

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACKSON HACKER JONES

Appeal No. 2002-2132
Application 09/124,907

HEARD: February 19, 2003

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jackson Hacker Jones appeals from the final rejection (Paper No. 24) of claims 1, 3 through 14 and 17 through 23, all of the claims pending in the application.

THE INVENTION

The invention relates to "a device for varying a cylinder's effective diameter which for example can be arranged in a folding apparatus for processing a web of material" (specification, page 1). Representative claim 1 reads as follows:

1. Device for varying an effective diameter of the [sic, a] cylinder comprising:
a shell member removably mounted on a surface of the cylinder;

said shell member having a base plate, a leading edge, a trailing edge, and an elastic material arranged on said base plate allowing for a compressible surface gain; and

a lock-up device, secured in a gap of said cylinder, for securing the trailing edge, including a tensioning member secured on a base, which base pivots about an axis;

wherein the leading edge and trailing edge are positioned in such a manner providing a gap therebetween; and

wherein the base is biased to pivot about the axis in such a manner that the tensioning member provides tension in at least a direction tangential to the cylinder.

THE PRIOR ART

The items relied on by the examiner to support the final rejection are:

Duckett et al. (Duckett)	3,882,750	May 13, 1975
Kirkpatrick	4,982,639	Jan. 8, 1991
Huber et al. (Huber)	5,163,584	Nov. 17, 1992
Neal	5,916,346	Jun. 29, 1999

The subject matter discussed at lines 9 through 11 on page 2 in the appellant's specification (the admitted prior art)¹

THE REJECTIONS

Claims 1, 3 through 14 and 17 through 23 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which does not describe the claimed invention in such a way as to reasonably convey to one skilled in the relevant art that the appellant had possession thereof at the time the application was filed.

¹ The appellant does not dispute that this subject matter is prior art relative to the claimed invention.

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Claims 1, 4, 9 through 11, 13 and 17 through 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Duckett.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Duckett.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of Huber and the admitted prior art.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of the admitted prior art.

Claims 3, 6, 7 and 20 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of Neal.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of Kirkpatrick.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 28 and 30) and to the examiner's answer (Paper No. 29) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection

This rejection rests on the examiner's determination that the appellant's specification fails to comply with the written description requirement of § 112, ¶ 1, because it lacks support for the limitations in independent claim 1, 17 through 19 and 23 requiring the tensioning member to provide tension or force "in at least a direction tangential to the cylinder." According to the examiner, "[b]ased on the disclosure, the lock-up device 28, including a tensioning member and a base, is meant to lock the base plate and elastic coating in a position around the cylinder, not to provide any kind of tension in a tangential direction of the cylinder" (answer, page 5).

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in

determining compliance with the written description requirement.

Id.

The appellant's original disclosure indicates that the trailing edge 23 of the shell member 21 is clamped by a lock-up device 28 having a tensioning member 32 secured on a base which is spring loaded or otherwise biased to pivot about an axis 31 (see page 9 in the specification and Figure 5). Although the disclosure does not expressly state that the tensioning member 32 provides tension or force in at least a direction tangential to the cylinder 7, the depiction in Figure 5 of the relationship between the lock-up device 28, the cylinder 7 and the shell or surface member 21 indicates that the tensioning member 32, biased via the base to pivot about axis 31, inherently exerts on the member 21 a tension or force which is at least in a direction tangential to the cylinder 7. Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that the appellant had possession at that time of a device embodying the subject limitations in claims 1, 17 through 19 and 23.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of independent claims 1, 17

through 19 and 23 and dependent claims 3 through 14 and 20 through 22.

II. The 35 U.S.C. § 102(b) rejection

Duckett discloses a "rotary anvil construction which employs a die-cutting mat which is readily installed on and removed from an associated rotary anvil in a minimum of time" (column 1, lines 23 through 26). The examiner focuses on the embodiment 20A shown in Figures 7 through 11. This embodiment comprises a rotary anvil or cylinder 21A having a longitudinal groove 24A therein defining a pair of spaced holding surfaces 23A, a die-cutting mat 26A having a pair of locking lips or flanges 31A, 32A at its opposite end portions for receipt into the groove 24A, and an elliptical locking wedge 35A secured to a rod 72A rotatably mounted on post-like members 67A in the groove 24A. The die-cutting mat 26A consists of a suitable elastomeric material and a backing sheet 56A of a suitable metallic material, and the locking flanges 31A, 32A define opposed channels 70A for accommodating the locking wedge 35A and opposed recesses or cutouts 62A for accommodating a wedge-rotating tool T. As described by Duckett,

[t]he tool T is again employed by inserting the end 64 thereof around end portion 63 of the wedge 35A whereupon tool handle 65 is grasped and rotated either clockwise or counterclockwise 90° . . . whereupon the

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comparatively large dimension 36A, i.e., along the major axis [of] the elliptical wedge 35A, is urged against the flanges 31A and 32A urging such flanges tightly against the holding surfaces 23A to tighten and lock the mat 26A against the anvil 21A while simultaneously moving associated outer edges 37A of the mat firmly against each other whereby a single line contact 40A is provided [column 6, lines 28 through 40].

Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

The examiner's analysis as to how Duckett meets each of the elements set forth in claims 1, 4, 9 through 11, 13 and 17 through 19 appears on pages 5 and 6 in the answer. This analysis, however, does not address the limitations in independent claims 1 and 17 through 19 requiring the base to be "biased" to pivot about an axis. Although Duckett's rod 72A, which the examiner reasonably finds to correspond to the recited base, pivots around an axis, it is not "biased" to do so under any sensible definition of this term. Thus, Duckett does not disclose each and every element of the invention set forth in claims 1 and 17 through 19.

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1 and 17 through 19, and dependent claims 4, 9 through 11 and 13, as being anticipated by Duckett.

III. The 35 U.S.C. § 103(a) rejections

Claims 3, 5 through 8, 12, 14 and 20 through 22 depend variously from independent claims 1 and 17 through 19. In short, the examiner's application of Duckett alone or in combination with Huber, the admitted prior art, Neal and/or Kirkpatrick does not account for the "biased" limitation in parent claims 1 and 17 through 19.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 5 as being unpatentable over Duckett, the standing 35 U.S.C. § 103(a) rejection of claim 8 as being unpatentable over Duckett in view of Huber and the admitted prior art, the standing 35 U.S.C. § 103(a) rejection of claim 12 as being unpatentable over Duckett in view of the admitted prior art, the standing 35 U.S.C. § 103(a) rejection of claims 3, 6, 7 and 20 through 22 as being unpatentable over Duckett in view of Neal, or the standing 35 U.S.C. § 103(a) rejection of claim 14 as being unpatentable over Duckett in view of Kirkpatrick.

We shall sustain, however, the standing 35 U.S.C. § 103(a) rejection of independent claim 23 as being unpatentable over Duckett in view of Neal.

Claim 23 is similar in scope to claim 1 and additionally requires "a hook-shaped fastening device operable to attach said leading edge [of the shell member] to said cylinder." The examiner, finding that Duckett meets all of the limitations in the claim except for the recitation of the hook-shaped fastening device (see page 8 in the answer), concludes that it would have been obvious to one of ordinary skill in the art to provide Duckett with such a device in view of Neal (see page 9 in the answer).

The appellant does not dispute the examiner's assessment of Neal or related conclusion that it would have been obvious to modify the Duckett device in view of Neal to include a hook-shaped fastening device of the sort required by claim 23. The appellant does contend (see pages 9 through 13, 21 and 22 in the main brief and pages 2 and 3 in the reply brief), however, that the rejection of claim 23 is unsound because the combined teachings of the references, and particularly those of Duckett, do not respond to the limitations in the claim requiring "a gap" between the leading and trailing edges of the shell member and a

tensioning member which secures the trailing edge by providing "force in at least a direction tangential to the cylinder."²

The appellant's position here is not persuasive. Figure 11 in the Duckett reference clearly shows the presence of a gap between the bottom portions of the outer surfaces 54A of flanges 31A and 32A which embody the leading and trailing ends of Duckett's shell member (die-cutting mat 26). Duckett's tool accommodating cutouts 62A also define a gap between the leading and trailing edges of the shell member. The appellant's contention that any gap in the Duckett device would not allow for a knife assembly or anvil bar to be positioned therein is of no moment since claim 23 does not so limit the recited gap. Furthermore, Duckett's tensioning member (locking wedge 35A) provides "force in at least a direction tangential to the cylinder" as evidenced by Duckett's disclosure that rotation of the locking wedge simultaneously moves the outer edges 37A of the mat firmly against each other whereby a single line contact 40A is established. Such movement, which is tangential to the cylinder, necessarily involves a force in at least a direction tangential to the cylinder.

² Claim 23 does not include the "biased" base limitation found in claims 1 and 17 through 19.

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Thus, the appellant's traverse of the 35 U.S.C. § 103(a) rejection of claim 23 as being unpatentable over Duckett in view of Neal is not well taken.

SUMMARY

The decision of the examiner;

a) to reject claims 1, 3 through 14 and 17 through 23 under 35 U.S.C. § 112, first paragraph, is reversed;

b) to reject claims 1, 4, 9 through 11, 13 and 17 through 19 under 35 U.S.C. § 102(b) as being anticipated by Duckett is reversed;

c) to reject claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Duckett is reversed;

d) to reject claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of Huber and the admitted prior art is reversed;

e) to reject claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of the admitted prior art is reversed;

f) to reject claims 3, 6, 7 and 20 through 23 under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of Neal is reversed with respect to 3, 6, 7 and 20 through 22 and affirmed with respect to claim 23; and

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g) to reject claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Duckett in view of Kirkpatrick is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	
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