

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD S. DOWNING and JOHN E. TRAISE

Appeal No. 96-1227
Application 08/134,853¹

ON BRIEF

Before COHEN, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Richard S. Downing et al. originally took this appeal

¹ Application for patent filed October 12, 1993. According to appellants, the application is a continuation of Application 07/656,439, filed February 19, 1991, now abandoned, which is a continuation-in-part of Application 07/417,775, filed October 6, 1989, now U.S. Patent No. 5,397,427, issued March 14, 1995.

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from the final rejection of claims 1 through 10 and 24. The appellants have since canceled claim 1, amended claims 2 through 9 and 24 and added claim 26. Thus, the appeal now involves claims 2 through 10, 24 and 26. Claims 12 through 23, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

The subject matter on appeal relates to a method of sealing business forms. Claim 26 is illustrative and reads as follows:

26. A method of handling a plurality of paper business forms in succession, each form having at least two strips of pressure sealing adhesive of a predetermined width for fixing one part of the business form to another part, and wherein one of said strips of pressure sealing adhesive extends substantially perpendicularly to the other, comprising the step of (a) automatically, in a continuous, sequential manner, acting on successive business forms aligned in a predetermined orientation, and each fed in a single direction of movement corresponding to a long grain direction of said one part and said another part, to apply a force thereto sufficient to activate the pressure sealing adhesive to fix said one part of the form to said another part of the form, the force being applied substantially equally to each strip and only to the approximate area of the predetermined width of said two strips of pressure sealing adhesive, without having to alter said predetermined orientation or single direction of movement of said successive business forms.

The references relied upon by the examiner are:

Klar
1962

3,068,933

Dec. 18,

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Neill et al. (Neill)	4,033,807	Jul. 5, 1977
Gerlach et al. (Gerlach) 1977	4,035,984	Jul. 19,
Traise et al. (Traise)	5,397,427	Mar. 14, 1995
		(filed Oct. 6, 1989)

Claims 2 through 10, 24 and 26 stand rejected:

a) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 through 25 of the Traise patent in view of Klar and Gerlach;

b) under 35 U.S.C. § 103 as being unpatentable over Neill in view of Klar and Gerlach; and

c) under 35 U.S.C. § 103 as being unpatentable over Traise in view of Klar and Gerlach.

Reference is made to the appellants' main and reply briefs (Paper Nos. 29 and 31) and to the examiner's answer (Paper No. 30) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

In response to the obviousness-type double patenting rejection, the appellants filed a terminal disclaimer (Paper No. 32) with their reply brief. The record indicates that this terminal disclaimer has been reviewed, accepted and duly

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recorded (see Paper No. 33). The examiner, however, has not made any determination as to the effect of the terminal disclaimer on the double patenting rejection. Since an appropriate terminal disclaimer overcomes an obviousness-type double patenting rejection (see MPEP § 804.02), and the examiner has failed to give any reason why the terminal disclaimer filed by the appellants is insufficient in this regard, we shall not sustain the standing obviousness-type double patenting rejection of claims 2 through 10, 24 and 26.

Nor shall we sustain either of the standing 35 U.S.C. § 103 rejections of claims 2 through 10, 24 and 26.

Neill, the examiner's primary reference in the first of these rejections, discloses a system for manufacturing two-way mailers from blanks having perpendicularly arranged bands or strips of hot-melt adhesive thereon. As described by Neill,

the mailer passes through a pair of heated end sealers 29 of a finishing stage SS which serve to adhere the end margins of the sections together, and from there through a cross sealer 30 which applies heat and pressure in the long margin of the sections to complete the two-way mailer [column 8, lines 36 through 41].

Figure 8 shows that the paths taken by the mailers through the

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end sealers 29 and cross sealer 30 are perpendicular to one another.

Klar discloses a packaging machine and method "wherein the packages pass between two nipping rollers which apply heat and pressure along one or more edges of the package to effect sealing" (column 1, lines 9 through 11). As best shown in Figure 1, "[t]he two heated rollers 1, 2 of the machine are provided with recesses so as to form raised transverse portions 3 for sealing the transverse edges of the bag or flat packages passing between the rollers, as well as peripheral raised portions 4 which serve to seal the longitudinal edges" (column 2, lines 64 through 69).

Gerlach discloses a packaging apparatus and method wherein "a web having a pre-printed pattern of pressure sensitive sealant thereon may be pressure sealed with the subject apparatus when the material is cold" (column 2, lines 46 through 48).

In explaining the first of the § 103 rejections, the examiner concludes that it would have been obvious to one of ordinary skill in the art (1) "to substitute Klar's sealing

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roller pair for both pairs of Neill et al's sealing rollers, because Klar teaches that longitudinal and transverse seals may be made using only one pair of his rollers" (answer, page 3), and (2) "to design Klar's sealing rollers in the combination above for pressure sealing, because Gerlach et al teach that pressure sealing is an alternative method of longitudinally and transversely sealing overlying webs" (answer, page 3).

As pointed out by the appellants, however, independent claim 26 requires that business forms aligned in a predetermined orientation be "fed in a single direction of movement corresponding to a long grain direction of said one part and said another part" and that a force be applied to each perpendicular strip of adhesive only to the approximate area of the predetermined width of the strips "without having to alter said predetermined orientation or single direction of movement" of the forms. In response to the appellants' argument that the proposed combination of Neill, Klar and Gerlach does not respond to these limitations, the examiner submits that "[i]t would have been within the purview of those having ordinary skill in the art to choose to convey the

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business forms in the methodology of the above combined references in the long grain direction" (answer, page 4).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The above limitations in claim 26 relating to the "long grain direction" are disclosed in the appellants' specification (see page 3) as solving the problem of form wrinkling caused by the application of sealing forces in the direction perpendicular to the long grain direction of the form. This problem and the appellants solution thereto are further discussed in the 37 CFR § 1.132 declaration of David G. Wagner filed on December 20, 1994 (Paper No. 24). Neill, Klar and Gerlach do not make any mention of the long grain direction of the respective packaging materials disclosed therein, and certainly do not appreciate that grain direction

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is a factor to be taken into account during the sealing process to prevent wrinkling. The examiner's attempt to overcome these deficiencies in the applied prior art by baldly stating that the claim limitations in question would have been within the purview of those of ordinary skill in the art clearly rests on speculation, unfounded assumptions and/or hindsight reconstruction.

Moreover, this fundamental flaw in the prior art also applies to the examiner's proposed combination of Traise, Klar and Gerlach in the second 35 U.S.C. § 103 rejection of claims 2 through 10, 24 and 26.

Thus, the two prior art combinations advanced by the examiner to support the 35 U.S.C. § 103 rejections on appeal fail to provide the factual basis necessary to conclude that the differences between the subject matter recited in independent claim 26, and in dependent claims 2 through 10 and 24, and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

In summary and for the above reasons, the decision of the

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examiner to reject claims 2 through 10, 24 and 26 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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CHARLES F. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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