

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONRAD V. ANDERSON,
JOHN R. DAVID, and
RONALD STEELMAN

Appeal 2007-0487
Application 09/759,993
Technology Center 1700

Decided: September 28, 2007

Before EDWARD C. KIMLIN, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's final rejection of claims 1, 4, 5, 8-13, 17, 18, and 21-25. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

Appellants present an application for a patent directed to a method and apparatus for removing an adhesive film from a substrate. Appellants indicate that the disclosed apparatus is useful for removing an adhesive film from a substrate having a large area, such as a building or a side of a truck, etc. (Specification 2 and 3). Claim 22¹ is reproduced below:

22. An apparatus for removing adhesive film from a substrate, the apparatus comprising:

a winding roll attached to a frame, the winding roll comprising a longitudinal axis;

a motor operably connected to the winding roll for rotating the winding roll about its longitudinal axis; and

a support roll rotatably attached to the frame, the support roll located a fixed distance from the winding roll, wherein the winding roll and the support roll are arranged on the frame such that tension applied to an adhesive film during removal of the adhesive film from the substrate is transferred to the substrate through the support roll, and wherein the support roll is not located at a release line of the adhesive film.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Appollonio	FR 2 643 487 A1	Aug. 24, 1990
Stadtmueller	US 5,891,297	Apr. 6, 1999
Kuroda	US 5,891,298	Apr. 6, 1999

Claims 1, 4, 8-13, 17, 21, 22 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Apollonio (French Patent Publication 2 643 487). Claims 1, 5, 8-10, 12, 18, and 22 stand rejected under

¹ The copy of claim 22 presented in Appendix A of the Brief erroneously includes the words “as compression” in the penultimate line thereof.

35 U.S.C. § 102(b) as being anticipated by Kuroda (U.S. Patent No. 5,891,298). Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Apollonio. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Apollonio in view of Stadtmueller.²

§ 102(b) Rejections over Apollonio or Kuroda

Appellants bring this appeal with the concession that the rejected claims pertaining to each of the separate anticipation rejections stand or fall together as a group (Br. 6). We note that the Brief is incorporated by reference in the Second Reply Brief filed June 12, 2006 (Second Reply Br. 1). Thus, we select claim 22 as the representative claim on which we shall decide this appeal as to each of the anticipation rejections.

The apparatus of representative appealed claim 22 includes a winding roll and a support roll. Each of these rolls are attached to a frame and separated from each other by an unspecified fixed distance. A motor is connected to the winding roll for rotating same and the support roll is rotatably attached to the frame. The apparatus is asserted to have the functional capability of transferring tension applied to an adhesive film during film removal to a substrate from which the adhesive film is removed, as compression through the support roll during the use of the apparatus for removing an adhesive film from the substrate.

Apollonio describes a structure for removing film from a substrate that includes framework, a winding reel (24) and a support roll (34) which rolls are separated from each other by a distance. Thus Apollonio describes

² The obviousness rejection of claim 23 was presented in a new ground of rejection presented in the Answer mailed April 10, 2006 after a Remand dated September 30, 2005.

a film removing apparatus including structure substantially corresponding to Appellants' claimed apparatus as noted above and further discussed by the Examiner (Supplemental Answer 6).

Appellants do not contend that Apollonio does not describe structure corresponding to the recited motor of representative claim 22.³ Rather, Appellants seemingly base their argument against the Examiner's anticipation determination on the contention that Apollonio's described film removal apparatus does not disclose arranging the winding roll and support roll on the frame thereof such that the structure would be capable of transferring tension applied to a film during film removal to the substrate holding the film, as required by representative claim 22.

Similarly, concerning the Examiner's anticipation rejection over Kuroda, the Examiner has found that Kuroda describes an apparatus for removing adhesive tape (film) from a substrate. The apparatus was found to include a take-up (winding) roll (19) and a compressive (support) roll (8) attached to framework of the tape peeling unit (16), with the rolls located a distance apart from each other (Supplemental Answer 4, 5, and 7-9; Kuroda, Fig. 8 and Fig. 13). Appellants do not contest the anticipation rejection over Kuroda based on the motor limitation of representative claim 22. Rather, the thrust of Appellants' argument against the Examiner's rejection as applied to representative claim 22 basically centers on the functionality specified for the claimed apparatus as expressed in the wherein clause of claim 22.

³ Arguments not made in the Brief are considered to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). In any event, we note that the implied winding function associated with Apollonio's described winding reel (24) would have inherently conveyed/described a motor (either hand operated, electrical or mechanical) was part of or connected to the winding reel of Apollonio.

Appellants have not specifically argued that each of the applied references do not have structure corresponding to the representative claim 22 requirements for a winding roll attached to a frame with the winding roll including a longitudinal axis as well as a support roll rotatably attached to the frame and located a fixed distance from the winding roll.

Thus, the principal issue raised in this appeal by the opposing positions of the Examiner and Appellants is: Have Appellants identified reversible error in the Examiner's anticipation rejection by counsel's assertions that the film removal structure of Apollonio or the tape removal apparatus of Kuroda do not describe structure, including an arrangement of the support roll and winding roll of each of these references on framework such that the apparatus of each reference would be expected to have the capability of functioning with the application of force in a manner as set forth in the wherein clause of representative 22; that is, such that the applied prior art apparatus would not have been capable of transferring (applying or distributing) any tension applied to the adhesive film during the removal thereof to the substrate via a support roll?

We answer this question in the negative and affirm the Examiner's separate anticipation rejections over Apollonio or Kuroda for the reasons stated herein and in the answer.

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention, either explicitly or inherently. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It is also well-settled that an Examiner may shift the burden to Appellants by showing how a prior art structure substantially corresponds to a claimed structure such that it would be reasonable to

presume that the prior art structure would also possess a claimed function employing an inherency theory. *See In re Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432.

In a case such as this where Appellants present claims with a functional feature for establishing novelty in the claimed subject matter that reasonably may, in fact, be an inherent characteristic of applied prior art devices, it is incumbent and appropriate that Appellants bear the burden to prove that the applied prior art devices do not in fact possess the functional characteristics that Appellants rely on for establishing novelty. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1658 (Fed. Cir. 1990); *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1977); *In re Glass*, 474 F.2d 1015, 1019, 176 USPQ 529, 532 (CCPA 1973); *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971); *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226 228-29 (CCPA 1971). After all, Appellants have taken the risk of attempting to establish novelty of the claimed device based on a recited functionality for their apparatus, a functionality that their apparatus is alleged and claimed to possess, and which functionality the applied prior art is argued to lack.

In this regard, the Patent and Trademark Office is not in a position to build and comparatively test products for an asserted functionality, especially where, as here, the functionality, in question, is seemingly tied to a particular manner of use of the recited structural elements (recited rolls and the arrangement thereof on a frame) rather than clearly indicating a further restriction to the type of recited elements and/or arrangement of the recited structural elements (rolls on a frame).

Here, Appellants have not satisfied this burden by the arguments furnished in the Briefs.

In further regard to this matter, we note that the claim recitation “wherein the winding roll and the support roll are arranged on the frame such that tension applied to an adhesive film during removal of the adhesive film from the substrate is transferred to the substrate through the support roll, and wherein the support roll is not located at a release line of the adhesive film” (cl. 22) identifies the utility of removing adhesive film from a substrate as a potential use of the claimed apparatus frame and rolls. This utility is a use that Apollonio and Kuroda fairly disclose for their apparatus frame and rolls as a reading of these references relates and as noted above and in the Supplemental Answer. As for the recited and repeatedly argued transfer of tension applied to the film during removal thereof from a substrate to the substrate through the support roll, we again note that representative claim 22 is drawn to apparatus not a method of using same. Furthermore, Appellants have not substantiated their arguments with evidence. For example, Appellants have not submitted a force diagram prepared by a recognized expert showing how the spaced rolls on a frame constructed according to claim 22 necessarily are capable of acting on a substrate during an adhesive removal operation with transfer of at least some tension experienced by a film as a [compressive force] to the substrate via the rolls according to the claim 22 requirements whereas the spaced rolls and frame of the applied references are incapable of so transferring tension applied to a film no matter how used during adhesive removal.⁴

⁴ Indeed, the tension acting on an adhesive film being pulled from a substrate would seemingly result from a force being applied to the film and

As for the argued lack of a pivoting ability or pivoting elements for the framework in Apollonio, as variously asserted in the Brief and Reply Briefs, we note that representative claim 22 does not require or specify any particular structure, including pivot members, for mounting the frame and rolls for use in removing an adhesive film from a substrate. Rather,

which applied force is resisted by the adhesive power of the adhesive tending to hold the film to the substrate. This is not unlike how pulling on an affixed rope results in tension in the rope to the extent that the affixture is capable of resisting the pulling force. The pulling or peeling force applied to the film would also act on the substrate through the pulling action on the adhesive film just like a pulled affixed rope would, in turn, apply a pulling force that acts on the structure to which the rope is affixed. In this regard, we interpret the claimed functional limitation regarding transfer of tension experienced by the film to a force acting on the substrate via a spaced support roll as requiring a support roll or rolls that are capable of applying some force or load to the substrate during a film removal operation using the winding roll.

In the event of further prosecution of this subject matter before the Examiner in this application or a continuing application, however, the Examiner should consider whether or not a § 112, first and/or second paragraph rejection should be introduced with regard to any claims broadly reciting this claimed transferring tension functionality. In this regard, Appellants may wish to submit a force diagram comparing how all of the forces act and are distributed for the prior art apparatus during film removal and for the claimed apparatus by a recognized expert to establish what apparatus feature of a subcombination of a frame and two rolls, as disclosed and claimed by Appellants, differs from the applied prior art such that a tension experienced by a film during peeling is transferred as a [compressive] force to the substrate (as opposed to applying a pulling force on the substrate) when using Appellants' subcombination frame and rolls, but not when using the applied prior art subcombination frame and rolls. In this regard, it would seem that any dissipation (transfer) of film tension would appear to result in less film tension, not a conversion of the film tension to another force, such as a compressive force. In any event, representative claim 2 is drawn to an apparatus, not a method of removing a film.

representative claim 22 is drawn to a subassembly of a frame and associated rolls without requiring a combination thereof with mounting elements for arranging the frame and rolls relative to a substrate.

In other words, much of Appellants' argument with respect to both of the applied references as far as representative claim 22 is concerned seems to be directed at a supposed distinction between how the frame and associated rolls would ultimately be arranged for use relative to a substrate from which a film is to be removed rather than spelling out how the claimed subassembly of a frame and spaced rolls are patentably distinguishable over the applied references. Accordingly, these arguments are not accorded any persuasive weight.

In light of the above, we determine that the Examiner has presented a prima facie case of anticipation based on the described subject matter of either Apollonio or Kuroda that has not been rebutted by Appellants. Hence, we affirm both of the Examiner's anticipation rejections, on this record.

Concerning the Examiner's separate obviousness rejections of claims 24 and 23 over Apollonio and Apollonio in view of Stadtmueller, respectively, Appellants base their arguments for patentability of these dependent claims on the asserted lack of a teaching or suggestion of the apparatus features of claim 22, from which claims 23 and 24 depend (Br. 12 and 13; Reply Br. 8 and 9). Hence, for the reasons stated above and in the Supplemental Examiner's Answer, we shall also affirm the Examiner's obviousness rejections.

CONCLUSION

The decision of the Examiner to reject claims 1, 4, 8-13, 17, 21, 22 and 25 under 35 U.S.C. § 102(b) as being anticipated by Apollonio (French

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Patent Publication 2 643 487); to reject claims 1, 5, 8-10, 12, 18, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kuroda (U.S. Patent No. 5,891,298); to reject claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Apollonio; and to reject claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Apollonio in view of Stadtmueller is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

tf/ljs

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