

DECISION OF THE COMMISSIONER

UNOBEVIOUS: New Combination Not Mere Substitution.

The question is not whether the elements per se are new, but whether the arrangement of elements in the combination is new and unobvious. The dancer roll not only performs the known function of storage but also actuates the switching controlling the intermittent operation of an advanced section, eliminating the electric eye scanner of the cited prior art. There is a prima facie showing of inventive ingenuity in that: "The Commissioner ... ought not to refuse an application unless it is substantially without foundation" (Vanity Fair v. Commissioner - 1939 S.C.R. 245 at 248).

FINAL ACTION: Reversed.

IN THE MATTER OF a request for a review by the  
Commissioner of Patents of the Examiner's Final  
Action under Section 46 of the Patent Rules.

And

IN THE MATTER OF a patent application serial  
number 981,418 filed January 27, 1967 for an  
invention entitled:

MACHINE FOR THE INTERMITTENT PROCESSING  
OF A CONTINUOUSLY SUPPLIED WEB, AS IN  
THE MANUFACTURE OF BAGS

Patent Agent for Applicant: Messrs. Kirby & Shapiro,  
Ottawa, Ontario.

This decision deals with a request for a review by the Commissioner of Patents of the Examiner's Final Action rejecting claims 1-5 inclusive of application 981,418.

The Patent Appeal Board has reviewed the prosecution of this application and the facts are as follows:

Application 981,418 was filed January 27, 1967 in the name of A. Schwarzkopf and refers to "Machine For The Intermittent Processing Of A Continuously Supplied Web, As In The Manufacture Of Bags".

In the prosecution terminated by the Final Action, the Examiner refused to allow claims 1-5 inclusive on the ground that they fail to define patentable subject matter over the state of the art as evaluated by the applicant in his disclosure and as shown in the following reference:

Canadian Patent

696,259 Oct. 20, 1964 Hayes et al

In the Final Action the examiner stated:

The rejection of the claims 1-5 inclusive is maintained and the reason for such rejection is that applicant's alleged invention as defined in claims 1-5 is obvious in view of the state of the art as evaluated by the applicant in his disclosure and as shown by the citation of record.

Applicant's alleged invention as defined by claim 1 appears to be directed to controlling an intermittently operated section of a bag making machine by utilizing a movable dancer roll located upstream of said section to actuate a switch positioned at a predetermined location. Claims 2-5 all dependent on claim 1 add further characteristics which do not alter materially the concept of the invention as expanded further in applicant's letters of amendment dated October 15, 1969 and April 14, 1970.

In his responses to Office Actions rejecting the claims the applicant stressed the fact that his alleged invention comprises a continuously operating section and an intermittently operated section with a dancer roll therebetween carrying an actuating element for a switch ... for energizing the intermittently operating section in contradistinction to the cited Canadian Patent where the dancer roll assembly does not perform such control function and also that the alleged invention does not reside in the choice of location of an actuating element, but it is a basically different concept namely "operation of the intermittent feed as a result of the condition of the dancer roll device" which is located upstream of said feed.

Considering now the state of the art as evaluated on page 1 of the instant disclosure it will be noted that controlling an intermittently operated device by a movable dancer roll actuating a switch is known and therefore this feature can not be relied upon to provide a patentable distinction for "basically different concept" (see above) as argued by the applicant.

Further, concerning the cited Canadian Patent 696,259, this patent shows a machine substantially as claimed by the applicant i.e. continuously and intermittently

operated sections with a dancer roll assembly located upstream of the intermittent section but with one difference namely the controlling function is performed by a separate scanner and not by a dancer roll. This difference however, does not provide a patentable distinction either as it is held that it would be well within the skill of the art to replace the scanner in the cited Canadian Patent by a known arrangement of a dancer roll actuated switch of the prior art evaluated in the instant application.

The applicant responded on August 27, 1970 and stated the following:

The present invention relates to a machine for the intermittent processing of a continuously fed web. In other words, the web is supplied from a previous machine at a constant speed. However, it is necessary in the present machine to process such web intermittently. Thus, the web must be halted periodically; processed; and then moved forward. During the period while the web is stationary, the incoming web will continue, and thus obviously there must be provision for temporarily storing the excess web. The invention provides a dancer roll device for this purpose. Applicant concedes that a dancer roll device per se is known.

The inventive advance of the present invention is the arrangement that the dancer roll device, when it reaches a predetermined position with the web extended (i.e. when a maximum amount of incoming web is stored), operates a switch which starts the intermittent feeding means that are located downstream of the dancer roll device. The portion of the web downstream of the dancer roll device is thus moved forward at a greater speed than that of the incoming web, so that the amount of web in storage is reduced. When the intermittent feeding device is again stopped, the amount of web in storage builds up again until the action is repeated. In this way, there is positive provision to prevent any excess of web in storage; at the same time, an adequate supply of web for the intermittent feeding device is provided.

The examiner combines with this art the acknowledgement of prior art contained on page 1 of the present application. He refers to the paragraph beginning in line 24 on page 1, where it is stated that an apparatus is known in which a motor drives a "follow-up device preceding the dancer roll device". The

text goes on to state that this motor is controlled by the dancer roll. However, as this passage clearly states, in the apparatus concerned, the motor that is controlled by the dancer roll device clearly precedes that device. Applicant cannot see the relevance of this type of arrangement to the present problem, which is to ensure that an intermittently operated device downstream of the dancer roll device is operated by that device in order to ensure that the proper amount of web is stored in the dancer roll device. In other words, when the storage loop becomes too large, as measured by the dancer roll device, the motor downstream of that device is operated to take up the slack. Obviously, a motor that precedes, i.e. is arranged upstream, of the dancer roll device cannot achieve the same function. Furthermore, it becomes obvious that the apparatus referred to on page 1 of the present application cannot be of the same character, i.e. apparatus in which there is first a continuously operating section followed by an intermittently operating section.

For a combination of references to be a properly citable combination, it is necessary that the teachings of the two references, when combined, should result in the invention that is argued to be unpatentable over such combination. In other words, the references must truly combine to yield the alleged invention. When the two references relied upon by the Examiner in the present case are carefully studied in this regard, it will be found that they are inadequate.

Upon review of the grounds set forth by the examiner, as well as all the arguments presented by the applicant I am not satisfied the rejection is well founded.

The consideration which must be decided in this application is not whether the elements are new but whether the combination of elements, with its arrangements of parts, is novel and the result of inventive ingenuity. Furthermore it is necessary only that there should be ingenuity exercised in the conception of the idea or in the method of applying it.

Claim 1 of the application reads as follows:

A machine for the intermittent processing of a continuously supplied web, particularly a bag-making machine for the manufacture of bags by transverse heat-sealing and transverse severing operations performed on a tubing or on a folded,

two-ply sheet web of plastics material, said machine comprising a dancer roll device preceding an intermittently operated section of the machine for storing the incoming web when said intermittently operated section is stopped, said dancer roll device carrying an actuating element for a switch located for operation by said actuating element when the dancer roll device reaches a predetermined position with the web extended for starting an intermittent feeding device in the intermittently operated section when the dancer roll device reaches such predetermined position.

The cited Canadian patent discloses a machine having a continuously fed web which is stored in a dancer roll when work is being done on an advanced section. The advanced section is intermittently operated under the control of an electric eye scanner.

The present invention relates to a machine having a continuously fed web which is stored in a dancer roll when work is being done on an advanced section. The advanced section is intermittently operated under the control of the dancer roll. In other words the dancer roll not only performs the known function of storage but also eliminates the need for the electric eye scanner in that the dancer roll also controls the intermittent movement of the advanced section.

The question to be answered is: Is it obvious to delete the electric eye scanner and have the dancer roll perform a dual function of storing the web and controlling the movement of the advanced section?

It is noted that the dancer roll of this application receives a continuously moving web and intermittently operates an advanced section when the dancer roll reaches a predetermined position without stopping the continuous flow fed to the machine. In the prior art disclosed by applicant the flow to the machine was stopped when the dancer roll reached a predetermined position. In the cited patent the electric eye scanner directly controls the advanced section only.

I find that there is positive provision to prevent any excess of web storage in the dancer roll from a continuously fed web; at the same time, there is an adequate supply of web for the intermittent feeding of the advanced section, which intermittent feeding is itself controlled by the dancer roll. In other words there is a control relationship between the dancer roll and the advanced section of the machine.

I am of the opinion that an advance in the art has been made, and that it would not be obvious to arrive at applicant's

new combination from the prior art relied upon by the examiner. I am satisfied that applicant has made a prima facie showing of inventive ingenuity. The Court has held, Vanity Fair v. Commissioner of Patents (1939), S.C.R. 245 at 248: "The Commissioner of Patents ought not to refuse an application for patent unless it is clearly without substantial foundation".

I recommend that the rejections, against the allowance of Claims 1 to 5 inclusive of this application, should be withdrawn.

R.E. Thomas,  
Chairman, Patent Appeal Board.

I concur with the finding of the Patent Appeal Board and I am therefore setting aside the Final Action and returning the application to the examiner for resumption of prosecution.

Decision accordingly,

A.M. Laidlaw,  
Commissioner of Patents.