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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS HARTMANN, BERNHARD WAGENSOMMER,
and MICHAEL KRUEGER

Appeal No. 2003-0119
Application No. 09/569,477

ON BRIEF

Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11 and 12. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a method for synchronous transfer of printed sheets. A basic understanding of the invention can be derived from a reading of exemplary claim 11, a

copy of which appears in the APPENDIX to the brief (Paper No. 14).

As evidence of anticipation, the examiner has applied the document specified below:

Volz et al (Volz)	5,826,505	Oct. 27, 1998

The following rejection is before us for review.

Claims 11 and 12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Volz.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 15), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 14 and 16).

Appellants group claims 11 and 12 together (main brief, page 3) and, thus, our main focus is upon independent claim 11.

OPINION

In reaching our conclusion on the anticipation issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied patent, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We cannot sustain the anticipation rejection of appellants' claims.

Anticipation under 35 U.S.C. § 102(e) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach

specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Independent method claim 1 requires, in particular, the steps of first establishing a first phase synchronism through a transfer unit with respect to a front printing-unit group, and then establishing a second phase synchronism with respect to a rear printing-unit group.

The examiner views the second exemplary embodiment of the Volz patent (Fig. 2) as anticipatory of the claimed invention (answer, pages 3 through 5), while appellants argue otherwise in the main and reply briefs.

The difficulty we have with the anticipation rejection on appeal is that, as to the disclosure that can be fairly understood from the reference relative to the relied upon second embodiment of the Volz patent, we do not discern that the second

embodiment itself would be anticipatory of the method of appellant's claim 11. If the impression cylinders of the second embodiment of Volz (column 6, lines 33 through 37) are comprehended to be geared together with the transfer cylinders, as disclosed and as argued by appellants, then it appears to us that the transfer cylinders would not be capable of being mechanically decoupled. Like the examiner (answer, pages 4), we recognize that the ABSTRACT for the Volz reference addresses what appears to be highly relevant teachings vis-a-vis the present invention. However, it is not certain that the ABSTRACT addresses, in particular, the second embodiment of Volz. For the above reasons, the present rejection cannot be sustained.

REMAND TO THE EXAMINER

We remand for the examiner's review of the following matters.

1. From the disclosure it appears to this panel of the Board that an apparent attribute of appellants' printing machine for achieving the claimed first phase synchronism and second phase synchronism (claim 11) is a transfer unit (page 6, line 30 to

page 7, line 1) which is “mechanically uncoupled from the gear trains of both printing-unit groups 2 and 3.” However, it is not clear to us from the disclosure if the first phase synchronism and second phase synchronism, respectively, are effected by the selective movement of the transfer unit into alternate (gearing) engagement with the front and then the rear printing-unit groups. The examiner should consider whether the disclosure satisfies 35 U.S.C. § 112, first paragraph, and take appropriate action.

2. In conjunction with the invention description in the body of the Volz patent, the ABSTRACT and claim 1 of the patent seem to us to characterize a drive system for a sheet-fed offset printing press whose operation would appear to be highly relevant to appellants’ method for synchronous transfer of printed sheets involving first and second phase synchronism. Based upon the above, the examiner should consider whether claims 11 and 12 are anticipated or rendered obvious thereby.

In summary, this panel of the board has not sustained the rejection of the claims on appeal, and has remanded the application to the examiner to assess matters addressed above.

The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

ICC:pgg

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004