

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JUHA KIVIMAA and  
MARTTI HIRSIMAKI

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Appeal No. 96-0089  
Application No. 08/027,060<sup>1</sup>

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HEARD: May 5, 1999

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Before CAROFF, METZ, and HANLON, Administrative Patent Judges.  
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of claims 1-3, 8-10, 14-15 and 21-25. Claims 4-7 and 11-13, all the other claims remaining in the involved application, stand withdrawn from consideration in accordance with the provisions

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<sup>1</sup> Application for patent filed March 5, 1993.

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of 37 CFR 1.142(b) and 1.146 as being drawn to a non-elected invention or species and, therefore, are not before us.

The claims on appeal relate to a section of a paper machine where an air-transfer device is positioned to produce a reduced pressure in an opening outlet nip defined between a transfer roll and a straight run of a press felt; the straight run extending from the transfer roll to a press nip. For purposes of this appeal, claim 1 is representative:

1. A device in a paper machine for guiding a leader of a paper web, comprising

a first press nip defined by a center roll and a press roll,

a transfer roll located after said center roll in a running direction of the web,

a second press nip defined between a separate pair of rolls and arranged after said transfer roll in the running direction of the web,

a press felt on which the leader of the web is received over said transfer roll and carried through said second press nip, said press felt having a substantially straight run from said transfer roll to said second press nip, the web first touching said press felt as said press felt runs over said transfer roll to thereby define a closing inlet nip prior to contact between the leader of the web and said press felt, and

air-transfer means arranged exterior to said transfer roll and at an initial end of said straight run of said press felt in an area between said first press nip and said second press nip, said air-transfer means being positioned proximate

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to said transfer roll and producing a reduced pressure at least across a width of the leader in an opening outlet nip defined between said transfer roll and said straight run of said felt, said reduced pressure causing the leader to adhere to an upper face of said felt as said felt is detached from said transfer roll and remain adhered to said upper face of said felt as it is carried into said second press nip.

The examiner relies upon the following eight references to support multiple rejections of the claims for obviousness:

Beachler	2,714,342	Aug.
2, 1955		
Karvinen et al. (Karvinen)	4,526,655	Jul. 2,
1985		
Kerttula et al. (Kerttula)	4,543,160	Sep.
24, 1985		
Autio	4,608,125	Aug. 26, 1986
Weideburg	4,768,294	Sep. 6, 1988
Skaugen	4,874,470	Oct. 17, 1989
Laapotti	5,120,400	Jun. 9, 1992

McDonald et al. (McDonald), "A New Web Transfer System for Closing the Draw Between the Last Press and the Dryer Section", CCPA Annual Mtg. (1990).

The following six rejections under 35 U.S.C. § 103 are before us for consideration:<sup>2</sup>

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<sup>2</sup> We note that the appealed claims were also rejected under 35 U.S.C. § 112, second paragraph, in the final rejection (Paper No. 10). Since there is no reference to the 35 U.S.C. § 112 rejection in the examiner's Answer, we presume that this rejection has been withdrawn by the examiner.

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(I). Claims 1, 9, 15, 21 and 22 stand rejected as obvious from Autio or Skaugen, each in view of Karvinen or Weideburg.

(II). Claims 2, 3, and 10 stand rejected as obvious from the references as applied in (I) above, further in view of McDonald or Beachler.

(III). Claims 8, 14 and 23-25 stand rejected as obvious from the references as applied in (I) above, further in view of Laapotti with or without Kerttula.

(IV). Claims 1, 8-9, 14-15 and 21-25 stand rejected as obvious from Laapotti in view of Karvinen or Weideburg.

(V). Claims 8, 14 and 23-25 stand rejected as obvious from the references as applied in (IV) above, further in view of Kerttula.

(VI). Claims 2, 3 and 10 stand rejected as obvious from the references as applied in (IV) above, further in view of McDonald or Beachler.

After having carefully considered the entire record in light of the well-reasoned positions set forth by appellants and by the examiner, respectively, we agree with appellants that the appealed claims define subject matter which is

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patentable and nonobvious from the cited prior art.

Accordingly, we shall reverse each of the rejections applied by the examiner.

Initially, we note that all of the applied rejections are premised upon the basic combination of any one of three primary references (Autio, Skaugen, Laapotti) with Karvinen or Weideburg. The dispositive issue on appeal relates to the propriety of this basic combination. We agree with appellants essentially for the reasons expressed in their Brief and Reply Brief that the collective teachings of the subject prior art references would not provide a person of ordinary skill in the papermaking art with the requisite motivation to position an air-transfer device in an opening outlet nip defined between a transfer roll and a straight run of a press felt extending from the transfer roll to a press nip. Even accepting, as a general proposition, that air transfer devices of the sort recited in the instant claims have been used in prior art papermaking machines (Karvinen, Weideburg) at certain locations to maintain a web (or leader) in contact with a felt, the examiner has failed to establish why it would have

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been obvious to do so at the precise location and in the particular system defined by appellants' claims.

Appellants offer a reasonable basis for concluding that there would be no critical need for providing suction or reduced pressure at an outlet nip in either the system of Autio or Skaugen inasmuch as in these systems, unlike appellants' system, the run of the press felt between the transfer roll and a press nip is curved; thereby providing a mechanism for tensioning the web against the press felt. In this regard, we emphatically disagree with the examiner's conclusion that the claims do not require the entire run of the press felt, from roll to subsequent press nip, to be straight. On the contrary, in our view the claims clearly require that the recited "substantially straight run" extend "from" the transfer roll to the press nip.

With regard to all three of the primary references, including Laapotti, we note that appellants' system has been specifically designed to counter a number of problems which tend to occur in such systems as fully explained in the Brief and Reply Brief. The primary references, on the other hand, do not even recognize that these particular problems exist.

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Discovery of the source of a problem constitutes a further ground which supports a finding of patentability. In this regard, see In re Roberts, 470 F.2d 1399, 1401, 176 USPQ 313, 314-315 (CCPA 1973); In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969); In re Conover, 304 F.2d 680, 684, 134 USPQ 238, 241 (CCPA 1962); Eibel Process Co. v. Minnesota and Ontario Paper Co., 261 U.S. 45, 67-68, 1923 Dec. Comm'r Pats. 623, 639-640 (1923).

None of the other references which have been applied against the claims cure the deficiency of the basic combination of the primary references with Karvinen or Weideburg. Thus, all of the applied rejections fall with the basic combination relied upon by the examiner.

For the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF )  
Administrative Patent Judge )  
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) BOARD OF PATENT

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ANDREW H. METZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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ADRIENE LEPIANE HANLON	)	
Administrative Patent Judge	)	

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APJ CAROFF

APJ HANLON

APJ METZ

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: January 12, 2000

Draft    Final

3 MEM. CONF.    Y    N

OB/HD    GAU

PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT