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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM C. NEUBAUER, ROGER MATTILA, and
ILIJA ILIJEVSKI

Appeal 2014-001878
Application 12/489,332
Technology Center 3700

Before BRANDON J. WARNER, LEE L. STEPINA, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

William C. Neubauer et al. (“Appellants”) appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–2, which are all the pending claims.¹ Appeal Br. 5. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ According to Appellants, the real party in interest is G&K-VIJUK INTERN. CORP. of Wellendingen, Germany. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellants' disclosed invention relates to "forming informational items such as outserts," which are informational items "formed from a sheet of paper which is folded in two perpendicular directions," typically for association with pharmaceutical containers. Spec. ¶¶ 2–3. Claim 1, reproduced below with emphasis added, is the sole independent claim appealed and is representative of the subject matter on appeal.

1. A method of using a folding apparatus to form an outsert having product information printed thereon, said method comprising:

(a) making a first fold in a first direction in a sheet of paper having a leading edge, a trailing edge, and product information printed thereon with a first folding apparatus by a method comprising:

(a1) feeding said sheet of paper in said first folding apparatus until said leading edge of said sheet of paper makes contact with a first stop member of said first folding apparatus;

(a2) continuing to feed said sheet of paper through said first folding apparatus with said leading edge of said sheet of paper in contact with said first stop member of said first folding apparatus so that an intermediate portion of said sheet of paper between said leading edge and said trailing edge forms a buckled portion; and

(a3) continuing to feed said sheet of paper through said first folding apparatus to cause said buckled portion of said sheet of paper to pass between a first pair of folding rollers of said first folding apparatus to form a first fold in said sheet of paper in said first direction;

(b) making at least one additional fold in said sheet of paper in a direction parallel to said first fold and said first direction with said first folding apparatus to form a first folded article having a first end comprising a plurality of unfolded sheet edges, a second end comprising a plurality of unfolded

sheet edges, and a maximum thickness, said at least one additional fold being made by a method comprising:

(b1) continuing to feed said sheet of paper through said first folding apparatus until a leading portion of said sheet of paper makes contact with a stop member of said first folding apparatus;

(b2) continuing to feed said sheet of paper through said first folding apparatus with said leading portion of said sheet of paper in contact with said stop member referred to in paragraph (b1) so that an intermediate portion of said sheet of paper between said leading portion and a trailing portion of said sheet of paper forms a buckled portion; and

(b3) continuing to feed said sheet of paper through said first folding apparatus to cause said buckled portion referred to in paragraph (b2) to pass between a pair of folding rollers of said first folding apparatus to form a fold in said sheet of paper in said first direction;

(c) making a fold in said first folded article in a second direction perpendicular to said first direction, said fold in said first folded article being made so that said first folded article is folded to form a second folded article having a first end comprising said fold in said first folded article and a second end comprising both said first and second ends of said first folded article and so that said second folded article has a maximum thickness of twice said maximum thickness of said first folded article, said fold in said first folded article being made by a method comprising:

(c1) feeding said first folded article in a folding apparatus until a leading portion of said first folded article makes contact with a stop member of said folding apparatus referred to in paragraph (c1);

(c2) continuing to feed said first folded article through said folding apparatus referred to in paragraph (c1) with said leading portion of said first folded article in contact with said stop member referred to in paragraph (c1) so that an intermediate portion of said first folded

article between said leading portion of said first folded article and a trailing portion of said first folded article forms a buckled portion; and

(c3) continuing to feed said first folded article through said folding apparatus referred to in paragraph (c1) to cause said buckled portion of said first folded article to pass between a pair of folding rollers of said folding apparatus referred to in paragraph (c1) to form said fold in said first folded article in said second direction;

(d) making a fold in said second folded article in said second direction to form a third folded article having a first end comprising said fold in said second folded article, a second end comprising said fold in said first folded article, and a maximum thickness of twice said maximum thickness of said second folded article and four times said maximum thickness of said first folded article, said fold in said second folded article being made by a method comprising:

(d1) feeding said second folded article through a folding apparatus until a leading portion of said second folded article makes contact with a stop member of said folding apparatus referred to in paragraph (d1);

(d2) continuing to feed said second folded article through said folding apparatus referred to in paragraph (d1) with said leading portion of said second folded article in contact with said stop member referred to in paragraph (d1) so that an intermediate portion of said second folded article between said leading portion of said second folded article and a trailing portion of said second folded article forms a buckled portion; and

(d3) continuing to feed said second folded article through said folding apparatus referred to in paragraph (d1) to cause said buckled portion of said second folded article to pass between a pair of folding rollers of said folding apparatus referred to in paragraph (d1) to form said fold in said second folded article in said second direction;

(e) making a fold in said third folded article in said second direction to form a fourth folded article having a first end comprising said fold in said third folded article, a second end comprising said fold in said first folded article, and a maximum thickness of twice said maximum thickness of said third folded article, four times said maximum thickness of said second folded article and eight times said maximum thickness of said first folded article;

(f) making a fold in said fourth folded article in said second direction to form an outsert having a first end comprising said fold in said fourth folded article and a second end comprising said fold in said first folded article and said fold in said third folded article, said fold in said fourth folded article being made by a method comprising:

(f1) feeding said fourth folded article in a folding apparatus using rollers until a leading portion of said fourth folded article makes contact with a stop member of said folding apparatus referred to in paragraph (f1);

(f2) causing a movable knife member of said folding apparatus referred to in paragraph (f1) to make contact with and push an intermediate portion of said fourth folded article towards a folding roller;

(f3) continuing to feed said fourth folded article through said folding apparatus referred to in paragraph (f1) so that said intermediate portion of said fourth folded article makes contact with said folding roller referred to in paragraph (f2) to form said fold in said fourth folded article; and

(g) *applying pressure to at least one of said folded articles, said pressure being at least about 30 pounds per square inch, said pressure being applied by a pressing unit comprising a plurality of pressure rollers, a minimum spacing between the plurality of pressure rollers being adjustable by operation of a spacing adjustment mechanism, wherein the pressure applied to the folded article is adjustable by an adjustable pressure exerting mechanism coupled to a support of one of the pressure [rollers].*

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Waterworth	US 1,716,936	June 11, 1929
Hoshi	US 4,427,405	Jan. 24, 1984
Ishida	US 6,030,165	Feb. 29, 2000
Vijuk	US 6,068,300	May 30, 2000

REJECTION

The following rejection is before us for review: Claims 1–2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waterworth, Ishida, Vijuk, and Hoshi.

ANALYSIS

All the claims recite, in relevant part, a method of using a folding apparatus to form an outsert, where the method includes “*applying pressure to at least one of said folded articles,*” with “*said pressure being applied by a pressing unit comprising a plurality of pressure rollers,*” including both “*a minimum spacing between the plurality of pressure rollers being adjustable by operation of a spacing adjustment mechanism,*” and where “*the pressure applied to the folded article is adjustable by an adjustable pressure exerting mechanism coupled to a support of one of the pressure [rollers].*” See Appeal Br., Claims App. (emphasis added). Thus, the claimed method requires applying pressure with a pressing unit including a plurality of pressure rollers, where the same pressure rollers have both (1) adjustable minimum spacing therebetween via a spacing adjustment mechanism, and

(2) adjustable pressure being applied via an adjustable pressure exerting mechanism. Appellants argue that Hoshi, as relied on in the rejection, does not teach pressure rollers that have both of the recited adjustability features. *See* Appeal Br. 13–16. We agree.

In rejecting the claims, the Examiner relies on Waterworth for disclosing a method of using a folding apparatus to make various folds in a sheet of paper and applying pressure to the folded article with a pressing unit including a plurality of pressure rollers. *See* Final Act. 2–9. The Examiner acknowledges, however, that Waterworth fails to disclose that the pressure rollers have the two disputed features enumerated above. *See id.* at 9–10. For these limitations, the Examiner turns to Hoshi for teaching pressure rollers that have these features. *See id.* at 10 (citing Hoshi, claim 4); Ans. 12–13 (citing Hoshi, claim 4, col. 6, ll. 24–29).

Appellants persuasively assert that the rejection is deficient because Hoshi does not teach a plurality of pressure rollers, where the same pressure rollers have both (1) adjustable minimum spacing therebetween via a spacing adjustment mechanism, and (2) adjustable pressure being applied via an adjustable pressure exerting mechanism. *See* Appeal Br. 13–16. In particular, Appellants acknowledge that Hoshi teaches guide pulleys 53, 63 with a gap/spacing therebetween that may be adjustable to accommodate different thicknesses, but note that these guide pulleys 53, 63 “do not actually apply pressure to passing articles, let alone folded articles, as claimed.” *Id.* at 14; *see id.* at 14–15; *see also* Hoshi, col. 4, ll. 38–68, col. 5, ll. 1–19, Figs. 4–6. Appellants also acknowledge that Hoshi teaches tension pulleys 54, 64, and presser roller 85, each of which applies pressure that may be adjusted, but note that “none [of these rollers] are associated with an

adjustable minimum spacing or gap, let alone have a spacing adjustment mechanism,” as these rollers do not apply pressure to an article passing through spacing between cooperating rollers. *Id.* at 15; *see id.* at 14–15; *see also* Hoshi, col. 4, ll. 38–68, col. 5, ll. 1–19, 50–68, col. 6, ll. 9–35, Figs. 4–8.

We appreciate the Examiner’s position that Hoshi teaches the concept of providing rollers within a rotary press assembly—some of which (guide rollers 53, 63) have an adjustable gap, and others of which (rollers 54, 64, 85) have adjustable pressure. *See* Ans. 12–13. However, we agree with Appellants that “Hoshi does not disclose rollers that have both (1) a minimum spacing that is adjustable via a spacing adjustment mechanism and (2) a pressure that is adjustable via a separate adjustable pressure exerting mechanism,” as required by the claims—because it is “the plurality of pressure rollers,” as recited (including both of these adjustability features), that must form the pressing unit that applies pressure to the folded articles. Appeal Br. 15. In other words, the Examiner’s finding that Hoshi teaches pressure rollers that have both of the recited adjustability features is not supported by a preponderance of the evidence.

The Examiner’s reliance on Ishida and Vijuk, as teaching additional claimed features, does not cure the deficiency of Hoshi identified above. Accordingly, based on the record before us, the Examiner has not met the burden of establishing a proper *prima facie* case of obviousness. On this basis, we do not sustain the rejection of claims 1–2 as being unpatentable over Waterworth, Ishida, Vijuk, and Hoshi.

Appeal 2014-001878
Application 12/489,332

DECISION

We REVERSE the Examiner's rejection of claims 1–2.

REVERSED