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and (2) is not binding precedent of the Board.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PIETER G. MARKUS

Appeal No. 97-2626
Application 08/234,502¹

ON BRIEF

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

The appeal is from a decision of the Examiner rejecting

¹ Application for patent filed April 28, 1994. According to appellant, the application is a continuation of Application 08/033,947, filed March 18, 1993, which is a continuation of Application 07/818,413, filed January 6, 1992, which is a continuation of Application 07/504,188, filed April 3, 1990.

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claims 49-52 and 57-65. We reverse.

A. Findings of fact

The record supports the following findings by a preponderance of the evidence.

Claims on appeal

1. The application on appeal contains claims 49-52 and 57-65. Claims 1-48 and 53-56 have been canceled.

2. Claim 59 reads as follows:

A device comprising a wall portion formed with a polygonal loading aperture for the introduction of an object having a correct size including a correct width and correct height, wherein the device comprises:

blocking means for blocking the introduction of objects having a width less than said correct width,

detection means for detecting the presence of a partially introduced object being introduced through said loading aperture, upon detection of said object having a correct size said detection means cooperating with said blocking means to discontinue blocking; and wherein said detection means operates within a tolerance field situated inside the envelope of a space having a width and height equal to said correct width and height, said tolerance field being situated adjacent a boundary of said envelope, and

means for urging said partially introduced object towards one side of the loading aperture, characterized in that

said blocking means blocks the introduction of objects having a height less than said correct height,

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said means for urging urges said partially introduced object simultaneously towards one side of the loading aperture and towards an adjoining further side so that said partially introduced object is urged towards a corner between the adjoining sides,

said tolerance field is situated diametrically opposite to said corner, and

said detection means operates exclusively in said tolerance field.

The 35 U.S.C. § 112 rejection

3. The examiner has rejected claims 49-52 and 57-65 under the first paragraph of 35 U.S.C. 112 for an alleged failure of the specification to provide an enabling disclosure to make and/or use the "means for urging". (Examiner's Answer, Paper 43, pages 4 and 5).

4. The examiner alleges that the specification as it applies to the description of figures 3 and 7, fails to adequately teach how the "means for urging", shown as springs 3a-3c is:

a. "initially positioned to commence urging of the partially-inserted object toward one side/corner" (id. at 4);

b. "reset"(id. at 4-5); and

c. "activated" (id. at 5).

5. The examiner further alleges that given the

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description of figures 8-15 and 18-20, it is uncertain how the means for urging is "positioned with respect to any one of the blocking/detection elements shown in figures 8-15 and 18-20 so as to not interfere with the performance of the blocking/detection element(s)." (id. at 5).

The prior art rejections

6. Claims 49, 51, 57, 59, 61, and 62 have been rejected as being unpatentable under 35 U.S.C. § 103 over Narita '93, Japanese Kokai 61-206993 (1986).

7. Claims 50, 52, 58, 60, and 63-65 have been rejected as being unpatentable under 35 U.S.C. § 103 over Narita '93 in view of Hasegawa, Japanese Kokai 61-187188 (1986).

8. In the examiner's answer, the following new rejections were made²:

a) Claims 49, 51, 57, 59, 61, and 62 have been rejected as being unpatentable under 35 U.S.C. § 103 over Narita '93 in view of Narita '92, Japanese Kokai 61-206992

² Claims 50 and 52 were also rejected under 35 U.S.C. 101 as claiming the same invention, however the examiner withdrew the rejection in response to an amendment by the appellant.

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(1986).

b) Claims 50, 52, 58, 60, and 63-65 have been rejected as being unpatentable under 35 U.S.C. § 103 over Narita '93 in view of Narita '92 and further in view of Hasegawa.

Narita '93

9. Narita '93 generally teaches a device for preventing the accidental opening of a cassette cover.

10. The examiner alleges that Narita '93 shows in figures 1-6 a means for blocking (9) an object having a width less than a correct width, a means for urging (8) the object towards one side, a means for detecting (11) a correct width, and a means for disabling (discontinue blocking) 10 if a correct width is detected. (Examiner's Answer, page 6).

The examiner's rationale

11. According to the examiner, the subject matter of claims 49, 51, 57, 59, 61, and 62 would have been obvious within the meaning of 35 U.S.C. § 103 over Narita '93 (id. at 7). The examiner reasons that it is well known in the art of storage cassette devices "to have a one dimensional task be performed equivalently as a two dimensional task", and that therefore it would have been obvious to modify the Narita '93

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device to further inhibit insertion of an incorrectly sized cassette. (id. at 8).

Narita '93 in view of Narita '92

12. Narita '92 generally teaches a device for preventing the accidental opening of a cassette cover.

13. The examiner alleges that Narita '92 shows in figures 1-5 a means for blocking (10) an object having a height less than a correct height, a means for urging (8) the object towards the top side, means for detecting (11) a correct height, and a means for disabling (discontinue blocking) 10 if a correct height is detected. (id. at 6).

The examiner's rationale

14. According to the examiner, the subject matter of claims 49, 51, 57, 59, 61, and 62 would have been obvious within the meaning of 35 U.S.C. § 103 over Narita '93 in view of Narita '92 (id. at 14). The examiner reasons that it would have been obvious to combine Narita '93 and '92, since doing so "would further inhibit the insertion of undersized foreign objects." (id. at 14).

B. Discussion

1. The rejection based on 35 U.S.C. § 112

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A nonenablement rejection under section 112, first paragraph is appropriate where the written description fails to teach those in the art to make and use the invention as broadly as it is claimed without undue experimentation. In re Cortright, 165 F.3d 1353, 1356, 49 USPQ2d 1464, 1466 (Fed. Cir. 1999). The test is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re Wright, 999 F.2d 1557, 1562, 27 USPQ 1510, 1513 (Fed. Cir. 1993). The examiner must "explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

Based on the evidence before us, the examiner has failed to establish a reasonable basis to question the enablement provided for the claimed invention. Specifically, the examiner has failed to demonstrate that undue experimentation

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would be necessary in order to determine how to initiate, activate, and reset the means for urging. (Findings 4a-4c). The examiner has failed to demonstrate that given the specific embodiments of figures 8-15 and 18-20, that undue experimentation would be necessary to make or use an urging means that would not interfere with the blocking and detecting means. (Finding 5).

The examiner provides no prior art or other relevant evidence to support his argument that the specification is nonenabling. Furthermore, there is nothing on the record before us that suggests that the examiner considered the factors for determining whether experimentation is undue, as provided in In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), citing with approval to Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Because the examiner has failed to meet his burden of proving a lack of enablement, the rejection of claims 49-52 and 57-65 under 35 U.S.C. § 112, first paragraph will be reversed.

2. The prior art rejections

Based on the record before us, the examiner has failed to set forth a prima facie case of obviousness. The Narita '93

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and '92 devices prevent the accidental opening of a cassette cover. (Findings 8 and 11). The claimed invention is directed to detecting both the width and height of an inserted object and blocking insertion of the object if either the width or the height is less than a correct width and height. (Finding 2). The examiner's suggestion that one skilled in the art would have been motivated to modify the Narita '93 device, or alternatively modify Narita '93 in view of Narita '92 to arrive at the claimed invention can only be made with the benefit of knowledge found in the Appellant's disclosure. It is improper to rely on Appellant's own disclosure as motivation for combining the prior art. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."); In re McLaughlin, 443 F. 2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (obviousness judgments are necessarily based on hindsight; so long as judgment takes into account only knowledge known in the art,

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there is no error.).

Accordingly, we will reverse the decision of the examiner rejecting claims 49, 51, 57, 59, 61, and 62 as being unpatentable under 35 U.S.C. § 103 over Narita '93, and over Narita '93 in view of Narita '92.

As applied by the examiner, Hasegawa does not make up for the deficiencies of Narita '93 and Narita '92. Accordingly, we will also reverse the decision of the examiner rejecting claims 50, 52, 58, 60, and 63-65 under 35 U.S.C. § 103 over Narita '93 in view of Hasegawa, and over Narita '93 in view of Narita '92 and Hasegawa.

C. Decision

The decision of the examiner rejecting claims 49-52 and 57-65 under the first paragraph of 35 U.S.C. § 112 is reversed.

The examiner's rejection of claims 49, 51, 57, 59, 61, and 62 as being unpatentable under 35 U.S.C. § 103 over Narita '93 is reversed.

The examiner's rejection of claims 50, 52, 58, 60, and 63-65 as being unpatentable under 35 U.S.C. § 103 over Narita '93 in view of Hasegawa is reversed.

The examiner's rejection of claims 49, 51, 57, 59, 61,

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and 62 as being unpatentable under 35 U.S.C. § 103 over Narita '93 in view of Narita '92 is reversed.

The examiner's rejection of claims 50, 52, 58, 60, and 63-65 as being unpatentable under 35 U.S.C. § 103 over Narita '93 and Narita '92 in view of Hasegawa is reversed.

REVERSED

_____)	
FRED E. MCKELVEY, Senior)	
Administrative Patent Judge)	
)	
_____)	BOARD OF PATENT
RICHARD SCHAFER)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
_____)	
JAMESON LEE)	
Administrative Patent Judge)	

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