

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CLAUDIO CICCORILLI

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Appeal No. 2001-1275  
Application No. 09/128,120

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ON BRIEF

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Before ABRAMS, STAAB, and McQUADE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a conveyor section for supporting a conveyor belt. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears 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:

Baker	2,815,252	Dec. 3, 1957
Fiedler	3,711,090	Jan. 16, 1973
German Offenlegungsschrift <sup>1</sup>	3518134	Nov. 11, 1986

Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over the German reference in view of Baker or Fiedler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 12) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 11) and Reply Brief (Paper No. 13) for the appellant's arguments thereagainst.

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<sup>1</sup>Our understanding of this reference was obtained from a PTO translation, a copy of which is enclosed.

### 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. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to the problem of reducing the friction between a conveyor belt guide surface and the surface of the conveyor belt that is in contact therewith. In the disclosure of the invention, the problem is solved by interposing a layer of material having a low friction surface between the belt guide and the belt, examples being an anti-friction tape or a coating. As manifested in independent claim 1, the invention comprises a layer having at least one adhesive side provided between a conveyor belt and a conveyor belt guide, and wherein a coefficient of friction between one of the conveyor belt and the conveyor belt guide and the other side of the layer is lower than a coefficient of friction between the conveyor belt and the conveyor belt guide.

Although not succinctly stated, it would appear that the examiner's position is that the German reference teaches all of the subject matter recited in claim 1 except for the particular friction-reducing element, but it would have been obvious to replace the friction-reducing element in this reference with the one recited in the claim in view of the teachings of Baker or Fiedler. However, the examiner makes no mention in the statement of the

rejection regarding the matter of where one of ordinary skill in the art would have found suggestion to combine the references in the manner proposed, and this is not supplied by comments elsewhere on the record. If it is the examiner's view that the friction-reducing elements disclosed in each of the three applied references are equivalents and therefore can be used interchangeably, he has not so stated,<sup>2</sup> nor has he provided evidence from which to conclude that one of ordinary skill in the art would have considered this to be the case.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure.

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<sup>2</sup>The examiner has stated on page 4 of the Answer that he considers the friction reducing "approaches" of Baker and Fiedler to be alternatives, but in the statement of the rejection (Paper No. 7, page 2, line 3) has said only that it would have been obvious to "add" these teachings to some unspecified structure, presumably that of the German reference.

See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is our view that the rejection is fatally defective at the outset since the examiner has failed to provide a reason why one of ordinary skill in the art would have been motivated to replace the anti-friction system disclosed in the German reference with that of either Baker or Fiedler.<sup>3</sup> Furthermore, our analysis of the references leads us to conclude that the required suggestion to combine the references in the manner proposed by the examiner is lacking, for the reasons which follow.

The German reference was discussed by the appellant on page 1 of the specification as an example of a system over which he considers his invention to be an improvement. This reference discloses a conveyor belt and a conveyor belt drive coupled to the conveyor belt. It does not, however, disclose a "layer . . . having at least one adhesive side . . . and at least one other side," the latter contacting either the belt or the guide and providing a coefficient of friction less than the coefficient of friction that would be present if the guide directly contacted the belt. In the German reference, at least part of the surface of the guide is provided with "a grid of depressions (honeycomb pattern or waffle-type structure)" (translation, page 6). The German reference can be used in wet or dry

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<sup>3</sup>See Section 706.02(j) of the Manual of Patent Examining Procedure.

environments, and the advantages of the grid construction are explained on page 9 the translation:

As a result of the grids on the sliding surface 32 of the guide profile 20, a suction of the conveyor belt on the guide profile 20 during wet operation is prevented, and the liquid between the parts is laterally discharged. In the case of a dry operation, the friction between the conveyor belt and guide profile 20 is reduced as a result of the air cushion, which is formed in the depressions of the grid.

Thus, the system disclosed by the German reference solves two problems. The first is the same as that solved by the appellant's invention, and the second is peculiar to wet operation, which apparently is not a concern of the appellant.

Baker is directed to an anti-friction bearing device comprising a tape having a pressure-sensitive adhesive on one side and an anti-friction coating on the other side. The reference teaches that it may be used "wherever desired to provide an anti-friction runner or bearing or the like wherever the same may be needed, for instance for sticking drawers, slides, doors or the like" (column 1, lines 35-38). Fiedler discloses a means for reducing the friction between the lower surface of a continuous treadmill belt and the upper surface of the base that supports it, comprising a sheet of friction-reducing material such as TEFLON placed on the opposed surfaces of the belt and the base. Fiedler explains that coefficients of friction can be achieved which are 0.04 or less (column 3, lines 7-18).

The German reference recognizes the problem to which the appellant has directed his inventive efforts, and solves it by placing a grid of depressions directly upon the surface

of the conveyor guide. According to the reference, this establishes an air cushion that reduces the friction between the belt and the guide during dry operations. However, the German reference also recognizes an additional problem, that of the development of suction between the belt and the support during wet operations. This second problem likewise is solved by the grid of depressions, which allows the liquid to drain from between the belt and the support.

There is no evidence to support a conclusion that the anti-friction elements disclosed by the appellant, by Baker and by Fiedler are considered by those of ordinary skill in the art to be equivalents, as appears to be the position taken by the examiner. We therefore cannot agree with the examiner that it would have been obvious to substitute one for the other. Nor is there evidence that the anti-friction elements disclosed by Baker and Fiedler are capable of preventing the development of suction between the belt and its support during wet operations, which is one of the functions desired in the German reference. Of course, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so.<sup>4</sup> Thus, to substitute the anti-friction elements of either Baker or Fiedler for the grid surface disclosed in the German reference would at the very least result in the elimination

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<sup>4</sup>In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

of one of the features of the German invention which, in our view, would operate as a disincentive to one of ordinary skill in the art to do so.

For the reasons set forth above, it is our conclusion that the combined teachings of the applied references fail to establish a prima facie case of obviousness with regard to independent claim 1, and the rejection of this claim will not be sustained. It follows that we also will not sustain the like rejection of claims 2-18, which depend from claim 1.

#### SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

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APPLICATION NO. 09/128,120

APJ ABRAMS

APJ McQUADE

APJ STAAB

DECISION: **AFFIRMED**

Prepared By:

**DRAFT TYPED:** 30 Sep 02

**FINAL TYPED:**