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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MASAHIRO TOMAMOTO, MICHIHARU ETA,
HIDETAKA ODA, TATSUYA TAKAYA, YASUO YAMAZAKI,
HIROSHI TAKIMOTO, SHINICHI ISHIBASHI, KEIJI TAKAGI,
DAISUKE NAGATA, TAKAHIDE NAKAMURA,
TORU SAKURABAYASHI, KATSUTOSHI FUJIWARA,
MITSU HARU NODA, YASUHIKO OGISO, and
TAKAHIDE FUJII

Appeal 2019-005363
Application 14/327,673
Technology Center 1700

Before ROMULO H. DELMENDO, DONNA M. PRAISS, and
N. WHITNEY WILSON, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant¹ appeals under 35 U.S.C. § 134(a) from the Primary Examiner’s final decision to reject claims 1–3.² We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

I. BACKGROUND

The subject matter on appeal relates to a glass roll formed by winding a glass film into a roll while superposing the glass film on a protective sheet (Specification filed July 10, 2014 (“Spec.”) ¶ 16). The Inventors explain that the protective sheet is wound one or more turns around a roll core in advance in order to prevent flaws on a surface of the glass film (*id.* ¶ 74; Drawings filed July 10, 2013, Fig. 1).

Claim 1, the sole independent claim on appeal, is reproduced from the Claims Appendix to the Appeal Brief, as follows:

1. A glass roll comprising:
a roll core;
a glass film having exposed front and back surfaces; and a protective sheet,
wherein the glass film and the protective sheet are wound around the roll core so that the glass film is superimposed on the protective sheet, and
wherein a leading end of the protective sheet extending from an innermost layer of the protective sheet is wound one or more turns around the roll core prior to a leading end of the glass film extending from an inner most layer of the glass film

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42—namely, “Nippon Electric Glass Co., Ltd.” (Application Data Sheet filed July 10, 2014 at 9), which is also identified as the real party in interest (Appeal Brief filed January 7, 2019 (“Appeal Br.”) at 3).

² See Appeal Br. 9–15; Final Office Action entered August 6, 2018 (“Final Act.”) at 3–12; Examiner’s Answer entered May 3, 2019 (“Ans.”) at 3–16.

being located on the protective sheet and wound around the roll core.

(Appeal Br. 17 (emphasis added)).

II. REJECTIONS ON APPEAL

The claims on appeal stand rejected under 35 U.S.C. § 103(a) (pre-AIA), as follows:

- A. Claims 1 and 2 as unpatentable over Walty³ in view of Specogna et al.⁴ (“Specogna”);
- B. Claims 1 and 2 as unpatentable over Walty in view of Birkeland;⁵ and
- C. Claim 3 as unpatentable over Walty in view of either Specogna or Birkeland, and further in view of Kondratenko.⁶

(Ans. 3–16; Final Act. 3–12).

III. DISCUSSION

Rejection A. The Examiner finds that Walty describes a glass roll comprising a glass sheet **19**, two protective webs **23a** and **23b**, and a spool core **24**, wherein the protective webs are disposed on the outer circumference of the glass sheet (Ans. 3; Final Act. 3) (citing, e.g., Walty Fig. 1). The Examiner acknowledges that “Walty is silent regarding a leading portion of the protective sheet being wound around the roll core one or more [turns]” (Ans. 4; Final Act. 4). The Examiner finds, however, that

³ WO 87/06626 A1, published November 5, 1987.

⁴ US 5,472,089, issued December 5, 1995.

⁵ US 4,455,076, issued June 19, 1984.

⁶ US 2004/0251290 A1, published December 16, 2004.

Specogna discloses a package of a web wound on a core, wherein an opaque flexible material portion **24** (i.e., a leading end) is wrapped around an outermost first convolution **20** of the roll (i.e., one turn around the roll core) (Ans. 4–5; Final Act. 4–5) (citing, e.g., Specogna Figs. 1 and 5B). Based on these findings, the Examiner concludes that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the protective web of Walty by wrapping a flexible material around the roll at least once with a flexible material portion comprising several segments as taught by Specogna in order to easily enable wrapping and promote uniform wrapability of successive segments that follow the flexible material.

(Ans. 5).

Alternatively, the Examiner finds that Specogna discloses a third stretchable segment **32** (i.e., a leading end), provided with a cushioning layer that enhances physical protection such as shock and abrasion during handling, wrapped around an outermost second convolution **34** (Ans. 6; Final Act. 5) (citing, e.g., Specogna Figs. 1 and 5B). The Examiner then concludes that “[i]t would have been obvious to one of ordinary skill in the art . . . to have modified the protective web of Walty by wrapping a segment with a cushioning layer around the roll in order to provide shock and abrasion protection for the glass sheet of Walty.” (Ans. 6; Final Act. 6).

The Appellant contends that the Examiner’s proposed combination of references would not have rendered the subject matter recited in claim 1 obvious to a person having ordinary skill in the art because, in Specogna, a photosensitive film material and a flexible material portion **24** constitute a single band-like body that is tightly wound around a core **21**, whereby “a large tensile stress acts directly on both the film material and the flexible

material portion **24**” (Appeal Br. 9–10 (bolding added)). The Appellant argues that, therefore, if Specogna’s teachings are implemented in Walty, “a large tensile stress will likely act directly on the glass sheeting **19** and cause the glass sheeting **19** to break” (*id.* at 10 (bolding added)). Furthermore, the Appellant argues that the claimed subject matter would not have been obvious because “the Specogna reference discloses that the flexible material portion **24** is connected to the *outermost* layer of the photosensitive film material in order to protect the photosensitive film from light” (*id.* at 10) (bolding and italics added).

We concur with the Appellant that the Examiner’s articulated reason for combining Walty and Specogna is insufficient, because it lacks sufficient rational underpinning to support a conclusion that a person having ordinary skill in the art would have combined the references in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Walty discloses a sputter-coated thin glass sheeting in roll form formed by winding a glass sheeting **19** on a take-up spool **23**, wherein protective webs **23a** and **23b** are fed onto the spool **23** from spools **27** and **28** such that one or more layers of the protective web materials are interposed between the glass surfaces (Walty Abstract; Fig. 1; 5, ll. 3–14). As the Examiner acknowledges (Ans. 4; Final Act. 4), Walty’s disclosure differs from claim 1’s subject matter in that the reference does not disclose the limitations highlighted in reproduced claim 1 above.

In contrast to Walty and the claimed subject matter, Specogna’s disclosure “concerns light-tight and physically protected packaging for a roll of photosensitive web insertable in a cassette or similar device” (Specogna

col. 1, ll. 8–11). Specogna teaches that “several convolutions of a flexible material portion **24** [are] wrapped around the *outermost* first convolution **20** of the roll (R)” (*id.* at col. 4, ll. 49–54 (italics added)). Specogna also teaches that a third stretchable segment **32** is wrapped around an *outermost* second convolution **34** to form an outermost third convolution **38** comprising the third stretchable segment **32** (*id.* at col. 6, ll. 6–9 (emphasis added); Fig. 3).

The Examiner’s rejection, however, fails to include a sufficient explanation as to how Specogna’s teachings regarding the flexible material portion **24** wrapped around an *outermost* first convolution **20** of roll (R), as depicted in Figure 1, or a third stretchable segment **32** wrapped around an *outermost* second convolution **34**, as depicted in Figure 3, if implemented in Walty, would satisfy the disputed claim limitations highlighted above in reproduced claim 1 above (i.e., “protective sheet is wound one or more turns around the roll core prior to a leading end of the glass film”).

Therefore, we conclude that a prima facie case of obviousness has not been established.

Rejection B. The Examiner’s rejection based on the combination of Walty and Birkeland is similarly flawed. Birkeland discloses a photographic film cassette in which a length of light-sensitive photographic film **21** is convolutely wound about a trailer **20**, which is secured by a length of tape to a hub **10** (Birkeland col. 2, ll. 18–40). As the Appellant points out (Appeal Br. 13), Birkeland teaches that the trailer **20** is attached to the innermost layer of the photographic film **21** to provide a microswitch sensing slot to signal the end of the photographic film **21** (Birkeland col. 2, ll. 27–31).

Thus, Birkeland’s teachings, which relate to providing a trailer in a photographic film, are insufficient to support the Examiner’s position that “one of ordinary skill in the art would have been motivated to initiate the wrapping of the glass roll of modified Walty by first sufficiently wrapping a leading edge of the protective web followed by the wrapping of the glass sheet” to initiate wrapping and to provide protection prior to the wrapping of the glass sheet (Ans. 14; *see also* Final Act. 7). *In re NuVasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (“‘[C]onclusory statements’ alone are insufficient and, instead, the finding must be supported by a ‘reasoned explanation.’” (internal citation omitted)).

Therefore, we also do not sustain this rejection.

Rejection C. Although this rejection relies further on Kondratenko, it also relies on the combination of Walty and either Specogna or Birkeland. As Kondratenko has not been applied in a way so as to cure the deficiencies in the Examiner’s basic combination of Walty and either Specogna or Birkeland (Ans. 9; Final Act. 8), we also do not sustain this rejection.

IV. CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2	103(a)	Walty, Specogna		1, 2
1, 2	103(a)	Walty, Birkeland		1, 2
3	103(a)	Walty, Specogna or Birkeland, Kondratenko		3
Overall Outcome				1–3

REVERSED