

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS M. GALLAGHER, JOHN R. NOBILE, THOMAS M. PFEIFER,
WILLIAM A. ROSS and RICHARD P. SCHOONMAKER

Appeal No. 96-1706
Application 08/203,461¹

ON BRIEF

Before THOMAS, KRASS and FLEMING, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 3, 5, 6, 8 and 9. Claims 4, 7 and 10 are

¹Application for patent filed February 28, 1994.

considered by the examiner to be directed to allowable subject matter.²

The invention pertains to a method of controlling a tape motor for feeding tape to a printing drum so that only the necessary amount of tape is utilized regardless of the length of printing which occurs.

Representative independent claim 1 is reproduced as follows:

1. A method for controlling a tape motor for feeding tape in correspondence to printing of an indeterminate length of printing on the tape by a print drum comprising the steps of:

a) providing a micro controller operative to control a tape motor;

b) providing a sensor for indicating a tape condition which changes in accordance with the engagement of a printing portion of the print drum with the tape;

c) providing an optical sensor and slotted disk for providing signals indicative of the rotation of a motor shaft of the tape motor;

d) providing at least first and second counters for counting signal pulses from said optical sensor corresponding to the passage of slots during rotation of the motor;

e) energizing the motor for feeding tape;

f) counting the signal pulses in said first and second counters; and

²It is assumed that the inclusion of claim 10 in the statement of rejection at page 3 of the answer, paragraph 9.1.2 was a typographical, or other type of, error.

Appeal No. 96-1706
Application 08/203,461

g) based on said counts of signal pulses in said first and second counters and the sensor indicated tape condition, the micro controller determining the timing of control signals of controlling the motor in correspondence to the length of printing on the tape.

The examiner relies on the following references:

Hubbard	3,869,986	Mar. 11, 1975
Schwartz	4,168,533	Sep. 18, 1979
Storage et al. (Storage)	4,831,554	May 16, 1989

Claims 1 through 3, 5, 6, 8 and 9 stand rejected under 35 U.S.C. 103 as unpatentable over known postage meters in view of Schwartz "and a substitution of equivalent devices" [answer, page 3].

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

We reverse.

At the outset, we note that the examiner's reliance on references (Hubbard and Storage), to whatever extent relied on, wherein the references form no part of the statement of rejection, is clearly improper. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we place no reliance on the Hubbard and Storage references.

Appeal No. 96-1706
Application 08/203,461

While the examiner's rationale for the obviousness rejection is sometimes hard to follow, it is clear that the examiner has failed to establish a case of prima facie obviousness because a key claimed limitation is missing from the prior art on which the examiner relies in making the rejection. Each of the independent claims calls for "first and second counters..." As the examiner recognizes, at page 4 of the answer (paragraph 9.1.8), the prior postage meters upon which the examiner relies, "do not use the optical encoders or counters as claimed." The examiner takes the position that the "claimed optical encoder performs the same function as the optical encoder of Schwartz" and "the claimed counters are used to keep track of the correct location of the item to receive the postmark and the data to be printed so that the postmark is correctly placed at the specified location [sic] this is one of the functions of processor 113 of Schwartz."

Even if the functions to which the examiner refers were the same, and we do not accept this premise, the fact that the first and second counters are part of specifically claimed structure for achieving appellants' intended result and that the examiner has not shown such structure to be disclosed or suggested in any way by the prior art constitutes a firm basis

Appeal No. 96-1706
Application 08/203,461

for holding that the examiner has not established a case of prima facie obviousness and we so hold.

Further, we agree with appellants that the skilled artisan would have been unlikely to look toward Schwartz for a teaching of controlling a tape motor for feeding tape to a printing drum since Schwartz is directed to a postage meter which utilizes an ink jet printing mechanism rather than a mechanical drum mechanism.

The examiner's decision rejecting claims 1 through 3, 5, 6, 8 and 9 under 35 U.S.C. 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Appeal No. 96-1706
Application 08/203,461

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