

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERENCE J. GALLAGHER

Appeal No. 2000-0909
Application No. 08/784,752

HEARD: March 15, 2001

Before CALVERT, ABRAMS and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 4, 5, 7 through 11, 15 through 19 and 27 through 34, which are all of the claims remaining in the application.

We AFFIRM-IN-PART.

The subject matter on appeal is directed to a machine for

Appeal No. 2000-0909
Application No. 08/784,752

transferring discrete areas of material from a flexible
carrier

onto a substrate. A copy of the appealed claims is reproduced
in "Appendix A" attached to the appellant's main brief (Paper
No. 21).

The prior art references of record relied upon by the
examiner in rejecting the appealed claims are:¹

Craig	4,701,239	Oct. 20, 1987
Nyfeler et al. (Nyfeler)	5,207,855	May 04, 1993

The appealed claims stand finally rejected on the
following grounds:

(1) claims 27 through 34 stand rejected under 35 U.S.C.
§ 112, second paragraph, as being indefinite for failing to
particularly point out and distinctly claim the subject matter
which the appellant regards as the invention;²

¹ We note that the listing of prior art found at page 3 of the answer is
incomplete and inaccurate. The list omits the Craig patent and includes
several patents which were not relied on in the rejections under review.

² The examiner's failure to list this rejection in the statement of the

(continued...)

Appeal No. 2000-0909
Application No. 08/784,752

(2) claims 1, 2, 4, 5, 7, 9 through 11, 15 through 19, 27 through 29 and 31 through 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nyfeler; and

(3) claims 8 and 30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nyfeler in view of Craig.

The full text of the examiner's rejections and response to the argument presented by the appellant appears in the final rejection (Paper No. 19) and the answer (Paper No. 22), while the complete statement of the appellant's argument can be found in the main and reply briefs (Paper Nos. 21 and 24, respectively).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

²(...continued)

grounds of rejection in the answer is an apparent oversight. See answer, pp. 10 and 11.

Appeal No. 2000-0909
Application No. 08/784,752

The rejection under 35 U.S.C. § 112, second paragraph

We will not sustain the rejection of claims 27 through 34 under 35 U.S.C. § 112, second paragraph.³

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's statement of the rejection is as follows (final rejection, pp. 2 and 3):

Claims 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[1] Claims 27-34 are incomplete for failing to actually transferring [sic: transfer] discrete areas as the preamble states. Such omission amounting to a gap in the structure of the elements.

[2] Such phrases as "for transferring . . .", "includes at least . . .", "including at least "includes a microprocessor . . .", et cetera are merely the recitation of structural possibilities.

³ We note that the language "the foil" in claim 1, line 19 (as it appears in the appendix to the main brief), lacks antecedent basis in the claim and should properly read --the carrier--. This informality is worthy of correction upon return of the application to the jurisdiction of the examiner.

Such phrases fail to particularly point out and distinctly claim those possibilities.

[3] Such phrases as "capable of moving" and "not being pressed" merely describe the potential capabilities of the claimed limitations rather than actual structural interactions.

[4] Claim 27, line 5 and claim 33, line 4: the "allows relative movement. . ." limitation renders the claim vague and indefinite. What is being allowed relative movement?

[5] Claim 27 recites the limitation "the repetitive presses" in line 6. There is insufficient antecedent basis for this limitation in the claim.

[6] Claims 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap

between the elements. See MPEP § 2172.01. The omitted elements are: the sensor targets (62). Without this element, it is impossible for the second sensor to provide a second signal related to the repetitive instances of the at least one contact area urging.

[7] Claims 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: a transfer station, a first mechanism, a second mechanism, a first sensor, a second sensor, a carrier handling assembly, a carrier control mechanism, an electronic control system, a microprocessor, and one arm.

Appeal No. 2000-0909
Application No. 08/784,752

[Paragraph numbers in brackets added]

At the outset, we note that the examiner has withdrawn the specific grounds set forth in paragraphs [4] and [5], above. See main brief, p. 12 and the answer, p. 10.

We do not agree that claims 27 through 34 are incomplete for "failing to actually transferring [sic] discrete areas as the preamble states." See paragraph [1], above. Both independent claims 27 and 33 require a "transfer station" including "at least one contact area that repetitively presses the carrier against the substrate." Thus, actual structure is recited in the body of each claim "for transferring discrete areas" as set forth in the preamble.

We also find no merit in the examiner's criticisms of claims 27 through 34 because of the phrases identified in paragraphs [2] and [3] or the failure to claim the sensor targets in paragraph [6], above. In our view, the cited phrases and the omission of the sensor targets do not make the metes and bounds of the claimed invention indefinite.

With regard to the specific grounds set forth in

Appeal No. 2000-0909
Application No. 08/784,752

paragraph [7], above, we do not agree with the examiner that the claims lack essential structural cooperative relationships between the elements listed in the rejection.

The rejection under 35 U.S.C. § 102

The rejection of claim 33 under 35 U.S.C. § 102 is sustained, but not the rejection of claims 1, 2, 4, 5, 7, 9 through 11, 15 through 19, 27 through 29, 31, 32 and 34.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Independent claim 1 is drawn to a machine for transferring discrete areas of material from a carrier onto a substrate and requires, inter alia, "means . . . for simultaneously adjusting by equal and opposite amounts path lengths followed by the carrier on the input and output sides of the transfer station"

Appeal No. 2000-0909
Application No. 08/784,752

Likewise, independent claim 27 is drawn to a machine for transferring discrete areas of material from a carrier onto a substrate and requires, inter alia, "a carrier control mechanism including at least a second electrical motor that positions at least first and second guides to change path lengths followed by the carrier on opposite sides of the transfer station by equal and opposite amounts."

Claim 34, which depends from independent claim 33, also requires "first and second carrier path guides with their positions being moved by said at least a second electrical motor to adjust the path lengths of the carrier station by equal and opposite amounts before and after passing through the transfer station."

Nyfeler (Figure 3) teaches a machine for transferring discrete areas of material, such as stamps 3, 3' (Fig. 1), from a carrier or backing strip 5 onto a substrate 1 including a sensor 37 for recording the movement of graduation markings located on the substrate 1 representing the pitch MaT of the

Appeal No. 2000-0909
Application No. 08/784,752

motif or design printed on the substrate, a pulling means 14 for moving the substrate through the sticking or transfer stations 11, 11' at a forward feed speed V, a sensor 38 which reads graduation markings provided on the carrier representing integral subdivisions of the stamp pitch MaT (col. 7, ll. 30-34), rotary pick-ups or senders 39, 39' which record the precise angular rotation of the pressing cylinders 12, 12', drive rollers 20 having a drive system (not shown) for unwinding the carrier 5 from a supply roller 19 at a predetermined speed B (col. 4, ll. 4-8) which is lower than the forward feed speed V (col. 7, ll. 64-65), a carriage 40 for supporting rollers 21, 22, 23, 26, 22' and 23' and which, immediately prior to each sticking phase, is moved by electrical motor 41 and linkage 42 from a first reversal point 44 in the forward feed direction 8 to a second reversal point 45 in a

uniform manner at the differential speed $V-B$ (col. 8, ll. 50-54) and a control arrangement 31 which controls the drive

Appeal No. 2000-0909
Application No. 08/784,752

system

for the drive rollers 20 (see col. 5, ll. 59-63 and col. 7, ll. 41-44) and the speed of rotation of the electrical motor 41 in dependence on the position of the carriage 40 and the signals from the sensor 37 and the rotary sender 39 (see col. 8, ll. 20-24).

The examiner determined that Nyfeler teaches a "means (34) [sic, (40)?] responsive to the first and second sensors (37 and 38) for simultaneously adjusting by equal and opposite amounts path lengths followed by the carrier (5) on the input and output sides of the transfer station (11)." See answer, p. 4. In support, the examiner cites the following disclosure at col. 8, ll. 2-8 of Nyfeler (answer, p. 8):

Movement of the carriage 40 in the forward feed direction 8 or in opposite relationship thereto increases the speed of the backing strip 5 in the sticking plane 18 relative to the strip speed B or reduces it, or reverses it, in other words the backing strip 5 is pulled back by a predetermined length in opposite relationship to the forward feed direction 8.

In our opinion, the examiner's position that movement of Nyfeler's carriage 40 between first 44 and second 45 reversal

Appeal No. 2000-0909
Application No. 08/784,752

points will necessarily result in the path lengths of the carrier 5 being adjusted by "equal and opposite amounts" as required by claims 1, 27 and 34 is speculative. Nyfeler gives no express indication that the path lengths of the carrier 5 are adjusted by equal and opposite amounts before and after passing through the transfer station. Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as

Appeal No. 2000-0909
Application No. 08/784,752

sufficient.

In the present case, the fact that the carriage 40 travels an equal distance in each direction between the first 44 and second 45 reversal points does not necessarily mean that the path lengths of the carrier 5 are adjusted by equal and opposite amounts before and after passing through the transfer station.

Accordingly, we will not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 27 and 34 or of claim 2, 4, 5, 7, 9 through 11 and 15 through 19 dependent on claim 1 or of claims 28 through 29, 31 and 32 dependent on claim 27.

We reach a different result with respect to independent claim 33. Unlike claims 1, 27 and 34, claim 33 does not require structure for adjusting the carrier path length by equal and opposite amounts before and after passing through the transfer station. Instead, claim 33 is drawn to a machine for transferring discrete areas of material from a carrier onto a substrate and requires, inter alia, a carrier movement

Appeal No. 2000-0909
Application No. 08/784,752

control mechanism comprising "a first sensor of the substrate moving mechanism that provides a first signal related to the movement of the substrate through the transfer station," "a second sensor

providing a second signal related to the repetitive instances of said at least one contact area urging the carrier against the substrate," "a carrier handling assembly including a first electrical motor that causes the carrier to be supplied to the transfer station," "an assembly including at least a second electrical motor that controls the velocity of the carrier through the transfer station during intervals when the carrier is not being pressed against the substrate" and "an electronic control system that utilizes both the first and second signals to drive the first and second electrical motors in a manner to move the carrier within the transfer station with a velocity that is equal to that of the substrate."

We agree with the examiner's determination that claim 33 is anticipated by the Nyfeler patent.

Appeal No. 2000-0909
Application No. 08/784,752

The appellant argues (main brief, pp. 8-10 and reply brief, p. 3) that there is no disclosure in Nyfeler that the control 31 utilizes the first sensor 37 to control the speed of the carrier 5 "in the manner to move the carrier within the transfer station with a velocity that is equal to that of the substrate but

otherwise moves the carrier in a manner that advances significantly less of the carrier than the substrate through the transfer station between the repetitive instances of said at least one contact area pressing the carrier against the substrate" as required by claim 33. We disagree.

Nyfeler states that "[t]he control arrangement 31 controls the speed of rotation of the drive 41 in dependence on the position of the carriage 40 and the signals from the sensors 37 and 38 and the rotary senders 39 and 39'" (col. 8, ll. 20-24). Thus, Nyfeler explicitly teaches that the control arrangement 31 controls the speed of rotation of the drive 41 and, thus, the speed of the carriage 40 and carrier 5 in

Appeal No. 2000-0909
Application No. 08/784,752

response to, inter alia, signals from the first sensor 37.

Nyfeler also teaches that the backing strip or carrier 5 "moves at a speed which is composed of the strip speed B and the speed of the carriage 40 and which is equal to the forward feed speed V of the substrate 1 at least during the sticking and intermediate phases" (col. 7, l. 66 through col. 8, l. 2) and that strip speed B of the carrier is lower than the forward feed speed V of the substrate (col. 7, ll. 64 and 65).

Accordingly, we will sustain the examiner's rejection of claim 33 under 35 U.S.C. § 102.

The rejection under 35 U.S.C. § 103

We will not sustain the rejection of claims 8 and 30 as unpatentable under 35 U.S.C. § 103(a) over Nyfeler in view of Craig.

We have reviewed the Craig patent but find nothing therein which makes up for the deficiencies of Nyfeler discussed above with respect to the rejection of claims 1 and 27. That is, the combined teachings of the applied prior art would not have suggested the claimed structure for adjusting

Appeal No. 2000-0909
Application No. 08/784,752

the carrier path length by equal and opposite amounts before and after passing through the transfer station. Accordingly, we cannot sustain the examiner's rejection of appealed claims 8 and 30 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 27 through 34 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1, 2, 4, 5, 7, 9 through 11, 15 through 19, 27 through 29, 31, 32 and 34

under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claim 33 under 35 U.S.C. § 102(b) is affirmed; and the decision of the examiner to reject claims 8 and 30 under 35 U.S.C. § 103 is reversed.

Appeal No. 2000-0909
Application No. 08/784,752

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

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

jfg/vsh

Appeal No. 2000-0909
Application No. 08/784,752

GERALD P. PARSONS
MAJESTIC, PARSONS, SIEBERT & HSUE
FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 94111-4106