

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JURGEN GROSSMANN

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Appeal No. 2002-1267  
Application No. 09/333,928

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 21, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

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<sup>1</sup> Claim 1 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to tools for folding sheet-like blanks around block-shaped commodities in wrapping machines (title). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claim 1, the only independent claim on appeal, reads as follows:

A tool for conversion of discrete deformable blanks into envelopes for block shaped commodities, comprising  
at least one lightweight carrier having at least one active surface shaped to deform a blank; and  
at least one wear-resistant liner covering and in contact with said active surface,  
said liner having a blank deforming surface adjacent to the active surface of said carrier,  
said liner comprising a different material than said carrier.

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

Adams et al. (Adams)	5,249,416	Oct. 5, 1993
Focke et al. (Focke)	5,588,286	Dec. 31, 1996
Spada et al. (Spada)	5,653,086	Aug. 5, 1997

Claims 1 to 6, 8, 9 and 18 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spada in view of Focke.

Claims 7 and 10 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spada in view of Focke as applied to claim 1, and further in view of Adams.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed February 26, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed January 16, 2002) and reply brief (Paper No. 17, filed April 17, 2002) for the appellant's arguments thereagainst.

#### 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 21 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Spada in view of Focke (answer, pp. 3-4), the examiner (1) set forth the teachings of both Spada and Focke; (2) ascertained<sup>2</sup> that Spada does not disclose that his recesses 105 have a liner made of a different material, such as hardened steel; and (3) concluded that it would have been obvious to one of ordinary skill in this art, at the time of the invention, to include a hardened steel liner in the recesses 105 of Spada as taught by Focke in order to reduce friction and retain the lightweight structure of the turret.

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<sup>2</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The appellant argues throughout both briefs that the applied prior art does not suggest the claimed subject matter. Specifically, the appellant argues that there is no motivation or suggestion in the applied prior art to have included a hardened steel liner in the recesses 105 of Spada and that Spada's recesses 105 are not active surfaces shaped to deform a blank. We agree. In our view, Focke's teaching of a folding mandrel 13 made from a high-alloy rust-resistant spring-steel sheet provides no teaching, suggestion, or motivation for a person of ordinary skill in the art to have lined Spada's recesses 105. Moreover, there is no disclosure in Spada that his recesses 105 are active surfaces shaped to deform a blank. In fact, Spada teaches (column 1, lines 17-30) that wrappers and blanks are folded by stationary folding means and movable folding means distributed in predetermined positions for each folding step around the periphery of the wheels with sockets/recesses which is mounted so as to rotate, in predetermined steps. Thus, the only possible suggestion for modifying Spada to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure.<sup>3</sup> The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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<sup>3</sup> Spada does not anticipate claim 1 for the reasons set forth by the appellant in the reply brief (pp. 1-2).

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 to 6, 8, 9 and 18 to 21 dependent thereon, under 35 U.S.C. § 103 as being unpatentable over Spada in view of Focke is reversed.

We have also reviewed the reference to Adams additionally applied in the rejection of claims 7 and 10 to 17 (dependent on claim 1) but find nothing therein which makes up for the deficiencies of Spada and Focke discussed above regarding claim 1. Accordingly, the decision of the examiner to reject claims 7 and 10 to 17 under 35 U.S.C. § 103 as being unpatentable over Spada in view of Focke as applied to claim 1, and further in view of Adams is also reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 21 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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