

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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-BERNARD DE DOMPIERRE and ULRICH SCHWAGER

Appeal No. 2001-0257
Application No. 08/927,412

HEARD: May 8, 2001

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 3, 5, 8, 10, 14 and 16 to 23, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claims 14, 16 and 17 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a movable upper tool for separation of blanks from a die-cut sheet. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Varidel et al. (Varidel)	5,353,978	Oct. 11,
1994		

Claims 2, 3, 8, 14, 16 to 19, 21 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Varidel.

Claims 5, 10, 20 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Varidel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper

No. 21, mailed July 6, 1999) and the answer (Paper No. 27, mailed February 24, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 25, filed January 13, 2000) and reply brief (Paper No. 28, filed April 24, 2000) for the appellants' arguments thereagainst.

OPINION

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

The anticipation rejection

We will not sustain the rejection of claims 2, 3, 8, 14, 16 to 19, 21 and 22 under 35 U.S.C. § 102(b).

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).

Claims 2, 3, 8, 14, 16 to 19, 21 and 22 are drawn to a movable upper tool for separation of blanks from a die-cut sheet including, inter alia, a base plate having apertures and punches fastened on a lower surface of the base plate, wherein the punches are arranged along two orthogonal axes, one of the orthogonal axes consisting of a line slanted at an angle with regard to an edge of the base plate to provide a regular or identical full pressure on each blank to be separated.

Varidel's invention is directed to a movable upper tool for a blank separating station situated in a sheet processing machine which is used for producing blanks for making packages. The upper tool includes a horizontal plate 1 having a lower surface on which an upper surface of each of the separated blocks 2 is mounted. The plate 1 is provided with numerous apertures 10 arranged in a pattern to allow air to

pass through the plate during movement of the plate. As shown in Figure 2, the apertures 10 are arranged in rows and columns (i.e., arranged along orthogonal axes in which neither one of the orthogonal axes consists of a line slanted at an angle with regard to an edge of the plate 1). The lower surface of the plate 1 is covered at least partially with a layer 12 of a fastening arrangement (either a layer of loops or a layer of hooks) and the upper surface of each of the blocks is covered at least partially with a mating layer of the fastening arrangement to insure a securing of the block on the plate.

Varidel teaches that every block 2 is usually shaped as a hollow body and, as illustrated in Figure 2, has a rectangular configuration. These blocks 2 can be made from wood provided with a foam layer 22 which is designed to contact the blank or be made out of a resilient polyurethane in which case, the blocks are not provided with the foam layer 22. Varidel also teaches that it is, of course, possible to envision solid blocks, although he prefers to use hollow blocks so as to have openings 24, a portion of which may be aligned with the apertures 10 of the plate 1 and, thus, enable the passage of

air during the operation of the tool. Varidel further teaches that while the blocks are illustrated as having a rectangular shape, it is possible that they have other shapes, as desired.

With respect to the claimed limitation that one of the orthogonal axes that the punches are arranged in is a line slanted at an angle with regard to an edge of the base plate, the examiner determined (final rejection, p. 3) that one of the orthogonal axes of the punches of Varidel "is capable of being a line slanted at an angle with regard to one of the edges of the base plate."

The examiner may be correct that due to the ability of Varidel's punches to be rearranged on the plate the punches of Varidel are **capable** of being arranged along two orthogonal axes, one of the orthogonal axes consisting of a line slanted at an angle with regard to an edge of the plate. However, anticipation under 35 U.S.C. § 102(b) requires more than just the fact that the prior is **capable** of being arranged in the manner set forth in the claim. It is well-settled that

anticipation 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 to establish anticipation. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

From the above discussion, the claimed tool is only a possibility in light of Varidel. Thus, it is clear that Varidel does not disclose, either expressly or under principles of inherency, each element of claims 2, 3, 8, 14, 16 to 19, 21 and 22. Accordingly, the decision of the examiner to reject claims 2, 3, 8, 14, 16 to 19, 21 and 22 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 2, 3, 5, 8, 10, 14 and 16 to 23 under 35 U.S.C. § 103.

As set forth above, Varidel does not disclose his punches being arranged along two orthogonal axes wherein one of the

orthogonal axes consists of a line slanted at an angle with regard to an edge of the plate. In the rejections under 35 U.S.C. § 103 before us in this appeal, it is the examiner's position (answer, p. 4) that this limitation would have been obvious at the time the invention was made to a person having ordinary skill in the art. However, the examiner has not provided any evidence² as to why at the time the invention was made a person having ordinary skill in the art would have modified the nonslanting orthogonal axes arrangement of the punches taught by Varidel to arrive at the claimed subject matter. Without such evidence, we cannot sustain the

² Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

rejections under 35 U.S.C. § 103 made by the examiner in this appeal.

For the reasons set forth above, the decision of the examiner to reject claims 2, 3, 5, 8, 10, 14 and 16 to 23 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3, 8, 14, 16 to 19, 21 and 22 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 2, 3, 5, 8, 10, 14 and 16 to 23 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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Administrative Patent Judge)	AND
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