

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte RICHARD O. RATZEL, ROGER P. M. RINKENS,
MICHAEL J. LENCOSKI and DIRK J. SIEKMANN

Appeal No. 2001-1916
Application No. 09/189,551

ON BRIEF¹

Before McQUADE, 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 to 5, 9 to 14, 41, 42, 47, 48, 59 to 62 and 68. Claims 6 to 8, 15 and 16 have been objected to as depending from a non-allowed claim. Claims 17 to 40, 43 to 46, 49 to 58 and 63 to 67 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. No claim has been canceled.

We REVERSE and REMAND.

¹ On October 18, 2001, the appellants waived the oral hearing (see Paper No. 21) scheduled for November 29, 2001.

BACKGROUND

The appellants' invention relates to a cushioning conversion machine and method in which the cross-sectional geometry of a pad may be selectively varied (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Mugnai	4,671,047	June 9, 1987
Armington et al. (Armington)	5,322,477	June 21, 1994

Claims 1 to 5, 9 to 14, 41, 42, 47, 48, 59 to 62 and 68 stand rejected under 35 U.S.C. § 103 as being unpatentable over Armington in view of Mugnai.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 17, mailed November 17, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 16, filed October 13, 2000) and reply brief (Paper No. 18, filed January 19, 2001) 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 to 5, 9 to 14, 41, 42, 47, 48, 59 to 62 and 68 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).

In the rejection before us in this appeal (answer, pp. 3-4) the examiner determined that it would have been obvious to one having ordinary skill in the art at the

time the invention was made to provide "a device for varying the width and/or cross-sectional geometry of the product by moving rollers disposed on opposite transverse sides of the product equal distances on the Armington et al. apparatus, as taught by Mugnai, in order to allow rapid adjustability of the width of the product."

The appellants argue throughout the briefs that there is no motivation in the applied prior art to combine the teachings of Armington and Mugnai as set forth above by the examiner. We agree.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. 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. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would

have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In our view, there is no teaching in the applied prior art of the desirability of allowing rapid adjustability of the width of the dunnage produced by the cushioning conversion machine of Armington. Without such a teaching, there would be no motivation, absent impermissible hindsight, for a person of ordinary skill in the art at the time the invention was made to have provided the cushioning conversion machine of Armington with either (1) a device which controls the width of the strip and which is adjustable to change the width of the strip as recited in claim 1; (2) a device for selectively varying the cross-sectional geometry of a cushioning pad produced by the machine as recited in claim 59; (3) a device which guides a stock material as it travels between a forming assembly and a feed assembly, the device selectively varying the cross-sectional geometry of a strip of cushioning produced by the machine as recited in claim 68; or (4) a device which controls the width of the strip and which is adjustable to

change the width of the strip, which device is adjusted to control the width of the strip as recited in claim 41.

For the reasons set forth above, the decision of the examiner to reject claims 1, 41, 59 and 68, and claims 2 to 5, 9 to 14, 42, 47, 48 and 60 to 62 dependent thereon, under 35 U.S.C. § 103 is reversed.

REMAND

We remand the application to the examiner for the following actions:

- (1) determine if the clause "a device which controls the width of the strip and which is adjustable to change the width of the strip" as recited in claims 1 and 41 does or does not invoke the sixth paragraph of 35 U.S.C. § 112;
- (2) determine if the clause "a device for selectively varying the cross-sectional geometry of a cushioning pad produced by the machine" as recited in claim 59 does or does not invoke the sixth paragraph of 35 U.S.C. § 112;
- (3) determine if the clause "a device which guides a stock material as it travels between a forming assembly and a feed assembly, the device selectively varying the cross-sectional geometry of a strip of cushioning produced by the machine" as recited in claim 68 does or does not invoke the sixth paragraph of 35 U.S.C. § 112; and

(4) after making the above-noted three determinations, determine if any pending claim is either (i) anticipated under 35 U.S.C. § 102 by the admitted prior art discussed on page 2 of the specification and page 15 of the brief, or (ii) rendered obvious under 35 U.S.C. § 103 when that admitted prior art is combined with other prior art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5, 9 to 14, 41, 42, 47, 48, 59 to 62 and 68 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Aug. 2001).

REVERSED and REMANDED

JOHN P. McQUADE)	
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)	
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