

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. HEIL, JAMES F. PITZEN,
and JEFFREY J. SCHWAB

Appeal No. 2004-1831
Application No. 09/338,095

ON BRIEF

Before GARRIS, WARREN, and KRATZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 3, 5-9, 11, 12, 19, and 21-24 which are all of the claims remaining in the application.

The subject matter on appeal relates to a roll of masking material comprising a coiled elongate sheet having elongate edges and longitudinal folds and pleated portions arranged in a variety

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of embodiments. With reference to the appellants' independent claims and the application drawing, the claim 3 embodiment is depicted in Figure 3, the claim 5 and claim 22 embodiment is depicted in Figures 4-5, the claim 7 embodiment is depicted in Figures 6-8 and the claim 19 embodiment is depicted in Figure 9. This appealed subject matter is adequately illustrated by representative independent claims 3, 19 and 22 which read as follows:

3. A roll of masking material having an axis, first and second axially spaced ends, and a predetermined width between said spaced ends, said roll of masking material comprising a coiled elongate sheet, said sheet having opposite first and second elongate edges, having longitudinal folds defining, with said elongate edges, edges of longitudinally extending portions of said sheet, said longitudinally extending portions of said sheet including pleated portions of said sheet each having opposite major surfaces generally parallel with said axis, said pleated portions being superimposed major surfaces to major surfaces to form a laminate with outermost ones of said superimposed pleated portions defining the opposite outer surfaces of said laminate, and at least some of the edges of said superimposed pleated portions being positioned generally radially aligned at said first end of said roll, said longitudinally extending portions of said sheet further including a first radial portion extending radially of said roll along said radially aligned edges at said first end of said roll from the edge of one of the outermost pleated portions at said first end of said roll and a first distal portion having said first elongate edge of said sheet and extending for a distance less than said predetermined width along the outer surface of the laminate toward the second end of the roll from the edge of said first radial portion opposite the outer most pleated portion to which the first radial portion is attached; said one of the outer most pleated portions to which the first radial portion is attached being disposed radially outwardly of the roll from the other one of said outermost pleated portions in the laminate.

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19. A roll of masking material having an axis and first and second axially spaced ends, said roll of masking material comprising a coiled elongate sheet, said sheet having opposite first and second elongate edges, having longitudinal folds defining, with said elongate edges, edges of longitudinally extending portions of said sheet, said longitudinally extending portions of said sheet including pleated portions of said sheet each having opposite major surfaces generally parallel with said axis, said pleated portions being superimposed major surfaces to major surfaces to form a laminate with outermost ones of said superimposed pleated portions defining the opposite outer surfaces of said laminate, said first elongate edge of said sheet being at said first end of said roll and at least some of the edges of said superimposed pleated portions being positioned generally radially aligned at said first end of said roll to support said first elongate edge of said sheet, at least 75 percent of the width of the sheet material in the pleated portions forming the laminate between said edges is within the 2/3 of the axial length of the roll from said first end.

22. A roll of masking material having an axis and first and second axially spaced ends, said roll of masking material comprising a coiled elongate sheet, said sheet having opposite first and second elongate edges joined along a line of weakness affording manual separation of said edges, and having longitudinal folds defining, with said elongate edges, edges of longitudinally extending portions of said sheet.

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

Steidinger	5,086,683	Feb. 11, 1992
Yoshino	5,741,389	Apr. 21, 1998

Claims 3, 7-9, 11, 12, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshino, and claims 5, 6 and 22-24 stand correspondingly rejected over this reference and further in view of Steidinger.

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We refer to the brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

For the reasons set forth below, we cannot sustain any of the rejections advanced by the examiner on this appeal.

As correctly argued by the appellants and acknowledged by the examiner, claim 3 distinguishes over Yoshino by requiring "a first distal portion having said first elongate edge of said sheet and extending for a distance less than said predetermined width [of the roll]" In Yoshino, the distal portion extends completely across the roll width as clearly shown in Figure 1 of the patent. According to the examiner, it would have been obvious for one of ordinary skill in the art "to vary the length of the distal portion, since the length of the distal portion would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Yoshino" (answer, page 4). This obviousness conclusion is not well taken.

Contrary to the examiner's apparent belief, the Yoshino patent contains no teaching or suggestion that the distal portion length was recognized as a result effective variable. For this

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reason, no basis exists for the examiner's conclusion that it would have been obvious to vary this length based on routine optimization. See In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977). Also contrary to the examiner's apparent belief (e.g., see page 7 of the answer), Yoshino contains no teaching or suggestion of any advantage to be expected from shortening patentee's distal portion dimension in the manner required by the claim under review. On the other hand, it is apparent from Figure 1 of the patent that shortening the distal portion would dispose adhesive surface c of adhesive tape 3 on top of an underlying layer of film 2, thereby creating potential disadvantages (e.g., the unintended and undesirable adhesion of surface c to underlying film 2 with the concomitant possibility of damaging the underlying film when pulling the adhesive surface away therefrom as the masking material is unrolled during use).

Under these circumstances, it is apparent that the examiner's obviousness conclusion lacks the requisite suggestion for the proposed modification as well as the requisite reasonable expectation that the proposed modification would be successful. See In re O'Farrell, 853 F.2d 846, 850-51, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). It follows that we cannot sustain the section 103 rejection of independent claim 3 or of the claims which

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depend therefrom as being unpatentable over Yoshino. For analogous reasons, we also cannot sustain the corresponding rejection of independent claim 7 (which requires that both the first and second distal portions extend for a distance less than the roll width) or of the claims which depend therefrom.

As for independent claim 19, the appellants and the examiner again agree that this claim distinguishes from Yoshino via the limitation "at least 75 percent of the width of the sheet material in the pleated portions forming the laminate between said edges is within the 2/3 of the axial length of the roll from said first end." According to the examiner, it would have been obvious for one with ordinary skill in the art "to vary . . . the percent of the width of the sheet material [of Yoshino] in the pleats forming the laminate between the edges is [sic, to be] within 2/3 of the axial length from the end since these parameters would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end result" (answer, page 5).

As before, Yoshino provides utterly no evidentiary support for this obviousness conclusion. Quite plainly, it is only the appellants' own disclosure which provides any teaching or suggestion for the claim feature under consideration. These

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circumstances compel us to regard the examiner's obviousness conclusion as based upon impermissible hindsight rather than some teaching, suggestion or incentive derived from the applied prior art. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It follows that we also cannot sustain the examiner's section 103 rejection of claim 19 or of the claims which depend therefrom as being unpatentable over Yoshino.

Concerning the rejection of claims 5, 6 and 22-24 based on Yoshino in view of Steidinger, the examiner expresses his obviousness position on page 8 of the answer with the following language:

Yoshino teaches that the disclosed masking material is made by the cutting of the plastic tubular film (column 3, lines 57-60 [sic, lines 32-35]) and Ste[i]dinger teaches that perforating paper or plastic is well known in the art to be equivalent to cutting for the purpose of manufacturing an article of the paper or plastic (column 1, lines 13-16). Therefore, one of ordinary skill in the art would have recognized the utility of perforating instead of cutting in Yoshino, which comprises a plastic film, in order to manufacture an article from the film as taught by Ste[i]dinger.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicants['] invention was made to have provided for perforating, rather than cutting the film in Yoshino in order to manufacture an article from the film as taught by

Ste[i]dinger. The first and second edges would therefore be separably attached, along the line of perforation.

The examiner's rationale is fatally flawed. Although Yoshino may disclose a step of cutting his corona-discharged tubular film, the examiner's proposed replacement of this cutting operation with a perforating operation would not yield the here claimed invention. This is because patentee's cutting step is for the purpose of transforming the tubular article shown in Figure 2 into a sheet of film which is then provided with adhesive tape and folded into the shape depicted in Figure 1. From our perspective, replacing Yoshino's cut with a perforation of the type taught by Steidinger would not in any way alter the aforementioned tape-applying and film-folding steps of Yoshino. Thus, if Yoshino's tubular article shown in Figure 2 were provided with a perforation rather than a cut, an artisan would have severed this perforation in order to then perform the tape-applying and film-folding steps pursuant to patentee's teaching. Indeed, it seemingly would be impossible to perform these last mentioned steps without first severing the perforation.

In light of the foregoing, it is clear to us that the combined teachings of Yoshino and Steidinger would not have led to a roll of masking material having first and second edges

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"separably attached" or "joined along a line of weakness" as required by independent claims 5 and 22 respectively. We cannot sustain, therefore, the examiner's section 103 rejection of these claims and the claims which depend therefrom as being unpatentable over Yoshino in view of Steidinger.¹

In summary, we are unable to sustain any of the section 103 rejections advanced by the examiner on this appeal.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris)	
Administrative Patent Judge)	
)	
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)	
Charles F. Warren)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Peter F. Kratz)	
Administrative Patent Judge)	

BRG:tdl

¹ The examiner's obviousness conclusion with respect to independent claim 5 is additionally flawed for the reasons discussed with respect to independent claim 3.

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