

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. SIMMONS

Appeal No. 1998-2032
Application No. 08/410,048

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
COHEN and GONZALES, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's
final rejection of claims 1-24.¹ No other claims are
pending in the application.

¹ Subsequent to the final rejection (Paper No. 6 mailed November 19, 1996), claims 1 and 24 were amended in Paper No. 7 filed February 24, 1997 and claim 15 was amended in Paper No. 22 filed March 15, 1999 to remove indefinite claim language from the independent claims. Although the examiner has indicated in the letter filed February 9, 1999 (Paper No. 20) in response to our remand (Paper No. 19), that the amendment to claim 15 would be entered upon being submitted in a paper separate from the reply brief, the record does not show as yet that this amendment has been formally entered. We nevertheless presume that the amendment to claim 15 has been entered in view of the fact that the rejection of claim 15 and the other appealed claims under the second paragraph of 35 U.S.C. ' 112 has not been carried forward and restated in the examiner's supplemental answer (Paper No. 16). We therefore presume that the

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Appellant's invention relates to a cushion-producing machine (also called a dunnage-creating machine on page 1 of appellant's specification) for producing cushions or dunnage pads which are placed in shipping containers to protect shipped articles. The cushion-producing machine includes a forming assembly (38) for forming a continuous strip of pillow-like cushioning pads or elements from sheet-like stock material. As disclosed, the forming assembly comprises a forming member (38) coacting with curved surfaces of a conically shaped chute (44) to roll the lateral edges of the stock material inwardly. All of the independent claims on appeal, namely claims 1, 15 and 24, are limited to a forming assembly in which the forming member is a **A**triangular plate.®

A correct copy of claims 1-14 and 16-24 is appended to appellant's brief. As a result of the amendment filed March 15, 1999 (see note 1 supra), the copy of claim 15 in appellant's appendix is no longer correct. This amendment deletes the word **A**the® from the phrase **A**the lateral edges of the stock material.®

rejection of the appealed claims under the second paragraph of ' 112 has been withdrawn. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

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The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. ' 103:

Ottaviano (Ottaviano '776)	4,237,776	Dec. 9, 1980
Ottaviano (Ottaviano '613)	4,717,613	Jan. 5, 1988
Komaransky et al. (Komaransky)	4,750,896	Jun. 14, 1988
Baldacci (Baldacci '999)	4,884,999	Dec. 5, 1989
Baldacci (Baldacci '543)	5,061,543	Oct. 29, 1991
Baldacci (Baldacci '581)	5,188,581	Feb. 23, 1993

The following rejections are before us for review:

Claims 1-24 stand rejected under 35 U.S.C. ' 103 Aas being unpatentable over Baldacci, `999, `581, or `543, in view of Ottaviano, `776, or `613, or Komaransky@ (supplemental answer, page 3).

According to the examiner's findings (see page 4 of the supplemental answer), each of the Baldacci patents discloses the invention defined in claims 1, 15 and 24 except for the recitation that the forming member is a triangular plate. He nevertheless concludes:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Baldacci with the teachings of Ottaviano or Komaransky to improve a cushioning machine operation by ensuring reliable throughput since Ottaviano or Komaransky teach that utilizing a triangular plate shape having curved edge surfaces in

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order to complement and coact with a pair of curved, triangular, converging and conical surfaces improves the reliable throughput of a cushioning machine operation and was old and well known at the time the invention was made, . . . [supplemental answer, page 4].

Reference is made to the examiner's supplemental answer for further details of his rejections.

We cannot sustain any of the standing rejections of the appealed claims. Our reasons for this determination follow.

Each of the Baldacci patents describes the forming member as being an **A**elongated bar like former member@ (see, for example, column 6, lines 4-5 of the '999 Baldacci patent). A **A**bar@ or **A**bar like member@ is normally not regarded by those skilled in the art as being a plate. But even assuming for the sake of argument that the elongated, rectangular **A**bar like former member@ disclosed in the Baldacci patents is a plate, the rejections of the appealed claims are still untenable.

In this regard, each of the secondary references, namely the '776 Ottaviano patent, the '613 Ottaviano patent and the Komaransky patent fails to teach a former member in

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the form of a plate. In each of these secondary references the former member is a triangular framework made of bar stock such as tubular members. Following these teachings, one of ordinary skill in the art would have substituted the triangular frame of the secondary references for the bar like former member in the Baldacci references. Such a modification, however, obviously would not meet the terms of the independent claims on appeal inasmuch as each of the independent claims requires the triangular former member to be in the form of a plate, not a frame.

The examiner nonetheless attempts to somehow combine the feature of the flat bottom of the bar like former member in the primary references (i.e., the Baldacci patents) with the triangular shape of the forming frames in the secondary references in order to arrive at appellant's claimed invention. However, the only way the examiner could have arrived at such a piecemeal reconstruction of the prior art is through hindsight based on appellant's teachings. Hindsight analysis, however, is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

With regard to the remarks on page 5 of the supplemental answer, the examiner has misapplied the ruling in In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (discovery of an optimum range by routine experimentation is not patentable). In the case before us, we are not concerned with ranges of any kind. The claimed difference in structure, namely the triangular plate in appellant's invention as compared with the bar like forming member in the primary references and the triangular frames in the secondary references, cannot be likened to a difference in numerical ranges.

The examiner's decision to reject claims 1-24 as unpatentable over the '999 Baldacci patent in view of each of the secondary references (namely the '776 Ottaviano patent, the '613 Ottaviano patent and the Komaransky patent) is reversed, the examiner's decision to reject claims 1-24 as unpatentable over the '581 Baldacci patent in view of each of the foregoing secondary references is reversed and the examiner's decision to reject claims 1-24

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as unpatentable over the `543 Baldacci patent in view of
each of the foregoing secondary references is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge))	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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Jay R. Campbell
Renner, Otto, Boisselle
And Sklar
1621 Euclid Ave.
19th Flr.
Cleveland, OH 44115

HEM/dal