

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DAVID CLARKE POLLOCK, MATTHEW THOMAS SHARKADY,
PAUL EMMETT BREDENBERG, KEVIN LAUREN COTE, RICHARD DANIEL CURLEY,
and JOHN MARSHALL GAFFNEY

Appeal No. 2004-2315
Application No. 09/348,155

ON BRIEF

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

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-8, all the claims currently pending in the application.

Appellants' invention pertains to an apparatus (claims 1-5) and method (claims 6-8) for transporting signatures from a printing press and diverting the signatures to either a first

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conveying stream or a second conveying stream. A further understanding of the invention can be derived from a reading of exemplary claims 1 and 6, copies of which can be found in the appendix to appellants' main brief.

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

Carricato	3,841,625	Oct. 15, 1974
Rahe	4,534,552	Aug. 13, 1985
Curley et al. (Curley)	5,927,712	Jul. 27, 1999

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rahe in view of Curley and Carricato.¹

Reference is made to appellants' main and reply briefs (Paper Nos. 10 and 12) and to the examiner's final rejection and

¹Although the statement of the rejection appearing on page 3 of the examiner's answer does not include dependent claims 2-5, 7 and 8, it is clear from a review of the final rejection, appellants' main brief and the totality of the examiner's answer that the standing rejection continues to apply to all the pending claims. Normally, rejections of claims which are not repeated in the answer are considered to have been withdrawn by the examiner. See, for example, *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957). In the present case, appellants' grouping of the claims as set forth on page 5 of the main brief in no way relieves the examiner of the obligation to expressly state in the answer exactly what references and rejections are applicable to the appealed claims.

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answer (Paper Nos. 6 and 11) for the respective positions of appellants and the examiner regarding the merits of this rejection.

Appellants' Invention

With reference to appellants' drawing figure, independent claim 1 is directed to a signature transferring assembly comprising a first positive control deceleration device (element 7) for transporting some signatures of a stream of signatures to a first delivery stream (element 9), a gripper cylinder (element 4) "containing a plurality of grippers [elements 12 and 11, respectively] for gripping a trailing edge and a leading edge of remaining signatures in the signature stream for transporting the remaining signatures on said gripper cylinder," and a second positive control deceleration device (element 15) for transporting the remaining signatures released by the gripper cylinder to a second delivery stream (element 10). The steps of independent method claim 6 contain similar language.

The Examiner's Position with respect to Rahe and Carricato

Rahe, the examiner's primary reference, is directed to a sheet handling system for dividing a stream of sheets into two streams of sheets for two delivery stations. As explained in the abstract (with reference numerals added):

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A sheet diverter system in which a stream of sheets [115-118] is fed by a pair of tapes [13, 15] to a gripping zone between a pair of separating cylinders [27, 29]. The tapes on opposite sides of the sheet diverge downstream of the gripping zone and wrap around a part of the outer periphery of the adjacent separating cylinder [27, 29] so that they travel at the same velocity as the outer periphery of the cylinder. The sheets advance toward the gripping zone at a velocity controlled by the separating cylinder and successive sheets are presented to the grippers [87-90] carried by the cylinders so that alternate sheets are carried along different paths to different delivery stations [e.g., belts 49, 69].

Rahe's system also includes rotary fan wheels 47, 67 for discharging the steams onto creeping belts 49, 69, which rotary fan wheels function to slow down or decelerate the sheets of each stream as they flow downstream from the cylinders 27, 29 (column 5, lines 24-31). In addition, Rahe provides a brush guide 81 just below the cylinders 27, 29 to minimize the whipping around of the trailing ends of the sheets when they are released from between the tapes 13 and 15 (column 3, lines 64-68).

In rejecting the appealed claims as being unpatentable over the applied references, the examiner considers that Rahe's separating cylinder 29 corresponds to the claimed gripper cylinder. The examiner concedes that cylinder 29 does not contain a gripper for gripping a trailing edge of a sheet. To account for this deficiency the examiner turns to Carricato.

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Carricato pertains to a method and apparatus for delivering sheets from a printing unit to a pile of sheets. Carricato's apparatus includes an intermediate transfer cylinder **26** for transferring a sheet from a first chain **16** to a second chain **34**, and for slowing the sheet down as it is deposited on the pile of sheets **38**. To this end, the transfer cylinder includes a first gripper **42** for gripping the leading edge of a sheet to be transferred, and a second gripper **44** for gripping the trailing edge of the sheet. Carricato indicates that engaging the trailing edge of the sheet permits the sheet to be deposited on the pile of sheets without disturbances or flutter (column 1, lines 45-50; column 4, line 61, through column 5, line 2). According to the examiner, it would have been obvious to one of ordinary skill in the art in view of the teachings of Rahe and Carricato "to utilize . . . grippers for gripping a trailing edge of the signatures on the gripper cylinder [of Rahe] as another way to reduce tail-edge flutter" (final rejection, page 5).

Discussion

We appreciate that the stated purpose of the brush guide **81** of Rahe is to minimize the whipping around of the trailing ends of sheets when they are released from between the tapes **13** and

15. We also appreciate that the tail edge gripper **44** of Carricato functions to release sheets onto the pile **38** without tail flutter. While the examiner's citation of this similarity of purpose as the rationale for providing trailing edge grippers on the gripper cylinder of Rahe as another way to reduce tail-edge flutter has a certain logic, for the reasons explained below we find ourselves in agreement with appellants' argument (main brief, pages 10-12) that this modification would not have been obvious to one of ordinary skill in the art in the absence of appellants' own disclosure.

Looking at the operation of Carricato's apparatus in more detail, first a sheet is transferred from gripper **18** of chain **16** to transfer cylinder **26**, where the sheet is gripped at its front edge by gripper **42** and at its tail edge by gripper **44**. As the cylinder rotates, front edge gripper **42** transfers the front edge of the sheet to the front edge gripper **36** on chain **34** while the gripper **44** continues to grip the tail edge of the sheet, so that the front edge of the sheet is gripped by gripper **36** of chain **34** and the tail edge of the sheet is gripped by gripper **44** of the transfer cylinder. Subsequently, the tail edge gripper **44** of cylinder **26** cooperates with the front edge gripper **36** on chain

34 to slow down and gently release the sheet to the pile **38**. In order to accomplish this, the grippers **36** and **44** are articulated to their respective supports so that they undergo a coordinated series of motions wherein they pivot away from their respective supporting structures to define an elongated path of movement that results in the sheet slowing down relative to the peripheral speed of the transfer cylinder and chain (Carricato, column 4, line 31, through column 5, line 2). This motion can be seen in Figure 9 where the tail edge gripper **44** has pivoted out and away from the surface of the cylinder **26** at the 10 o'clock position and in Figure 17 where the front edge gripper **36** likewise has pivoted out and away from the path of the chain **34** at the point of release of the sheet in order to slow down the sheet as it is deposited on the pile. Thus, the tail end gripper **44** of Carricato is specifically targeted to stacking sheets on the pile in a way that will not cause a disturbance to previously deposited sheets.

In contrast to the above, the brush guide **81** of Rahe is situated at a place where signatures are merely transferred from one location where they are held between a first set of tapes (tapes **13** and **15**) to a second adjacent location where they are

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held between a second set of tapes (tapes **13** and **35**, or tapes **15** and **37**). While we appreciate that Carricato may be viewed as broadly disclosing the concept of providing grippers for gripping both the front and tail edges of a sheet, why one of ordinary skill in the art would have resorted to Carricato's complex articulated tail edge gripper **44** arrangement as an incentive for providing a tail edge gripper in Rahe as an alternative to brush guide **81** has not been adequately explained by the examiner. This is especially so in that the tail edge gripper of Carricato relied upon by the examiner is specifically designed to solve a problem (depositing a sheet onto a pile without disturbing previously deposited sheets) that does not appear to exist in Rahe, at least not at the point of the proposed modification.

As stated by our reviewing court in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

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In this instance, assuming for the sake of argument that a person of ordinary skill in the art would have been motivated to replace the brush guide **81** of Rahe with an alternative device for minimizing whipping around of the trailing ends of the signatures as they emerge from between the cylinders **27** and **29**, it is not apparent to use why the ordinarily skilled artisan would have looked to Carricato, where the sheets are being handled in a different manner for a different end purpose. In our view, the only suggestion for modifying Rahe in the manner proposed to meet the above-noted trailing edge gripper limitation stems from the luxury of hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The above noted deficiency in the basic combination of Rahe and Carricato is not cured by Curley, which is relied upon by the examiner solely for its teaching of providing a deceleration device that comprises a series of arms with grippers at the ends thereof to slow down signatures as they are released to a delivery stream.

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Conclusion

In light of the foregoing, we shall not sustain the standing rejection of appealed claims 1-8 as being unpatentable over Rahe in view of Curley and Carricato.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

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