

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 RICHARD A. BERGER, CLIFTON M. BUELL,
KEVIN IKE WILSON, R. DANIEL HICKMAN,
JOSE MARIA AGUILA PLASSA, JAVIER LLAVINA NADAL,
and BARRY JANEWAY

Appeal 2006-2640
Application 10/364,657
Technology Center 1700

Decided: November 9, 2006

Before GARRIS, WARREN, and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the Examiner finally rejecting claims 1 through 35 and 39, all of the claims in the Application.

Claim 1 illustrates Appellants' invention of a method of making a loaf of crustless, sliced bread from a rectangular prismatic loaf of bread, and is representative of the claims on appeal:

1. A method of making a loaf of crustless, sliced bread from a rectangular prismatic loaf of bread, the method comprising:

decrusting the bread by moving the loaf of bread longitudinally past cutting blades to remove the crust from four sides of the loaf of bread;

slicing the crustless bread by moving the loaf transversely past a plurality of blades to slice the loaf; and

packaging the loaf by moving the loaf longitudinally to a packaging station.

The references relied on by the Examiner are:

Duke	US 1,493,326	May 6, 1924
Van Poolen	US 2,669,377	Feb. 16, 1954
Mantelet	US 3,406,730	Oct. 22, 1968
Otto	US 4,195,098	Mar. 25, 1980
Koberlein	US 4,512,137	Apr. 23, 1985

http://web.archive.org/web/20021019181238/http://www.baking911recipes.com/bread_pullmanloaf.htm, pages 1-2 (10/2002) (*baking911recipes*)

The Examiner has advanced the following grounds of rejection on appeal:

claims 1 through 9, 18 through 20 and 24 through 28 under 35 U.S.C. § 103(a) as being obvious over Duke in view of Mantelet and Koberlein (Answer 3-5);

claims 10 through 17, 23, 29 through 35 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Duke in view of Mantelet and Koberlein, as applied above, further in view of Otto (Answer 5-6); and

claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over further in view of Duke in view of Mantelet and Koberlein, further in view of Otto, Van Poolen and *baking911recipes* (Answer 6).

We affirm.

We refer to the Answer and to the Brief and Reply Brief for a complete exposition of the positions advanced by the Examiner and Appellants.

OPINION

The principal issues in this appeal involve the first two steps specified in appealed independent claim 1: (1) moving a rectangular prismatic loaf of crusted bread longitudinally past cutting blades, that is, a plurality of such blades, to remove the crust from any four sides; and (2) moving the decrusted loaf transversely past a plurality of blades to slice the loaf. It is apparent from the plain language thereof that claim 1 does not, as appellants argue, require “simultaneously decrusting opposite sides of [sic] loaf” (Reply Br. 1). This requirement is found in appealed independent claim 4 which specifies, among others things, that in the decrusting step, the crusted loaf is moved “longitudinally between first and second blades to simultaneously remove crust from opposite first and second sides of the loaf, and moving the loaf past third and fourth blades to remove crust from third and fourth sides.” Appealed claim 24, directly dependent on appealed dependent claim 21 and indirectly dependent on claim 1, also contains this limitation.

The Examiner relies on Duke and Mantelet with respect to the decrusting and slicing steps, respectively, in each of the combinations of references applied. With respect to the decrusting limitation in claim 4, the Examiner states that

Duke discloses the decrusting step comprising moving the loaf longitudinally into contact with knife member to remove the crust from one side at a time (page 1, line

64). Although, Duke does not disclose removing the crust from opposite sides of the loaf at the same time, it would be obvious to remove the crust from two sides at a time rather than only one side in order to increase efficiency.

Answer 4-5; *see also* 7. The Examiner finds that Mantelet at col. 1, l. 24, would have disclosed “a method for slicing crustless bread,” and concludes that it would have been “obvious to cut the loaf in order to provide slices of crustless bread for use in making sandwiches” (Answer 4 and 7).

Appellants submit, with respect to claim 1, that the combination of Duke and Mantelet would not have taught “moving the loaf longitudinally to decrust it and transversely to slice it because” Mantelet “teaches moving the tool against the loaf, not moving the loaf transversely as claimed” (Reply Br. 1; *see also* Br. 8). With respect to claims 4 and 24, Appellants contend that the knife structure of Duke would not simultaneously remove crust from opposite sides of the loaf, and the Examiner has not established the motivation to modify the knife structure of the reference in this respect (Br. 9-10; *see also* Reply Br. 2).

We find that Duke would have disclosed a single knife blade **16** attached to a flat support such that “[t]he crusts from loaves of bread are cut by moving the same longitudinally over the support and against the cutting edge of the blade 16” (Duke page 1, ll. 31-51 and 64-69, and **Figs. 1-3**). Mantelet would have disclosed a device to slice, among other things, “crustless bread” in a “slicing device” having two sets of blades which are “driven in opposite directions . . . so that by lowering the multiblade tool on to an object to be sliced . . . a series of parallel slits may be cut” (Mantelet, e.g., col. 1, ll. 44-50, and col. 2, ll. 16-28, and **Figs. 1-3**). Mantelet further

discloses “a board for supporting the material to be sliced, . . . having grooves between parallel fins or webs for supporting the said material and adapted to receive the blades during the final stage of the downward displacement of the tool through the said material” (Mantelet, e.g., col. 1, ll. 51-63, col. 4, ll. 8-43, and **Figs. 3-5**).

On this record, we agree with Appellants. The teachings of each of Duke and Mantelet must be modified by one of ordinary skill in this art in order to arrive at the separate claimed method steps to which the references are individually applied. As stated by our reviewing Court, “when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.”

In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) (citing *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)). Here, the Examiner has not adduced either explanation or evidence establishing that one skilled in this art would have so modified the references.

We are of the opinion that one of ordinary skill in the art would have been led by the teachings Duke to urge a crusted loaf across the single blade attached to a support, turning the loaf until all desired sides are crustless. While this person could have modified the knife/support structure of Duke to include additional blades to “increase efficiency” as the Examiner contends, we find no suggestion or motivation in the record leading to a knife/support structure which removes crust from opposite sides of the loaf as required by claims 4 and 24. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the

modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784-85 (Fed. Cir. 1992).

This is also the case with the teachings of Mantelet. The reference teaches that the loaf of crustless bread is positioned between parallel fins or webs and the multiblade tool cuts the stationary loaf from top to bottom. The Examiner does not explain how this teaching corresponds to or suggests “slicing . . . by moving the loaf transversely past a plurality of blades” as claimed.

In the absence of an explanation or evidence establishing a suggestion or motivation to modify the teachings of Duke and of Mantelet, the Examiner has not established a *prima facie* case of obviousness. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (“The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.”). Accordingly, we reverse the grounds of rejection under 35 U.S.C. § 103(a) advanced on appeal.

The Examiner's decision is reversed.

Remand

We remand the application to the Examiner for consideration of issues raised by the record. 37 CFR § 41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The Examiner refers to Appellants' admission that an "inter-wrap machine" was known at the time the application was filed (Specification 9:2-6) in responding to argument (Br. 10-11) with respect to the step of "moving the [crustless, sliced] loaf longitudinally to a packing station" specified in claim 1, appealed dependent claim 3, and claim 4 (Answer 7 and 8).

We note that Appellants further admit that a "decruster" that can perform the decrusting step specified in claims 4 and 24 and a "slicer" that can perform the slicing step in claims 1 and 4 were known at the time the application was filed (Specification 8:22-26 and 28-30).¹

The record, however, does not contain explanation or evidence establishing that one of ordinary skill in the art with knowledge of these kinds of machines and armed with the knowledge in the art would have

¹ See *In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611-12, (CCPA 1975) ("We see no reason why appellants' representations in their application should not be accepted at face value as admissions that Figs. 1 and 2 may be considered "prior art" for any purpose, including use as evidence of obviousness under § 103. By filing an application containing Figs. 1 and 2, labeled prior art, *ipsissimis verbis*, and statements explanatory thereof, appellants have conceded what is to be considered as prior art in determining obviousness of their improvement.") (citation omitted).

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combined such machines to arrive at the claimed methods encompassed by the appealed claims.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider the knowledge in the art, as admitted by Appellants as well as developed from patent and non-patent prior art documents and other evidence, *see, e.g.*, *Pro-Mold & Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996) (“In this case, the reason to combine [the references] arose from the very nature of the subject matter involved, the size of the card intended to be enclosed.”), and determine whether a new ground or grounds of rejection of one or more of the pending claims in this application under 35 U.S.C. §§ 102(b) and 103(a) should be entered on the record.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REVERSED AND REMANDED

clj

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