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BOARD OF PATENT APPEALS  
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* MICHAL J. CAHILL  
and DAVID R. SEAWARD

Appeal No. 95-1854  
Application No. 07/650,597<sup>1</sup>

HEARD:  
July 9, 1996

Before CALVERT, STAAB, and McQUADE, *Administrative Patent Judges*.  
CALVERT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12, 15 to 21, 28, 29, 31 and 33 to 49, all the claims remaining in the application. Also, in the examiner's answer a new ground of rejection was applied against claim 49.

<sup>1</sup> Application for patent filed February 5, 1991.

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The independent claims on appeal, claims 28, 38, 44 and 49 are reproduced in the appendix hereto.

The references applied in the final rejection and new ground of rejection are:

Flood	2,981,432	Apr. 25, 1961
Ettre	3,415,706	Dec. 10, 1968
Simonton	4,783,234	Nov. 8, 1988
McCoy	4,867,833	Sep. 19, 1989
Ball et al. (Ball)	4,919,738	Apr. 24, 1990 (filed May 25, 1989)
Punater et al. (Punater)	5,043,749	Aug. 27, 1991 (filed Dec. 29, 1989)
Tubbs	5,186,779	Feb. 16, 1993 (effective filing date Aug. 21, 1989)

The claims on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over the following combinations of references:

1. Claims 12, 15, 28, 35 to 38, 40, 41, 43 and 44 to 49, over Flood in view of Tubbs.
2. Claims 20 and 42, over Flood in view of Tubbs and McCoy.
3. Claim 16, over Flood in view of Tubbs and Ball.<sup>2</sup>
4. Claims 21, 29, 33, 34 and 39, over Flood in view of Tubbs and Punater.

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<sup>2</sup> From the manner in which rejections 3, 4 and 5 are stated in the final rejection, they might be interpreted as being cumulative to the preceding rejection. For example claim 16 is rejected "over the references as applied in (16) above in view of Ball et al" (p.3). This would mean Flood in view of Tubbs, McCoy and Ball et al, since Flood, Tubbs and McCoy are applied in (16). However, the rejections as we have stated them in this decision appear to be as intended by the examiner, and as understood by the appellants.

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5. Claims 17 to 19, 21 and 31, over Flood in view of Tubbs and Simonton.

6. Claim 49, over Ettore in view of Flood.

We will first consider the rejection of claim 44. In reading the subject matter recited in this claim on Flood, the primary reference, we find that Flood discloses a carrier strip (web) S with transferable images (labels) L which are to be applied to a stock W (Fig. 21). As disclosed in columns 6 and 7, and shown in Figs. 26 and 27, during sector d of a cycle the strip S is accelerated to the speed of the stock W (e.g.,  $4\frac{1}{2}$ ) and the label is then transferred during sector a. The strip is then decelerated (sector b) to a speed of  $-\frac{1}{2}$ , at which it runs during sector c, so that the average speed is equal to its speed outside the label transfer zone (col. 7, lines 10 to 25). Since the strip has a speed of " $-\frac{1}{2}$ ," and the curve S' extends downward to the left in the "c" regions of Fig. 26, it is evident that strip S moves in reverse during sector c of the transfer cycle, i.e., that Flood discloses a "means for reversing motion of the web" as claimed.

However, claim 44 also recites:

... wherein said reversing means is arranged to move the web in each cycle through a distance corresponding to that advanced during acceleration to and

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deceleration from the speed of the stock, whereby the net distance travelled by the web in each cycle is substantially equal to the repeat length of the image;  
...

Flood does not disclose the distance recited, nor does it appear that the Flood strip S would inherently move this distance during sector c of the cycle, because from Fig. 26 the distance moved in reverse during sector c (curve S') seems to be considerably greater than the distance moved during acceleration and deceleration (sectors b and d). The examiner seemingly acknowledges this, but takes the position on pages 4 to 5 of the answer that:

... said distance could be easily facilitated by the Flood patent, for Flood teaches in col. 8, line 47 that the speed of the strips can be changed as desired and as is well known, distance is directly related to an article/object's speed, it stands to reason the distance the web travels would be easily controlled to produce identical length/distances as claimed.

Also, on page 9 of the answer it is stated:

Applicants argue that Flood failed to determine how to compensate for the distance travelled by a web during acceleration and deceleration. To this the Examiner would disagree for it has long been held that the provision of adjustability, where needed, involves only routine skill in the art and would have been done manually or automatically. In re Stevens [, 212 F.2d 197,] 101 USPQ 284 (CCPA 1954).

We do not agree with the examiner. Assuming arguendo that the Flood apparatus could be adjusted so that the strip S would

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reverse by the recited distance, the question still remains, what is there in the prior art which would have suggested or taught one of ordinary skill to make such an adjustment? The question is not whether the Flood apparatus could be adjusted to meet the claimed limitations, but whether, in view of the prior art, one of ordinary skill would have found it obvious to do so. We find nothing in Flood (or in Tubbs, which is discussed *infra*) which would teach or suggest to one of ordinary skill that the strip S be reversed a distance which corresponds to that advanced during its acceleration and deceleration.

The examiner evidently feels that the fact that the Flood apparatus would be capable of reversing the web (strip) by the claimed distance is sufficient to meet the claim. However, this is not a case like In re Stevens, *supra*, where the apparatus was claimed as being adjustable, nor like In re Collier, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968), where an element was claimed as being "for" a particular intended use. In the present case, the reversing means is specifically recited as being arranged to move the web a specified distance; this is neither a recitation of adjustability nor of an intended use, but rather is of a particular means arranged to produce a particular manner of operation. Even if Flood's apparatus could be easily controlled

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to operate as recited in the claim, there is nothing in the prior art which teaches or suggests that it should be so controlled.

The final clause of claim 44 recites:

wherein the web advancing means is arranged to withdraw the web from a reservoir in which, during advancement and reversal, the web is maintained under controlled tension by pneumatic means.

As evidence of the obviousness of this limitation, the examiner cites Tubbs as teaching "that it is known to provide reservoir means (84, 89, 69) which contain portions of web-like material" (answer, page 4). The examiner acknowledges that Tubbs does not disclose pneumatic means, but states at page 9:

The examiner believes that pneumatic means are notoriously well known in the art and could have been employed in the cited reference depending on availability and desires.

This argument by the examiner is not well taken. The use of pneumatic means is not a matter which, in our view, is so "notoriously well known in the art" that it is unnecessary to supply any evidence thereof, and we do not find any such evidence in the record.<sup>3</sup> See In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-1 (CCPA 1970) ("Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a

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<sup>3</sup> The examiner states on page 7 of the answer that pneumatic means "is taught by the cited references," but does not identify any such references.

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particular art should also be supported [by citation to a reference work]..."). Absent such evidence, it cannot be concluded that the use of pneumatic means to maintain the Flood web (strip) under controlled tension would have been obvious.

For the foregoing reasons, the rejection of claim 44 will not be sustained.

Independent claim 28 recites a "pneumatic means arranged upstream of the transferring means for assisting in the reversal of the carrier web" and thus is likewise considered patentable in view of the lack of any cited prior art disclosing such pneumatic means.

Independent claims 38 and 49 both call for reversal of the web "through a distance corresponding to that advanced" during acceleration and deceleration, and are considered patentable in view of the lack of any teaching or suggestion thereof in the cited prior art, as discussed above with regard to claim 44. With regard to the new ground of rejection of claim 49 over Ettore in view of Flood, we do not find anything in these references which would supply this deficiency.

The additional references applied against the dependent claims do not contain any disclosure which would overcome the

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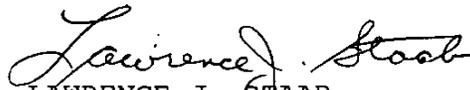
noted inadequacies of the references applied against the parent claims.

Accordingly, the examiner's decision to reject claims 12, 15 to 21, 28, 29, 31 and 33 to 49, all the claims on appeal, is reversed.

REVERSED

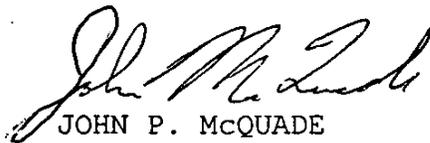


IAN A. CALVERT )  
Administrative Patent Judge)



LAWRENCE J. STAAB )  
Administrative Patent Judge)

BOARD OF PATENT  
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JOHN P. McQUADE )  
Administrative Patent Judge)

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APPENDIX

28. An apparatus for applying a series of images to a moving stock, comprising: means for conveying the images on a carrier web, the images having corresponding portions at a first spacing on the carrier web; means for transferring the images from the carrier web to predetermined positions on the moving stock, the images having corresponding portions at a second spacing on the stock, said second spacing being greater than said first spacing; means for controlling said conveying means in successive application cycles to control movement of the carrier web at the same speed as the stock during transfer, but at a lower speed between transferring, so as to reduce net travel of the carrier between transferring, and to reverse the motion of the carrier web between each transferring of images to said moving stock by said transferring means, said controlling means including carrier web driver means arranged downstream of said transferring means for driving said conveying means and pneumatic means arranged upstream of said transferring means for assisting in the reversal of the carrier web; and a web reservoir through which the carrier web passes upstream of the transferring means for accumulating carrier web during reverse movement thereof.

38. An apparatus for processing a web, comprising means for conveying the web in a conveying direction past a processing position at a variable speed by alternately accelerating and decelerating the web in successive cycles; and means for periodically subjecting successive portions of the web to a process step including engagement of the web at said position; said conveying means including means for controlling movement of the web (a) to accelerate said web to convey at least said portion of the web at a predetermined speed during said process step, (b) to decelerate the web and reverse the motion of the web after completion of a process step so as to move the web in a direction reverse to the conveying direction through a distance corresponding to that advanced during acceleration and deceleration, and then (c) to convey the web in the conveying direction at a lower speed than said predetermined speed between process steps so that successive process steps are performed at substantially adjacent successive portions of the web.

44. Apparatus for applying a series of images to a moving stock, comprising: means for conveying a carrier web, said web carrying transferable images; means for conveying a stock to which the images are to be applied; means for

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advancing the stock at a controlled speed; means for advancing the web at a variable speed by alternately accelerating and decelerating the web in successive cycles; and means for transferring the images to predetermined positions of the stock; said web advancing means including means for moving the web at the speed of the stock while images are being transferred and means for moving the web at a lower speed at other times so as to reduce net travel of the web between successive transferring steps, said moving means including means for reversing motion of the web, wherein said reversing means is arranged to move the web in each cycle through a distance corresponding to that advanced during acceleration to and deceleration from the speed of the stock, whereby the net distance travelled by the web in each cycle is substantially equal to the repeat length of the image; and wherein the web advancing means is arranged to withdraw the web from a reservoir in which, during advancement and reversal, the web is maintained under controlled tension by pneumatic means.

49. A method for applying a series of images to a moving stock, comprising the steps of: conveying a carrier web, said web carrying transferable images; conveying a stock to which the images are to be applied; advancing the stock at a

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controlled speed; advancing the web at a variable speed by alternately accelerating and decelerating the web in successive cycles; and transferring the images to predetermined positions of the stock; said web advancing including moving the web at the speed of the stock while images are being transferred, moving the web at a lower speed at other times so as to reduce net travel of the web between successive transferring steps, and reversing motion of the web so as to move the web in each cycle through a distance corresponding to that advanced during acceleration to and deceleration from the speed of the stock, whereby the net distance travelled by the web in each cycle is substantially equal to the repeat length of the image; and wherein the web advancing further includes withdrawing the web from a reservoir in which, during advancement and reversal, the web is maintained under controlled tension by pneumatic means.