

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DANIEL H. BURNETT,  
KENNETH E. GIUNTA, DONALD E. JOHNSTON,  
ARTHUR H. KAHN, ANTHONY G. POLETTO  
and HARRY RAMOS

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Appeal No. 2006-0456  
Application No. 10/410,778

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ON BRIEF

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Before HAIRSTON, BARRY, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-24, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a quad roll decurler wherein the degree of curl can be adjusted (specification, pages 1 and 6).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A quad-roll curl control apparatus comprising:
  - first, second, third, and fourth rolls configured to form first and second nips;
  - the first nip comprising the first and third rolls;
  - the second nip comprising the second and fourth rolls;
  - respective bearings supporting ends of the first and second rolls;
  - the third and fourth rolls each having a substantially incompressible surface;
  - the first and second rolls each having a compressible surface into which the third and fourth rolls selectively penetrate, respectively;
  - a curl adjuster connected to the first and second nips to control the selective penetration of the first and second roll compressible surfaces by the third and fourth roll substantially incompressible surfaces; and
  - a gate member in communication with the first and second nips, the gate member sending sheets to one of the first and second nips for application of respective types of curl.

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

Young	4,632,533	Dec. 30, 1986
Baruch	5,084,731	Jan. 28, 1992
Kuo et al.	5,848,347	Dec. 8, 1998

Claims 1-13 and 22-24 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Young in view of Kuo and Baruch.

Claims 14-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Kuo.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 3, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed April 28, 2005) for the appellants' argument thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Argument which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1-13 and 22-24 as being unpatentable over Young in view of Kuo and Baruch. We begin with independent claims 1 and 22.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 3) is that "Young does not teach the first, second, third and fourth rolls which are configured in a substantially linear formation, the first and second rolls surfaces which are compressible and the curl adjuster member connected to the first and second nips to control the selective penetration of the first and the second roll compressible surfaces by the third and the fourth rolls." To overcome these deficiencies of Young, the examiner turns to Baruch for a teaching of a sheet decurler having rollers arranged in a substantially linear formation. The examiner additionally relies upon Kuo for a teaching of rollers with compressible surfaces and for a teaching of a curl adjuster for adjusting the amount of curl induced by the nip.

Appellants' position (brief, page 5) is that the examiner has not shown four rolls configured in a substantially linear formation, and that Baruch forms two nips using three rollers. Appellants submit (brief, page 6) that the examiner has not identified any suggestion in the references to combine the various features to arrive at the claimed invention. It is asserted (brief, page 7) that the examiner has pointed to nothing in the prior art that would suggest any advantage to adding a

fourth roller in Baruch thereby creating two nips that do not share a common roller.

From our review of the record, we find, for the reasons which follow, that an artisan would not have been motivated to modify Young in view of Baruch and Kuo to arrive at the claimed invention, as advanced by appellants.

In Young, the nip is offset so that the baffle 203 and surface 204 reverse bends the sheet for straightening (col. 5, lines 56-58). It is further disclosed (col. 6, lines 8-11) that "[t]he decurler includes off-set nips from a vertical plane that in combination with output baffles apply reverse bending to the sheets in order to straighten them." From the disclosure of Young that the structure of the off-set nips and baffles causes the decurling to occur, we find that an artisan would not have been motivated to replace the off-set nips with rollers in a substantially linear formation, as advanced by the examiner.

We are not persuaded by the reasoning provided by the examiner (answer, page 4) that "simplicity in design the curl control apparatus and to permit more precise controlling of the amount of decurling on a printed medium," because we have no evidence that more precise control of the decurling would occur. The reasons provided by the examiner do not provide a motivation

for making the combination. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para- Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Kuo does teach making the decurler of Young adjustable, as set forth by the examiner. However, Kuo discloses (col. 10, lines 52-54 and column 4) that there is provided a compact dual decurler mechanism that provides a single straight paper path for achieving bi-directional decurling capability. From the disclosure of a compact decurler with offset rollers, having a single straight paper path, we find that an artisan would not have been motivated by the teachings of Kuo to make the decurler of Young in a substantially linear formation. Thus, because Kuo does not make up for the deficiencies of Baruch, we find that the

teachings of the prior art fail to suggest the language of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) is reversed. We additionally reverse the rejection of claim 22 because independent claim 22 also recites that the four rolls are in a substantially linear formation. The rejection of independent claim 22 under 35 U.S.C. § 103(a) is therefore reversed. As claims 2-13, 23 and 24 depend from claims 1 and 22, the rejection of claims 2-13, 23 and 24 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 14-21 under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Kuo. From our review of Young, we find that the reference is silent as to the adjustability of the decurler. From the disclosure of elastomer-layered drive roller 204 and 304 and pinch rollers 202 and 302 (col. 7, lines 22-24, 39 and 40) we find that Kuo discloses both compressible and substantially incompressible rolls. From Kuo's disclosure (col. 4, lines 28-33 and col. 10, lines 21-23) we find a teaching of providing adjustability of the two decurling nips. However, we find from the disclosure of Kuo (col. 7, lines 44-46) that the axes of elastomeric drive rolls 302 and 304 are fixed with respect to the side frames 230 and that the opposing pinch shafts 202 and 302 are connected to the

end caps 232. It is further disclosed that the pinch shafts can be moved together up and down with respect to the drive rolls (col. 7, lines 42-46). It is additionally disclosed that all of the up and down movements of the end caps 232 are driven by cam shaft 205 (col. 7, lines 52-56), and that (col. 10, lines 54-57) the dual decurler mechanism consists of two pairs of drive roll and pinch shaft and a camming mechanism for controlling their engagements.

From the disclosure of Kuo that all of the up and down movements of the end caps, which hold the pinch rollers, are driven by the cam shaft 205, we agree with appellants that Kuo does not disclose that the drive roll 304 supports pinch roll 302. To find that the drive roll supports the pinch roll we would have to resort to speculation, which we decline to do.

From all of the above, we find that although Kuo suggests providing the decurler of Young with a mechanism for adjusting the amount of curl induced by a nip and compressible/substantially uncompressible rolls, we find no suggestion of making the compressible roll support the uncompressible roll. Accordingly, we find that even if we combined the teachings of Young and Kuo, the resultant structure would fall short of meeting the limitations of independent claim

14. The rejection of claims 14-21 under 35 U.S.C. § 103(a) is therefore reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-24 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
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	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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STUART S. LEVY	)	
Administrative Patent Judge	)	

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