The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-0774
Application No. 09/952,349

ON BRIEF

Before FRANKFORT, OWENS and NAPPI, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 6 through 10. Claims 14 through 16, the only other claims remaining in the application, stand allowed. Claims 2 through 5 and 11 through 13 have been canceled.

Appellant's invention relates to a method for winding a continuously advancing yarn into a yarn package with an even mass distribution of the yarn so as to obtain a uniform density

package. More specifically, it is noted on page 4, lines 1-14, of the specification that

> The method of the present invention establishes a relationship between the stroke modification function and the mass distribution. In this connection, a mass distribution of the yarn is predetermined on a hypothetically wound, ideal yarn package. From the hypothetically wound, ideal yarn package with a predetermined mass distribution of the yarn, the stroke modification function is determined from the distribution of the reversal points on the hypothetically wound, ideal yarn package. This stroke modification function is used to produce the yarn package being wound. The special advantage of the invention lines in that it is possible to wind the end regions of the yarn package with a defined mass distribution of the yarn.

A further understanding of the invention can be derived from a reading of independent claims 1 and 6, a copy of which appears in the Appendix attached to appellant's brief.

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

Mayer et al. (Mayer)	6,065,712	May 23, 2000
Lieber et al. (Lieber)	6,283,401	Sep. 4, 2001

Claims 1 and 7 through 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mayer.

Claims 1 and 6 through 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lieber.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted anticipation rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we make reference to the answer (mailed January 29, 2004) for the examiner’s reasoning in support of the rejections, and to appellant’s brief (filed November 10, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

With regard to both the rejection of claims 1 and 7 through 10 based on Mayer and the rejection of claims 1 and 6 through 10 based on Lieber, the only issue presented for our consideration on appeal is whether the claimed methods reflected by appellant's independent claims 1 and 6 are "inherent" in the operation and use of the respective apparatus described by Mayer and Lieber for their intended purpose. It is by now well settled that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by probabilities or possibilities. The mere fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See, In re

Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

While the desire in the yarn winding processes described in both Mayer and Lieber is to obtain a stable package build, a uniform package density, as well as satisfactory unwinding characteristics during a later further processing step, neither of the applied patents achieves their desired results by using a method of winding exactly like that defined in appellant's claims on appeal. In the claimed invention, the stroke modification function (Z) which is utilized to vary the length of the transverse stroke of the traversing yarn guide (3) is determined from a predetermined mass distribution (F) of the yarn on a hypothetically wound ideal yarn package. As noted particularly in claim 1, the mass distribution (F) of the yarn on the hypothetically wound ideal yarn package is "computed by the steps of predetermining a desired value of the mass distribution ($F_{desired}$) from predetermined winding parameters (E) and then computing the mass distribution (F) while maintaining the limits of the desired value of the mass distribution ($F_{desired}$)." While both Mayer and Lieber periodically alter the length of the

transverse stroke of a yarn guide to modify the amount of yarn deposited at the package edge regions adjacent the yarn guide reversal points, neither Mayer nor Lieber describes using a predetermined mass distribution (F) of the yarn on a hypothetically wound ideal yarn package as the starting point to determine a stroke modification function (Z), or the computation of such a mass distribution (F) in the manner required in the claims on appeal. Nor do we see that those aspects of appellant's claimed method are necessarily present in the apparatus or processes disclosed in Mayer and Lieber.

Mayer specifically focuses on acceleration and/or deceleration of the yarn guide over the reversal length so as to modify the amount of yarn deposited in the package edge regions, and expressly notes (col. 1, lines 47-51) that such corrected yarn deposit takes place in the edge regions "irrespective of a stroke modification and irrespective of the length of the transverse stroke." Lieber approaches the problem in an entirely different way by relying on a modified stroke cycle that ensures that the yarn reversal points are substantially evenly distributed in the end regions of a cross-wound package. To that end, Lieber notes in column 2, lines 57-62, that to obtain an as

precise package buildup as possible, the actual diameter of the package and the angular position may be continuously determined, so that the traversing yarn guide drive is controlled by a control device as a function of the comparison between the position of the starting reversal point and the position of the ending reversal point. Again, as we indicated above, neither Mayer nor Lieber describes using a predetermined mass distribution (F) of the yarn on a hypothetically wound ideal yarn package as the starting point to determine a stroke modification function (Z), or the computation of such a mass distribution (F) in the manner required in the claims on appeal.

As for the examiner's positions that the empirical assumptions arrived at in Mayer and Lieber through trial and error somehow equate to appellant's computing of a mass distribution on a hypothetically wound ideal yarn package, and that a previously wound package in Mayer or Lieber can serve as a "hypothetically wound ideal yarn package," we find such assertions to be without merit. A trial and error approach does not equate to predetermined computation of a mass distribution (F) of the yarn on a hypothetically wound ideal yarn package like that described in appellant's specification and required in the

claims on appeal. Moreover, a prior yarn package wound in a trial and error process would not be viewed by one of ordinary skill in the art as the type of predetermined "hypothetically wound ideal yarn package" used by appellant in carrying out the processes of the present application.

Based on the foregoing, we conclude that the examiner has not met his burden of establishing a *prima facie* case of anticipation based on inherency with regard to either of the Mayer or Lieber patents. Thus, we will not sustain the examiner's rejection of claims 1 and 7 through 10 under 35 U.S.C. § 102(b) as being anticipated by Mayer, or that of claims 1 and 6 through 10 under 35 U.S.C. § 102(e) as being anticipated by Lieber. It follows that the decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ROBERT E. NAPPI	)	
Administrative Patent Judge	)	

Comment [jvn1]: Type or Paste Address

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