

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 STEVEN E. ARMINGTON, RICHARD O. RATZEL,
PAUL J. GUTH and MACDONALD C. BOOZE

Appeal No. 2003-0204
Application No. 09/096,123

ON BRIEF

Before FRANKFORT, McQUADE, 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 279 to 284 and 287 to 294, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a cushioning conversion system which converts sheet stock material into cushioning material. More particularly, the present invention relates to a cushioning conversion system including a packaging controller, wherein the system is adapted to provide recommended packaging and/or packaging information to an operator based on the parts to be packaged, and further to provide for monitoring of packaging supply inventories (specification, p. 1). 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:

DePoint, Jr. et al.
(DePoint)

5,105,600

Apr. 21, 1992

Claims 279 to 284 and 287 to 294 stand rejected under 35 U.S.C. § 103 as being unpatentable over DePoint. The basis for this rejection as set forth on pages 2-3 of the final rejection (Paper No, 22, mailed November 1, 2001) was as follows:

DePoint discloses a packaging system comprising an input device used to identify the part and generate a signal indicative of the identified part (column 6, lines 25-27); a controller (48) coupled to the input device and receiving the signal indicative of the identified part (column 5, lines 46-51); the controller programmed to retrieve a predetermined set of packaging instructions associated with the identified part from a memory (column 2, lines 32-45); the packaging instructions having a step contains [sic] a description of a cushioning

technique designed for the identified part (column 2, lines 60-63); an output device (via 34) coupled to the controller to receive an output signal from the controller (column 5, lines 59-62). DePoint does not disclose the output device being operative to communicate to the operator at least one of an audible and a visual output of the instruction for packaging the identified part. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified DePoint's packaging system by having the output device being operative to communicate to the operator at least one of an audible and a visual output of the instruction for packaging the identified part, as a matter of engineering design choice since the Examiner takes official notice that the mentioned devices are old, well known, and available in the art to use together with an automated system or computer.

On pages 8-9 of the brief (Paper No. 27, filed May 22, 2002), the appellants argue that the examiner has failed to establish a prima facie case of obviousness because there is no teaching or suggestion of why a person of ordinary skill in the art would have been motivated to have modified DePoint to arrive at the claimed invention.

On page 4 of the answer (Paper No. 28, mailed July 17, 2002), the examiner's response to the argument set forth in the brief was as follows:

Appellants argue that DePoint's reference discloses an automated packaging apparatus that uses a robot to perform certain packaging operations, there is totally lacking any reason the ordinary skilled person would have considered adding such an output device for providing audible or visual instructions to an operator. The examiner believes that it would be obvious to one having ordinary skill in the art to modify DePoint's apparatus by adding such an output device for providing audible or visual instructions to an operator for further check up and to follow up with the process step while the process is running (Note, a good example for something similar to that is the McDonald's ordering person replace the order and through the output device (screen) follows up with the process). The examiner also believes that DePoint could replace the

robot by an output devices to inform the operator with the proper steps need to be done, in order to reduce the price of the apparatus.

On pages 1-2 of the reply brief (Paper No. 31, filed August 2, 2002), the appellants argue that there is no motivation, absent the use of their own disclosure, for a person of ordinary skill in the art to have modified DePoint to arrive at the claimed invention.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the DePoint patent, and to the respective positions articulated by the appellants 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 279 to 284 and 287 to 294 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

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).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some

motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be

articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Claim 279, the only independent claim on appeal, reads as follows:

A packaging system for presenting packaging information for packaging a part to an operator, comprising:

an input device used to identify a part and generate a signal indicative of the identified part;

a controller coupled to the input device to receive the signal indicative of the identified part, the controller programmed to retrieve a predetermined set of packaging instructions associated with the identified part from a memory, the packaging instructions including a step to be completed by the operator, which step contains an instruction for packaging the identified part; and

an output device coupled to the controller to receive an output signal from the controller, the output device being operative to communicate the step to be completed by the operator based on the output signal, the output device being operative to communicate to the operator at least one of an audible and a visual output of the instruction for packaging the identified part.

DePoint's invention is related to apparatus and methods for automatically positioning or erecting cases for single objects or arrays of objects, placing such objects or arrays in the case and closing the case. The primary objective of DePoint's invention was to provide an apparatus and method for packaging or packing objects which can automatically, or with minimal operator intervention, adjust for changes in the type of product to be packed, the size of case to be used and the amount of dunnage to be added to a given case.

The apparatus according to DePoint's invention comprises means, such as a conveyor, for providing a series of a plurality of different types of such objects; a first source, such as a carousel with several bins, of a plurality of different types of cases for receiving such objects; means, such as a host computer or a programmable controller for the robot used in the apparatus, for storing and providing information on the order of such objects in the series to be provided; means, such as an assembly table with vacuum elements for holding the case, for locating such cases for insertion of such objects; programmable robot means, responsive to the means for storing and providing, for selecting a type of case from the first source, the selected case being appropriate for the order of such objects in the series and placing such type of case at said means for locating; means for inserting such objects into such type of case; and means for closing such type of case following such inserting. The robot may be used to insert such objects, or they may be inserted by a separate mechanism.

The apparatus of DePoint's invention may further comprise means, such as a stacker elevator, for accumulating a plurality of such objects in arrays for insertion into such type of case. Typically, such cases are collapsed when selected from the first source; the means for locating locates such collapsed cases for erection prior to insertion of such objects and the programmable robot means erects such case at the means for locating. In a preferred embodiment, the apparatus of DePoint's invention

also comprises a second source of dunnage inserts for such cases to accommodate different types of such objects; and means for holding such dunnage inserts in position for insertion into such type of case. In such preferred embodiment, the programmable robot means also performs the functions of selecting appropriate dunnage inserts from the second source and placing such dunnage inserts at the means for holding. Means, which may be comprised in the programmable robot or in a separate mechanism, are provided for inserting such dunnage inserts into such cases with such objects. Alternatively, the dunnage inserts may be placed on top of or interleaved with the objects. In all embodiments, the apparatus of DePoint's invention can pack objects singly or in arrays such as vertical stacks or horizontal groups and, depending on the objects, can insert them into cases either horizontally or vertically.

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).

Based on our analysis and review of DePoint and claim 279, it is our opinion that the differences are (1) the controller programmed to retrieve a predetermined set of packaging instructions associated with the identified part from a memory, the packaging

instructions including a step to be completed by the operator, which step contains an instruction for packaging the identified part; and (2) an output device coupled to the controller to receive an output signal from the controller, the output device being operative to communicate the step to be completed by the operator based on the output signal, the output device being operative to communicate to the operator at least one of an audible and a visual output of the instruction for packaging the identified part.

All the claims under appeal require an output device coupled to the controller to be operative to communicate to the operator at least one of an audible and a visual output of the packaging instruction step to be completed by the operator for packaging the identified part. In our view, these limitations are not suggested by the applied prior art. In that regard, while it may have been obvious at the time the invention was made to a person of ordinary skill in the art to have provided DePoint's programmable controller 48, such as a general purpose computer, with output devices such as a video monitor and speakers, the applied prior art does not teach or suggest using any output device of a controller or computer to provide at least one of an audible and a visual output of at least one of the packaging instructions to be completed by the operator for packaging the identified part. It is our opinion that the examiner has failed to provide the required evidence that would have led one of ordinary skill in the art to have modified DePoint to arrive at the claimed invention. Thus, we must conclude that the

examiner in the rejection before us in this appeal utilized hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible.

For the reasons set forth above, the decision of the examiner to reject claims 279 to 284 and 287 to 294 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 279 to 284 and 287 to 294 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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