

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TATSUO FUJIWARA

Appeal No. 1999-1488
Application 08/630,332¹

ON BRIEF

Before CALVERT, ABRAMS and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

¹ Application for patent filed April 10, 1996.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 8. Claims 9, 10 and 12, the other claims remaining in the application, have been allowed.

The appealed claims are drawn to a medium conveying apparatus, and are reproduced as Exhibit A of appellant's brief.

The references applied in the final rejection are:

Suzuki et al. (Suzuki)	4,009,957	Mar. 1, 1977
Yamamoto et al. (Yamamoto)	5,067,835	Nov. 26, 1991
Lang	5,157,448	Oct. 20, 1992
Okamoto et al. (Okamoto) 1993 ² (Japanese Application)	5-92825	Apr. 16,

The claims on appeal stand finally rejected under

² A copy of a translation of this reference, prepared for the Patent and Trademark Office, is forwarded to appellant herewith. All references in this decision to pages and lines of Okamoto are to pages and lines of this translation.

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35 U.S.C. § 103 as unpatentable over the following combinations of references:

- (1) Claims 1 to 3, Lang in view of Yamamoto and Suzuki;
- (2) Claims 4 to 7, Lang in view of Yamamoto, Suzuki and Okamoto;
- (3) Claim 8, Okamoto in view of Suzuki.

Rejection (1)

The basis of this rejection is stated on pages 2 and 3 of the final rejection, and need not be repeated here. Appellant argues (brief, pages 15 to 16) that Lang's drawer 12 is the hopper, rather than a hopper "of a drawer type having a drawer" as recited in claim 1, but we perceive no difference between Lang's drawer 12 and the claimed hopper, since if drawer 12 is a hopper, it certainly is a hopper "of a drawer type having a drawer." Appellant also argues that Suzuki's collecting tray 63 "is not of a drawer type" (brief, page 18); this argument is not well taken because tray 63 fits into an

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aperture in the machine and in effect constitutes a drawer. Also, whether the tray (stacker) 63 of Suzuki is a drawer type is moot as far as claim 1 is concerned, since claim 1 only requires that one of the hopper and stacker be "of a drawer type having a drawer."

Nevertheless, we will not sustain rejection (1) because we do not consider that it would have been obvious to one of ordinary skill in the art, in view of Yamamoto, to provide the apparatus of Lang with a sensor means as recited in claim 1. In the first place, the thrust of Lang's disclosure is to simplify the prior known automatic drawer lock controls by using the

preexisting signals to the feeder to actuate the lock (col. 1, lines 15 to 21 and 54 to 59; col. 4, line 62, to col. 5, line 7). Adding sensors to the Lang apparatus to control the drawer lock would be contrary to Lang's teachings, in that it would require the use of extra wiring and other hardware, which is what Lang seeks to avoid.

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Moreover, the sheet sensors 26 of Yamamoto are used to activate the drive rollers 23 to the printer 30 when a sheet P is detected (col. 4, lines 48 to 64). The examiner contends on page 4 of the answer that this disclosure would have made it obvious to place a sheet sensor downstream of Lang's feed roller 24 to control drawer lock 18, but we do not agree, because in Yamamoto the sensors 26 control a device (rollers 23) downstream, rather than upstream, from them. Also, in the examiner's proposed modification of Lang, the sensor would control a device (lock 18) upstream from the sensor; such a modification of Lang would not have been obvious because in Lang's device the tray (drawer) is intended to be locked when the feeder 24 starts, not thereafter, as it would be if sensors were placed after the feeder.

Rejection (2)

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This rejection will likewise not be sustained because, as applied by the examiner, the additional reference (Okamoto) does not supply the deficiencies noted in rejection (1), supra.

Rejection (3)

We agree with the examiner that it would have been obvious to provide the copying machine of Okamoto with a stacker, this being a conventional feature as shown by collection tray 63 of Suzuki. However, we will not sustain this rejection because, even assuming that the handhold 11 in the front of Okamoto's hopper tray (cassette) 10 might be considered an "operator panel" as recited in claim 8, we do not agree with the examiner that it would have been obvious to one of ordinary skill "to have the photo sensor 1 of Okamoto in the form of a button" (final rejection, page 4). Although buttons and photo sensors may be art recognized equivalents (id.), the purpose of Okamoto's sensor is to prevent removal of the tray when paper is feeding by automatically locking the tray when someone reaches in with their hand 12 and breaks the light beam (Fig. 3; pages 6 to 7). Since a button must be

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deliberately pressed, rather than working automatically, it would not have been obvious to substitute a

button for Okamoto's light sensor because the feature of automatically preventing removal of the tray would be lost. On page 7 of the answer, the examiner seems to assert that door 14 (Fig. 4) may be considered a "button," but even if this were the case, the requirement of claim 8 that the operator panel, which has the button, be on a front surface of the tray would still not be met, since Okamoto's "button" 14 is in a recess behind the front of the tray.

Rejections Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), we enter the following new grounds of rejection:

(A) Claims 1 to 7 are rejected as unpatentable for failure to comply with the second paragraph of 35 U.S.C. § 112, on the following grounds:

(i) In claims 1 to 3 and 6, the term "said sensor" has no antecedent basis.

(ii) Claim 2 is inconsistent with its parent claim 1. Claim 1 recites that the medium "is fed from said hopper into a feed passage and is discharged into said stacker," thus indicating that the "feed passage" is between, and not a part of, the hopper and the stacker; it then recites that a sensor means is

"provided in said feed passage." Claim 2, on the other hand, recites that "said sensor [sic: sensor means] is provided at least on [sic: in] any one of said hopper and stacker." This recitation conflicts with claim 1, because in claim 1 the sensor means is recited as being provided in the feed passage, and the feed passage (as indicated in claim 1) is not in the hopper or in the stacker. The scope of claim 2 therefore is indefinite.

(iii) Claim 4 is indefinite in that, in its last three lines, it recites that the controlling means controls the drive means such that when the medium is located at the boundary of the apparatus body and "any one of said hopper and stacker," the locking portion "can" be engaged by said engaging portion. As

disclosed, when the medium is located at the boundary of the hopper and the apparatus body, the controller drives the motor to drive the locking portion (page 17, lines 5 to 18).

Therefore, reading this claim in light of the disclosure,³ the meaning of the term "can be engaged" is indefinite, since it appears from the disclosure that the locking portion will be engaged.

(B) Claims 1 and 7 are rejected under 35 U.S.C. § 103 as unpatentable over Okamoto in view of Suzuki.⁴ In Fig. 6 et. seq., Okamoto discloses a copier having a tray 10, which constitutes a hopper of the drawer type, the paper sheets

³ See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

⁴ Normally, a rejection under § 103 should not be based on assumptions as to the scope of claims, but rather the claims should be rejected under § 112, second paragraph. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Here, in the interest of administrative efficiency, we have interpreted "said sensor" as --said sensor means-- in making the present rejection of claim 1. Cf. Ex parte Saceman, 27 USPQ2d 1472 (Bd. Pat. App. & Int. 1993). However, in view of the indefiniteness noted in rejections (A)(ii) and (iii), supra, we have refrained from rejecting any of claims 2 to 6 under § 103, but would add that if rejections (A)(ii) and (iii) are overcome, claims 2 to 6 might still be considered unpatentable over Okamoto in view of Suzuki and/or other prior art.

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(medium) 22 in the tray being fed through passages 24, 25, by roller 23. When the paper sheets contact sensor means (feeler) 18a in the feed passage, the feeler 18 enters slit 17 in the tray, to prevent removal (opening) of the tray. As for claim 7, indicator 35 lights to indicate the presence of paper in the feed passage (page 11, last line, to page 12, line 7). The only element recited in claim 1 which is not disclosed by Okamoto is a stacker, but as discussed above in connection with rejection (1), Suzuki discloses stacker 63 (collection tray) in a copier, such being a well known feature which would obviously have been provided in the copier of Okamoto.

Conclusion

The examiner's decision to reject claims 1 to 8 is reversed. Claims 1 to 7 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains new grounds 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)),

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1203 Off. Gaz. Pat. and 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."

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 grounds 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 be remanded to the examiner. . . .

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

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

REVERSED, 37 CFR § 1.196(b)

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	Administrative Patent Judge)	
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PATENT)	BOARD OF
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