

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN SLABOWSKI

Appeal No. 97-3214
Application No. 08/280,369¹

ON BRIEF

Before COHEN, ABRAMS and McQUADE, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-8, which constitute all of the claims of record in the application.²

¹Application for patent filed July 26, 1994.

²An amendment under Rule 116 was entered, but did not result in the allowance of any claims, although it overcame a rejection under 35 U.S.C. § 112, second paragraph.

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The appellant's invention is directed to a transversely movable thread sled for use in a slitting line. The subject matter before us on appeal is illustrated by reference to claim 1, which has been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Graf et al. (Graf)	3,448,645	Jun. 10, 1969
Brand	3,795,166	Mar. 5, 1974
Matsunaga	4,567,799	Feb. 4, 1986

THE REJECTION

Claims 1-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsunaga in view of Graf and Brand.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

The problem upon which the appellant's inventive efforts are focused concerns replacement of the arbors used in the continuous

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slitting of rolls of coiled material in a manner which minimizes the disruption to the material pass line. As explained in the opening pages of the specification, modern slitting lines include a slitter having multiple arbors. These are preceded in the line by a thread sled, which receives the sheet material from an uncoiler and passes it in proper alignment to the slitter. It is necessary periodically to remove the arbors for servicing, and for this reason the arbors are pivotally mounted so they can be swung into and out of the active position in the material pass line in a horizontal arc. The thread sled, when in its active position, interferes with the pivotal movement of the arbors, and in the prior art the thread sled is moved upstream along the material pass line to get it out of the way of the arbors. This prior art system is disclosed in the Matsunaga patent, which the examiner has cited as the primary reference. In the appellant's invention, the thread sled is moved transversely out of the way of the pivotal path of the arbors. This offers the advantage of shortening the length of the material pass line.

As manifested in claim 1, the appellant's invention comprises, *inter alia*,

mounting means for mounting said sled for movement relative to said slitting arbors and said uncoiler, said mounting means including guide means for guiding

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said sled along a rectilinear path extending in a direction other than along the material pass line, and means for moving said sled along said path between said active and inactive positions,

with the active position having previously been defined as being "in" the material pass line and the inactive position as being "out of" the material pass line.

The examiner has rejected this claim as being unpatentable over Matsunaga in view of Graf and Brand. It is axiomatic that the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v.*

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Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052
(Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

As has been admitted by the examiner, Matsunaga fails to disclose or teach moving the thread sled perpendicular to the material pass line. In this regard, the examiner points out that Graf teaches displacing a tool station component in a direction transverse to the material pass line, and Brand teaches displacing a material conveying means transversely to the tools operating upon it. From these teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art to modify the Matsunaga system so that it meets the terms of claim 1. We do not agree.

Graf discloses a system for punching sheet material with a plurality of tools carried by a rotatable tool holder (Figure 11). The tool holder is transversely movable across the material pass line, and advancement of the sheet along the pass line coupled with transverse positioning of the proper tool results in punching in the desired location. However, as we understand the Graf machine, while the tool holder is movable transversely, it does not move to an "inactive" position, that is, "out of" the material pass line. It would appear that, at best, the transverse movement of the tool holder merely allows one of the

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tools to be rotated to a position at the outer edge of the pass line, whereupon it could be accessed for service while the other tools remain over the active position (see Figure 11). It also is material to our analysis that Graf is not concerned with the problem of moving a component out of the material pass line to provide an unobstructed path for another to be moved in and out.

Brand teaches moving the coils of sheet material being fed to an operating station transversely with respect to a stationary work station. This amounts to the opposite of the theory of operation of appellant's invention. Also, the problems solved by Brand differ from those of the appellant's invention.

Matsunaga solves the same problem as the appellant's invention, but does so by moving the thread sled upstream along the material pass line, rather than transversely, as in the appellant's invention. We fail to perceive any teaching, suggestion or incentive in the applied prior art which would have led one of ordinary skill in the art to modify the Matsunaga system by moving the thread sled transversely "out of" the material pass line to an "inactive position" with respect thereto. Graf's teaching of moving a punch tool transversely across a material pass line would not, in our view, have suggested to one of ordinary skill in the art that the movement

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of the Matsunaga thread sled be altered to the arrangement recited in claim 1. The same can be said for Brand. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). From our perspective, suggestion for combining the references in the manner proposed by the examiner is found only in the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is impermissible. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It is our opinion that the teachings of the references applied fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 1. Therefore, the rejection of independent claim 1 and, it follows, of dependent claims 2-8, cannot be sustained.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge))	
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NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
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JOHN P. McQUADE)	
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