

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW PERKINS, OLIVER M. REYES, PHILIPP
BORCHARD, and NICHOLAS P. DeLUCA

Appeal 2008-3716
Application 11/186,820
Technology Center 3700

Decided: December 19, 2008

Before JENNIFER D. BAHR, LINDA E. HORNER, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

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DECISION ON APPEAL

STATEMENT OF THE CASE

Andrew Perkins et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Appellants' counsel presented arguments for this appeal at an oral hearing on December 11, 2008.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

The claimed invention is to a machine for manufacturing a continuous production of pneumatically filled packaging pillows. (Specification ¶ 129.1.)

Claims 18 and 24, reproduced below, are representative of the subject matter on appeal.

18. Apparatus for use in inflating a plurality of inflatable chambers in a plastic film having a single longitudinally extending channel, the apparatus comprising:

a driving mechanism configured to cause the plastic film to be gripped at or near the longitudinally extending channel and drawn in a continuous and uninterrupted manner in a planar path;

an inflation mechanism positioned along the planar path comprising a source of inflation gas and an air outlet which together are capable of injecting inflation gas into the inflatable chambers as the plastic film is drawn along the path and through the inflation mechanism;

a sealing mechanism positioned along the planar path comprising an electrically energized heating element capable of generating heat to be delivered to seal an unsealed opening of the inflatable chambers and trap the inflation gas within the inflatable chambers as the plastic film is drawn along the path and through the sealing mechanism; and

a slitting mechanism positioned along the planar path comprising a blade that is configured to slice open the longitudinally extending channel of the plastic film as the film is drawn along the path and through the slitting mechanism.

24. A system for manufacturing air cushions for use as packaging dunnage comprising:

(a) a longitudinally extending plastic film comprising a relatively narrow longitudinally extending channel, at least one row of generally rectangular presealed inflatable chambers each having three sides closed and a fourth side with an unsealed opening into the longitudinally extending channel, and a plurality of laterally extending perforations separating the inflatable chambers; and

(b) an inflation machine for inflating the inflatable chambers of the plastic film, the inflation machine comprising:

drive rollers that cause the plastic film to be gripped at or near the narrow longitudinally extending channel and drawn in a continuous and uninterrupted manner through inflation, sealing and slitting mechanisms in a planar path;

wherein the inflation mechanism comprises a source of inflation gas and an air outlet which together cause inflation gas to be injected into the relatively narrow longitudinally extending channel of the plastic film as the plastic film is drawn through the inflation mechanism;

wherein the sealing mechanism comprises an electrically energized heating element that generates heat to be delivered to the inflation side of one or more of the inflatable chambers to seal the unsealed opening and trap the inflation gas within the inflatable chambers as the plastic film is drawn through the sealing mechanism; and

wherein the slitting mechanism comprising a blade that slices open the relatively narrow longitudinally extending channel of the plastic film as the film is drawn through the slitting mechanism.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Levrini	US 3,713,930	Jan. 30, 1973
Troy	US 3,868,285	Feb. 25, 1975
Larson	US 4,017,351	Apr. 12, 1977

Appeal 2008-3716
Application 11/186,820

Gotoh US 5,824,392 Oct. 20, 1998

THE REJECTIONS

The following Examiner's rejections are before us for review:

Claims 13-23 are rejected under 35 U.S.C. § 102(b) as being anticipated by Troy.

Claims 1-12, 24, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Larson and Levrini or Larson and Gotoh.

The Appellants argue claims 13-23 as a group. We select claim 18 as representative of the group. As such, claims 13-17 and 19-23 will stand or fall with claim 18.

ISSUES

Claims 13-23

The Appellants do not specifically contest the Examiner's finding that Troy discloses an apparatus for use in inflating chambers in a plastic film. Instead, the Appellants contend the Examiner erred in rejecting the claims because 1) the Examiner improperly construed the term "single," 2) the Examiner failed to accord the recitation "single" channel any patentable weight, and 3) the claims are directed to an apparatus configured to inflate and seal a film having a single channel, whereas Troy describes inflating two channels with its apparatus. (App. Br. 13-15.)

Claims 1-12, 24, and 25

The Appellants contend that the Examiner erred in construing "planar path" as a path being formed from multiple planar surfaces when the ordinary and customary meaning of "planar" characterizes something as

“flat or level surface.” As such, the Appellants assert that the claims require the drawing of the film to be done in a flat or level path and Larson performs this drawing in a circumferential path; therefore, Larson does not teach the claimed feature. (App. Br. 16-18.)

The Examiner found that because Troy’s film has two narrow longitudinally extending channels, Troy has a single relatively narrow longitudinally extending channel along the left side of the film and a single relatively narrow longitudinally extending channel on the right side of the film. (Ans. 8.) Additionally, the Examiner found that the Appellants are claiming an apparatus that is capable of working on a specific type of film and Troy’s apparatus is capable of working with a film having a single channel. (Ans. 8.) Further, the Examiner construed the recitation “drawn in a continuous and uninterrupted manner through inflation, sealing[,] and slitting mechanisms in a planar path” as not requiring the mechanisms to be aligned in a straight, noncurved manner. (Ans. 8.) Accordingly, the Examiner found Larson’s circumferential path through the inflation, sealing, and slitting mechanisms is sufficient to meet the claimed planar path.

Based on the Appellants’ contentions and the Examiner’s findings, the issues before us are as follows:

Have the Appellants shown the Examiner erred in finding that the “single relatively narrow longitudinally extending channel” language does not patentably distinguish claims 13-23 over Troy’s apparatus?

Have the Appellants shown the Examiner erred in finding Larson’s circumferential path is sufficient to meet the claimed planar path?

FINDINGS OF FACT

We find that the following enumerated findings of fact 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. The Appellants do not specifically contest the Examiner's findings that Troy discloses an apparatus for use in inflating chambers in a plastic film. (App. Br. 13-15.)
2. Troy describes long channels 48 that are free to accommodate two margin guiding devices 73. Each guide tube 73 has a slot 74 extending along its length to enable each tube 73 to distribute air uniformly. At the end of each tube 73 is a knife 75 for severing the marginal seals as the film leaves the sealing chamber. (Troy, col. 6, l. 50 to col. 7, l. 7 and Figure 3.)
3. While Troy describes its apparatus being used with a plastic film having two longitudinally extending channels, nothing in Troy prohibits the apparatus from being used with a plastic film having a single longitudinally extending channel. Each channel in Troy appears to have its own air supply connected to its own guide tube. Accordingly, Troy's apparatus appears readily capable of using just one of its guide tubes 73, air supply, and knife 75 to inflate and slice a single longitudinally extending channel within a plastic film after the sealing chamber.
4. There is no dispute that Larson describes a system for manufacturing air cushions comprising a longitudinally extending plastic film and an inflation machine with a drive mechanism that grips the film near the

channel and draws the film in a continuous and uninterrupted manner through inflation, sealing, and slitting mechanisms.

5. As shown in Figure 5 of Larson, the path of the plastic film through the inflation, sealing, and slitting mechanisms is a circumferential path. (Larson, Figure 5.)
6. The Examiner has not relied on Levrini and Gotoh to disclose, teach, or suggest drawing a plastic film through the inflation, sealing, and slitting mechanisms in a planar path.

PRINCIPLES OF LAW

Anticipation

It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Where the record reasonably supports a conclusion that the prior art product is capable of performing the recited function, the burden falls on the applicant to show that the prior art structure does not inherently possess such capability. *See id.* at 1478. The rationale for this burden-shifting is the recognition that the USPTO is not equipped to perform experimentation necessary to produce such proof. *See In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986).

Obviousness

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

Claims 13-23 (Claim 18 is representative)

Troy discloses a machine that inflates and seals air cushioning material. (Fact 1.) The Appellants' only argument is that Troy's film has two longitudinal channels, not a single longitudinal channel, as required in the claims. (App. Br. 13-15.) However, while we agree with the Appellants that Troy's film has two longitudinal channels, not a single longitudinal channel, claims 13-23 are directed to the apparatus for processing the film and not to the film itself. The claim language directed to a film having a single longitudinally extending channel limits claims 13-23 only to the extent that an apparatus covered by these claims must be capable of inflating such a film in the manner claimed. The Appellants have not alleged, much less provided any evidence, that Troy is incapable of inflating a plastic film having a single longitudinally extending channel. In this case, the record reasonably supports a conclusion that Troy's apparatus is capable of inflating a plastic film having a single longitudinally extending channel in the manner set forth in the claims. Each guide tube 73 has a slot 74 extending along its length to enable each tube 73 to distribute air uniformly. (Fact 2.) At the end of each tube 73 is a knife 75 for severing the seals as the film leaves the sealing chamber. (Fact 2.) Nothing in Troy prohibits the apparatus from being used with a plastic film having a single longitudinally extending channel. (Fact 3.) Each channel in Troy appears to have its own air supply connect to its own guide tube. (Fact 3.) Accordingly, Troy's apparatus appears readily capable of using just one of its guide tubes 73, air

supply, and knife 75 to inflate and slice a single longitudinally extending channel within a plastic film after the sealing chamber. (Fact 3.)

Moreover, once the Examiner found Troy was capable of inflating a plastic film having a single longitudinally extending channel (see Ans. 8) the burden shifted to the Appellants to provide evidence that Troy was incapable of inflating a plastic film having a single longitudinally extending channel. The Appellants have not provided any such evidence.

Accordingly, the Appellants have not shown that the Examiner erred in finding Troy is capable of inflating a plastic film having a single longitudinally extending channel.

Claims 1-12, 24, and 25

Each of these claims requires “rollers that cause the plastic film to be gripped at or near the narrow longitudinally extending channel and drawn in a continuous and uninterrupted manner through inflation, sealing and slitting mechanisms in a planar path.” Larson describes a system for manufacturing air cushions comprising a longitudinally extending plastic film and an inflation machine with a drive mechanism that grips the film near the channel and draws the film in a continuous and uninterrupted manner through inflation, sealing, and slitting mechanisms. (Fact 4.) The path through the inflation, sealing, and slitting mechanism is not planar, i.e., flat or level, when the term “planar” is given its ordinary and customary meaning as argued by the Appellants. (App. Br. 18.) In Larson, the path through the inflation, sealing, and slitting mechanisms is a circumferential path. (Fact 5.) The Examiner has not relied on Levrini and Gotoh for teaching the path through the inflation, sealing, and slitting mechanisms to

Appeal 2008-3716
Application 11/186,820

be planar. (Fact 6.) Accordingly, the Appellants have shown that the Examiner erred in rejecting claims 1-12, 24, and 25.

CONCLUSIONS

The Appellants have not shown that the Examiner erred in finding that the “single relatively narrow longitudinally extending channel” language does not patentably distinguish claims 13-23 over Troy’s apparatus.

The Appellants have shown that the Examiner erred in finding Larson’s circumferential path is sufficient to meet the claimed planar path.

DECISION

The Examiner’s decision to reject claims 13-23 as being anticipated by Troy is affirmed.

The Examiner’s decision to reject claims 1-12, 24, and 25 as being unpatentable over Larson and Levrini or Larson and Gotoh 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

Appeal 2008-3716
Application 11/186,820

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