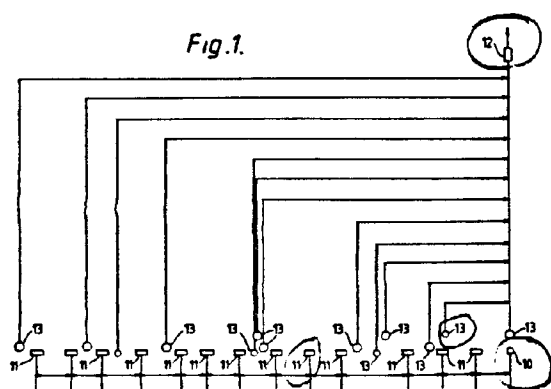


Obviousness:

Amend to limit claims to simultaneous punching by separate sets of punches removed relevancy of prior art. Rejection modified.

This decision deals with the Applicant's request for review by the Commissioner of Patents of the Final Action on application 360,266 (Class 101-78) filed September 12, 1980, entitled APPARATUS FOR PUNCHING MATERIALS USED IN THE PRODUCTION OF PRINTING PLATES. It is assigned to Embassy Litho Plates Pty. Ltd. The inventor is Peter W. Wilson. The Examiner in charge issued a Final Action on September 23, 1983, refusing to allow the claims. A Hearing was held on February 24, 1988, at which Applicant was represented by his Patent Agent, Mr. D. Hitchcock. By letters dated April 29, 1988 and June 29, 1988, Mr. Hitchcock submitted amendments to the claims.

The application relates to punching apparatus to align films and plates to provide improved printing accuracy in photo-lithographic color reproduction where several color negatives are positioned with an un-exposed printing plate. The punching apparatus depicted in figure 1 reproduced below shows the left hand side of the punch, the right hand side being the mirror reverse. It includes a center positioning round hole punch 10, and front end slotted hole punches 11 on each side to position the prepunched negatives and plates and provides for even movement on either side of center. An adjustable back slot punch 12 provides a hole for film expansion and contraction in a transverse direction to the front edge slots. Punch holes 13 provide for use of a plate and the negatives, and are formed simultaneously with holes 10, 11, and 12.



In the Final Action the Examiner refused the claims for failing to define patentable subject matter in view of United States patent:

3,290,975	Dec. 13, 1966	Caesar
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The Caesar patent relates to a punch device having a plate configuration of openings for receiving negatives to be punched, and for re-registering negatives for alignment with negatives that are to be punched. The layout of the openings in the plate is shown in figure 4, reproduced below:

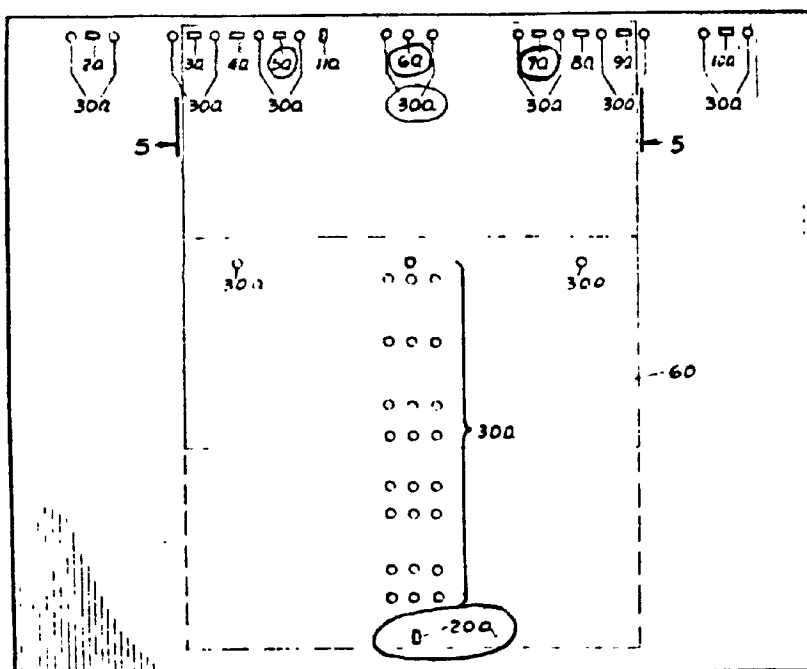


FIG. 4

The centering hole 6a is round whereas the rectangular openings 5a and 7a on either side of center provide for slight expansion or contraction of a negative. The rectangular opening 20a on the edge opposite to centering hole 6a is positioned with its longer axis in alignment with the center line so as to provide for slight expansion or contraction with respect to the centering hole. Openings 30a are used in punching substitute negatives at a later time.

The Examiner refused the claims, in part, as follows:

. . .

The cited patent clearly teaches that a punch apparatus for punching materials is well known in the art. The Caesar patent shows a punch device having a plate configuration (Fig. 1, Fig. 2 and Fig. 5) with a central roundhole 6a (Fig. 4), at least two slotted hole punches 4a, 5a, equally spaced from the central punch and a position-adjustable punch adjustable in a perpendicular direction 20a. The applicant states in his arguments that the Caesar and the present invention are directed towards different activities, but the applicant claims the device operating in substantially the same manner to produce the same result as that being described in the Caesar patent, and hence there is no inventive step or inventive ingenuity in making such a variation for another environment.

. . .

The Applicant responded to the Final Action, in part, as follows:

. . .

The Examiner appropriately notes that Caesar describes a punch apparatus with a particular configuration which is similar to the configuration disclosed and claimed in the present application.

. . .

Caesar does not address the problem of initial registry (nor re-registry) of film, plate and press. It is concerned only with the re-registry of elements of a single medium - negatives.

...With respect to the operation of the two devices, Caesar does not have any plate configuration punch which is operable in unison with the operation of the punch respecting the film material. Caesar operates only with respect to a single medium. It does not operate with respect to both film negatives and press plates.

...In the present invention, the registration of materials in the same medium was only part of the full objective. The full objective or purpose of the present invention was to register material of the same medium plus insure that the material of the first medium is properly registered with respect to material of a second medium. In particular, the objective of the present invention was to register several films with respect to each other and, also, to accurately register all those films with respect to a press plate.

. . .

The issue before the Board is whether or not the claims define patentable subject matter in view of the cited art.

At the Hearing Mr. Hitchcock explained the operation of the Applicant's punch apparatus, stressing that it had separate sets of punches which acted simultaneously to form the several sets of holes, for example, center hole punch 10, the rectangular hole punches 11, and the hole punches 13. He compared the Applicant's punch apparatus with that of the Caesar patent, pointing out that the Caesar apparatus was not capable of punching holes 5c to 7c, and 5d to 7d, at the same time that the holes 6a, 11a, and 20a were formed. He noted that in the Caesar patent, the holes such as 5c and 5d were formed only at a later time should substitute negatives be needed.

Mr. Hitchcock then discussed claim 1 under rejection in the Canadian application, at which point it became evident that the action of the Applicant's punch was not clearly stated in the rejected claims, in that the simultaneous punching action by the sets of punches has not been defined. Further discussion indicated that once the Applicant's claims had accurately defined the action outlined by the Agent, then the Caesar reference would cease to be relevant. Mr. Hitchcock subsequently submitted amended sets of claims to define the Applicant's punch apparatus, amended claim 1 below being from that set presented April 29, 1988:

Punch apparatus for punching materials used in the production of printing plates, comprising first punching means having a symmetrical punching configuration, the first punching means comprising a central round hole punch positioned to punch one edge

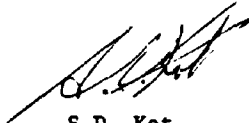
of a material to be punched, and at least two slotted hole punches provided one on each side of said central punch and equally spaced from said central punch to punch said material along said one edge, and further comprising second punching means having a punch configuration corresponding to a pin configuration of a press plate and the second punching means operable simultaneously with the operation of the first punching means along said one edge.

We are satisfied the amended set of claims define patentable subject matter over the cited Caesar patent.

We recommend that the amended claims be accepted, and that the application be remanded to the examiner for normal prosecution.



M.G. Brown
Acting Chairman
Patent Appeal Board



S.D. Kot
Member

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly I remand the application to the Examiner for prosecution consistent with the recommendation.



J.H.A. Gariépy
Commissioner of Patents

Dated this 19th day of September 1988
Hull, Quebec

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