

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH BEGEMANN
and ALFRED SCHAULZ

Appeal No. 2005-0659
Application 09/799,134

ON BRIEF

Before KIMLIN, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejections advanced on appeal:

claims 1, 2, 5 through 9, 11, 12, 15 through 17, 20, 21, 24 and 25 stand rejected under 35 U.S.C. § 102(e) as anticipated by Shakespeare et al. (Shakespeare) (answer, pages 4-8);

claims 3, 4, 10, 13, 14, 18 and 27 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shakespeare in view of Wood et al. (Wood) (answer, pages 8-10);

claims 22 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shakespeare in view of Gorinevsky et al. (Gorinevsky) (answer, page 10);

claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shakespeare in view of Kuni (answer, page 11); and

claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shakespeare and Wood as applied to claims 1 and 18 above and further in view of Spurr et al. (Spurr) (answer, pages 11-12).^{1,2}

We refer to the answer and to the brief and reply brief for a complete exposition of the respective positions advanced by the examiner and appellants.

We agree with appellants' positions expressed in the brief and reply brief, and add the following for emphasis.

The dispositive issue in this appeal is whether one of ordinary skill in this art would have found in Shakespeare the teachings and inferences establishing that the information involving process measurements of the paper web taken by measurement devices situated after cross machine direction (CD) moisture actuators in the paper web manufacturing process is used in subsequent processing of the paper web such as, e.g., printing.³ Indeed, evidence of such use of process information in Shakespeare is necessary with respect to the grounds of rejection on appeal because when the terms of representative appealed claim 1, on which all other appealed claims depend, are given the broadest reasonable interpretation in light of the written description in the specification as it would be interpreted by one of ordinary skill in this art, *see In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), the plain language thereof comprises at least the specified four steps, of which the steps pertinent here are (1) determining information regarding the paper during manufacturing thereof, (2) transmitting this information for use in a paper converting process of, among others, printing, and (3) compensating the converting process based on this information.

We find as a matter of fact that Shakespeare would have disclosed the use of

¹ Appealed claims 1 through 29 are all of the claims in the application. See the appendix to the brief.

² The examiner withdrew the ground of rejection under 35 U.S.C. § 103(a) over Wood (answer, page 2).

³ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

at least two actuators which affect the CD moisture profile and means for controlling the web elongation by said CD moisture actuator, said CD moisture actuators being situated at different stages in the web manufacturing process, and the means for measuring the web elongation profile and moisture profile situated after the CD moisture actuators. [Col. 2, ll. 1-9; see also col. 2, ll. 10-23, and col. 3, ll. 43-65.]

Shakespeare would have taught that profile controllers are used to govern the CD moisture actuators to control the web profile measured by the measurement devices (e.g., col. 5, ll. 43-51), and that additional web characteristics may be similarly measured and controlled (e.g., col. 5, l. 66, to col. 6, l. 62, and col. 7, ll. 16- 23). Additional actuators and measurement devices can be used as well (e.g., col. 6, l. 63, to col. 7, l. 15). Shakespeare would have further taught that the control of certain profiles during manufacture prevent dimensional problems during manufacture and use (col. 7, ll. 23-31).

Shakespeare would also have disclosed that the “at least two actuators which affect the CD moisture profile . . . [can be] situated at different stages in the web manufacturing process or subsequent processing such as . . . printing” (col. 5, ll. 21-42). We find that one of ordinary skill in this art would have inferred from Shakespeare as a whole that the application of the disclosed invention to printing processes would have involve the same profile controllers governing actuators based on paper web profile measurements by measurement devices positioned after the actuators as disclosed for the paper web manufacturing processes.

Thus, we find that Shakespeare would not have taught one of ordinary skill in this art to transmit paper web profile information measured by the measurement devices during the paper web manufacturing process to compensate a printing process using the same paper web, because indeed, the information obtained by the profile measurement devices is used as feedback to a controller to control upstream actuators. In this respect, we point out that contrary to the examiner’s findings (answer, e.g., pages 4-5 and 12-13), the use of actuator, profile measuring device and controller combinations in the printing process would control the profile of the paper web in that process without regard to the profile information of the paper web obtained and used during its manufacture.

On the basis of the disclosure that we find in Shakespeare, we are of the opinion that the examiner has not established as a matter of fact that, *prima facie*, Shakespeare identically describes each and every element of the claimed method of manufacturing and processing paper,

arranged as required by the appealed claims, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof within the meaning of § 102(e). *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Furthermore, we find no teachings in any of the other applied references which cure this difference between the claimed invention encompassed by the appealed claims as represented by appealed claim 1 and the teaching of Shakespeare, and the examiner has not pointed to such teachings in those references. Thus, the applied references do not provide a factual foundation establishing that, *prima facie*, some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Accordingly, in the absence of a *prima facie* case of anticipation and of obviousness, we reverse the grounds of rejection advanced on appeal.

The decision of the examiner is reversed.

Remand

Pursuant to our authority under 37 CFR § 41.50(a)(1),⁴ we remand this application to the examiner to consider whether certain disclosure in the written description in appellants' specification constitutes an admission of the state of the art. This disclosure appears to

⁴ Effective September 13, 2003; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004). This remand is not for the purpose of further consideration of a rejection advanced on appeal, and accordingly, the provisions of 37 CFR § 41.50(a)(2) do not apply.

acknowledge that certain paper machines are known which provide cross direction shrinkage curve profiles (page 8, ll. 13-18), and that it is a practice of “[p]aper factories [to] establish a data record for every produced roll” of the characteristics of that roll, which “data records serve as a basis for further converting and also as investigational material in the event of customer complaints,” and the characteristics can be determined to the extent of “each produced ‘square meter’” (page 8, l.

Appellants further acknowledge in the specification German patent document DE 199 18 399 A1 (page 4, ll. 3-10). Appellants state that in the process disclosed in this document, characteristics of a paper web are determined from a roll thereof, and the so measured characteristics are utilized in compensating the printing process by setting the drive control to achieve uniform paper web profiles during printing (*id.*). Appellants made this document of record in the information disclosure statement filed March 5, 2001 (Paper No. 2). We find no translation of this document in the record.

It seems reasonable to us that if one of ordinary skill in the art would have known that a manufacture data record of paper web characteristics, including cross direction shrinkage curve profiles, which are obtained during manufacture is available for a roll of paper web and apparently used “for further converting” of the paper web on the roll, and that paper web profiles are useful information for controlling at least a part of a printing operation, it would have been *prima facie* obvious for this person to have used the manufacturer’s data records for that purpose. *See, e.g., Dow Chem., supra; In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider at least the disclosure in appellants’ specification noted above as well as a translation of DE 199 18 399 A1, along with any other applicable prior art the examiner deems appropriate, and determine whether a new ground or grounds of rejection

of the appealed claims based on prior art should be entered for purposes of further prosecution of the appealed claims.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.*, MPEP§ 1211 (8th ed., Rev. 2, May 2004; 1200-30).

Reversed

Remanded

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHARLES F. WARREN)	
Administrative Patent Judge)	

Todd T. Taylor
Taylor & Aust, P.C.
142 S. Main St.

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P.O. Box 560
Avilla, IN 46710