

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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE E. ARMINGTON, RICHARD O. RATZEL, MICHAEL J.
LENCOSKI, JAMES A. SIMMONS and DAVID V. MURPHY

Appeal No. 2001-1486
Application No. 09/137,218

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 135, 141-147, 150-153 and 157, all the claims currently pending in the application.

Appellants' invention pertains a stand for supporting a machine that converts sheet-like stock material into a relatively low density cushioning dunnage product. With reference to drawing Figures 27, 43 and 78, the stand (306) is characterized by a pair of spaced apart feet (308) removably attaching to the stand, with the feet having supports (316) for supporting the ends of a holder

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for a roll of stock material (683). A copy of the appealed claims is appended to the main brief.

The references relied upon by the examiner as evidence of obviousness are:

Johnson	3,799,039	Mar. 26, 1974
Reid	3,930,350	Jan. 6, 1976
Armington	4,650,456	Mar. 17, 1987
Reichental et al. (Reichental)	5,203,761	Apr. 20, 1993
Jensen et al. (Jensen)	5,450,710	Sep. 19, 1995

The following rejections under 35 U.S.C. § 103 are before us for review:

(a) claims 135, 143-147 and 150-153, rejected as being unpatentable over Johnson in view of Reid;

(b) claims 141, rejected as being unpatentable over Johnson in view of Reid and further in view of Jensen;

(c) claim 142, rejected as being unpatentable over Johnson in view of Reid, and further in view of Armington; and

(d) claim 157, rejected as being unpatentable over Reichental in view of Reid.

Reference is made to appellants' main and reply briefs (Paper Nos. 22 and 27) and to the Office action dated January 14, 2000 (Paper No. 16), the final rejection (Paper No. 20) and the examiner's answer (Paper No. 23) for the respective positions of

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appellants and the examiner regarding the merits of these rejections.¹

DISCUSSION

Rejection (a)

Independent claim 135 is directed to a conversion machine (300) for converting sheet-like stock material into a relatively low density cushioning dunnage product, a stand (306) supporting the machine, and a pair of laterally spaced apart feet (308) removably attached to the stand and located at a lower end of the stand for holding the machine upright. The feet include laterally spaced apart supports (316) for supporting the ends of a holder for a roll of stock material (683). In addition, the feet extend beyond the vertical footprint of the machine. The arrangement is such that the stand and the machine are readily removable and

¹The statement of the rejection on page 3 of the answer merely states that the rejections on appeal "[are] set forth in prior Office action[s], Paper Nos. 16 and 20." Paper No. 20, the final rejection, in turn states that several of the rejections set forth therein are "as discussed in . . . the last office action [i.e., Paper No. 16]." This practice is improper. The Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., Aug. 2001) expressly provides that incorporation by reference in an examiner's answer may be made only to a *single* other action. In the interest of judicial economy, we shall, in this instance, proceed to decide the appeal on the merits notwithstanding the examiner's failure to follow established office procedure in formulating the answer.

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replaceable relative to the feet without removing the stock holder from the supports. Independent claim 147 contains similar limitations.

Johnson, the examiner's primary reference, pertains to a cushioning dunnage producing mechanism of the type disclosed by appellants. The mechanism is supported in a generally horizontal position by a rectangular frame (22) that includes uprights (22a) at the corners. The uprights at one end of the frame have brackets (24) for removably supporting a roll of stock material (12).

Reid is directed to an assembly (10) for vacuum packaging a product. The assembly comprises a stand (not numbered) for supporting a roll (40) of packaging material, and a vacuumizing and sealing assembly (12) for shaping and sealing the packing material about the product. The vacuumizing and sealing assembly (12) includes a V-shaped portion (16) and a movable portion (24) that cooperate to form a chamber where the packaging material is shaped around the product and vacuum sealed. Figure 1 appears to show the entire assembly (10) mounted to a pair of elongated angles (not numbered).

In rejecting claims 135 and 147, the examiner considers (Paper No. 16) that uprights (22a) of Johnson correspond to the claimed feet, but that these uprights are not shown as being removable

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relative to the machine and as projecting beyond a vertical plane of the machine. The examiner considers, among other things, that Reid discloses a stand for roll (40) that extends outwardly of the roll and wherein "[i]t appears that the stand is attached by some bolt means which are easily removable/adjustable." (Paper No. 16, page 3). Based on these findings, the examiner considers that it would have been obvious to provide the frame (22) of Johnson with removable feet that extend beyond the vertical footprint of the dunnage producing mechanism and thus arrive at the claimed subject matter. For the reasons that follow, we do not agree.

While it may be true that the Johnson *could* be modified as proposed by the examiner, the examiner has supplied no evidence that the prior art suggests the desirability, and thus the obviousness, of such doing so. See *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed Cir. 1990); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). In our view, the only suggestion for modifying Johnson in the manner proposed to meet the limitations of claims 135 and 147 stems from impermissible hindsight knowledge derived

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from the appellants' own disclosure. This constitutes a first reason necessitating reversal.

In addition, we do not agree with the examiner that Reid teaches legs that are readily removable from the stand and machine, as called for in claims 135 and 147. In this regard, the examiner's determination that Reid's legs are readily removable from the remainder of the stand based on what appears to the examiner to be bolts in Reid's drawings is, at best, speculative. For all Reid's drawings show, the legs may just as well be riveted or welded to the stand. This constitutes a second reason necessitating reversal.

Furthermore, claims 135 and 147 call for the readily removable feet to include the supports for supporting the ends of the holder for a roll of stock material, such that the stand is readily removable from the feet without removing the stock roll holder from the supports. Thus, in making Johnson's feet removable from the stand, it would be necessary to locate the joint or connection for the legs above Johnson's brackets (24) in order to satisfy this claim limitation. The examiner has not explained, and it is not apparent to us, where the applied prior art teaches or suggests this particular way of making Johnson's feet removable. This constitutes a third and final reason necessitating reversal.

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In light of the above, the rejection of claims 135 and 147 as being unpatentable over Johnson in view of Reid, as well as claims 143-146 and 150-153 that depend from one or the other of claims 135 and 147 and stand similarly rejected, shall not be sustained.

Rejections (b) and (c)

Claim 141 depends from claim 135 and stands rejected as being unpatentable over Johnson in view of Reid and further in view of Jensen. Claim 142 also depends from claim 135 and stands rejected as being unpatentable over Johnson in view of Reid and further in view of Armington. We have carefully reviewed the Jensen and Armington references additionally relied upon in these rejections but find nothing therein that makes up for the deficiencies of Johnson and Reid discussed above. For this reason, the rejection of claims 141 and 142 also shall not be sustained.

Rejection (d)

Independent claim 157 is directed to the combination of a vertically oriented cushioning conversion machine (300) for converting a sheet stock material into a cushioning product whereby the stock material passes through the machine in an upstream to downstream direction that is substantially vertical, a stand (306) for supporting the machine, and a holder for a roll of stock material (683). The stand includes a frame and a pair of laterally

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spaced apart feet (308) that extend beyond the vertical footprint of the machine. In addition, the feet have supports (316) for supporting the holder. The machine is mounted to the stand such that it can be readily removed from the stand without removing the holder for the roll of stock material.

The examiner has applied Reichental as the primary reference in the rejection of this claim. Reichental discloses a machine (11) for converting sheet stock material into a cushioning product. Reichental's arrangement includes a support (14) for supporting the machine, and a *separate and independent* mobile supply cart (12) for supporting a roll (R) of stock material. As set forth in the abstract, the separate cart (12) and machine (11) may be removably interconnected for lateral alignment.

In rejecting claim 157, the examiner characterizes Reichental's machine as being "vertically oriented" (final rejection, page 2), which we take as meaning that the examiner views Reichental as satisfying the claim requirement that the stock material passes through the machine in an upstream to downstream direction that is substantially vertical. Although this appears to us to be debatable, the point is moot in that appellants have not challenged the examiner's rejection in this regard. The examiner states (final rejection, page 2) that Reichental "shows a stand

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[presumably, cart (12)] that holds stock material with laterally spaced apart feet support means [Reichental's element 70?] . . . [but] does not show the removable means as claimed." The examiner concludes, however, that it would have been obvious "to provide Reichental with feet support means as taught by Reid to provide better adjustability means" (final rejection, page 2). Implicit in the rejection is the examiner's position that the above modification of Reichental would result in the subject matter of claim 157.

The rejection is not well founded for several reasons. First, the examiner has not adequately addressed appellants' argument on page 9 of the main brief to the effect that Reichental does not disclose a single stand that supports both the cushioning conversion machine *and* the holder for the roll of stock material. Second, for the reasons noted above, we do not consider that Reid can be said to teach a stand having removable feet. Third, it is not clear to us where the combined teachings of Reichental and Reid teach a single stand for supporting a cushioning conversion machine wherein the stand includes feet having supports for supporting a holder for a roll of stock material and wherein "the machine [is] mounted to the stand such that the machine readily can be removed

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from the stand without removing the holder" as called for in claim 157.

For these reasons, the rejection of claims 157 as being unpatentable over Reichental in view of Reid shall not be sustained.

CONCLUSION

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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JUDGE STAAB

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DECISION: REVERSED

PREPARED: Sep 26, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK