

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY H. JENKINS

Appeal No. 2003-0550
Application No. 09/580,411

ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, which are all of the claims pending in this application. In the examiner's answer (Paper No. 13, page 2), the examiner has withdrawn all of the rejections from the final except the rejection of claim 1 under 35 U.S.C. § 102(b). Accordingly, only that rejection remains for our consideration on appeal.

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As noted on page 1 of the specification, appellant's invention is directed to a die cutter apparatus for severing blisters into individual blisters from a sheet of blisters which has been formed from a deformable transparent or translucent sheet of plastic material by a process known to those skilled in the art. More specifically, independent claim 1 on appeal provides for a "compensating blister die cutting apparatus" including, *inter alia*, a lost motion connection connecting each blister die cutter unit support member (50) to the base member (31) of the die cutter apparatus and permitting relative lateral movement of each die cutter unit (34-39) relative to the base member and relative to each other through a range of 360 degrees. The "lost motion connection" described on page 6 of the specification includes threaded adjustment members (70) being of a smaller diameter than the holes (72) in the top board (50), backup plate (47) and bottom board (44) so that the die cutter units can move relative to the base member and relative to each other when a blister on a blister sheet is pushed down into the cavity (62) of a given die unit which causes that unit to shift so that a given blister fits into a given cavity in a symmetrical fashion. A copy of independent claim 1 on appeal, as reproduced

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conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 13, mailed October 9, 2002) for the reasoning in support of the rejection, and to appellant's brief (Paper No. 11, filed May 10, 2002) and reply brief (Paper No. 16, filed October 24, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claim 1, to the applied prior art Carll reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination which follows.

Like the examiner, we are of the view that during a loosened state of the threaded bolts (32) in the die cutter apparatus of Carll, the connection between the support members (16) and the base member (12) would be such as to permit lateral movement of each die cutter unit (14) relative to the base member and relative to each other through a range of 360 degrees. While it

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is true that during use of the die cutter apparatus in Carll in a cutting operation, the die cutter units (14) are fixed in an adjusted position by tightening of the bolts (32), we remain of the view that the structure in Carll would broadly be understood by one of ordinary skill in that art to constitute a "lost motion connection" like that set forth in claim 1 on appeal, at least during the set-up phase for the die cutter apparatus. In that regard, we agree with the examiner's assessment on page 6 of the answer that

the only difference between the two inventions is how they are intended to be used. Carll discloses that the die cutting units are locked in position during use, while the die cutting units of the present invention are free to move during use. However, there is no structural difference between the claimed invention and the invention of Carll, thus the difference amounts to a functional recitation of intended use, and as is well established in patent law, a functional recitation of intended use cannot serve to distinguish a claimed apparatus/device over the prior art. Further, it is noted that there is nothing in Carll which prevents it from being used in the manner described by appellant. For example, by simply not tightening the screws 32, Carll is exactly the same as the claimed invention. No modification of the structure disclosed by Carll is required. This loosened state is clearly present in Carll during adjustments, but also could be present during use of the device if a user chose to do so. Also, it is noted that there is nothing preventing the adjustment members of the present invention from being tightened down to lock the die cutting units in place and thus used in the same manner as the die cutting units of Carll. A structural difference between the

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lost motion connection of the claimed invention and the corresponding structure of Carll cannot be found.

Appellant's argument in the brief (page 8) that the reference to Carll "does not in spirit anticipate the claimed invention," followed by what appears to be a concession that Carll "does show and disclose on an element by element basis what is contained in the claims" is somewhat confusing. Like the examiner, we are of the view that appellant and Carll show essentially the same structure for connecting the die unit support member to the base member of their respective die cutter apparatus and that the structure in each is capable of functioning as a "lost motion connector," depending on the desires of the user. There is nothing in appellant's claim 1 on appeal which mandates that the "lost motion connection" necessarily must be usable during operation of the die cutter apparatus so as to shift the die cutter units relative to each other to accommodate for uneven shrinkage in a plastic sheet of blisters, as opposed to during set-up, with the die units subsequently being fixed in an adjusted position. In that regard, we note from appellant's specification, page 4, that within a given batch of polymeric sheet material, after a first group of blisters has been produced, the individual shrinkage

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will be somewhat consistent for subsequent sheets, so that after the first group of blister is cut, the die cutter units of appellant's invention could be fixed in position for the remainder of the runs for that batch of sheet material.

An anticipation under 35 U.S.C. § 102(b) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element or limitation of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, we observe that the law of anticipation does not require that the reference teach what the appellant has disclosed 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). In the present case, while it is true that there is nothing in the Carll patent which indicates that the connection in question is used as a "lost motion connection" during operative use of the die cutter apparatus, we agree with the examiner that the connection in Carll is fully responsive to the

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structural features of the connection set forth in claim 1 on appeal and is inherently capable of being used in the manner set forth in claim 1 to permit relative lateral movement of each die cutter unit (14) relative to the base member (12) and relative to each other through a range of 360 degrees.

As was made clear in In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1431, by choosing to define an element functionally as in appellant's claim 1 on appeal, appellant assumes a risk, that risk being that where the Patent and Trademark Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. In the present case, appellant has provided no evidence to prove that the connection in Carll is not capable of the use asserted by the examiner. We therefore are constrained to agree with the examiner that the differences in the intended use of the connector seen in Carll and appellant's claimed connector do not patentably distinguish

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appellant's die cutter apparatus from the die cutter apparatus of Carll.

Since we find that the examiner has treated all of the limitations of claim 1 and agree with the examiner that the connection in Carll can serve as a "lost motion connection" and actually does so during set-up of the die units therein, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Carll.

The decision of the examiner, accordingly, is affirmed.

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

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

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Claim 1

A compensating blister die cutter apparatus including a base member,

at least first and second blister die cutter units supported by said base member,

each said blister die cutter unit comprising a [sic]

a support member carrying a steel rule die,

a lost motion connection connecting said support member to said base member permitting relative lateral movement of each die cutter unit relative to said base member and relative to each other through a range of 360 degrees.