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Roberts Calderon Safran & Cole, P.C. 7918 Jones Branch Drive Suite 500 McLean, VA 22102			TAWFIK, SAMEH	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAL RACHEL BOKOVZA,
ROBERT MAEGERLEIN, and THORSTEN CSELLNER

Appeal 2019-006795
Application 14/178,368
Technology Center 3700

Before PHILLIP J. KAUFFMAN, TARAL HUTCHINGS, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–9. Final Act. 2–8. Claim 10–16 are withdrawn from consideration. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37C.F.R. § 1.42. Appellant identifies Boehringer Ingelheim International GmbH as the real party in interest. Appeal Br. 1. Assignment data on file with the U.S. Patent and Trademark Office indicates that rights in the application have been assigned to Boehringer Ingelheim International GmbH and Eukerdruck GmbH & Co. KG.

Claim 1, the sole independent claim on appeal, is reproduced below.

1. A method for producing a bundle of different information leaflets, comprising the steps of:
 - producing the bundle from a sheet of a flat material having at least two different sections which form the different information leaflets,
 - folding the sheet in at least two folding processes,
 - forming at least one protruding fold between sections of the sheet of flat material produced by said folding processes, wherein the protruding fold has a folded edge that protrudes beyond a folded edge of other folds formed with said sections of the sheet of flat material between which said at least one protruding fold is formed; and
 - separating the information leaflets and forming the bundle of different information leaflets by separating the at least one protruding fold.

REJECTIONS

I. Claims 1–3 and 5–9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shacklett and Zeisky, and alternatively, further in view of Ishizuka.² Final Act. 2–7.

II. Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Shacklett, Zeisky, and Honegger, and alternatively further in view of Ishizuka.³ Final Act. 4–5, 7–8.

² Shacklett (US 4,660,856; issued Apr. 28, 1987); Zeisky (US 5,192,093; issued Mar. 9, 1993); Ishizuka (JPS5663563 U; published May 28, 1981). A partial, machine English translation of Ishizuka is available in the application file.

³ Honegger (US 6,029,968; issued Feb. 29, 2000).

ANALYSIS

*Claims 1–3 and 5–9 over Shacklett and Zeisky, and alternatively additionally in view of Ishizuka*⁴

The dispositive issue in this case relates to the at least one protruding fold of independent claim 1.

The Examiner finds that Shacklett and Zeisky each disclose a protruding fold as claimed. Final Act. 2–3. Taken in context, it appears that the Examiner intends to rely on Shacklett for a fold and to modify that fold to be a protruding fold as taught by Zeisky. Final Act. 2–3. For the reasons that follow, the Examiner has not adequately demonstrated that the claimed subject matter, including the recited protruding fold, would have been obvious.

Regarding Shacklett, the Examiner finds that reference numerals 49 and 53 form at least one protruding fold. Final Act. 2 (citing Figures 3 and 5). Neither panel 49 nor terminal portion 53 is a protruding fold; rather, panel 49 is the terminal portion of leaf 15, and portion 53 is the section of panel 49 that does not include adhesive 52. Shacklett, 3:44–51, Fig. 4. Further, there is no fold between panel 49 and terminal portion 53. Shacklett, Fig. 3. Therefore, the Examiner’s finding that panel 49 and terminal portion 53 correspond to a protruding fold as claimed is incorrect.

Regarding Zeisky, the Examiner finds that foldable pull strip 22⁵ corresponds to a protruding fold as claimed. Final Act. 2–3. Zeisky discloses indicia card storage device 10 that includes elongate sheet 16 formed of a plurality of foldable panels 18. Zeisky, 2:4–11; Fig. 1. Foldable

⁴ Claims 2, 3, and 5–9 depend from independent claim 1.

⁵ The Examiner refers to element 22 as “protruded portion 22.” Final Act. 3.

pull strip 22 is not a protruding fold; rather, it is the lower edge of bottom panel 18 of elongated sheet 16. Zeisky, 2:8–11, Figs. 2, 5, 6. Therefore, the Examiner’s finding that foldable pull strip 22 corresponds to a protruding fold as claimed is incorrect.

Given that the Examiner has not demonstrated that either reference discloses a protruding fold, we agree with Appellant that the Examiner has not shown that the subject matter of independent claim 1 is obvious over Shacklett and Zeisky. Appeal Br. 2–4; *see also* Reply Br. 2–3. We do not sustain the rejection of claims 1–3 and 5–9 under 35 U.S.C. § 103(a) as unpatentable over Shacklett and Zeisky.

In the alternative, the Examiner concludes that the subject matter of claims 1–3 and 5–9 would have been obvious from the combined teachings of Shacklett, Zeisky, and Ishizuka. Final Act. 5–7. This conclusion is based in part on the finding that Ishizuka discloses the step of separating the information leaflets. Final Act. 6 (citing Ishizuka, Figs. 2, 3) (“separating/perforating lines 4 & 7”); *see also* Ans. 4–5 (finding that Ishizuka discloses “cutting off outer protruded portion of folded stacked sheets”). The Examiner concludes that it would have been obvious to modify Shacklett and Zeisky by “having the steps of separating the information leaflets, as suggested by Ishizuka.” *Id.*

In light of this, we agree with Appellant that Ishizuka fails to remedy the deficiencies in the teachings of Shacklett and Zeisky as applied to independent claim 1. Appeal Br. 4; *see also* Reply Br. 4.

Claim 4 over Shacklett, Zeisky, and Honegger, and alternatively additionally in view of Ishizuka

The Examiner concludes that the subject matter of claim 4 would have been obvious from the combined teachings of Shacklett, Zeisky, and Honegger, alone or further in view of Ishizuka. Final Act. 4–5, 7–8. The Examiner cites Honegger as suggesting that a sheet might be folded in directions that are transverse to one another. Final Act. 4, 7. This suggestion fails to remedy the deficiencies in the combined teachings of Shacklett and Zeisky, alone or in combination with Ishizuka, as applied to parent claim 1. We do not sustain the rejection of claim 4 under 35 U.S.C. § 103(a) as unpatentable over Shacklett, Zeisky, and Honegger, alone or in combination with Ishizuka.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference/Basis	Affirmed	Reversed
1–3, 5–9	103(a)	Shacklett, Zeisky		1–3, 5–9
1–3, 5–9	103(a)	Shacklett, Zeisky, Ishizuka		1–3, 5–9
4	103(a)	Shacklett, Zeisky, Honegger		4
4	103(a)	Shacklett, Zeisky, Ishizuka, Honegger		4
Overall Outcome				1–9

Appeal 2019-006795
Application 14/178,368

REVERSED