supported by a plurality of rolls and arranged to move in a predetermined path through a plurality of processing stations disposed therealong, including:

a plurality of rolls for supporting and driving said belt, including a belt steering roll for supporting the belt, each of said plurality of rolls being adapted for driven rotational movement about a first axis and said belt steering roll being adapted for driven rotational movement about a first axis and tilting movement about a second axis transverse to the first axis, each of said plurality of rolls comprising a cylindrical member supported for rotational movement about its longitudinal axis wherein each end of said cylindrical member comprises a relieved portion to provide a nonsharp contact point with the belt;

means for sensing movement of the belt in a direction substantially normal to the predetermined path and generating a signal indicative thereof; and

means, responsive to the signal generated by said sensing and generating means, for tilting said steering roll about the second axis, to return the belt to the predetermined path.

In the rejection of independent claims 1 and 4 under 35 U.S.C. § 103 as being unpatentable over Tawara in view of Hiroaki the examiner (1) set forth the pertinent teachings of each reference (answer, pp. 3-5); (2) correctly ascertained (answer, p. 4) that "Tawara does not teach that said plurality of rolls, each comprised of a cylindrical member is relieved at each end to provide a nonsharp contact point with the web or photoreceptor belt;" and (3) determined (answer, p. 5) that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the

In our view, the above-noted modification of Tawara based on the teachings of Hiroaki does not arrive at the claimed subject matter for the reasons set forth by the appellant on page 6 of the brief. In short, while the teachings of Hiroaki would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have provided roll 11 of Tawara with relieved ends, the teachings of Hiroaki would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have provided a plurality of Tawara's rolls with relieved ends. In that regard, absent the use of impressible hindsight⁵, there is no suggestion, teaching or motivation in the applied prior art (Tawara, Hiroaki and Wafler) to have provided roll 12 of Tawara (or for that matter roll 13 or 14 of Tawara) with relieved ends.

For the reasons set forth above, the decision of the examiner to reject independent claims 1 and 4, and claims 2, 3, 5 and 6 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claims 7 and 9

We will not sustain the rejection of claims 7 and 9 under 35 U.S.C. § 103.

Claim 7 reads as follows:

A roll for supporting a web in a drive system wherein a web is moved along a predetermined path comprising:

a support member;

a cylindrical member to contact and support the web, coupled to said support member for rotational movement about its longitudinal axis, wherein said cylindrical member comprises a relieved portion at each end to reduce the diameter thereof, said cylindrical member further comprising a compliant fill material added to the relieved portion to provide a substantially constant diameter along the length of said cylindrical member and reduce tension at a point of contact of the support member and the edge of the web.

In the rejection of independent claim 7 under 35 U.S.C. § 103 the examiner combined Tawara and Hiroaki as in the rejection of independent claims 1 and 4 and further (1) set forth the pertinent teachings of Wafler (answer, p. 5); (2) ascertained (answer, p. 5) that the combination of Tawara and Hiroaki "does not teach that a compliant fill material is added to the relieved portion of said cylindrical member which provides support to the web thereby reducing the tension at the point of contact of the support member and the edge of the web;" and (3) determined (answer, pp. 5-6) that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Wafler for a compliant fill material in the relieved

In our view, the above-noted modification of Tawara based on the teachings of Hiroaki and Wafler⁶ does not arrive at the claimed subject matter for the reasons set forth by the appellant on pages 8-9 of the brief. In short, the examiner incorrectly ascertained the differences between claim 7 and the combination of Tawara and Hiroaki. The correct assessment of the differences between claim 7 and the combination of Tawara and Hiroaki is that the combination of Tawara and Hiroaki does not teach that a compliant fill material is added to the relieved portion **to provide a substantially constant diameter along the length of said cylindrical member** and reduce tension at a point of contact of the support member and the edge of the web. While the teachings of Wafler may have made it obvious at the time the invention was made to a person of ordinary skill in the art to have provided roll 11 of Tawara with relieved ends as suggested by Hiroaki and to have further provided roll 11 of Tawara with compliant fill material inside the relieved portions as suggested by Wafler, the applied prior art would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have provided Tawara's roll 11 with relieved ends having a compliant fill material added to the relieved portion **to provide a substantially constant diameter along the length of said cylindrical member**. Instead, it appears

For the reasons set forth above, the decision of the examiner to reject independent claim 7, and claim 9 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7 and 9 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

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