

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILEMON L. BRUNER and DAVID C. BUGGE

Appeal No. 96-1605
Application No. 07/887,629¹

HEARD: March 10, 1999

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and McQUADE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed May 22, 1992. According to appellants, this application is a continuation-in-part of Application No. 07/754,202 filed August 21, 1991, now abandoned; which is a continuation of Application No. 07/469,306 filed January 24, 1990, now abandoned; which is a continuation-in-part of Application No. 07/163,307 filed March 16, 1988, now U.S. Patent No. 4,911,280 issued March 27, 1990; which is a continuation-in-part of Application No. 07/042,797 filed April 27, 1987, now abandoned.

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This is a decision on an appeal from the examiner's final rejection of claims 2, 3 and 11. The only other claims still pending in the application have been allowed.

In a supplemental answer mailed September 11, 1996 (Paper No. 29), the examiner withdrew the rejection of claim 11. Accordingly, the only issue before us is the propriety of the examiner's rejection of claims 2 and 3.

Appellants' invention relates to an apparatus for separating and rejecting coins. According to appellants' invention, coins of a first diameter are retained while coins of a lesser diameter are rejected.

The apparatus recited in claim 2 (which is the only independent claim still on appeal) includes a primary race (10), a secondary race (20) and an aperture (30) formed in a wall between the races to establish communication between the two races. A means described as a protrusion 22 in the specification is situated in the region of the aperture (30) to apply a lateral force to coins traveling down the primary race from an inlet coin portal (9). The arrangement is such that coins of the first diameter are too large to pass through the aperture and into the secondary race. However, coins of a

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lesser diameter will be urged by the protrusion through the aperture and into the secondary race to thus separate the coins of lesser diameter from the coins of the larger, first diameter.

Claim 2 recites that the secondary race is connected to the above-mentioned aperture and is dimensioned to retain coins in a substantially on-edge orientation. Claim 2 also recites that the means for applying the lateral force pivots the coin in the primary race to align the leading edge of the coin with the above-mentioned aperture.

A copy of appealed claims 2 and 3 is appended to appellants' brief.

The following reference is relied upon by the examiner as evidence of anticipation in support of his rejection under 35 U.S.C. § 102(b):

French patent ²	469,837	Aug. 12,
1914		

² A translation of this reference is attached to appellants' brief.

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Claims 2 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the French reference. Reference is made to the examiner's answer for details of this rejection.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellants' arguments. As a result, we conclude that the rejection of the appealed claims cannot be sustained.

It is well established patent law that for a reference to be properly anticipatory, each and every element of the rejected claim must be found either expressly described or under the principles of inherency in the applied reference. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

There is no dispute that the coin separating apparatus in the French reference has a primary race or coin passage (e) and a secondary race or coin passage (h) interconnected by an aperture (f) such that a lateral force exerted by a member (g) causes coins traveling down the primary race and having a diameter smaller than a first diameter to pass through the aperture and into the secondary race while allowing coins of the larger, first diameter to continue their downward travel

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in the primary race. However, as correctly argued by appellants, the French reference lacks an express disclosure of pivoting the coin in the primary race to align its leading edge with the aperture (f). As also correctly argued by appellants, the French reference additionally lacks an express disclosure of maintaining a coin in the secondary race in its substantially on-edge orientation.

Furthermore, neither of the foregoing features in appellants' claimed invention appears to be inherent in the apparatus of the French reference inasmuch as the examiner has not established that they necessarily flow from the teachings of the French reference. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990) and cases cited therein. It does not necessarily follow from the disclosure in the French reference that the coin "climbs to the edge (j)" of the aperture (f), that the coin traveling through the aperture will be maintained in a substantially on-edge orientation in the wide channel portion of the secondary race immediately adjacent to the aperture (f). Mere possibilities or even probabilities are not enough to establish inherency. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

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Since the French reference does not expressly or inherently disclose each and every element of the invention defined in claim 2, it follows that it is not a proper anticipatory reference for the subject matter of claim 2 and, hence, for the subject matter of claim 3. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d at 1444, 221 USPQ at 388.

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The examiner's decision rejecting claims 2 and 3 under 35
U.S.C. § 102(b) is therefore reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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