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Leydig, Voit & Mayer, Ltd. (Frankfurt office) Two Prudential Plaza, Suite 4900 180 North Stetson Avenue Chicago, IL 60601-6731			STINSON, CHELSEA E.	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROLF MEYERHANS and ROLAND KOST

Appeal 2020-001683
Application 15/000,066
Technology Center 3700

Before DANIEL S. SONG, CHARLES N. GREENHUT, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

GREENHUT, *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 10–18. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM AND ENTER NEW GROUNDS OF REJECTION.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Mueller Martini Holding AG. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to a device for bringing together a wrapper and a plurality of inserts to form an advertising means compilation.

Claim 10, reproduced below, is illustrative of the claimed subject matter:

Claim 10: A device for bringing together a wrapper and a plurality of inserts to form an advertising means compilation, the device comprising:

a compilation section with a conveying element which is movable in a direction of transport;

a plurality of individualisation and supply elements for the wrapper and the inserts arranged in succession along the compilation section, the individualisation and supply elements being configured to deposit the wrapper and the inserts on one another individually such that a leading edge of the wrapper is deposited offset relative to leading edges of the inserts in the direction of transport, forming an excess length of the wrapper relative to the inserts;

a deflecting space and a deflecting device arranged downstream from the compilation section, the deflecting device being configured to introduce the excess length of the wrapper into the deflecting space, the conveying element, at least in a region of the deflecting space being configured such that both the wrapper and the inserts lie flat on the conveying element;

a folding device for the advertising means compilation arranged downstream from the deflecting space; and

a removal device for the advertising means compilation arranged downstream from the folding device.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Kragh	US 6,892,514 B2	May 17, 2005
Haller	US 2003/0041571 A1	Mar. 6, 2003
Meyerhans	US 2013/0026003 A1	Jan. 31, 2013

REJECTIONS

Claims 10 and 11 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claim 11 and 15 of copending Application No. 15/641 ,055. Final Act. 3.

Claims 10–12, 15, and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Kragh and Meyerhans.² Final Act. 5.

Claims 13, 14, 16, and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Kragh, Meyerhans, and Haller. Final Act. 9.

OPINION

Appellant does not seek review of the merits of the provisional double-patenting rejection (Appeal Br. 10–11), and we therefore do not reach the merits of that rejection at this time. *See Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010); *In re Mott*, 539 F. 2d 1291, 1295–6 (CCPA 1976).

Claims 10–12, 15, and 18 are argued as a group (Appeal Br. 4–10) for which claim 10 is representative under 37 C.F.R. § 41.37(c)(1)(iv). Claims 13, 14, 16, and 17 are argued based only on dependency from claim 10. Appeal Br. 10.

Kragh undisputedly discloses the aspects of claim 10 that relate to deflecting a wrapper 14 around a plurality of inserts, bundle 16. Final Act. 5. Kragh does not discuss, and leaves to the skilled artisan, how Kragh’s wrapper 14 is initially deposited on conveyor 2 with the bundle of printed

² Meyerhans is also named as an inventor in the present application. References to Meyerhans in our discussion of the Examiner’s rejection refer to US 2013/0026003 A1. We reference the “Specification” or “Spec.” when referring to the Specification of the present application.

matter 16 disposed on the wrapper. Ans. 11; Kragh figs 2–5 and col. 2, ll. 41–57. The Examiner takes the position that it would have been obvious to use Meyerhans’s system to place the wrapper and inserts on the conveyor initially “in order to more efficiently add the various inserts. . .” Final Act. 6; Ans. 11. Appellant’s point that this rationale is legally insufficient is well-taken. Appeal Br. 9. It is not clear to us to what type of efficiency the Examiner is referring or what the Examiner is using as a basis for comparison to conclude there will be “more” efficiency. Nevertheless, despite this shortcoming in the reasoning articulated by the Examiner, we ultimately agree with the Examiner’s conclusion that it would have been obvious to use the Meyerhans system to supply the wrapper and inserts to Kragh’s conveyor.

The fact that Kragh leaves unstated how the wrapper and inserts arrived on the conveyor would be understood by the skilled artisan as an invitation to fill in that gap with a known solution such as that of Meyerhans. Accordingly, combining the Meyerhans teaching with Kragh in this regard clearly falls outside the type of “cherry-pick[ing]” Appellant argues is prohibited in an obviousness analysis. *See* Appeal Br. 7. Indeed, the Supreme Court has recognized that “in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR v. Teleflex*, 550 U.S. 398, 421 (2007).

Meyerhans touts several reasons for employing the system disclosed therein (Meyerhans paras. 3–7), and any one of them could serve as motivation for the skilled artisan to select the Meyerhans system over another. Ultimately, the combination involves the combination of known

devices and techniques that combine to achieve nothing more than predictable results. *See KSR*, 550 U.S. at 416.

Appellant also takes issue with the fact that Meyerhans is not actually depositing a *wrapper* with Meyerhans individualisation³ elements A–E as the Examiner suggests. Appeal Br. 7–9; Final Act. 6 (citing “wrapper (a₁)”). It is true that Meyerhans indicates that a cover or wrapper may be added *somewhere else* in the assembly process that is not further described or illustrated by Meyerhans. Meyerhans para. 38. However, the Examiner’s characterization of insert a₁ specifically as a “wrapper” notwithstanding, the Examiner’s ultimate point, as explained more clearly in the Examiner’s Answer, is that Meyerhans’s individualisation and supply element A, although it may be described as depositing an “insert[] a₁” (Meyerhans para. 45), bears no apparent structural distinction from an individualisation and supply element “configured to” deposit a “wrapper.” Ans. 11–12. The Examiner concludes that this suffices to demonstrate the unpatentability of the *claimed* subject matter in part because claim 10 is directed to a device “for” manipulating a wrapper,⁴ as opposed to, for example, a combination of such a device with a wrapper, or a process or method requiring actual manipulative steps to be performed on a wrapper. Ans. 11–12. The Examiner’s point in this regard is well-taken.

As mentioned above, Kragh leaves open-ended the devices and techniques used to arrive at Kragh’s starting point of having both the

³ We adopt Appellant’s spelling throughout.

⁴ The wrapper is mentioned as the object of an intended use in the preamble. As discussed in more detail below, the wrapper is also recited in the body of the claim in an effort to, among other things, define the structure associated with the individualisation and supply elements.

wrapper and inserts on the conveyor. The Examiner reasonably concluded Meyerhans's device could serve both purposes to thereby yield the subject matter claimed because, as the Examiner points out, "Appellant does not disclose an[y] structural difference between the wrapper sheet and the inserts that would prevent the wrapper [being] deposited from an individualisation station that is capable of depositing inserts." Ans. 12. The Examiner's determination in this regard appears to be confirmed by Appellant's own Specification. *See, e.g.*, para. 54 ("the wrapper 1 may actually be a separate wrapper either without, or advantageously provided with, printed advertisements and/or other information, but may also directly be an advertising means in the form of a preconfigured multi-page printed sheet analogous to the inserts 2, 3, 4."). Appellant has not responded to the Examiner's position in this regard by pointing to any structural distinction that exists between an individualisation and supply element "configured to" deposit a wrapper as compared to individualisation and supply elements "configured to" deposit inserts. Nor has Appellant apprised us as to any structural distinctions, other than size differences apparent from Appellant's figures, between the inserts and the wrapper.

We certainly agree with Appellant that the phrase "configured to" coupled with an action may connote structure. Reply. Br. 3–4 (citing *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.* 672 F.3d 1335, 1349 (Fed. Cir. 2012).) However, precisely what structure is ultimately dictated by the acts recited following that phrase. The Examiner's point here is not whether that "configured to" language connotes *some* structure but whether reciting that the individualization and supply element is configured to deposit *a wrapper* connotes some structure that is *any different from* the individualization and

supply elements in the prior art that are configured to deposit inserts. Appellant has not apprised us as to how or why any such structural distinction is required or implied here by the mere difference in the recitation of what the individualization and supply elements are configured to deposit. Appellant's own Specification, insofar as we are aware, also fails to mention any such distinctions. If the structures are in fact identical, as the record presently before us seems to indicate, then the distinction over the prior art lies only in the intended use or articles intended to be worked upon by the claimed apparatus and not, as it must to create a patentable distinction, in the claimed apparatus itself. *See, e.g.*, MPEP § 2115 (and cases cited therein).

It is not fatal to the Examiner's position that Meyerhans may not previously have recognized or acknowledged that individualisation and supply element A (for example) could be used to supply a wrapper as opposed to, or in addition to, supplying an insert. This is because the obviousness analysis is an objective one, viewed from the perspective of the hypothetical person of skill in the art and not confined to the knowledge of, or particular uses disclosed by, any one specific inventor. Here, the only distinction between the inserts 2–4 and wrapper 1 worked upon by the individualisation and supply elements 1a–4a appears to be their respective sizes. *See* Fig. 1. Appellant does not offer any analysis regarding, and thus leaves uncontroverted, the Examiner's seemingly reasonable position that it would have been obvious to one skilled in the art that “one of the stations [of Meyerhans] would be configured to deposit the wrapper that is disclosed by Kragh.” Ans. 12. We are not apprised of any evidence or technical reasoning to demonstrate that, despite the similarities in both the individualisation and

supply elements and the similarities in the wrapper or insert articles they work upon, one skilled in the art would not have at least a reasonable expectation of success in making the combination proposed by the Examiner.

For the foregoing reasons we sustain the Examiner's rejection of claim 10 and that of the remaining claims not separately argued. Because we have provided additional analysis beyond that supplied by the Examiner we designate our affirmance of the Examiner's rejection as including a "new ground" of rejection pursuant to 37 C.F.R. § 41.50(b) so as to afford Appellant the procedural options for response associated therewith.

CONCLUSION

We do not reach the merits of the Examiner's provisional double patenting rejection.

We affirm the Examiner's prior art rejections but designate our affirmance as including new grounds of rejection.

DECISION SUMMARY

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Grounds
10–12, 15, 18	103	Kragh, Meyerhans	10–12, 15, 18		10–12, 15, 18
13–14, 16–17	103	Kragh, Meyerhans, Haller	13–14, 16–17		13–14, 16–17
Overall Outcome			10–18		10–18

RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, 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 prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been

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misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

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).

AFFIRMED; 37 C.F.R. § 41.50(b)