

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JAMES A. SIMMONS JR.

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Appeal No. 2005-1980  
Application No. 10/373,385

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ON BRIEF

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 15 and 31 to 36, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates generally to a dunnage conversion machine and method for producing a dunnage product from sheet stock material, and more particularly, to an improved machine and method for producing a void-fill dunnage product from a sheet stock material (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claims 1 and 31, the independent claims under appeal, read as follows:

1. A dunnage conversion machine for converting sheet stock material into dunnage product, comprising a forming assembly and a feeding/fixing assembly downstream of the forming assembly, the feeding/fixing assembly advancing the sheet a stock material from a supply thereof along the forming assembly, whereby the feeding/fixing assembly cooperates with the forming assembly to cause inward folding and crumpling of lateral edge portions of the sheet stock material to form a strip of dunnage having laterally spaced apart folded edge portions, wherein the feeding/fixing assembly includes laterally spaced-apart feeding/fixing members that engage respective laterally spaced apart folded edge portions to feed the sheet stock material through the machine and to fix the folded edge portions in a folded state.

31. A dunnage conversion machine for converting sheet stock material into a dunnage product, comprising a conversion assembly for withdrawing the sheet stock material from a supply thereof and inwardly folding and crumpling lateral edge portions of the stock material to form a strip of dunnage having laterally spaced apart folded crumpled edge portions.<sup>[1]</sup>

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<sup>1</sup>The examiner should determine if the "conversion assembly" limitation of claim 31 invokes means-plus-function treatment. If the "conversion assembly" limitation of claim 31 invokes means-plus-function treatment the examiner should determine if claim 31 is a "single means claim."

(continued...)

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mansfield	5,527,255	June 18, 1996
Lencoski et al. (Lencoski)	6,035,613	Mar. 14, 2000
Waechter	6,113,525	Sept. 5, 2000

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<sup>1</sup>(...continued)

Without the term "means," a claim element is presumed to fall outside means-plus-function strictures. See Sage Prods. Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997). That presumption collapses when an element lacking the term "means" nonetheless relies on functional terms rather than structure or material to describe performance of the claimed function. See AI-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1314, 1318, 50 USPQ2d 1161, 1167 (Fed. Cir. 1999).

A "single means claim" is a claim drafted in "means-plus-function" format yet reciting only a single element instead of a combination. In re Hyatt, 708 F.2d 712, 713, 218 USPQ 195, 196 (Fed. Cir. 1983). Paragraph six of 35 U.S.C. § 112 sanctions the use of the means-plus-function format for combination claims only. Id. See generally O'Reilly v. Morse, 56 U.S. 62, 112-113 (1854); General Elec. Co. v. Wabash Appl. Corp., 304 U.S. 364, 371, 37 USPQ 466, 469 (1938) ("A patentee may not broaden his product claims by describing the product in terms of function.").

The statutory basis for the rejection of a "single means claim" is the requirement of the first paragraph of 35 U.S.C. §112 that the enabling disclosure of the specification be commensurate in scope with the claim under consideration. In re Hyatt, 708 F.2d at 714, 218 USPQ at 197. The long-recognized problem with a single means claim is that it covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor. Id. Thus, a "single means claim" is properly rejected for what used to be known as "undue breadth," but which has since been appreciated as being, more accurately, based on the first paragraph of 35 U.S.C. § 112. Id.; see also In re Borkowski, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970).

Claims 1 to 6, 9 to 15 and 31 to 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lencoski in view of Waechter.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lencoski in view of Waechter and Mansfield.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed December 22, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed November 23, 2004) and reply brief (filed February 24, 2005) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of

claims 1 to 15 and 31 to 36 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the obviousness rejection of claims 1-6, 9-15, 31-36 as being unpatentable over Lencoski in view of Waechter (answer, pp. 3-4), the examiner (1) set forth the pertinent teachings of Lencoski; (2) ascertained<sup>2</sup> that the feeding/fixing members 40, 41 of Lencoski are not laterally spaced apart fixing members as claimed; (3) set forth that "Waechter shows the concept of having spaced apart feeding/fixing members 33 to perform an operation during the feeding of a web;" and (4) concluded that it would have

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<sup>2</sup>After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

been obvious to one of ordinary skill in the art at the time of the invention to provide Lencoski with laterally spaced apart feeding/fixing elements as taught by Waechter as an alternative design choice to fold spaced apart sections of the workpiece.

The appellant argues that the applied prior art does not suggest the subject matter of claims 1 and 31. We agree. In our view, the teachings of Waechter would not have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Lencoski so as to arrive at the claimed subject matter. In that regard, Waechter's folding members 33 used to fold a cardboard blank into a hinged-lid packet for cigarettes would not have provided any suggestion, motivation or incentive for an artisan to have modified the cushioning conversion machine of Lencoski as set forth in the rejection under appeal.

The only possible suggestion for modifying Lencoski in the manner proposed by the examiner to arrive at the claimed subject matter stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows

that we cannot sustain the examiner's rejections of claims 1 and 31, and claims 2 to 15 and 32 to 36 dependent thereon.<sup>3</sup>

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<sup>3</sup>We have also reviewed the reference to Mansfield applied in the rejection of claims 7 and 8 but find nothing therein which makes up for the deficiencies of Lencoski and Waechter discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 15 and 31 to 36 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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