

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORG ROSSLER
and DETLEF STRUNK

Appeal No. 1998-1024
Application 08/511,703

ON BRIEF

Before STAAB, NASE and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, which are all of the claims remaining in the application.

Appellants' invention relates to a drive for a multi-color printing press. The printing press includes a plurality of printing units (2) that are interconnected through the intermediary of a gear train.

The purpose of the present invention is to produce a constant power flow throughout the gear train to cause a constant bracing effect in the gear train and thereby assure registration between the plurality of printing units (2). The drive includes a separate motor (5) for each printing unit (2) to achieve a reduction in the loading of the gear train. A control device (7,8) for controlling the separate motors includes a determining means for determining load torque changes in the printing units (2). Said control device (7,8) is supplied with information regarding printing-specific variables from control busses (9, 29). The control device (7,8) including a memory (8.1-8.6, 8') for storing characteristic curves relating load-torque changes of the motors to various printing-specific variables provided by the control busses (9,29). Examples of the printing-specific variables are; rotational speed of the printing press, viscosity of the printing ink, ink distribution, and temperature of the inking and dampening units. Representative claim 1 is set forth below.

1. Drive for a printing press with a plurality of printing units mechanically interconnected through the intermediary of a gear train, the printing units being associated with respective drive motors for supplying power to the gear train in a preset torque ratio, comprising a control device, means for supplying to said control device information regarding printing-specific variables, said control device having means for determining, from said printing-specific variables, load-torque changes in the printing units, individually, and for energizing the drive motors so that power flow in the gear train is constant when averaged over time.

The prior art references of record relied upon by the examiner as evidence of obviousness are:

Tappert et al. (Tappert)	4,566,385	Jan. 28, 1986
Rodi	5,036,764	Aug. 6, 1991
Mamberer	5,117,753	June 2, 1992

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Claims 1-10 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-10 stand further rejected under 35 U.S.C. § 103 as being unpatentable over Tappert in view of each of Rodi and Mamberer.

Rather than attempt to reiterate the examiner's full commentary with regard to the above noted rejections and conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the final rejection (Paper No. 5, mailed September 13, 1996) and the examiner's answer (Paper No. 12, mailed April 24, 1997) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 10, received January 16, 1997) and the reply brief (Paper No. 13, received June 2, 1997).

OPINION

We turn first to the examiner's rejection of appealed claims 1-10 under 35 U.S.C. § 112, first paragraph, which rejection we understand to be based upon the enablement requirement of the first paragraph of section 112.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation.

See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217,

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1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

Thus, the dispositive issue is whether appellants' disclosure, considering the level of ordinary skill in the art as of the date of appellants' application, would have enabled a person of such skill to make and use appellants' invention without undue experimentation. The threshold step in resolving this issue is to determine whether the examiner has met his burden to establish a prima facie case of lack of enablement by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

Factors to be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.¹

The examiner has correctly pointed out that appellants' disclosure fails to disclose specific structural components and a manner of using the characteristic curves to determine load-torque changes. However, it is our opinion that in this instance these circumstances are not sufficient to establish a prima facie case of lack of enablement. This is especially true in view of the fact that the

¹ See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

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prior art of record (e.g., U.S. Patent 5,036,764 to Rodi) establishes that it was known as of the date of appellants' application how to compile and store data in a memory representative of the functional relationships between various printing specific variables (e.g., rotational speed of the printing press, operating temperature, ink viscosity, and the type of paper) and the torque of a printing press drive motor for setting register adjustments. Further, U.S. Patent 5,036,764 discloses in column 3, lines 23-29, that the functional relationships between the printing specific variables and the register adjustment may be determined by at least one trial run of the printing apparatus. Upon further review of the instant application, we note appellants teach that "[s]uch characteristic curves are determined experimentally, for example in test runs of the printing machine". Based on the state of the art and the relative skill in the art as demonstrated by the '764 patent, we conclude that appellants' disclosure would have enabled a person of ordinary skill to make and use appellants' invention without undue experimentation.

Therefore, we will not sustain the rejection of claims 1 through 10 under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

Now we turn to the rejection of claims 1-10 under 35 U.S.C. § 103 as being unpatentable over Tappert in view of Rodi and Mamberer.

As a preliminary matter, we note that despite appellants' indication on page 13 of the brief that "claims 2-10 do not stand or fall with claim 1," appellants have not separately argued any individual

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claim of this group with any reasonable degree of specificity apart from claim 1. Accordingly, we will treat claims 1-10 as standing or falling on the limitations of claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); In re Hellsund, 474 F.2d 1307, 1310, 177 USPQ 170, 172 (CCPA 1973).

The examiner rejected claims 1-10 under 35 U.S.C. §103 as being unpatentable over Tappet in view of Rodi and Mamberer. The examiner has reasonably found, and appellants have not disputed, that (1) Tappet (Answer, pages 11-12) discloses a press combination generally as claimed, including separate drive motors for individual printing units, (2) Rodi (Answer, pages 12-15) teaches a control device for controlling register adjustment of several printing units that use a single drive motor and a means for supplying to the control device information regarding printing-specific variables, and (3) Mamberer (Answer, pages 15-16) teaches press units that are individually controllable by drive motors which are responsive to a microprocessor. Based on these teachings, the examiner then logically concluded (Answer, pages 16-17) that it would have been obvious to one having ordinary skill in the art at the time the invention was made to control the power flow to the individual motors in Tappert in accordance with the teachings in Rodi and Mamberer, that is, to utilize a control processing system which determines, from the printing specific variables, load-torque changes in the printing units, individually and energizes the drive motors so as to produce a desired power flow in the press drive system.

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Turning to appellants' arguments on pages 26-31 of the brief, appellants, for the most part, merely point out differences between the disclosed invention and the teachings of the applied references individually. However, nonobviousness cannot be established by attacking references individually when, as here, the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) and In re Young, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968). Appellants also make much of the fact that Tappert's drive motors are hydraulic, implying that drive motors of this type are precluded by the claims. However, the appealed claims do not preclude hydraulic drive motors. Hence, this argument fails at the outset because it is predicated on limitations that are not found in the claims. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

In the present instance, appellants have not specifically argued the combination of references as set forth by the examiner in the rejection under section 103. Rather, appellants have merely pointed out individual deficiencies of the references and argued features of the invention that are not found in the claims. These arguments are not persuasive of error on the part of the examiner in rejecting the claims under section 103. Accordingly, we will sustain the examiner's rejection of claims 1-10 under section 103 as being unpatentable over Tappert in view of Rodi and Mamberer.

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CONCLUSION

The examiner's rejection of claims 1 through 10 under 35 U.S.C. § 112, first paragraph, is reversed. The examiner's rejection of claims 1 through 10 under 35 U.S.C. § 103 is affirmed.

Since at least one of the examiner's rejections of each of the appealed claims has been affirmed, the decision of the examiner finally rejecting claims 1-10 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

LAWRENCE J. STAAB)
Administrative Patent Judge)
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)
) BOARD OF PATENT
JEFFREY V. NASE)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JENNIFER D. BAHR)
Administrative Patent Judge)

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