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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. BURDINE

Appeal No. 98-0107
Application No. 08/545,920[1]

ON BRIEF

Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge and GONZALES, Administrative Patent Judge.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 3 under 35 U.S.C. § 103. No other claims are pending in the application.

[1]Application for patent filed October 20, 1995.

Appellant's invention relates to a clip carrier for storing and dispensing semi-automatic cartridge clips. Each cartridge clip holds a group of the individual cartridges. According to claim 1, the only independent claim on appeal, the clip carrier comprises a container (12) having opposite side panels (18, 20), opposite edge panels (22, 24) and a bottom panel (16). Claim 1 recites that a top part of one of the edge panels forms an entry opening (32) for receiving and dispensing a cartridge clip. Thus, cartridge clips are loaded into the carrier through the entry opening (32) and are dispensed through the same opening. According to claim 1, the entry opening is recited to be similar in size and configuration to a cartridge clip. The cartridge clips in the carrier are supported on a push plate (42) which is biased toward the end of the carrier having the entry opening by spring means (44, 46).[2]

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[2] Strict antecedent basis is lacking for the recitation of "said compression spring means" in lines 15-16 of claim 1. Correction of this informality is in order upon return of this application to the jurisdiction of the examiner.

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Puckett	2,779,522	Jan. 29, 1957
Buban et al. (Buban)	4,465,208	Aug. 14, 1984
Yablans	5,337,897	Aug. 16, 1994

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over "Puckett, Buban et al., or Yablans" (answer page 3). As we understand this statement of the rejections, the examiner relies solely on Puckett in the first rejection, solely on Buban in the second rejection, and solely on Yablans in the third rejection. With regard to each of these rejections, the examiner concedes on page 4 of the answer that the carriers of the applied references lack an entry opening that is similar in size and configuration to a cartridge clip. He also concedes that the applied references lack a

teaching of a carrier or magazine for storing and dispensing semi-automatic cartridge clips. He nevertheless takes the following position:

> However, the carriers of Puckett, Buban et al., and Yablans show and suggest that different articles of similar shape can be dispensed and that the opening is sized for the specific article to be dispensed. It would have been obvious to shape the opening of Puckett, Buban et al., and Yablans to the size of a cartridge clip when it is desired to dispense a cartridge clip. [Answer, page 4.]

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that none of the rejections can be sustained.

It is well established patent law that there must be some teaching, suggestion or inference in the prior art as a whole or some knowledge generally available to one of ordinary skill in the art that would have led one of ordinary skill in the art to make the modification needed to arrive at the claimed invention. See, inter alia, In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed

Cir. 1988) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988). See also In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) (The prior art must provide one of ordinary skill in the art with the motivation to make the modification needed to arrive at the claimed invention).

The Puckett patent discloses a magazine for receiving and dispensing individual cartridges or shells, not cartridge clips as defined in claim 1. Furthermore, the aperture in Puckett's panel 7, which corresponds to one of the claimed edge panels in claim 1, is not sized to receive and dispense cartridge clips as required by claim 1. The aperture in Puckett's panel 7 is not even intended to receive or dispense individual cartridges. Instead, the individual cartridges are inserted and dispensed through the side opening 24 bridging the side panel 10 and the top panel 12. In addition, Puckett lacks a disclosure of appellant's claimed inwardly folded flanges.

Puckett is also lacking in any disclosure of utilizing the magazine for dispensing other articles of “similar shape” as asserted by the examiner, and even if this reference contained such a teaching, we do not see how that teaching, without more, would have suggested the modifications required to arrive at the claimed invention. In the final analysis, Puckett contains no teaching or suggestion of appellant’s claimed container construction, including the entry opening and folded flanges, that would have led one of ordinary skill in the art to modify Puckett’s magazine in the manner required to arrive at the claimed invention. For these reasons we must reverse the § 103 rejection based on Puckett.

The Yablans patent discloses a magazine or carrier for receiving and dispensing thin flat-sided sampler strips containing lipstick or other material, not cartridge clips. We find no disclosure in Yablans of dispensing other articles of “similar shape” as asserted by the examiner, and even if this reference contained such a teaching, we do not see how that teaching, without more,

would have suggested the modifications required to arrive at the claimed invention.

Furthermore, the dispensing aperture 53 in Yablans's magazine is not sized to receive and dispense cartridge clips as required by claim 1. In addition, Yablans's dispensing aperture is not formed in a panel that corresponds to the claimed edge panel in appellant's invention. Instead, the aperture 53 is formed by a cutout 51 at the open end of a finger slot 24 in the top panel 22 of the container.

In the final analysis, Yablans, like Puckett, contains no teaching or suggestion of appellant's claimed container construction, including the size and location of the entry opening, that would have led one of ordinary skill in the art to modify Yablans's magazine in the manner required to arrive at the claimed invention. For these reasons we must reverse the § 103 rejection based on Yablans.

The Buban patent discloses a magazine for dispensing strips of gum, not cartridge clips as defined in appealed claim 1. Although Buban's dispensing slot 50 is formed in a container panel corresponding to one of appellant's edge panels, the slot 50 is not sized to receive and dispense cartridge clips as required by claim 1. In addition, we do not find a disclosure of any article of any "similar shape" to amount to a suggestion of modifying Buban's container to receive and dispense cartridge clips. Thus, Buban lacks a teaching or suggestion that would have led one of ordinary skill in the art to modify the patentee's container in the manner required to arrive at the claimed invention. For these reasons we must also reverse the § 103 rejection based on Bubans.

The examiner's decision rejecting appealed claims 1 through 3 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)
HARRISON E. McCANDLISH Senior Administrative Patent Judge	) BOARD OF PATENT APPEALS
) AND	
JOHN F. GONZALES Administrative Patent Judge	) INTERFERENCES

HEM/jlb

Robert M. Hessin
Dougherty Hessin Beavers & Gilbert
Two Leadership Square
211 North Robinson Suite 1400
Oklahoma City, OK 73102