

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFREY J. BOREALI, CAS FORMAS,  
STEVE MICHALOVIC and DANIEL G. SHENK

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Appeal No. 1999-1965  
Application 08/529,230

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ON BRIEF

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Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jeffrey J. Boreali et al. appeal from the final rejection of claims 1 through 20, all of the claims pending in the

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application.<sup>1</sup> We reverse.

The invention relates to a dispenser for linerless labels. A copy of the claims on appeal appears in the appendix to the appellants' main brief (Paper No. 22).

The references relied upon by the examiner as evidence of obviousness are:

Hill 9, 1975	3,924,498	Dec.
Yokota 1987	4,690,344	Sept. 1,
Cassia 1988	4,738,176	Apr. 19,
Hirono et al. (Hirono) 1995	5,447,383	Sept. 5,
Kudo et al. (Kudo) 1996	5,556,213	Sept. 17,
	(filed Mar. 30,	
1994)		
Boreali et al. (Boreali) 1, 1996	5,560,293	Oct.
	(filed Jun. 7,	
1995)		
Szczepanec et al. (Szczepaniec) 1998	5,725,719	Mar. 10,
	(filed Jun. 26,	
1995)		

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<sup>1</sup> Claims 1 and 4 have been amended subsequent to final rejection.

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The claims stand rejected as follows:

a) claims 5, 6, 17, 18 and 20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention;<sup>2</sup>

b) claims 1, 7, 8, 11, 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Boreali in view of Yokota;

c) claims 2 through 4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Boreali in view of Yokota and Hill;

d) claims 5, 13 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Boreali in view of Yokota, Hill and Szczepaniec;

e) claims 6, 14, 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Boreali in view of Yokota, Hill, Szczepaniec and Hirono;

f) claim 9 under 35 U.S.C. § 103(a) as being unpatentable

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<sup>2</sup> In the final rejection (Paper No. 12), claims 1 through 4 and 7 through 15 also stood rejected under 35 U.S.C. § 112, second paragraph. The examiner has since withdrawn the rejection as to these claims in light of amendments made subsequent to final rejection (see page 12 in the answer, Paper No. 24).

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over Boreali in view of Yokota and Cassia;

g) claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Boreali in view of Yokota, Cassia and Kudo; and

h) claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Boreali in view of Yokota, Szczepaniec and Hirono.

Reference is made to the appellants' main and reply briefs (Paper Nos. 22 and 25) and to the examiner's answer (Paper No. 24) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

The 35 U.S.C. § 112, second paragraph, rejection rests on the examiner's determination that claims 5, 6, 17, 18 and 20 are indefinite because

i) In claim 5 [and presumably claim 17], the phrase "a label" is vague and indefinite in that it is a double inclusion of the same

previously recited. Applicant is advised to carefully review the rest of the claims to obviate this issue.

ii) Claim 20 is vague and indefinite in that it is not clear what the claim encompasses. What is the "combination" in line 1 referring to?  
A "combination" has not been recited in independent claim 19 [answer, page 4].

Neither of these concerns is well taken. The references to "a label" in claims 5 and 17 (from which claims 6 and 18 depend, respectively) are made in a functional context to define how the claimed subject matter works. As such, they do not pose a double inclusion problem. Furthermore, although "dispenser" claim 19 does not explicitly include the word "combination," it is in fact a combination claim. In this light, the reference in the preamble of claim 20 to the "combination as recited in claim 19" is readily understood to refer to the combination of dispenser elements recited in claim 19.<sup>3</sup>

Thus, the claim limitations targeted by the examiner are not indefinite. Accordingly, we shall not sustain the

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<sup>3</sup> Nonetheless, the appellants might find it desirable for the sake of consistency to carry through on their offer (see page 5 in the main brief) to amend claim 19 by changing "combination" to --dispenser--.

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standing 35 U.S.C. § 112, second paragraph, rejection of claims 5, 6, 17, 18 and 20.

With regard to the standing prior art rejections, Boreali, the examiner's primary reference, discloses a linerless label printer and transport system comprising a roll of linerless labels 13 mounted on an unwind core 12, a label guide 15, a transport plate 16, a driven platen roller 17, a thermal printhead 18, a stripper blade/bridge 42, a cutter 60 and an exit plate 65. These elements are arranged as shown in Figures 1 and 2.

As conceded by the examiner (see page 4 in the answer), the Boreali system fails to meet the limitations in independent claims 1, 16 and 19 requiring first and second drive rolls for engaging the labels and taking them off a supply. In the Boreali system, this function is performed by driven platen roller 17. Boreali also fails to respond to the limitations in independent claim 1 requiring the drive rolls to be grooved and to be associated with first and second sets of stripper and guiding fingers disposed in at least some of the grooves.

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Yokota discloses an apparatus for rotatably holding and paying out a roll 1 of thin, film-like products 3 such as plastic pouches or paper towels. The apparatus includes a winding core 2 for supporting the roll, grooved feed rolls 6 and 7, and product guides 11 and 12 having wire portions disposed in the roller grooves.

In rejecting claims 1, 16 and 19 under 35 U.S.C. § 103(a), the examiner concludes that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Boreali et al '293 with the pair of drive rolls and first and second sets of "stripper and guiding fingers" as taught by Yokota in order to facilitate positive guiding [and] feeding of the strip of material to be cut [answer, page 5].

The appellants counter that this proposed reference combination constitutes an impermissible hindsight reconstruction of their invention.

Given the disparate teachings of Boreali and Yokota, the appellants' hindsight argument is persuasive. These references provide no support for the examiner's determination that the feeding and guiding characteristics of Boreali's linerless label system would be facilitated or improved by

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Yokota's plastic

bag/paper towel feed roll arrangement. The addition of the Yokota feed rolls and product guides to the Boreali system would appear to be unnecessarily redundant, while the substitution of same for Boreali's driven platen roller 17 would complicate the printing aspect of the Boreali system by necessitating the provision of another platen for printhead 18. In this light, it is evident that the examiner has improperly employed the claimed invention as a template to selectively combine the Boreali and Yokota disclosures. It is also noted that these references fail to respond to the particular relationship required by claims 1, 16 and 19 between the housing and the label supply support. As for the additional prior art references applied by the examiner, suffice to say that they are insufficient to cure the foregoing deficiencies in the basic Boreali-Yokota combination.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejections of independent claims 1, 16 and 19 or of

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claims 2 through 15, 17, 18 and 20 which depend therefrom.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	
JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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