

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 MIKA VILJANMAA AND
REIJO PIETIKAINEN

Appeal No. 2006-1557
Application No. 10/220,514

ON BRIEF

Before WALTZ, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2-16 and 19-28, which are all of the claims pending in this application. **We have jurisdiction pursuant to 35 U.S.C. § 134.**

BACKGROUND

Appellants' invention relates to a method and apparatus for processing a wide paper or board web wherein the web is divided into at least two part-webs in the paper machine immediately downstream of a head box, a web former, a press or a drying

section. An understanding of the invention can be derived from a reading of exemplary claim 19, which is reproduced below.

19. A method for processing a wide paper or board web in which a wide base web is manufactured and processed in a paper or board machine in a least one processing stage before the finished product is separated by being cut transversely from the web on the production line, comprising:

dividing the base web at least once in the paper or board machine to form at least two part-webs, the dividing occurring before the finished product is separated by being cut transversely from the web on the production line and before the processing stage; and

guiding at least one of the part-webs to at least one finishing stage, before the finished product is separated by being cut transversely from the web on the production line,

wherein the at least two part-webs are guided parallel

to or on top of each other and are divided immediately

downstream of a head-box, a web-former, a press, or a drying section.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Elger

6,391,157

May 21, 2002

(application filed Nov. 23, 1999)

Claims 2-16 and 19-28 stand rejected under 35 U.S.C.

§ 102(e) as anticipated by or, in the alternative, under

35 U.S.C. § 103, as being obvious over Elger.¹

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

§ 102(e) Alternative Rejection

¹ Smook, Handbook For Pulp & Paper Technologists, Vol. 2 (1992), pp. 228-29 was made of record by the examiner (answer, page 5) to substantiate the examiner's official notice of the fact that paper machines typically include a head box, former, press and dryer as set forth at page 2 of the final action. Appellants have not contested those factual assertions of the examiner in the briefs.

Anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. U.S. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). However, the law of anticipation does not require that the reference teach what the appellants teach in their specification, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Anticipation under this section is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

In the case before us, the examiner has determined that Elger discloses, expressly or inherently, a coating process and apparatus that meets every limitation of the invention set forth in the appealed claims. We agree for reasons set forth in the final rejection, the answer and below.

Claims 2-16, 19, 23 and 24

Appellants argue these claims together (brief, page 4). Thus, we select independent claim 19 as the representative claim on which we shall decide this appeal as to this claim grouping.

Appellants maintain that Elger divides or cuts the web at the output of a paper machine; that is, "subsequent to complete processing of the web 2, and this fact is repeated throughout Elger's specification" (brief, page 4), as opposed to in the paper machine itself, as claimed (brief, page 5).²

² Arguments not made in the briefs are not considered. See 37 CFR 41.37(c)(1)(vii).

We disagree for reasons stated by the examiner in the answer. As noted by the examiner at page 5 of the answer, Elger expressly describes cutting the web at a point upstream of or in a drying section of a paper machine. See column 3, lines 23-27 and column 7, lines 13-19) of Elger. As officially noticed by the examiner in the final action, the paper machine includes a head box, former, press, then a dryer. Thus, the description in Elger of cutting the web upstream of the dryer would have conveyed to one of ordinary skill in the art that Elger was in possession of a method wherein the raw web was cut or divided into part-webs at a location immediately downstream of either the head box, former or press, as required by claim 19. The description of the process and equipment conveyed by Elger embraces the claimed paper dividing location.³ Notwithstanding the use of "outlet" and "output" in a seemingly

³ See In re Schaumann, 572 F.2d 312, 316, 197 USPQ 5, 9 (CCPA 1978)(prior art preferred genus which disclosed limited species, inclusive of claimed species, constituted description of the claimed species within the meaning of 35 U.S.C. § 102(b)); In re Petering, 301 F.2d 676, 681, 133 USPQ 275, 280 (CCPA 1962) (prior art genus containing only 20 compounds inherently anticipated a claimed species within the genus because "one skilled in [the] art would . . . envisage each member" of the genus).

interchangeable manner at various locations in the text of Elger, it is clear from a review of the entirety of the patent disclosure that Elger employs those terms in a manner consistent with the definition furnished at column 3, lines 23-27 thereof. Accordingly, we agree with the examiner that representative claim 19 is anticipated by Elger and affirm the stated § 102(e) rejection of claims 2-16, 19, 23 and 24.

Claims 21 and 22

Appellants argue dependent method claims 21 and 22 as a group. Thus, we select claim 22 as the representative claim on which we shall decide this appeal for this grouping of claims. Appellants argue that Elger requires that the web is cut (divided) after it is dry whereas claim 22 requires that web dividing occurs at a location where the web contains a substantial amount of water; that is, at a location immediately downstream of a web former. We disagree with that argument.

As set forth above, the description in Elger of cutting the web upstream of the dryer conveys a method wherein the raw web is cut or divided into part-webs at a location immediately downstream of either the head box, former or press (which sections are all upstream of the dryer). Consequently, one of ordinary skill in the art reading that description of Elger would have envisioned cutting the web at a location after any of those limited number of upstream sections, including the former section as required by claim 22.

Thus, we shall also affirm the examiner's anticipation rejection of dependent claims 21 and 22, on this record.

Claims 20 and 25-28

Appellants argue these claims together (brief, page 6). Thus, we select independent claim 20 as the representative claim on which we shall decide this appeal as to this claim grouping.

Appellants (brief, page 6) argue that Elger cuts the web "at the output of the machine, i.e., outside of the paper machine, subsequent to complete processing of the raw paper web 2" (brief, page 6). In alleged contrast, appellants (brief, page 6) point to the claim 20 requirement for a "means for dividing the base web into at least two part-webs before the separation of the finished product by cutting it in a traverse manner from the web on the production line and before the final processing stage preceding separation." Appellants essentially maintain that Elger fails to teach the web-cutting (dividing) location, as required by the above-noted limitation of representative claim 20.⁴

⁴ Appellants (brief, page 6) do not argue that claim 20 requires a cutting device that patentably distinguishes over the cutting blades that appellants acknowledge to be disclosed in the drawing figure of Elger. See 37 CFR 41.37(c)(1)(vii).

The claim limitation argued by appellants is in a means-plus-function format without setting forth the structure in the claim and therefore must be interpreted as limited to the corresponding structure described in the specification or the equivalents thereof consistent with 35 U.S.C. § 112, sixth paragraph. In re Donaldson Co., Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc).

Appellants refer to page 11, line 16 to page 12, line 9 of the specification and figure 5 of the drawings for alleged corresponding structure described in the specification. In this regard, we note that WO 01/65005 (published PCT/FI01/00210) was submitted as corresponding to the originally filed international application PCT/FI01/00210 that is the original specification of this national stage application. The referred to section of the specification (page 11, line 16 through page 12, line 9) is drawn to describing originally submitted drawing figures 6-10. Lines 4-9 of page 12 of that portion of the original specification discloses that the division of the web can take place at locations after the drying, calendering, or coating; that is, at locations downstream of the so called paper machine outlet argued by appellants. See, e.g., original drawing figure 5, which shows a cutter (19) at an "outlet end" of a "paper machine."

Consequently appellants' arguments predicated on an interpretation of the "means for dividing" limitation of claim 20 as differentiating over the cutter (4) of Elger based on the location for the cutter required by that claim limitation are misplaced.

Moreover, to the extent that appellants (reply brief) maintain that the “means for guiding” limitation⁵ of claim 20 requires that the “means for cutting” must be located at a location corresponding to the claim 19 locations, we do not find those arguments persuasive for the reasons set forth above with

⁵ Appellants do not argue that the “means for guiding” limitation of claim 20 requires structure that differentiates over Elger other than the argued (cutting) location requirement as argued in the briefs. Consequently, we need not further develop the record as to the scope of the “means” limitations of claim 20 in deciding this appeal given the arguments and issues before us for review. However, in the event of further prosecution of this subject matter before the examiner, the examiner should review the means-plus-function limitations presented in the claims to determine if the full scope thereof is reasonably determinable. This is especially so given that the original application specification was provided without an accompanying drawing figure 1, as referenced therein; that is, as part of the originally filed application. If the scope of the affected claims is not determinable within the meaning of the second paragraph of Section 112 and/or if support for the determined scope can not be found in the original application, the introduction of rejections under the second and/or first paragraphs of § 112 should be considered, as may be appropriate.

respect to our discussion of the examiner's anticipation rejection of claim 19.

It follows that we shall sustain the examiner's anticipation rejection of claims 20 and 25-28, on this record.

§ 103 Alternative Rejection

In view of the above discussion, we shall likewise sustain the examiner's § 103 alternative rejection over Elger since a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

While we find that Elger anticipates and hence renders the claimed method and apparatus prima facie obvious for the reasons outlined above, we further determine that one of ordinary skill in the art would have been led to the claimed process and apparatus by simply following the teachings of Elger to cut the web at an upstream location so that increased flexibility and

equipment cost savings in producing the paper is achieved as discussed by Elger (column 1, lines 36-46 and column 2, lines 3-12). Indeed, the advantages for processing a divided web as disclosed in Elger correspond to the advantages of the claimed invention, as referred to by appellants in the paragraph bridging pages 2 and 3 of the brief. Just as unexpected results can be persuasive of the non-obviousness of claimed subject matter, expected results, as here obtained, evidence the obviousness of the subject matter before us in this appeal.

For reasons set forth above and in the answer, appellants' arguments with respect to a lack of suggestion of the claimed subject matter in Elger simply miss the mark.⁶

Consequently, we shall also sustain the examiner's § 103 rejection, as to all of the rejected claims, on this record.

⁶ We are bound to consider the disclosure of each reference for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); and In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968). Concerning this matter, it is well settled that a reference must be considered in its entirety, and it is well-established that the disclosure of a reference is not limited to preferred embodiments or specific working examples contained therein. See In re Fracalossi, 681 F.2d 792, 794 n. 1, 215 USPQ 569, 570 n.1 (CCPA 1982); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976). Nor is it necessary that suggestion or motivation be found within the four corners of a reference. See In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

CONCLUSION

The decision of the examiner to reject claims 2-16 and 19-28 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103, as being obvious over Elger is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

THOMAS A. WALTZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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