UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOTHAR SEBASTIAN, KLAUS SCHURMANN, HORST WEISS, WERNER THELEN, and JURGEN FRIGGER

Appeal 2007-4066
Application 10/402,246
Technology Center 3700

Decided: January 9, 2008

Before TERRY J. OWENS, HUBERT C. LORIN, and JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lothar Sebastian et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of Claims 1 and 3. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Claim 2 is canceled, and pending Claims 4 and 5 have been indicated by the Examiner as containing allowable subject matter.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' invention is a press for pressing a mat into a thin panel (e.g., particle board), using upper and lower press plates and having upper and lower press belts traveling through a press gap. The invention involves providing a plurality of rollers held against either the upper or lower belt, at an upstream portion of the intake mouth, and at least one roller held against the other of the belts at this upstream portion. The apparatus further has actuators connected to the rollers for setting a shape of the upstream portion of the intake mouth.

Claims 1 and 3, reproduced below, represent the subject matter on appeal:

> 1. A press for pressing a mat into a thin panel, the press comprising:
>
> a press frame;
>
> upper and lower press plates on the frame;
>
> upper and lower press belts having confronting lower and upper stretches defining a press gap extending in a horizontal and longitudinal transport direction and respectively running below and above the upper and lower press plates;

> respective arrays of roller rods between each press plate and the respective stretch;
>
> upper and lower flexible intake plates juxtaposed respectively above and below upstream ends of the lower and upper stretches of the belts and defining therewith a downstream portion of an intake mouth flaring upstream;
>
> means including actuators connected to the intake plates for setting a shape of the downstream portion of the intake mouth;
>
> a plurality of rollers braced against one of the upper and lower stretches of the belts at an upstream portion of the intake mouth immediately upstream of the downstream portion of the intake mouth;
>
> at least one roller braced against the other of the stretches at the upstream portion; and
>
> means including actuators connected to the rollers for setting a shape of the upstream portion of the intake mouth.
>
> 3. The panel press defined in claim 1 wherein the plurality of rollers are arrayed parallel to one another along a substantially circular arc.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Gawlitta	US 6,439,113 B1	August 27, 2002

The following rejection is before us for review:

1. Claims 1 and 3 stand rejected under 35 U.S.C. § 102(e) as anticipated by the Gawlitta patent.

ISSUES

The issue before us is whether Appellants have shown that the Examiner erred in finding that the subject matter of Claims 1 and 3 is anticipated by Gawlitta. The focus will be on certain claim elements directed to rollers being positioned at the upstream end of the intake mouth, and whether or not the cited reference discloses those elements.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellants disclose that a double-acting actuator 22 is connected between upper rollers 13 and lower roller(s) 14, and that this actuator serves to set the shape of a precompression zone 17. (Specification, p. 8, ll. 19-22; Fig. 1). No other actuators are disclosed as being connected to the rollers in the "SPECIFIC DESCRIPTION" section of the application.

2. Appellants disclose that the rollers 13, 14 positioned at an upstream portion of the intake mouth can be used to establish a

precompression zone at this upstream portion of the intake mouth. (Specification, p. 5, ll. 1-5; p. 8, ll. 3-7).

3. The double-acting actuator 22 as illustrated in Appellants' Fig. 1 is a piston and cylinder arrangement connected to upper and lower jaws (no reference numerals assigned) which carry rollers 13, 14 thereon. (Fig. 1).

4. Appellants' piston and cylinder arrangement and connection to upper and lower jaws is substantially identical in appearance to that disclosed in Fig. 1 of the Gawlitta reference. (Fig. 1 of Appellants' application; Fig. 1 of Gawlitta).

PRINCIPLES OF LAW

Anticipation of a claim exists when each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990). In particular, when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or

inherently possess characteristics attributed to the claimed product. *In re Spada*, 911 F.2d at 708; *In re Best*, 562 F.2d at 1255.

Patent application claims are given their broadest reasonable interpretation during the application process, for the simple reason that before a patent is granted the claims may be readily amended, for the purpose of distinguishing cited references, or in response to objections raised under Section 112, as part of the examination process. *Burlington Industries, Inc. v. Quigg*, 822 F.2d 1581, 1583 (Fed. Cir. 1987). This broadest reasonable construction is to be assessed in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Further, in making this assessment, embodiments or features present in the specification will not be read into the claims in determining their scope. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*); *see also In re Trans Texas Holdings Corp.*, 498 F.3d 1290 (Fed. Cir. 2007).

ANALYSIS

Appellants contend that the rejection of Claim 1 under 35 U.S.C. § 102(e) as being anticipated by Gawlitta is erroneous for three reasons, summarized as follows:

(1) the roller blocks on plates 27, 28, in Gawlitta serve solely to guide and position the belts, and have no influence on the treatment of the workpiece (Appeal Br. 6);

(2) the roller blocks of Gawlitta form nothing like the precompression zone of Appellants' invention (Appeal Br. 6); and

(3) the rollers disclosed in Gawlitta are not individually adjustable against the steel belts, and serve only to guide the steel belts, and that there are not individual actuators for the rollers, but only one for all of them. (Reply Br. 1, 2).

The Examiner's Answer correctly notes that the assertions in (1) and (2) above are directed to subject matter that is not present in Claim 1. (Answer 7). Claim 1 recites that one plurality of rollers and at least one other roller are braced against upper and lower stretches of the belts at an upstream portion of the intake mouth, which is immediately upstream of the downstream portion of the intake mouth. Claim 1 further sets forth that "means including actuators" are connected to the rollers for setting a shape of the upstream portion of the intake mouth.

The claim contains no recitation dictating that the rollers are somehow positioned or constructed and arranged to influence treatment of the workpiece or to form a precompression zone, as argued by Appellants. Claim 1 goes no farther than requiring that the rollers and actuators operate to set the shape of the upstream portion of the intake mouth. Appellants have admitted that the rollers in the Gawlitta patent perform this same function.[1] These contentions thus have no probative value in assessing the correctness of the rejection of Claim 1.

[1] "The rollers on the[se] roller blocks … are instead fixed on the plates 27

The argument raised in (3) above is also not fully commensurate in scope with Claim 1. The claim recites, "means including actuators connected to the rollers for setting a shape of the upstream portion of the intake mouth." This language does not restrict the scope of the claim to require that each of the rollers is individually adjustable, nor that each roller has an individual actuator associated therewith, which are the features argued by Appellants as allegedly distinguishing the claimed invention over the Gawlitta patent.[2]

Notwithstanding that Claim 1 is broader in scope than Appellants have argued, Appellants have raised an issue as to whether the Gawlitta patent discloses plural actuators, in that Claim 1 recites "means including actuators". We must therefore determine the meaning of "actuator" in this context, and whether the Gawlitta patent discloses the provision or use of more than one actuator.

The specification discloses that, "[A] double-acting actuator 22 connected between the upper rollers 13 and lower roller(s) 14 … serves to set the shape of the precompression zone 17." (Finding of Fact 1). The

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and 28 and function for establishing intake-mouth shape." (Appeal Br. 5)

[2] As an aside, we question whether such limitations, were they added to Claim 1, would find adequate description in the Appellants' Specification sufficient to meet the written description requirement in the first paragraph of 35 U.S.C. § 112. We see nothing in Appellants' Specification or drawing figures which discloses such features.

location of the "precompression zone" is at the claimed "upstream portion of the intake mouth". (Finding of Fact 2).

Passing reference is made to employing actuators[3], however, the double-acting actuator is the only embodiment actually illustrated, and is the only embodiment discussed regarding connection of the actuator to other structure, such that the rollers can be controlled.[4] Appellants specifically state that the double-acting actuator performs the claimed function of setting the shape of the upstream portion of the intake mouth. A reasonable interpretation of the claim term, "means including actuators", would therefore encompass the disclosed double-acting actuator.

The double-acting actuator is a piston and cylinder arrangement connected between jaws having the upper rollers and the lower rollers thereon, to move them in setting the shape of a "precompression zone" in the area between them.[5] (Findings of Fact 2, 3). In harmonizing this disclosure

[3] "Further actuators connected to the rollers set a shape of the upstream portion of the intake mouth." (Specification, p. 4, ll. 18-19); "The radius of curvature … is adjusted by the respective actuators in accordance with the thickness of the mat." (Specification, p. 5, ll. 16-18).

[4] No other actuators "connected to the rollers for setting a shape of the upstream portion of the intake mouth" are described in the "SPECIFIC DESCRIPTION" section of the Specification, nor are any such actuators illustrated. (Finding of Fact 1).

[5] The "upstream shape-setting system 11" as illustrated in Fig. 1 of the application is substantially identical (with the exception of the representation

with Claim 1, we conclude that the Specification supports an interpretation of the term "actuator" that would include an individual component or element of a piston and cylinder arrangement, such that the provision of a piston and cylinder arrangement is to be regarded as providing the claimed "means including actuators". Given the substantial identity between Appellants' upstream system 11 and the comparable elements shown in Fig. 1 of Gawlitta, we further conclude that the piston and cylinder arrangement in Gawlitta discloses the use of plural "actuators" in controlling the two sets of rollers in that device. *In re Spada*, 911 F.2d at 708; *In re Best*, 562 F.2d at 1255.

The Examiner has thus met the burden of establishing a prima facie case of anticipation with respect to Claim 1. As expressed herein, Appellants have not persuaded us that the invention set forth in Claim 1 contains any elements that are not disclosed by the Gawlitta patent. We will therefore affirm the rejection of Claim 1.

Claim 3 depends from Claim 1, and further requires that, "the plurality of rollers are arrayed parallel to one another along a substantially circular arc." (Appeal Br., Claims Appendix). The Examiner relies essentially on an assertion that this feature would be inherent in the Gawlitta device, due to the overall geometry of the intake plates and the belts against which the rollers bear. (Answer 5). Appellants counter with the assertion

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of the actual rollers) to the comparable construction in Fig. 1 of the Gawlitta patent. (Finding of Fact 2).

that this claim feature is clearly not shown in Gawlitta, and further contend that the rollers in Gawlitta are shown in a planar array.

Gawlitta does not explicitly disclose that the rollers in that apparatus will be arranged in a circular arc. By the same token, Gawlitta does not explicitly disclose that the rollers are to be positioned in a planar array. The limited detail that can be gleaned from Fig. 1 of Gawlitta appears to suggest a linear arrangement. Regardless, inherency can not be based on possibilities or probabilities, rather, the alleged inherent feature must *necessarily* be present in order to be properly asserted in an anticipation rejection under 35 U.S.C. § 102.

The Examiner has not presented persuasive evidence that the feature of Claim 3 discussed above would inherently be present in the Gawlitta apparatus. Accordingly, we will reverse the anticipation rejection lodged against Claim 3.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to establish that reversible error exists in the rejection of Claim 1 under 35 U.S.C. §102(e).

We conclude that Appellants have established that reversible error exists in the rejection of Claim 3 under 35 U.S.C. §102(e).

DECISION

The decision of the Examiner to reject Claim 1 is affirmed.

The decision of the Examiner to reject Claim 3 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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