

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** DALE A. CHRISTIANSEN, KENNETH D. CUMMINGS,  
DAVID C. GRAVES, JAMES L. LENTZ, DONALD E. LOCKETT, and  
GUILLERMO S. ROBLES

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Appeal No. 1998-2504  
Application No. 08/664,279

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ON BRIEF

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Before HAIRSTON, DIXON, and GROSS, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-28, 31, 33-44, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellants' invention relates to an automatic cartridge feeder with a priority slot. The priority slot is used to process cartridges out of the sequence set forth for the cartridges in the cartridge magazine. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A cartridge feeder system for engagement with a drive unit and for providing cartridges to the drive unit for processing, the feeder system comprising:

a magazine port that mates with a removable cartridge magazine having a plurality of shelves adapted to receive a cartridge for processing by the drive unit;

a priority slot separate from the magazine port and adapted to directly receive a cartridge for processing by the drive unit; and

a transport mechanism that exchanges cartridges between the magazine port and the drive unit by performing steps comprising:

exchanging cartridges between cartridge shelves of the cartridge magazine and the drive unit;

detecting placement of a cartridge in the priority slot; and

in response to said detection, interrupting said cartridge exchange to transport the priority slot cartridge to the drive unit.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kobayashi et al. (Kobayashi)	5,353,269	Oct. 04, 1994 (filing date Aug. 19, 1992)
Fago	EP 0 392 620	Oct. 17, 1990

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Claims 1-28, 31, and 33-44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Fago.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 27, mailed Dec. 11, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 26, filed Sep. 5, 1997) and reply brief (Paper No. 29, filed Feb. 13, 1998) for the appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that there is no motivation to combine the teachings of Kobayashi with respect to the use of a cartridge magazine and a separate cartridge slot for individual cartridges with the teachings of Fago with respect to the use of a priority slot in the magazine cartridge. (See reply brief at pages 1-2.) We agree with appellants. The language of claim 1 requires "a priority slot separate from the magazine port and adapted to directly receive a cartridge for processing by the drive

unit; and . . . a transport mechanism that . . . in response to said detection, interrupting said cartridge exchange to transport the priority slot cartridge to the drive unit.” Appellants argue that Fago does not teach or suggest a separate (“external”) cartridge slot for priority processing and that the external slot 17 of Kobayashi is used only for the exchanging of cartridges. (See reply brief at page 2.) (See Kobayashi at col. 7, lines 1-3, col. 10, line 25 et seq., and col. 12, lines 6-9.) We agree with appellants. Furthermore, the external door 22 in Kobayashi is used for exchanging cartridges between the external pack 21 and the storage devices 13 a and 13 b. Therefore, there is no teaching or suggestion of a need for priority processing of cartridges in Kobayashi.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." **ACS Hosp. Sys., Inc. v. Montefiore Hosp.**, 32 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." **Id.** Here, the prior art contains none. In fact, the advantages of utilizing a separate priority slot in combination with a cartridge magazine is not appreciated by the prior art applied by the examiner.

Appellants argue that the asserted transformation of the window 17 of Kobayashi into a priority slot as taught by Fago would be hindsight reconstruction. (See reply brief at page 2 and brief at page 8.) We agree with appellants. Appellants further argue that, at most, Fago would have suggested to designate a shelf in the storage pack 21 as a priority shelf/slot, which would still not be separate from the removable magazine. (See reply brief at pages 3-4.)

It appears to us that, as Appellants have maintained, the examiner has relied on hindsight in reaching his obviousness determination. However, our reviewing court has said that "[t]o 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." **W. L. Gore & Assoc. v. Garlock, Inc.**, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." **Id.** Since the limitation that a separate priority slot in combination with a cartridge magazine and interrupting the cartridge exchange to transport the priority slot cartridge to the drive unit is not taught or

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suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claim 1 and of dependent claims 2-9. Independent claims 10, 22, 31, and 38 contain similar limitations as discussed above, therefore we cannot sustain the rejection thereof nor the rejection of their dependent claims 11-21,23-28, 33-37, and 39-44.

**CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-28, 31 and 33-44 under 35 U.S.C. § 103 is reversed.

**REVERSED**

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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