THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUKKA MAKINEN

Appeal No. 95-0900
Application 07/947,117[1]

HEARD: March 4, 1998

Before KIMLIN, GARRIS and WALTZ, ***Administrative Patent Judges***.

WALTZ, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 6 through 12, which are the only claims remaining in this application.

According to appellants, the invention is directed to a method and assembly for placing a label onto the head of a paper roll using all horizontal transfer movements (main brief, page

[1] Application for patent filed September 17, 1992.

2). Appellants' method permits an essential shortening of the labeling work cycle since it involves only horizontal movements and the vertical transfer movement of the prior art is eliminated (specification, page 4). Claim 6 is illustrative of the subject matter on appeal and is attached as an APPENDIX to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Kistner	3,708,375	Jan. 2, 1973
Heitmann	3,955,481	May 11, 1976
Uchimura et al. (Uchimura)	4,618,392	Oct. 21, 1986
Matuda et al. (Matuda)	4,725,327	Feb. 16, 1988
Trouteaud et al. (Trouteaud)	4,895,614	Jan. 23, 1990
Hannen	5,024,718	Jun. 18, 1991

Claims 6, 7, 10 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Hannen in view of Matuda and Kistner. Claim 9 stands rejected under 35 U.S.C. § 103 as unpatentable over the same references as applied against claims 6, 7, 10 and 12 further in view of Trouteaud or Uchimura. Claims 8 and 11 stand rejected under 35 U.S.C. § 103 as unpatentable over the same references as applied against claims 6, 7, 10 and 12 further in view of

Heitmann.[2] We *reverse* all the stated rejections for reasons which follow.

OPINION

The method of appealed claim 6 requires three linear horizontal transfer movements, including removing the label from an inclined planar surface.

The examiner concedes that Hannen does not teach picking up labels from an inclined planar surface nor does Hannen teach pressing the labels against the roll by virtue of the horizontal path the clamp element travels (answer, page 3). The examiner states that Hannen was cited to show appellants' adhesive activation device in combination with a reciprocating label applicator (answer, page 6).

The examiner has relied upon Matuda to provide "motivation for omitting the horizontal [sic, vertical?] movement of Hannen's applicator as well as for applying the label by way of a horizontal transfer movement." (answer, page 7). However, as argued by appellants on pages 1 and 2 of the reply brief and

[2] It is noted that the examiner's answer incorrectly lists claims 6, 7, 10 and 12 as being the subject of every rejection instead of reciting claim 9 and claims 8 and 11 as the subject for the second and third rejections, respectively (see the answer, pages 4 and 5). However, the claims are set forth correctly for each rejection in the final rejection and appellants recite the correct status of the claims on page 1 of the main brief. This inadvertent error is therefore harmless.

conceded by the examiner on page 7 of the answer, Matuda clearly discloses vertical transfer movements for the label applicator. See Matuda, column 1, line 18, lines 26-27, column 3, lines 60-62, column 4, lines 43-47, 51, line 62-column 5, line 34.

The examiner states that Matuda, at column 4, lines 45-47, teaches that the vertical strokes can be adjusted to match the relative height of the object to be labeled. The examiner concludes that it would have been obvious that, depending on the relative height of the object to be labeled, the distance of the vertical strokes can be zero (answer, page 7). The examiner has presented no reasoning or factual basis for this interpretation of Matuda that the height of the object to be labeled can be zero and thus the vertical stroke taught by Matuda can be eliminated. *See In re Warner,* 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967)(It is improper to resort to speculation or unfounded assumptions to supply the deficiencies in the factual basis for a rejection).

The examiner relies on Kistner to show that for some label application heights a vertical stroke is unnecessary (answer, page 7). However, Kistner does not show that vertical movement is unnecessary and fails to disclose an inclined planar surface for label pick up. Kistner describes an adjustable hopper 11

that advances adhesive bandages 32 consecutively upward for contact with suction cup 31 (Kistner, column 3, lines 3-5). The hopper acts as a holding box for the bandages and does not present an inclined planar surface. Kistner does not show a vertical stroke for the bandage pick up but the hopper achieves the same function as a vertical stroke by advancing the bandages upwardly to the suction cup. Although not discussed by Kistner, it appears that the vacuum arm 30 does move through a vertical transfer when delivering the bandage to the first platen 15 (see the dotted line movement of 30 in Figure 1 and column 3, lines 7-13).

Trouteaud and Uchimura were applied by the examiner to show vacuum clamps used in a labeling process wherein the clamp element is rotatable between 115 to 165 degrees as required by the relative positions of the label pick-up station and the label application station (answer, page 5). Heitmann was relied upon by the examiner to show a water spraying device to activate the adhesive side of the labels along a label transport path.[3] None of these references applied in the rejections of claims 8, 9 and

[3] Heitmann appears cumulative to Hannen, who teaches the use of a device 23 to spray water onto the underside of the label 18 while it advances along its path (column 7, lines 13-17).

11 cure the deficiencies noted above in the Hannen, Matuda and Kistner references.

For the foregoing reasons, we conclude that the subject matter of claims 6, 7, 10 and 12 would not have been *prima facie* obvious based on the teachings of Hannen, Matuda and Kistner. Similarly, we conclude that the subject matter of claim 9 and claims 8 and 11 would not have been *prima facie* obvious based on the teachings of Hannen, Matuda, Kistner and Trouteaud or Uchimura and Heitmann, respectively. Accordingly, the examiner's rejection of these claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)
BRADLEY R. GARRIS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
THOMAS WALTZ Administrative Patent Judge	)

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APPENDIX

6. A method of placing a label onto an end of a paper roll, the method comprising placing the label on a planar surface which is inclined at an acute angle from the horizontal and is aligned facing the end of the paper roll, moving a clamp element having the same inclination as the planar surface in a first linear horizontal transfer movement against the label and clamping the label, removing the label from the planar surface by means of the clamp element by carrying out a second linear horizontal transfer movement parallel to the first horizontal transfer movement and directed away from the planar surface, activating one side of the label to obtain an adhering surface of the label, further moving the clamp element with the label in a third linear horizontal transfer movement also parallel with the first horizontal transfer movement toward the end of the paper roll, simultaneously rotating the clamp element with the label about a joint into a position extending vertically and parallel with the end of the paper roll, and pressing the adhering surface of the label against the end of the paper roll by the third horizontal transfer movement.