



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/493,996 06/29/2009 Patrick R. Lancaster III ZT645-15044 1397

22884 7590 12/02/2016
MIDDLETON & REUTLINGER
401 S. 4th Street, Suite 2600
(2600 Brown & Williamson Tower)
LOUISVILLE, KY 40202

Table with 1 column: EXAMINER

TAWFIK, SAMEH

Table with 2 columns: ART UNIT, PAPER NUMBER

3721

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

12/02/2016

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOmail@middreut.com
USPTOmail@middletonlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK R. LANCASTER III, DONNIE NORRIS, and
DAVID ELDRIDGE

Appeal 2014-008191
Application 12/493,996¹
Technology Center 3700

Before CHARLES N. GREENHUT, ANNETTE R. REIMERS, and
THOMAS F. SMEGAL, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Patrick R. Lancaster III et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 134, 140–144, and 150–180 under 35 U.S.C. § 103(a) as obvious over Thimon (US 5,077,956, iss. Jan. 7, 1992) and Geisinger (US 4,432,185, iss. Feb. 21, 1984). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION of claim 134 pursuant to our authority under 37 C.F.R. § 41.50(b).

¹ According to Appellants, the real party in interest is LANTECH.COM, LLC. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Claims 134, 140, and 166 are independent. Claim 134 is reproduced below and illustrates the claimed subject matter, with disputed limitations emphasized.

134. A method for wrapping a load, comprising:
dispensing a film web from a film dispenser;
moving the film web over a roller without slip around the circumference of the roller;
providing relative motion between the load and the film dispenser to wrap the film web around the load with the film dispenser;
forming a portion of the film web adjacent a lengthwise edge of the film web into a rope of film; and
selectively driving down the roped portion of the film web to lower an elevation of the film path relative to the load.

OPINION

The Examiner's rejection of claims 134, 140–144 and 150–180 as being obvious over Thimon and Geisinger is reversed.

Regarding the rejection of claim 134, the Examiner relies on rods 37 and 38 of Thimon for meeting the claim limitation, “moving the film web over a roller without slip around the circumference of the roller.” Final Act. 2 (citing Thimon, col. 12, ll. 25–33); *see* Appeal Br. 14, Claims App. Independent claims 140 and 166 contain a similar limitation. Appellants correctly point out that the Examiner’s finding “is factually incorrect” as Thimon “teaches that guide rods 37, 38 are configured to allow film to slide over the outer surfaces of the rods with little or no friction, and do not function as rollers.” Appeal Br. 8 (citing Thimon, col. 11, ll. 22–26). Thus, the Examiner has failed to articulate any reason with a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977,

988 (Fed. Cir. 2006), cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Accordingly, we are constrained to reverse the Examiner's rejection of claim 134, along with claims 140–144 and 150–180 under 35 U.S.C. § 103(a) as being unpatentable over Thimon and Geisinger.

Pursuant to our authority under 37 C.F.R. § 41.50(b), claim 134 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Thimon and Geisinger

Thimon discloses a method of wrapping a load by dispensing a film web from a dispenser, including *inter alia*, along rollers 59, 60, 62, and 63, each of which moves the film web around its circumference. *See* Thimon, col. 12, ll. 24–40. Thimon also discloses rollers 59, 60, 62, and 63 being employed for stretching the film. *See id.* at col. 13, ll. 3–17. In order to stretch the film Thimon's device must “mov[e] the film web over a roller without slip around the circumference of the roller,” as recited by claim 134. Based on the foregoing findings, we are not persuaded by Appellants' arguments at pages 8–11 of the Appeal Brief and at pages 2–3 of the Reply Brief that Thimon fails to teach this claim limitation.

We have carefully considered Appellants' other argument that Thimon doesn't teach “forming a portion of the film web adjacent a lengthwise edge of the film web into a rope of film [and] driving down the roped portion of film,” while Geisinger “is directed to a pallet wrapper wherein the entire web of film is formed into a rope.” Appeal Br. 12; *see also* Reply Br. 4. However, we are unpersuaded by Appellants' contention that because the claims “recite ‘forming a portion of the film web adjacent a lengthwise edge of the film web into a rope of film,’” a

[p]erson[] skilled in the art having read the Specification would not interpret the bunching of the entire film web into a rope of film, as disclosed in Geisinger '185, to be the same as forming a portion of the film web adjacent a lengthwise edge of the film into a rope of film, as set forth in the claims.

Id. at 12–13.

We determine the scope of the claims in a patent application by giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage.” *Id.* Thus “[it] is the [Appellants’] burden to precisely define the invention, not the PTO’s.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Appellants have not pointed to any lexicographic definition in the Specification of the term “portion” or identified any other disclosure therein that precludes the Examiner from construing “portion” as taught by Geisinger to be forming “a portion of the film web into a rope of film,” while “the remaining [portion of the film web that is] being dispensed and not being formed into rope [is still flat].” Ans. 5 (citing Geisinger, Figs. 6, 7); *see also* Geisinger, col. 4, l. 57–col. 5, l. 15 (describing the “roped portion 46 of the web 50.”² (emphasis added)). Thus, we are not persuaded

² Thimon also discloses forming a cord of the band of film 5, by “pleating or curling of the lower horizontal edge 30 of the band of film 5,” so that “the downstream delivered section 28 then has a smaller transverse width than the film 5, in band form, situated on reel 9.” *See* Thimon, col. 12, ll. 41–61 (emphasis omitted); *see also id.* at col. 3, ll. 43–48.

by Appellants' contention that "the Examiner's interpretation is inconsistent with the language of the claims and what persons skilled in the art would interpret the claims to mean after having read the Specification." Reply Br. 4. Furthermore, Appellants' argument is not commensurate with the scope of the claim. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability).

Although we have exercised our discretion under 37 C.F.R. § 41.50(b) in rejecting only claim 134 under this new ground, we leave claims 151–165 dependent therefrom, claim 140 and claims 141–144 and 150 dependent therefrom, and claim 166 and claims 167–180 dependent therefrom, for the Examiner's consideration in any further prosecution. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* MPEP 1213.03

DECISION

For the above reasons, the Examiner's rejection of claims 134, 140–144, and 150–180 as unpatentable over Thimon and Geisinger is reversed.

We enter a NEW GROUND OF REJECTION of claim 134 under 35 U.S.C. § 103(a) as unpatentable over Thimon and Geisinger.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b).