

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAO FUKUDA
and MICHIHIRO KUBO

Appeal No. 2004-2176
Application 09/996,624

ON BRIEF

Before PAK, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.
PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5 and 18-20.

On page 5 of the brief, appellants state that the claims stand or fall together. We therefore select the broadest claim from each rejection, which are claims 1 and 3, set forth below:

1. A packaging machine comprising:

a cylindrical chute;

means for bending an elongated bag-making film into a tubular form around said chute by mutually overlapping side edges of said film;

a heater unit for longitudinally sealing said mutually overlapping said edges of said film;

heater driving means for moving said heater unit between a sealing position at which said heater unit contacts said film and

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a retracted position at which said heater unit is separated from said chute; and

an air cylinder for controlling compressive force with which said heater unit at said sealing position compresses said film against said chute by having air of a specified pressure supplied thereto.

3. The packaging machine of claim 1 wherein said heater driving means includes another air cylinder.

The examiner relies upon the following references as evidence of unpatentability:

Husted	4,930,403	June 5, 1990
Fukuda	5,125,217	June 30, 1992

Claims 1, 4, and 5 stand rejected under 35 U.S.C. §102(b) as being anticipated by Fukuda.

Claims 1, 2, 4, 5, 19, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fukuda in view of Husted.

Claims 3 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over Fukuda.

OPINION

I. The rejection of claims 1, 4 and 5 under 35 U.S.C. §102(b) as being anticipated by Fukuda

We consider claim 1 in this rejection.

We refer to page 3 of the answer regarding the examiner's position in this rejection.

Beginning on page 5 of the brief, the single disputed issue presented by appellants is whether the air cylinder of Fukuda controls the compressive force with which the heater unit at the sealing

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position compresses the film against the chute. Appellants argue that there is no statement in Fukuda that the air cylinder 78 functions to control the compressive force between the belt 55 and the film "S."

Beginning on page 4 of the answer, the examiner rebuts and states that air cylinder 78 of Fukuda effectively moves the vertical sealing belt 55 in order to seal the web by direct contact, and the examiner then concludes that the compressive force is thereby controlled by air cylinder 78. We agree. We note that during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 320, 322 (Fed. Cir. 1999). In determining the patentability of claims, the PTO gives claim language its "broadest reasonable interpretation" consistent with the specification and claims. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (citations omitted). In the instant case, claim 1 recites, inter alia, "an air cylinder for controlling compressive force with which said heater unit at said sealing position compresses such film against said chute by having air of a specified pressure supplied thereto." Applying any desired amount of force (which air cylinder 78 of Fukuda provides) satisfies the meaning of "controlling compressive force." Fukuda's air cylinder 78 provides such function.

In any event, and more importantly, as pointed out by the examiner on page 5 of the answer, apparatus claims must be distinguished from the prior art in terms of structure, rather than function. See In re Schreiber, 128 F.3d 1473, 1474-77, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). On this record, however, there is no evidence that the claimed air cylinder is structurally different from that described in Fukuda. In the absence of such evidence (which appellants have not provided in the record before us), we affirm the rejection.

Accordingly, the 35 U.S.C. § 102(b) rejection of claims 1, 4

and 5 is affirmed.

II. The 35 U.S.C. §103 rejection of claims 1, 2, 4, 5, 19 and 20

Because appellants have stated that claims 1-5 and 18-20 stand or fall together (see page 5 of the brief), for the same reasons that we affirmed the 35 U.S.C. §102(b) rejection of claims 1, 4 and 5, we also affirm the 35 U.S.C. §103 rejection of claims 1, 2, 4, 5, 19 and 20. We refer to our discussion set forth above.

III. The 35 U.S.C. § 103 rejection of claims 3 and 18

We consider claim 3 in this rejection.

Claim 3 recites "the packaging machine of claim 1 wherein said heater driving means includes another air cylinder."

On page 4 of the answer, the examiner refers to column 8, lines 34-36, of Fukuda, and based upon the disclosure "different combinations of motion-communicating and torque-communicating means can be substituted," the examiner concludes it would have been obvious to have substituted an additional air cylinder in place of the screw axis 59 of Fukuda. On page 6 of the answer, the examiner states that air cylinders are well-known actuators for controlling movement and that an air cylinder is considered an obvious substitute for a screw axis operated by a servo motor. However, the examiner does not support this statement by evidence. Meanwhile, appellants dispute the examiner's contention that an air cylinder is an obvious substitute of a screw axis operated by servo motors. Brief, pages 8-9.

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner does not address appellants' discussion in the last paragraph of page 8 and the first paragraph on page 9 of the brief. Also, as stated

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above, the examiner has not pointed to any evidence in the record before us that air cylinders are obvious substitutes for a screw axis.

In view of the above, we therefore reverse the 35 U.S.C. § 103 rejection of claims 3 and 18.

IV. Other Issues

Upon return of this application to the jurisdiction of the examiner, consider whether claims 3 and 18 satisfy the requirements of 35 U.S.C. § 112, second paragraph. That is, these claims recite that "another" air cylinder is part of the heater driving means (suggesting that the air cylinder recited in claim 1, is part of the heater driving means), while claim 1 indicates that an existing air cylinder is part of the packaging machine (not the heater driving means).

V. Conclusion

The 35 U.S.C. §102 rejection of claims 1, 4 and 5 as being anticipated by Fukuda is **affirmed**.

The 35 U.S.C. §103 rejection of claims 1, 2, 4, 5, 19 and 20 under 35 U.S.C. §103 as being unpatentable over Fukuda in view of Husted is **affirmed**.

The 35 U.S.C. §103 rejection of claims 3 and 18 as being unpatentable over Fukuda is **reversed**.

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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)(1)(iv) (effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED-IN-PART

Chung K. Pak)	
Administrative Patent Judge)	
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Catherine Timm)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
Beverly A. Pawlikowski)	
Administrative Patent Judge)	

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BEYER, WEAVER & THOMAS, LLP
P. O. Box 778
Berkeley, CA 94704-0778