

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN R. MONTEITH,  
MITCHELL G. STERN, and CLYDE N. THARP

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Appeal 2007-2508  
Application 10/640,071  
Technology Center 2800

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Decided: January 24, 2008

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Before ANITA PELLMAN GROSS, ROBERT E. NAPPI,  
and MARC S. HOFF, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) (2002) of the final rejection of claims 40 and 42 through 45.

We affirm the Examiner's rejections of these claims.

INVENTION

The invention is directed to a printer and method of printing which makes use of plural rolls of material to be printed on. See pages 1 and 2 of

the Appellants' Specification. Claim 40 is representative of the invention and reproduced below:

40. Method of printing, comprising: providing an elongate thermal print head and a cooperable platen roll for printing on printable webs, providing first and second rolls of printable first and second webs having different characteristics, mounting the rolls on a common axis so that either one of the webs can be advanced into printing cooperation with the print head along parallel web paths transverse to the elongate print head, wherein the elongate print head and the platen roll span the web paths, selecting either the first web or second web to be printed, advancing only the selected web of one web roll to between the print head and the platen roll while the other web remains on the roll, and using only the portion of the elongate print head along the path of the selected web to print on the printable face of only the selected web.

#### REFERENCES

Voissem	US 3,371,776	Mar. 5, 1968
Ota	US 5,139,353	Aug. 18, 1992
Ota	US 5,222,291	Jun. 29, 1993

#### REJECTIONS AT ISSUE

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ota ('353) in view of Ota ('291). The Examiner's rejection is on pages 3 and 4 of the Answer.

Claims 42 through 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ota ('353) in view of Voissem. The Examiner's rejection is on pages 4 and 5 of the Answer.

Throughout the opinion, we make reference to the Brief (received November 6, 2006) the Reply Brief (received February 23, 2007) and the Answer (mailed February 13, 2007) for the respective details thereof.

## ISSUES

Appellants contend that the Examiner's rejection of claim 40 under 35 U.S.C. § 103(a) is in error. Appellants argue that Ota '353 does not teach using an elongated printing head. Further, the Appellants state:

The claimed method is practiced using an elongate print head and a cooperable platen roll so that the print spans the web path. The claimed method includes selecting either the first web or the second web to be printed, and advancing only the selected web of one web roll between the print head and the platen while the other web remains on the roll. The claimed method does not rely on the complicated method of Ota '353 which includes threading two webs between the path of a shuttling carriage-mounted-print head. The claimed method avoids threading both webs through the printer.

Brief 12-13.

Appellants assert that Ota '291 does not cure these deficiencies. Brief 13. Finally, on page 2 of the Reply Brief, Appellants assert that the Examiner's proposed modification would render Ota '353 inoperative, as it would advance both rolls.

The Examiner finds that Ota '353 teaches a printer where there are two rolls of web material which can be printed on. Both webs are placed between a print head and a platen. The arrangement of the printer is such that the webs can be individually advanced so that one web can be printed on and advanced while the other is not. Answer 3 and 4. The Examiner finds that Ota '291 teaches an elongated print head that can print using only

a portion of the print head and concludes that it would have been obvious to combine this teaching with the printer of Ota '353. Answer 4.

Thus, with respect to claim 40, the issue before us on appeal is whether the Examiner erred in determining that the combination of the Ota references teaches a method of printing with a print head that cooperates with a platen roll wherein one of two print web materials is selected to be printed on and only that print web material is advanced while the other stays on the roll.

Appellants contend that the Examiner's rejection of claims 42 through 45 under 35 U.S.C. § 103(a) is in error. Appellants state that independent claim 42 recites a printer with two holders for retaining a pair of web rolls in side by side relationship. Appellants argue that Ota '353 teaches a printer with two rolls but does not teach the claimed holder and that Voissem is not combinable with the printer. Appellants reason that Voissem is "related solely to [a] holder for use in shipping rolls of webs" and that there is no motivation to combine the references. Brief 13.

In response, the Examiner states, on pages 6 and 7 of the Answer:

In this case, although Voissem does not explicitly teach the roll holder is useful in printing applications, Voissem teaches that the holder is an advantageous method of connecting two side-by-side web rolls and that the rolls may be rotated on the holder in order to dispense the web. See column 3, lines 7-10. Since the secondary reference teaches that its holder is advantageous for holding two rolls side-by-side while permitting dispensing, one having ordinary skill in the art at the time of the invention would find it obvious to use the hubs of Voissem to mount the rolls of Ota '353 in the claimed, side-by-side relationship as discussed above.

Initially, we note that on page 14 of the Brief, Appellants make statements that separately identify claims 43-45. These statements recite

features of the claims and state that the features are not taught by the references. We do not consider these statements to be separate arguments under 37 C.F.R. § 41.37(c)(1)(vii) as they merely point out what the claims recite. Accordingly, we group claims 43 through 45 with claim 42<sup>1</sup>.

Thus, the issue for us on appeal, with respect to claims 42 through 45 is whether the Examiner erred in determining that one skilled in the art would have found it obvious to combine the Ota '353 printer with Voissem's teaching of a holder for two webs of paper to be dispensed.

#### PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has recently stated that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1739.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A]

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<sup>1</sup> We note that though claims 43 through 45 were not separately argued, we nonetheless find that the limitations of these claims are taught by Voissem. See Facts 12 and 13.

court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

*Id.* at 1740. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742.

#### FINDINGS OF FACT

1. Ota ‘353 teaches a printer having a single platen and having multiple paper feeds. Abstract.
2. The printer has two rolls of paper, a receipt sheet item 55 and a journal sheet 56, supported inside the printer. Unwound portions of both of these sheets pass between the platen and the print head. Ota ‘353, col. 3, ll. 28-35.
3. The printer has two tape feed/stop mechanisms which make use of a pressure roller, to press the paper against the platen roller. These pressure rollers can be selectively applied to advance the paper. When the pressure roller is not applied, a clamp is applied to prevent the paper from advancing. Ota ‘353, col. 4, ll. 16-40, 47-50.
4. The printer can print on paper from either of the rolls of paper individually or can print on both rolls of paper. Only the paper being printed on is advanced. Ota ‘353, table 1, col. 5.
5. Ota ‘353 teaches using a print head mounted on a carriage which traverses the width of the paper to be printed. Col. 1, ll. 18-20, 28-33.

6. If only one tape is selected for printing, the printer head carriage only traverses the width of the one tape to be printed on, i.e., only over a portion of the total area which can be printed on by the print head. Ota '353, col. 9, ll. 14-36.
7. The Examiner finds that Ota '291 teaches an elongated thermal print head which can print using only a portion of the print head along the path of the selected web. Appellants have not contested this finding. Answer 4, Appeal Brief 13, Reply Brief 2.
8. Voissem teaches a plug for supporting the core of a roll of paper. Abstract, col. 1, ll. 11-15.
9. Voissem teaches that the plug is useful in holding two rolls of paper together when being dispensed from a container. See figure 6, col. 3, ll. 5-10.
10. Voissem teaches that the plug to connect two rolls of paper has a body portion (item 10) that fits in the cores of the paper rolls (i.e., it forms a shaft that is received in the central openings of the paper rolls). Col. 1, 48-55, see figures 1 and 6, items 8.
11. As shown in figure 6 of Voissem, there is one plug between the two rolls of paper (items 36) and two  $\frac{1}{2}$  plugs associated with horizontal panels (items 38) on either side of the combined rolls of paper.
12. As shown in figure 8, the width of the two rolls of paper accommodates the two  $\frac{1}{2}$  plugs and the center plug. Thus, the shaft of the center plug is shorter than the combined width of the paper rolls.
13. The center plug includes a flange item 20. See figure 6.

## ANALYSIS

### Rejection of claim 40 under 35 U.S.C. § 103(a)

Appellants' arguments have not persuaded us that the Examiner's rejection is in error. Claim 40 recites

mounting the rolls on a common axis so that either one of the webs can be advanced into printing cooperation with the print head along parallel web paths transverse to the elongate print head, wherein the elongate print head and the platen roll span the web paths, selecting either the first web or second web to be printed, advancing only the selected web of one web roll to between the print head and the platen roll while the other web remains on the roll.

Thus, the scope of the claim includes that either of the print webs can be printed on and advanced (paper drawn from) while the other web remains on the roll (not drawn from). The Examiner has interpreted this as being broad enough to encompass both webs spanning from the rolls to the platen, but only one web (the web being printed on) being advanced. Answer 6. We concur with this claim interpretation; we see no limitation, nor have Appellants identified any limitation, which precludes the Examiner's claim interpretation.

Appellants have not persuaded us that the Examiner erred in determining that the combination of the Ota references teaches a method of printing with a print head that cooperates with a platen roll wherein one of two print web materials is selected to be printed on and only that print web material is advanced while the other stays on the roll. Ota '353 teaches a printer with two rolls of paper to be printed on. Fact 2. The printer can print on one or the other roll of paper and only advances the paper from the roll being printed on (i.e., the paper on the roll not printed on is not advanced and thus stays on the roll). Fact 4. Ota '291 teaches an elongated print head

for use on printers. Fact 7. The Examiner has concluded, and the Appellants have not challenged<sup>2</sup>, that one skilled in the art would have found it obvious to combine the two references. Appellants' argument on page 2 of the Reply Brief that the proposed combination would be inoperative as "it would mean that both webs would be between the elongate thermal print head and the platen roll which span the web paths. Therefore, both webs would always be advanced even though according to the claimed method only one web at a time is to be advanced" is not persuasive. Ota '353 teaches that though both webs are between the print head and platen roller, the tape feed/stop mechanism operates to only advance the tape from the roll being printed on. Thus, we do not find that the combination would be inoperative. As Appellants have not persuaded us of error in the Examiner's rejection, we affirm the Examiner's rejection of claim 40.

Rejection of claims 42 through 45 under 35 U.S.C. § 103(a)

Appellants' arguments have not persuaded us that the Examiner's rejection is in error. Independent claim 42 recites a printer with two holders. Claim 42 recites the

first holder for retaining a pair of web rolls in side-by-side relationship on a common axis, each web roll being comprised of printable webs, the first holder including a shaft received in central openings in the web rolls, and second holder having hubs received in the central openings in the web rolls to mount the pair of web rolls and the first holder.

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<sup>2</sup> Appellants' arguments on pages 12 and 13 of the Brief, and page 2 of the Reply Brief, discuss the features of the references individually and do not discuss the Examiner's findings regarding the combining of the references.

We find that Voissem teaches an arrangement for dispensing paper rolls where there are two holders. Fact 11. The first holder has a shaft, plugs items 8, which are received in the core of a roll of paper. Fact 10. The second holder includes two plugs and horizontal panels which hold the two rolls of paper connected by the holder. Fact 11. Thus, we find that Voissem teaches the holders as claimed. Further, Ota '353 teaches a printer that has two rolls of paper. Fact 2. While Ota '353 does not discuss the compartment that the paper rolls are stored in, one skilled in the art would have recognized that this compartment must be designed to dispense the paper from the rolls, so that the paper can be advanced as needed. Voissem teaches that the holders are useful in the dispensing of paper from rolls. Fact 9. One skilled in the art would have recognized that combining Voissem's holders for dispensing paper from paper rolls in the printer of Ota '353 is nothing more than using known elements for their known purposes, i.e. Voissem's holders are being used to perform the function for which they are designed, dispensing paper from a roll of paper. Thus, we do not find error in the Examiner's determination that one skilled in the art would have considered it obvious to combine the Ota '353 printer with Voissem's teaching of a holder for two webs of paper to be dispensed.

Accordingly, we sustain the Examiner's rejection of representative claim 42 and the claims grouped with claim 42, claims 43-45.

#### ORDER

The decision of the Examiner is affirmed.

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Application 10/640,071

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).

AFFIRMED

KIS

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