

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW PERKINS
and
OLIVER M. REYES

Appeal No. 2005-1224
Application No. 10/087,897

ON BRIEF

Before KIMLIN, GARRIS and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7 and 13-20. Claims 8-12 have been withdrawn from consideration.

Claim 1 is illustrative:

1. In a machine for inflating and sealing air-filled packing cushions:

a roll of prefabricated film material having two layers which are sealed together to form a longitudinally extending

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inflation channel near one edge of the material, rows of chambers extending across the material, flow passageways interconnecting the chambers in each of the rows, and inlet passageways extending between the inflation channel and one of the chambers in each of the rows;

a pair of spaced apart, horizontally extending rollers on which the roll of film material rests;

an air injector which is connected to a source of air, positioned below the rollers, and extends in an upward direction for injecting air into the inflation channel and chambers to inflate the cushions;

a sealing unit for forming a longitudinally extending seal across the inlet passageways after the cushions are inflated; and

means for feeding the film material in a generally downward direction from the roll past the inflation tube and the sealing unit.

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

Larson et al. (Larson)	4,017,351	Apr. 12, 1977
Skalsky et al. (Skalsky)	4,936,079	Jun. 26, 1990
Murakami	5,581,983	Dec. 10, 1996
Simhaee	6,423,166 B1	Jul. 23, 2002

Appellants' claimed invention is directed to an apparatus for inflating and sealing air-filled packing cushions. The apparatus comprises a pair of spaced apart, horizontally extending rollers for supporting a roll of film having two layers that are sealed together, an air injector positioned below the rollers for injecting air into the inflation channel formed by the two layers, and means for feeding the film from the pair of

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spaced apart rollers in a downward direction past the air injector.¹ According to appellants, the claimed machine "is an important improvement over the prior art in that it provides a very compact machine in which the roll of film material is easily installed and the cushions flow from the machine in a downward direction where they are most easily used or collected" (page 4 of principal brief, third paragraph).

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

(a) claims 1, 4, 7, 16, 17 and 20 over Simhae in view of Skalsky;

(b) claims 2, 3, 5 and 6 over the stated combination of references further in view of Larson;

(c) claims 13-15 over the references cited in (b) above; and

(d) claim 18 over Simhae in view of Skalsky further in view of Murakami.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find

¹ There is no antecedent basis for the language "the inflation tube" in the last line of claim 1. While it appears that the language is referencing the "air injector," an appropriate amendment should be made upon return of this application to the examiner.

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that the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

Although Simhaee, like appellants, discloses a machine for making air-filled cushions from a roll of film having two layers sealed together, the examiner concedes that Simhaee fails to disclose the presently claimed pair of spaced apart, horizontally extending rollers on which the roll of film rests, as well as means for feeding the film material in a generally downward direction from the roll past the air injector tube and the sealing unit. The examiner cites Skalsky for teaching a pair of rollers for supporting a roll of film. Neither Simhaee nor Skalsky teaches the claimed means for feeding the film in a generally downward direction past an inflation tube and a sealing unit. Indeed, the apparatus of Skalsky does not comprise an air injector. Also, Figure 5 of Simhaee, cited by the examiner, shows the film being fed in the upward direction. According to the examiner,

[I]t would have been obvious to the skilled person in the art to have visualized a horizontally arranged machine with the roll of material positioned on one side of the machine when viewing the page of the schematic sideways or a vertically arranged with the roll of material positioned at the top of the machine

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when viewing the page of the schematic upside down
[sentence bridging pages 5 and 6 of Answer].

We appreciate the effort made by the examiner in determining what would have been obvious to one of ordinary skill in the art. However, the flaw in the examiner's reasoning is that it sets forth what one of ordinary skill in the art could have done to arrive at the claimed invention, rather than what would have been suggested by the applied prior art. It is well settled that the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we concur with appellants that the requisite teachings of the prior art to support a rejection under § 103 are lacking.

The additional disclosures of Larson and Murakami, cited by the examiner for various other claimed features, do not remedy the deficiencies of the combined teachings of Simhaee and Skalsky discussed above.

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In conclusion, based on the foregoing, we are constrained to reverse the examiner's rejections.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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BEVERLY PAWLIKOWSKI)	
Administrative Patent Judge)	

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