

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

---

Appeal No. 2002-2125  
Application No. 09/078,914

---

ON BRIEF

---

Before KRATZ, DELMENDO and MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 5, 6, 7, 8, 11, 19, 20, 21, 22 and 23. Claims 1-4, 9-10 and 12-18 have been canceled. Thus, claims 5-8, 11, and 19-23 are before us on appeal.

REPRESENTATIVE CLAIM

The appellants have indicated that claims 5-8 stand together; claims 11, 20 and 21 stand together; claims 22-23 stand together, and claim 19 stands alone. Accordingly, we shall focus our attention on claim 8 (the independent method claim), claim 11 (the

Appeal No. 2002-2125  
Application No. 09/078,914

broadest dependent method claim), claim 22 (the broadest apparatus claim) and claim 19, which stands alone. Note In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998); In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

These claims read as follow:

8. A method of providing text on a printed surface of each of a plurality of printed products having printing thereon comprising the steps of

conveying the printed products along a path of travel in an overlapping imbricated stream and such that a border region of the printed surface of each printed product is exposed by the imbricated overlap, while

applying a partially transparent contrast panel to the exposed border region of each printed product with the contrast panel overlying the printing on the printed surface and allowing the printing on the printed surface to be seen therethrough, and

forming information within or on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

11. The method as defined in Claim 8 wherein the applying step includes adhesively bonding a label to the printed surface of each printed product, and the forming information step includes printing the information onto each label after it is adhesively bonded to the printed surface.

19. The apparatus as defined in claim 22 wherein the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

22. An apparatus for providing text on a printed surface having printing thereon of each of a plurality of printed products comprising

Appeal No. 2002-2125  
Application No. 09/078,914

a conveyor system for conveying the printed products along a path of travel in an overlapping imbricated stream and such that a border region of the printed surface of each printed product is exposed by the imbricated overlap,

label applying means disposed along the path of travel for applying a partially transparent contrast label to the exposed border region of each printed product so as to overlie the printing on the printed surface of the printed product and to allow the printing to be seen therethrough, said label applying means comprising means mounting a supply roll of a strip of partially transparent label forming material, a cutting system for withdrawing the strip from the supply roll and cutting the same into individual labels, and an application device for sequentially applying the individual labels onto the printed products, and

printing means for printing information onto each label.

#### The References

In rejecting the claims under 35 U.S.C. § 103(a), the examiner relies upon the following references:

Doane et al. (Doane)	2,715,975	Aug. 23, 1955
Jackson	4,149,711	Apr. 17, 1979
Popat et al. (Popat)	5,407,718	Apr. 18, 1995

#### The Rejections

Claims 5-8, 11, and 19-23 stand rejected under 35 U.S.C. § 103(a) as obvious over Doane in view of Jackson and Popat.

#### The Invention

The invention relates to a method and apparatus for applying printed text. Multiple printed products are conveyed in an overlapping ("imbricated") stream, which provides for an exposed border region in each of the products. A partially transparent label is applied over the printed product, and the underlying

Appeal No. 2002-2125  
Application No. 09/078,914

printing can be seen while the printing on the label can be read. (Appeal Brief, page 2, lines 4-11). Further details of the claimed invention are seen by reference to claims 8, 11, 19, and 22 reproduced above.

#### Discussion

##### The Rejection of Claims 5-8, 11, and 19-23 under 35 U.S.C. §103(a)

Claims 5-8, 11, and 19-23 stand rejected under 35 U.S.C. § 103(a) as obvious over Doane in view of Jackson and Popat. The Examiner has found that Doane teaches a method and apparatus for address labeling articles fed in partial or overlapping relationship using a feed conveyor having individual lugs to engage and move each article past a label applying head. The label applying head includes a supply reel, a knife, a paste applying roller, and a label applying roller. (Examiner's Answer, page 3, line 18 - page 4, line 5).

The examiner has further found that Jackson teaches a printing system for printing personalized information onto an adhered label on a magazine moving along a conveyor. (Examiner's Answer, page 4, lines 7-10).

The examiner has additionally found that Popat teaches that a stark white address label creates a cheap, mass-produced appearance. Labels may be made from transparent paper label sheets to provide clear labels. A paper label should have a

Appeal No. 2002-2125  
Application No. 09/078,914

contrast ratio of 30-40% and be slightly tinted for decorative effect. (Examiner's Answer, page 4, lines 11-17).

The examiner then concludes that it would have been obvious to have modified the apparatus of Doane by providing a printing system as taught by Jackson to print personalized information on the magazines. The examiner further concludes it would have been obvious to use the partially transparent labels of Popat to obviate the cheap, mass-produced white labels. (Examiner's Answer, page 4, line 18 - page 5, line 11).

The appellants initially argue that there is no motivation to make what they characterize as a "highly selective" combination of the various features of the three applied references (Appeal Brief, page 3, lines 26-30).

The appellants challenge the stated content of the principal reference, Doane, stating that it does not disclose that the border region has a printed surface or that the label is transparent. (Appeal brief, page 4, lines 8-13). We disagree with the appellants' interpretation of Doane.

First, Doane clearly describes that the label is to be applied to a magazine, newspaper, catalogue, flyer, or tabloid (Column 1, lines 16-17) which may have a three or four color ink work on its cover (column 1, lines 43-44), where the label is to be applied. Second, Doane is not relied upon for the disclosure

Appeal No. 2002-2125  
Application No. 09/078,914

of a transparent label. Popat discloses a partially transparent label.

The appellants then state that the Jackson reference is "non-analogous" in that it teaches the separate handling of products and one concerned with imbricated streams would not look to Jackson. We disagree with this interpretation of Jackson. Imbricated streams and individual processing are not so different that one of ordinary skill in the art would not look to Jackson. Indeed, we find that Figure 3 of Jackson illustrates an imbricated stream (Reference Numerals 107, 18) feeding the labeling and printing station. While in this embodiment the actual printing does not occur on the imbricated stream, the appellants' argument that imbrication and Jackson's printing method are unrelated clearly fails.

The appellants finally assert that the use of Popat, which is said to relate to a particular construction of clear labels which are removed by a user and applied to envelopes, is improper (Appeal Brief, page 4, lines 24-36). Consequently, it is urged, no modification of an imbricated stream can be suggested. The appellants' argument is misplaced. Popat is not suggesting that the imbricated stream be altered, but is relied upon by the examiner for the proposition that cheap white labels be replaced with transparent or tinted labels. We therefore find this

Appeal No. 2002-2125  
Application No. 09/078,914

argument unpersuasive and conclude that the examiner has properly combined the instant three references.

The appellants next argue that, even when the references are considered collectively, they do not disclose the instantly claimed invention. They urge that none of the references disclose the feature that the label is applied to the exposed region of the products of an imbricated stream so as to overlie the printing thereon, and that the references do not teach a partially transparent contrast panel. (Appeal Brief, page 5, lines 4-11).

As regards the first portion of this argument, it is clear that Doane discloses that the cover may be printed as discussed above. As regards the second portion of this argument, it is urged that Popat only discloses clear labels and that "[t]here is no hint that the label might be anything else but clear or substantially transparent." (Appeal Brief, page 5, lines 32-33). Such clear labels are stated to be invisible when applied, and therefore, it is asserted, they cannot be a contrast panel. (Appeal Brief, page 6, lines 12-18).

This viewpoint overlooks the clear teaching in Popat that the decorative labels need not be entirely transparent. (Column 5, lines 43-45). While it is true that one part of this cited teaching is made by way of decorative tinting, the appellants also overlook the importance of the teaching at column 3, line 53 -

Appeal No. 2002-2125  
Application No. 09/078,914

column 4, line 17 regarding the transparency of the paper used for printing the labels. Taken together, they teach one of skill in the art that the labels need not be perfectly transparent.

Further, the claimed subject matter recites only a "partially transparent contrast panel." The specification, page 3, lines 7-13 provides that:

A contrast panel, which forms a text panel, is applied to the exposed border region of each printed product, and the contrast panel forms a contrast with respect to the information which is to be applied. This ensures that the information always appears in contrast with respect to its surroundings and thus can be seen and read easily.

The appellants urge, and have provided two examples which they assert support this point of view, that the panel itself constitutes a contrast to the underlying cover printing and helps to direct the user's look to the panel. (Appeal Brief, page 8, lines 2-16; see also unnumbered document dated October 31, 2001 entitled "Submittal of Exhibits Under 37 CFR 1.195.")

It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). See also In re Azorlosa, 44 CCPA 826, 241 F.2d 939, 941, 113 USPQ 156, 158 (1957), which holds, in pertinent part, that it is proper for the court and necessarily, the board, to consider everything that a reference discloses.

Appeal No. 2002-2125  
Application No. 09/078,914

Popat discloses a particular embodiment where a blue envelope is provided with a transparent paper label having a slightly reddish tint. When used on a blue envelope, it is observed that the area underneath the label has a slightly purple tint. (See Popat, column 5, lines 45-48). We find that this change in the tint will draw the eye to the label without obscuring the area under the label, within the meaning of the appellants' specification and claims.

We therefore agree with the examiner's interpretation of Popat that it is not limited to a "substantially" transparent label. We furthermore conclude that a prima facie case of obviousness has been established, for the reasons expressed by the examiner, and those recited above.

Turning now to the dependent claims, the appellants observe that dependent claims 11, 20, and 21 require a label to be adhesively applied to the printed surface of each printed product in the imbricated stream, and that the information is printed onto each label after the label is adhesively bonded to the printed surface. (Appeal Brief, page 9, lines 15-20). The appellants assert that Jackson's teaching of separately handled products is non-analogous to the instantly claimed imbricated stream, the proposed addition of a printing step to Jackson's conveyor would not be obvious because there is no room downstream where the

Appeal No. 2002-2125  
Application No. 09/078,914

products are in synchronization, and a total redesign of Doane would be required to print after the labels are applied. (Appeal Brief, page 9, lines 23-35).

We note that, in justifying the combination of reference teachings in support of a rejection, it is not necessary to show that a composition or device described in one reference can be physically inserted into the composition or device described in the other. Cf. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.").

As above, we note that imbricated or individual transfer are closely related, as evidenced by Jackson's feeder stream of imbricated articles. Again, we are not persuaded by this argument.

We agree that Doane's disclosure does not disclose a printer after the labels are applied. However, we are not persuaded by the unsupported conclusion that Jackson's printer could not be included without a total redesign of Doane. There is no evidence of record that a printing head could not be incorporated into Doane, merely attorney argument, which is not evidence. It is

Appeal No. 2002-2125  
Application No. 09/078,914

the combination of Doane and Jackson and Popat which render the instantly claimed invention obvious. Additionally, we have not observed a requirement in Doane that the labels must always be pre-printed. Finally, the Jackson printer discloses motivation for its addition - the inclusion of on-line printing of personalized information. (Abstract, lines 4-6). We therefore are not persuaded by these arguments relating to dependent claims 11, 20, and 21.

The appellants have also argued claim 19 separately, in that it discloses a conveyor system including a plurality of clamps for gripping respective ones of the printed products, which is said not to be suggested by the cited references. (Appeal Brief, page 10, lines 1-6).

The examiner has stated that providing lugs or clamps for engaging each article would have been obvious to one of ordinary skill in the art to provide means to ensure feeding of the articles in overlapping relationship. (Examiner's Answer, page 5, lines 18-20).

Although we find that retention of placement on a conveyor is well known, as evidenced by the lugs in Doane (column 2, line 32) we cannot say that the claimed clamps are rendered obvious by the lugs without evidence in the record to support this conclusion. We therefore reverse this rejection as it applies to claim 19.

Appeal No. 2002-2125  
Application No. 09/078,914

The appellants also argue that claims 22 and 23 are separately patentable as defining the use of printing means or station positioned to print the individual labels. It is asserted that Doane utilizes pre-printed labels and there is no suggestion to incorporate a printing station in Doane. Finally, it is again contended that a major redesign of Doane would have to be accomplished to include a printing station. (Appeal Brief, page 10, lines 7-17).

As noted above, Doane teaches only the application of a perforated address label (column 3, lines 68-69). It is not expressly required that it be a preprinted label. Further, we again note that there is no evidence whatsoever that the addition of a printing head would require a major redesign of Doane such that Doane can be read as teaching away from its inclusion. Finally, we note again that the three references in combination render the instantly claimed invention obvious, and the references should not be considered exclusively individually. We therefore affirm the rejection as it applies to claims 22 and 23 as well.

#### Rebuttal Evidence

The appellants have submitted, in a document dated October 31, 2001, two exhibits, which they state establish novelty and unobviousness. (Appeal Brief, page 7, paragraph c et seq.). A prima facie case of obviousness may be rebutted if the appellant

Appeal No. 2002-2125  
Application No. 09/078,914

(1) establishes unexpected properties in the claimed composition or (2) shows that the art, in any material respect, teaches away from the claimed invention. In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). Declaration evidence must be properly considered and the entire matter reweighed (see, e.g. In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 688 (Fed. Cir. 1986)). Whether evidence shows unexpected results is a question of fact and party asserting unexpected results has the burden of proving that the results are unexpected. In re Geisler, 116 F.3d 1465, 1469-70, 43 USPQ2d 1362, 1364-5 (Fed. Cir. 1997).

As regards the two examples provided by the appellants, we see the difference emphasized by the appellants - the partially transparent, almost translucent quality of the claimed label and the printing thereon, versus the clear label.

However, we are unpersuaded that the contrast panels presented are representative of the claimed process or the appropriate prior art. First, neither example is prepared according to the claimed process. The labels appear to be taped on after they were printed, and the location of the labels in exhibit B cannot be said to be in a border region. Additionally, neither example represents the closest prior art, which would incorporate the tinted example of Popat. Furthermore, we fail to see much difference at all in exhibit a.

Appeal No. 2002-2125  
Application No. 09/078,914

Finally, the exhibits are unaccompanied by a statement in the form of a declaration containing information about the provenance or properties of the examples. Accordingly, we give the exhibits little probative weight. Although a useful illustrative tool, on balance, they are insufficient to overcome the prima facie case of obviousness.

Summary of Decision

The rejection of claims 5-8, 11, and 19-23 under 35 U.S.C. § 103(a) as obvious over Doane in view of Jackson and Popat is sustained as to claims 5-8, 11, and 20-23, and reversed as to claim 19.

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**

PETER F. KRATZ	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JAMES T. MOORE	)	
Administrative Patent Judge	)	

Appeal No. 2002-2125  
Application No. 09/078,914

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET SUITE 4000  
CHARLOTTE NC 28280-4000

JTM/ki