

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEF GOTTLING
and GODBER PETERSEN

Appeal No. 2005-0812
Application No. 09/792,609

ON BRIEF

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Josef Gottling et al. appeal from the final rejection of claims 1 through 6, all of the claims pending in the application.¹

THE INVENTION

The invention relates to a rotary printing machine.
Representative claim 1 reads as follows:

1. A rotary printing machine for printing a web of printing material which is fed through the machine in a plane, said machine comprising

¹ Claim 6 has been amended subsequent to final rejection.

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a side wall;

a plurality of printing unit cylinders mounted on said side wall, said cylinders being arranged one above another and having respective axes which lie in a common plane which is inclined at an obtuse angle to the plane of the web, at least one of said printing unit cylinders lying on each side of the plane of the web; and

an image-setting device arranged adjacent to one of the printing unit cylinders and wholly within the obtuse angle.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Williams et al. (Williams)	5,103,731	Apr. 14, 1992
Fadner	5,129,321	Jul. 14, 1992
Guaraldi et al. (Guaraldi)	5,813,336	Sep. 29, 1998
Schneider et al. (Schneider)	5,878,666	Mar. 09, 1999
Marquez et al. (Marquez)	5,943,956	Aug. 31, 1999
Fuhrmann et al. British Patent Application (Fuhrmann)	2,323,177	Sep. 16, 1998

THE REJECTIONS

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Schneider and Guaraldi.

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Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Schneider, Guaraldi and Marquez.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Schneider, Guaraldi and Williams.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Schneider and Guaraldi and Fuhrmann.

Attention is directed to the main and reply briefs (filed April 21, 2004 and August 30, 2004) and the answer (mailed June 30, 2004) for the respective positions of the appellants and the examiner regarding the merits of these rejections.²

DISCUSSION

Fadner, the examiner's primary reference, pertains to lithographic printing assemblies. For purposes of the appealed rejections, the examiner focuses on the embodiment shown in

² In the final rejection (mailed September 18, 2003), claims 1 through 6 also stood rejected on the grounds of obviousness-type double patenting. As this rejection is not restated in the answer, we assume that it has been withdrawn by the examiner (see Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)), presumably in light of the terminal disclaimer filed subsequent to final rejection on December 22, 2003.

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Figure 2. The printing assembly 60 illustrated therein comprises a printing cylinder 10, a blanket cylinder 66, an inking system 62, a dampening system 64, and what reasonably might be called an image setting device composed of a scraper 44, a hydrophilic powder hopper 30, an oleophilic material delivery drum 35 and a radiant fusing heater 38. Figure 2 shows (1) that the printing and blanket cylinders are arranged one above another on one side of a web of printing material 68 and have respective axes which lie in a common plane inclined at an obtuse angle to the plane of the web, and (2) that the image setting device (scraper 44, hopper 30, drum 35 and heater 38) is arranged adjacent to the printing cylinder and wholly within the obtuse angle.

As conceded by the examiner (see page 8 in the answer), Fadner's printing assembly 60, and specifically its printing and blanket cylinders, do not respond to the limitation in claim 1 requiring at least one of the printing unit cylinders which are arranged one above another with respective axes lying in a common plane inclined at an obtuse angle to the plane of the web to lie

on each side of the plane of the web.³ To overcome this deficiency, the examiner looks to Guaraldi.

Guaraldi discloses a printing unit operable to print on both sides of a web. To this end, the unit includes upper and lower printing and blanket cylinders (see Figures 1, 3 and 4) arranged as set forth in appealed claim 1, i.e., one above another and having respective axes which lie in a common plane inclined at an obtuse angle to the plane of a printing web with at least one cylinder lying on each side of the plane of the web.

In proposing to combine Fadner and Guaraldi to account for the printing cylinder arrangement specified in claim 1 and missing in Fadner, the examiner submits that it would have been obvious to one of ordinary skill in the art "to construct the invention of Fadner with printing unit cylinders on each side of the web, as taught by Guaraldi et al., in order to be able to print on both sides of the web at the same time" (answer, page 5).

³ Although Fadner's Figure 2 shows an unnumbered printing cylinder which is on the opposite side of the web from the printing and blanket cylinders and has an axis that defines with the printing cylinder axis a common plane inclined at an obtuse angle to the plane of the web, the unnumbered cylinder and the printing cylinder are not arranged "one above another" as recited in claim 1.

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Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id.

In the present case, the advantage alleged by the examiner to justify the proposed combination of Fadner and Guaraldi does not stand up to close scrutiny. More particularly, the examiner has not explained, and it is not evident, why a person of ordinary skill in the art would have found it obvious to reconstruct the Fadner printing assembly to include the printing cylinder arrangement taught by Guaraldi in order to print on both sides of a web at the same time when this objective could be far more easily accomplished by simply using the Guaraldi apparatus. Moreover, given the structural differences between the printing cylinder arrangements respectively disclosed by Fadner and Guaraldi, the location of Fadner's "image setting device" within a reconstructed printing assembly would be unduly speculative. In this regard, neither Fadner nor Guaraldi expresses any appreciation of the space saving advantages attributed in the

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appellants' specification (see pages 2 and 3) to the image setting device location defined in claim 1.⁴

In this light, it is apparent that the only suggestion for combining Fadner and Guaraldi in the manner advanced by the examiner stems from hindsight knowledge impermissibly derived from the appellants' disclosure. As the examiner's application of Schneider, Marquez, Williams and/or Fuhrmann does not cure this shortcoming, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 1 and dependent claim 2 as being unpatentable over Fadner in view of Schneider and Guaraldi, the standing 35 U.S.C. § 103(a) rejection of dependent claim 3 as being unpatentable over Fadner in view of Schneider, Guaraldi and Marquez, the standing 35 U.S.C. § 103(a) rejection of dependent claim 4 as being unpatentable over Fadner in view of Schneider, Guaraldi and Williams, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 5 and 6 as being

⁴ Although Figure 9 of the Guaraldi reference depicts an image setting unit mounted with respect to printing and blanket cylinders, the appellants and the examiner agree that this unit is not arranged wholly within an obtuse angle as recited in claim 1, and the examiner makes it clear that Guaraldi is not relied on in the rejection to teach a particular location for an image setting device (see page 6 in the main brief and page 8 in the answer).

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unpatentable over Fadner in view of Schneider and Guaraldi and Fuhrmann.

SUMMARY

The decision of the examiner to reject claims 1 through 6 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

JPM/gjh

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