

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 MICHAEL ZOECKLER and TARCISIO SANTORO

Appeal No. 2006-2895
Application No. 09/971,469
Technology Center 3700

HEARD: November 14, 2006

Before FRANKFORT, OWENS and HORNER, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-12, all of the claims pending in the application.

We reverse.

BACKGROUND

The appellants' invention relates to a method of preparing reinforced carton blanks. Claim 1, reproduced below, is representative of the subject matter on appeal. A copy of all of the claims can be found in the appendix to the appellants' brief.

1. A method of preparing reinforced carton blanks, comprising:
 - moving a series of carton sheets toward an engaging position along a processing path, with each of the sheets having a desired grain orientation to enable an optimal number of press repeats per carton sheet;
 - moving at least one strip of a reinforcing material toward registration with each of the sheets, with the at least one strip of reinforcing material having a grain orientation aligned with the grain orientation of the carton sheets;
 - applying an adhesive material between each sheet and an associated strip of reinforcing material;
 - attaching each sheet to its at least one associated strip of reinforcing material; and
 - cutting the attached carton sheet and the associated reinforcing material to form carton blanks.

The examiner relies upon the following as evidence of unpatentability:

Anderson	2,502,117	Mar. 28, 1950
Mitchard	4,946,540	Aug. 07, 1990
Goldsborough <i>et al.</i> (Goldsborough)	5,163,891	Nov. 17, 1992
Walsh	5,794,812	Aug. 18, 1998

The following rejections are before us for review.

1. Claims 1, 5, 6, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
2. Claims 1-6 and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Walsh.
3. Claims 2, 4, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Mitchard.
4. Claims 2, 4, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Walsh and Mitchard.
5. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Goldsborough.
6. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Walsh and Goldsborough.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the examiner's answer (mailed June 29, 2004) and the supplemental examiner's answer (mailed March 31, 2006) for the examiner's complete reasoning in support of the rejections and to the appellants' brief (filed May 28, 2004), reply brief (filed

August 30, 2004), and supplemental reply brief (filed May 25, 2006) for the appellants' arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellants' specification and claims, the applied prior art, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, the examiner has failed to make a prima facie case of obviousness.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The examiner can satisfy this burden by showing that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references such that they would teach or suggest the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See id.* at 1073, 5 USPQ2d at 1598. 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). The examiner must articulate reasons for the examiner's decision. *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or

suggestion to combine references relied on as evidence of obviousness. *Id.* at 1343, 61 USPQ2d at 1433.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art. *See e.g., In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1337-38 (Fed. Cir. 2006) (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *Id.* at 987-88, 78 USPQ2d at 1336 (*citing In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000)).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

In the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Anderson, the examiner determined that Anderson does not disclose cutting both the reinforcing liner and the carton sheet. The examiner found, however, that the cutting/slitting mechanism of Anderson is fully capable of cutting both sheets and would do so if the adjustable slot cutters were not properly aligned with the pre-cut slots in the carton sheets. Supp. Answer, p. 4. The

examiner found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to cut both the reinforcing liner and the carton sheet by the slitting mechanism to insure the creation of separate panels to be later folded. Supp. Answer, p. 4. The examiner further explained,

One of ordinary skill in the art would recognize the advantages provided by the construction of the slitting device of Anderson given a range of foreseeable problems which may occur such as an insufficiently pre-cut blank, misalignment of blank and reinforcing material, inaccurate location of the reinforced blank immediately prior to the slitting operation, etc. (note Anderson provides guide 462), that would result in cutting of the carton sheet 35. (Supp. Answer, p. 9.)

Even if we were to find that the knives of Anderson are capable of cutting through the carton sheet, this capability does not provide the requisite motivation for a prima facie case of obviousness. *See e.g., In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (“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.”) The examiner attempts to distinguish *Fritch* from the present case, because in *Fritch* the examiner’s finding of obvious was based on a combination of two references, and in the present case the finding of obviousness is based on Anderson alone. Supp. Answer, p. 7. We find this to be a distinction without a difference. In both cases, a modification to the prior art was required in order to render the claimed invention obvious. As such, in either case the examiner is required to make a showing of a suggestion, teaching, or motivation from the prior

art or common knowledge of one of ordinary skill in the art that would have led to the modification.

In an attempt to further articulate his obviousness finding, the examiner found that “[o]ne of ordinary skill in the manufacturing industry of packaging materials would easily recognize the advantage of reducing the number of cutting steps during a process as a simple expedient.” Supp. Answer, p. 7. The examiner provided no evidentiary support for this purported advantage, and based on the teachings of Anderson to start with a pre-cut blank, we find that one having ordinary skill in the art would not have been motivated, absent hindsight, to start with uncut carton sheets.

The examiner further found that “the invention to Anderson is precisely engineered to accommodate for a redundancy cutting procedure to insure cutting through both layers takes place. Without such redundancy the cutting of only the reinforcing layer would not permit the subsequent folding process to occur.” Supp. Answer, p. 7. We do not see any teaching or suggestion in Anderson for using the knives (447, 453) for redundancy cutting of the carton blank, nor does the examiner point to any such teaching or suggestion.

The examiner further argued that there is implicit motivation for the construction as taught by Anderson which would result in cutting the carton sheet 35 because Anderson is directly concerned with severing the material to allow the subsequent folding/erecting operation to take place for a range of differently dimensioned blanks, and because the knives extend to the depth of the thickness of the entire blank. Supp. Answer, pp. 8, 9. The examiner further explained that the cutting step of Anderson performs the same function as the appellants’ cutting step, *viz*, for providing a flap in the carton blank. Supp. Answer, pp. 10.

“The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

While we agree that both Anderson and the claimed method are directed at solving the same problem of creating a lined carton blank, the nature of the problem to be solved in this case is not enough to provide a showing of implicit motivation. Anderson clearly suggests to an ordinary artisan to start with a pre-cut blank. The examiner does not point to any knowledge of one of ordinary skill in the art that would have led one to modify the method of Anderson to cut the blank at the end. Rather, because Anderson starts its method with a pre-cut carton blank, there would be no need to cut the blank again after applying the liner to it.

The examiner appears at one point to convert the obviousness rejection into an inherent anticipation rejection, when he states, “Speculative foreseeable circumstances such as misalignment of the cutting knives, loading of the wrong type of pre-cut blank, insufficiently slotted pre-cut blank would all result in *anticipating* the claimed process.” Supp. Answer, p. 10 (emphasis added). The examiner also contends that the step of cutting through the carton sheet would “*inherently* have taken place” given one of these circumstances. Supp. Answer, p. 11 (emphasis added).

The appellants argue that Anderson does not inherently anticipate claim 1, because none of the speculative foreseeable circumstances mentioned by the examiner would inevitably occur. Supp. Reply Brief, p. 3. The appellants further note that in order for any of these circumstances to occur, one of ordinary skill in

the art would have to operate the Anderson apparatus in a manner contrary to that disclosed in the patent, and as such, the circumstances are not inevitable. Supp. Reply Brief, p. 4. For the reasons provided by the appellants, we agree that the disclosure of Anderson does not inherently anticipate the claimed method.

With regard to the examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Walsh, the examiner determined that Anderson does not disclose applying the adhesive directly to the reinforcing material, however, Walsh teaches a method of applying a reinforcing strip/liners 130 to a sheet/box blank 128 using a spraying device 134 prior to registration of the two sheets. Supp. Answer, p. 4. The examiner found that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teachings of Walsh in the invention of Anderson in order to produce a reinforced carton blank from a laminate for its reinforcing characteristics. Supp. Answer, p. 4.

We find that Walsh does not cure the deficiency of Anderson because Walsh also fails to teach or suggest the step of cutting both a carton sheet and a reinforcing material to form carton blanks. Walsh discloses forming a carton for holding a product, e.g., cereal, in which a continuous strip (128) of paperboard material is laminated to relatively narrow continuous strips (130) of a relatively flexible material and to a continuous film (136) of a relatively flexible fluid impervious plastic material. Walsh, col. 6, line 59 – col. 7, line 17. As shown in Figure 11 of Walsh, the end of continuous strips (130) and the portions of the continuous film (136) are folded back upon themselves so that when the laminated material is passed through a die cutter; only the paperboard material (128) is cut. Walsh, col. 7, lines 22-27. As such, we find that neither Anderson nor Walsh,

when considered alone or in combination, teach or suggest the claimed step of “cutting the attached carton sheet and the associated reinforcing material to form carton blanks.”

The remaining prior art references relied upon by the examiner do not cure the deficiencies of Anderson and Walsh. In particular, Goldsborough discloses a printing station that is used as part of a box forming system (10). The system (10) of Goldsborough merely prints information on the carton blank (24) prior to the blank entering the die cutter station (18). Goldsborough, col. 3, lines 14-25. Goldsborough does not teach or suggest a system in which a strip of reinforcing material is adhered to a carton sheet prior to cutting the reinforcing strip and carton sheet to form carton blanks, as required by claim 1. Mitchard discloses a method for applying a liner to a carton blank, in which the method commences with a pre-cut blank (10). Mitchard, Figure 1, col. 4, lines 12-16. A liner (11) is aligned with the blank (1) and then adhered to the blank (10). Mitchard, col. 6, lines 2-6 and 36-46. There is no disclosure in Mitchard as to whether the liner is cut. As such, these prior art references do not render the method of claim 1 obvious. Accordingly, we do not sustain the examiner’s rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Anderson taken alone or in combination with Walsh.

The rejections of the remaining dependent claims 2-12 rely upon the underlying rejection of independent claim 1. For the reasons provided *supra*, we also do not sustain the examiner’s rejection of these claims. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

CONCLUSION

The decision of the examiner to reject claims 1-12 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

LINDA E. HORNER
Administrative Patent Judge

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