

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNST-GUNTHER URBAN

Appeal No. 95-2941
Application No. 08/139,616¹

HEARD: January 13, 1998

Before CALVERT, FRANKFORT, 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 8 through 17, which are all of the claims pending in this application.²

¹ Application for patent filed October 18, 1993. According to the appellant, the application is a continuation of Application No. 07/882,147, filed May 11, 1992, now abandoned.

² Claim 15 has been amended subsequent to the final rejection by an amendment filed on November 28, 1994 (Paper No. 23).

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We REVERSE.

BACKGROUND

The appellant's invention relates to a winding machine with an adhesive strip applicator. An understanding of the invention can be derived from a reading of exemplary claim 8 which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Kataoka	3,784,122	Jan. 8, 1974
Dowd	4,133,495	Jan. 9, 1979
Nowisch	4,422,588	Dec. 27, 1983
Welp et al. (Welp)	4,775,110	Oct. 4, 1988

Claims 8 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nowisch in view of Kataoka, Welp and Dowd.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 24, mailed February 21, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No.

22, filed November 28, 1994) and reply brief (Paper No. 26, filed March 20, 1995) 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. As a consequence of our review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 is not well founded and will therefore not be sustained. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

With regard to the examiner's rejection of claims 8 through 17 under 35 U.S.C. § 103, we share the appellant's view that the

combined teachings of the applied prior art would not have suggested the claimed invention. Specifically, it is our determination that the combined teachings of the applied prior art would not have suggested the carriage as recited in independent claims 8 and 15. In that regard, both independent claims 8 and 15 require the carriage to include (1) a pressing roller for transferring a two-sided adhesive strip to a web at the arc of the support roller, and (2) a cutter behind the pressing roller for cutting through the two-sided adhesive strip and web. It is our view, after a careful review of the combined teachings of the applied prior art, that in searching for an incentive for modifying the winding device of Nowisch, the examiner has impermissibly drawn from the appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Since we have determined that the subject matter of independent claims 8 and 15 would not have been suggested by the combined teachings of the applied prior art, it follows that we will not sustain the examiner's rejection of appealed independent

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claims 8 and 15, or claims 9 through 14, 16 and 17 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 8 through 17 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/139,616

APJ NASE

APJ CALVERT

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 20 Jan 98

FINAL TYPED:

HEARD: 13 Jan 98