

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL A. LIPPS

Appeal No. 1997-1109
Application 08/250,223

ON BRIEF

Before THOMAS, HAIRSTON and DIXON, Administrative Patent
Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims 1, 3-6, 8, and 22-26. Claims
9-21 and 28 have been allowed. Claims 2, 7, and 27 have been
canceled.

The disclosed invention relates to a method and device
for dispensing items from a dispensing unit wherein a

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controller controls the latching and unlatching of at least one door blocking access to storage locations in the dispensing unit.

Claim 22 is illustrative of the claimed invention, and it reads as follows:

22. A dispensing unit comprising:
an enclosure having an interior accessible through a doorway;

a plurality of storage locations within the interior for holding items to be dispensed;

at least one openable door across said doorway;

a controller disposed on the enclosure, the controller having means for inputting information into the controller;

means for locking the door to prevent access to the storage locations;

means in electrical communication with the controller for unlocking the locking means to permit access to the storage locations in response to information input from said input means.

The examiner relies on the following references:

Colson Jr. et al. (Colson)	5,346,297	Sep. 13, 1994
		(filed Jan. 4, 1993)
Ishizawa et al. (Ishizawa)	4,783,740	Nov. 8, 1988
Kimbrow	4,737,910	Apr. 12, 1988

Claims 1, 3-6, 8 and 26 stand rejected under 35 U.S.C.

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§ 103 as being unpatentable over Colson in view of Ishizawa.

Claims 22-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Colson.

Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Colson in view of Kimbrow.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

OPINION

The rejections of claims 22, 24, and 25 are sustained. The rejections of claims 1, 3-6, 8, 23 and 26 are reversed. Pursuant to 37 CFR 1.196(b), claims 1, 3-6, 8, and 26 are rejected for failure to comply with the second paragraph of 35 U.S.C. § 112.

According to appellant (Brief, page 3), the claim language of independent claim 1, and the claims that depend therefrom, is inconsistent, and the input device is intended to also be the item switch. We agree. As a result of this inconsistency, we are not able to determine exactly what actions are needed to open the door that blocks access to the storage locations. In addition, claim 1 states that the plurality of item switches are disposed next to storage

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locations, whereas the input device is visually located on the dispensing unit.¶ If the item switches and the input device are the same, then we do not know whether a single input device or a plurality of item switches are being claimed. Accordingly, claims 1, 3-6, 8, and 26 are indefinite.

In keeping with the provisions of 37 CFR § 1.196(b), claims 1, 3-6, 8, and 26 are rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness.

A claim should not be rejected over prior art if it is necessary to engage in considerable speculation as to the meaning of terms in the claim and assumptions as to its scope. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Thus, as a result of the indefiniteness of independent claim 1, and our inability to judge the merits of the elements obviousness rejection of this claim, the obviousness rejection of claims 1, 3-6, 8, and 26¹ is reversed.

According to the examiner (Answer, page 6), Colson

¹ Although we have reversed the obviousness rejection pro forma based on In re Steele, we note in passing that Ishizawa teaches the placement of item switches adjacent to shelves.

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discloses (Figure 1; and column 2) all of the elements and steps of claims 22, 23, 24, and 25, except for specifically maintaining a controller disposed on the enclosure. The examiner states (Answer, page 6) that Colson discloses (Figure 1; Abstract) an enclosure having an interior accessible through a doorway, and a plurality of storage locations within the interior for holding items to be dispensed. The examiner also states (Answer, page 6) that Colson discloses (Figure 1; and Abstract) at least one openable door across the doorway. The examiner further states (Answer, page 6) that Colson discloses a controller, means for inputting information into the controller, means for locking the door to prevent access to the storage locations, and means in electrical communication with the controller for unlocking the locking means to permit access to the storage locations in response to information input to the input means. The examiner indicates (Answer, page 6) that Colson does not specifically maintain a controller disposed on the enclosure. The examiner asserts (Answer, pages 6 and 7) that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Colson to employ a controller on the enclosure, in lieu of the stand-alone unit, because this would

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allow for the enclosure to stand alone and operate without a side unit, which would ;optimally allow for a plurality of such units to stand side by side.¢ We agree with the examiner because as computers decrease in size, the space needed for them correspondingly decreases in size. As a matter of interest, we note that Colson already discloses (column 7, lines 8-15; Figure 12) an electronic control circuit board 119 (i.e., a controller) contained within the enclosure.

Based upon the foregoing, the obviousness rejection of claim 22 is sustained.

Appellant argues (Brief, page 4) that Colson does not disclose the input means including a touch sensitive screen on the controller as in claim 23. We agree. The examiner's contentions to the contrary notwithstanding, the keyboard in Colson is not a touch sensitive screen (Answer, page 7). For this reason, the obviousness rejection of claim 23 is reversed.

The obviousness rejection of claim 24 is sustained, however, because Colson does have a keyboard in communication with the controller (column 4, lines 39-52).

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According to the examiner (Answer, page 7), Colson does not disclose a plurality of item switches spaced apart from some of the shelves. Kimbrow discloses (column 1, lines 55-68 and column 2, lines 1-40) a plurality of item switches located in close proximity and corresponding to at least some of the storage locations, wherein each item switch is positioned so that it can be visually correlated with items in the corresponding storage location before an item is removed, and wherein the item switches are connected to the controller so that the actuation of the item switches produces a record of items removed from or placed into the dispensing unit. The examiner is of the opinion (Answer, page 7) that it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the 'touch' system of Kimbrow with the medical dispensing cabinet of Colson because this allows for easy accountability of products.¶ We agree.

Appellant argues (Brief, page 9) that Kimbrow does not teach inclusion of a controller on the dispensing unit enclosure and interlocking of the controller to a door also on the enclosure.¶ As indicated supra, the examiner addressed the obviousness of placing the controller on the dispenser unit based upon the teachings and suggestions of Colson alone.

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Therefore, appellant's argument is not persuasive.

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In summary, the obviousness rejection of claim 25 is sustained.

Appellant argues (Reply Brief, pages 1-3) that the claims on appeal should be allowed because the Office allowed similar claims in Colson's U.S. patent 5,520,450. The PTO is not bound to repeat an error that may have been made in issuing the noted patent to Colson. See Ex parte Tayama, 24 USPQ2d 1614, 1618 (Bd. Pat. App. & Int. 1992).

DECISION

The decision of the examiner rejecting claims 22, 24, and 25 under 35 U.S.C. § 103 is affirmed. The decision of the examiner rejecting claim 23 under 35 U.S.C. § 103(a) is reversed. The decision of the examiner rejecting claims 1, 3-6, 8, and 26 under 35 U.S.C. § 103 is reversed because of our finding that these claims are indefinite.

As a result of the indefiniteness of claims 1, 3-6, 8, and 26, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground

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of rejection shall not be considered final for purposes of
judicial review.¢

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Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that [a] new ground of rejection shall not be considered final for purposes of judicial review.¶

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that 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 proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will

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be remanded to the examiner

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART
37 CFR 1.196(b)

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JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

KWH/CR:hh

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