

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 28 1997

**PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MANFRED KALUZA

Appeal No. 96-3295
Application 08/271,014¹

HEARD: February 6, 1997

Before MEISTER, NASE and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 and 6 through 19 which are the only claims pending in the application. Claims 3 and 5 have been canceled.

Appellant's invention is an apparatus for transporting rod-shaped articles from an outlet of a magazine to an inlet of a

¹ Application for patent filed July 6, 1994.

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pneumatic conveyor. Claim 1 is illustrative of the claims on appeal and recites:

1. Apparatus for transporting rod-shaped articles of the tobacco processing industry from a supply of articles in a magazine having an outlet into an inlet of a pneumatic conveyor, comprising a rotary conveyor having a series of receptacles for rod-shaped articles and being disposed between said outlet and said inlet; means for discontinuously driving said rotary conveyor to a plurality of different angular positions in each of which one of said series of receptacles is aligned with said inlet and at least one other receptacle registers with and can receive articles from said outlet, comprising means for alternately rotating said rotary conveyor at a higher first speed to move successive receptacles toward alignment with said inlet and at a lower second speed during intervals between movements of said rotary conveyor at said first speed; and means for pneumatically transferring articles from said one receptacle into said inlet of the pneumatic conveyor.

The References

The references relied upon by the examiner are:

Heitmann et al. (Heitmann)	3,827,757	Aug. 6, 1974
Wahle et al. (Wahle)	4,368,742	Jan. 18, 1983
Holzhäuser	4,429,781	Feb. 7, 1984
Kägeler et al. (Kägeler)	4,710,066	Dec. 1, 1987

The Rejection

Claims 1, 2, 4, 6 and 13 through 17 stand rejected under 35 U.S.C. § 103 as unpatentable over Heitmann in view of Kägeler. Claims 7 through 11, 18 and 19 stand rejected under 35 U.S.C. § 103 as unpatentable over Heitmann in view of Kägeler and Holzhäuser. Claim 12 stands rejected under 35 U.S.C. § 103 as unpatentable over Heitmann in view of Kägeler and Wahle.

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Rather than reiterate the respective positions of the appellant and the examiner, reference is made to appellant's brief (Paper No. 12) and the Examiner's Answer (Paper No. 13) for the full exposition thereof.

Opinion

In reaching our conclusions on the issues raised in this appeal, we have carefully considered appellant's specification and claims, the applied references and the respective viewpoints advanced by the appellant and the examiner. With respect to the applied references, we have considered all of the disclosures of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, we have taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). As a consequence of our review, we have made the determination that the examiner's rejections of claims 1, 2, 4, 12-14 should be sustained and that the examiner's rejections of claims 6-11 and 15-19 should not be sustained. Our reasons for this determination follow.

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All of the rejections are based upon lack of patentability under 35 U.S.C. § 103. Our reviewing Court has provided us with the following guidance for evaluating this issue: The question under 35 U.S.C. § 103 is not merely what the references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of the references, it is not necessary that such be found in the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in the particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of an artisan rather than lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Considering first the rejection of claims 1, 2, 4, 6 and 13 through 17 as being unpatentable under 35 U.S.C. § 103 over Heitmann in view of Kägeler, the Heitmann reference, as depicted

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in Figure 1, is directed to an apparatus for transporting rod-shaped tobacco articles 3 from a supply of articles 3 in a magazine 13. A drum-shaped transfer conveyor 1 having a series of receptacles 2 for receiving the articles 3 is disposed between the outlet of magazine 13 and a pneumatic conveyor and is driven continuously to rotate in the direction of arrow 15 (Fig. 3; Column 7, line 66 to Column 8, line 12). Heitmann further discloses in the Background of the Invention that:

As a rule, the drum must be moved intermittently which also contributes to a lower output of the apparatus. Moreover, the drive for the intermittently rotating drum is rather complex and prone to malfunction. [Column 2, lines 30 to 34; emphasis added].

Therefore, although Heitmann is directed to a continuously driven rotary conveyor, Heitmann teaches, or at least fairly suggests, that it is conventional to drive the rotary conveyor intermittently.

Kägeler discloses an apparatus in which rod-shaped tobacco articles are conveyed from a supply of the rod-shaped articles in a magazine 7 to a pneumatic conveyor 3 by a rotary conveyor 4. The rod-shaped articles are transferred from the pneumatic conveyor 3 to magazine 12. The speed of the rotary conveyor is controlled by a motor 68 which varies the speed of the rotary conveyor in accordance with the number of the rod-shaped articles in magazine 12. The examiner has cited Kägeler for teaching a

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variable drive for a motor and concludes that it would have been obvious to vary the rotational speed of the conveyor drum 1 of Heitmann discontinuously or intermittently by a variable drive motor as taught by Kägeler.

Appellant argues that the examiner has misinterpreted the discussion of prior art in Heitmann at lines 30-34 of column 2. According to the appellant, this passage is specifically discussing an apparatus of the type described and shown in U.S. Patent No. 3,614,166 to Spitz which describes a conveyor that moves in an oscillatory motion between two positions rather than in one direction. Appellant, however, has submitted no evidence to support this assertion. We note that there is no mention of oscillatory motion in Heitmann or of the reference Spitz. Moreover, Heitmann discloses in the preferred embodiment of the invention (Column 4, line 43) that drum conveyor 1 is rotated continuously "as contrasted with rotation in stepwise fashion" (emphasis ours), thus providing the artisan with even more of a suggestion that the prior art "conventional" arrangements included discontinuously driving the rotary drum to a plurality of different angular positions. As we have noted above, although Heitmann's invention is directed to a continuously rotating drum, the use of Heitmann as a reference is not limited to what Heitmann describes as the invention, rather Heitmann is relevant

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for all that it contains including the description of the prior art. In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968).

Kägeler discloses a motor 68 which drives a rotary conveyor at varying speeds and thus, in our opinion, would have suggested that the rotary conveyor of Heitmann be driven intermittently by a variable speed motor as disclosed in Kägeler.

Appellant also argues that Spitz (the apparatus with an oscillating rotary conveyor) and Heitmann are not compatible. This argument is not persuasive because the examiner's rejection does not rely on the teachings of Spitz. Rather, the rejection is based on what the combined teachings of Heitmann (including its description of the prior art) and Kägeler would have suggested to a person of ordinary skill in the art.

Appellant points to the recitation in claim 1 that the rotary conveyor is rotated so as "to move successive receptacles toward alignment with said inlet" and concludes that this language refers to movement of the rotary conveyor so that the speed is increased and reduced for each and every article. Appellant argues that the prior art does not teach this limitation because Heitmann, according to appellant, discloses that the rotary conveyor is rotated continuously and Kägeler discloses that the rotary conveyor is rotated at different speeds

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between the transport of a series of articles. We do not find this argument persuasive because Heitmann discloses a drum conveyor which moves successive articles into register with the inlet of a tubular conveyor (Column 2, lines 50-52). In addition, Heitmann discloses that it is known to drive the drum conveyor intermittently. Therefore, in our view, Heitmann suggests increasing and decreasing the speed of the rotary conveyor "to move successive receptacles toward alignment with said inlet" as claimed. In view of the foregoing, we will sustain the rejection of claim 1.

Claim 2 is dependant on claim 1 and further recites that the "receptacles form a circular array of equidistant receptacles and said means for rotating comprises means for indexing the rotary conveyor to align successive equidistant receptacles of said array with said inlet." Appellant argues that the references fail to disclose or suggests the subject matter of claim 2. As we discussed above, Heitmann is suggestive of adjusting the speed of a rotary conveyor "to move successive receptacles toward alignment with said inlet." In regard to the recitation in claim 2 of equidistant receptacles, appellant has admitted that Heitmann discloses a rotary conveyor having equidistant flutes or receptacles (specification at page 3). Thus, we will sustain the rejection as to claim 2.

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With regard to claim 4 which recites that the second speed is at least close to zero speed, the examiner states that an intermittent drive inherently has fast and slow (stopped) speeds. Appellant argues that no zero speeds alternating with above zero speeds are disclosed or suggested in Heitmann. In our opinion, reduction to a second speed close to zero is suggested by the disclosure in Heitmann of an intermittently driven drum. In any case, as admitted by appellant, Kägeler discloses a second zero speed (Brief at page 15).

Claims 12, 13 and 14 stand or fall with claim 1 and thus we will sustain the rejections of these claims (Brief at pages 15 and 16).

Appellant has pointed out that the claims which stand rejected recite subject matter which the Primary Examiner allegedly considered patentable in an interview and that the rejection does not cite any additional prior art and/or any newly discovered passages of the previously cited prior art. The appellant questions whether the implied indication by the Primary Examiner that the case contains patentable subject matter can be disregarded by the examiner. Under 35 U.S.C. § 134, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims and what the

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examiner may have said or implied at a previous point is simply not germane to the propriety of the rejections on appeal.

Claim 15 recites "a variable-speed prime mover and means for varying the speed of said prime mover in accordance with a predetermined program." Appellant argues that the prior art does not teach that the speed of a prime mover is varied in accordance with a predetermined program. Claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) (citations omitted). The broadest reasonable interpretation of this functional limitation consistent with the specification is that the speed of the prime mover is varied in accordance with a schedule established in advance. We fail to see how this function is taught or suggested by the applied prior art. Furthermore, as this limitation is drafted in a means plus function format, a determination of its scope is governed by 35 U.S.C. § 112, sixth paragraph. Accordingly, we look to the specification to interpret the language in light of the corresponding structure, material, or acts described therein and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994).

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The specification discloses at pages 25 to 29 that the speed of the prime mover for the rotary conveyor can be controlled in accordance with a predetermined program of desired variations in speed depicted in Figure 2. The predetermined program of signals, corresponding to desired speeds at respective angular positions of the rotary conveyor, is transmitted by source 97 to a comparing stage 96 as a function of time. The signals are compared in comparing stage 96 with the actual rotational speed of drum 1. The resulting signal is transmitted to the amplifier 98, and the speed of drum 1 is changed so as to correspond to the desired speed.

Although, Heitmann suggests that a rotary conveyor may be driven intermittently, there is no disclosure of a means to drive the rotary conveyor in accordance with a predetermined program as disclosed in appellant's specification or equivalents thereof. Kägeler also lacks a teaching of a predetermined program for driving a rotary conveyor in the manner disclosed in appellant's specification or in an equivalent manner. For these reasons, and the lack of input by the examiner directed to this matter, we will not sustain the rejection of claim 15. In addition, as dependent claims 6, 16 and 17 also include this subject matter, we will not sustain the rejection as to these claims.

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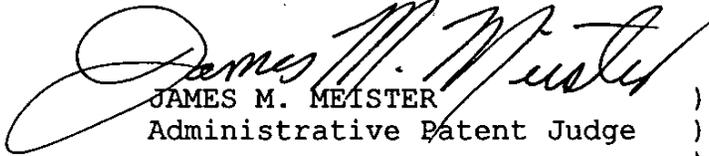
Claims 7 through 11, 18 and 19 are also dependent on claim 15 and thus include the subject matter that the rotary conveyor is rotated in accordance with a predetermined program. As discussed above, we find no teaching in Heitmann or Kägeler that a drum conveyor is rotated according to a predetermined program as recited in claim 15. Holzhäuser, which was cited in the rejection of claims 7 through 11, 18 and 19, discloses a source 18 of signals denoting a desired speed, a means 15 for generating a signal denoting the actual speed and a means 16 for generating a signal denoting the difference between the two signals. However, Holzhäuser does not disclose rotating a drum conveyor in accordance with a predetermined program. Rather the speed of drive 8 of Holzhäuser is changed in accordance with the speed of the continuous conveyor. Therefore, Holzhäuser does not cure the deficiencies of Heitmann and Kägeler. We will not sustain the rejection of claims 7 through 11, 18 and 19.

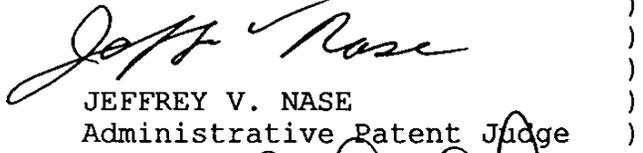
In summary, the decision of the examiner rejecting claims 1, 2, 4, 12, 13 and 14 as unpatentable under 35 U.S.C. § 103 is affirmed and the decision of the examiner rejecting claims 6 through 11 and 15 through 19 is reversed.

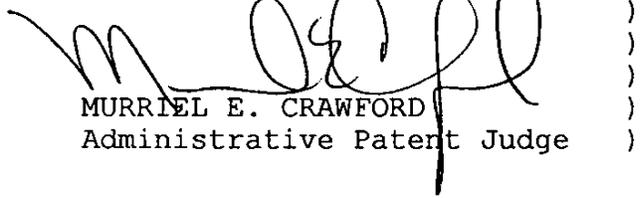
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


JAMES M. MEISTER)
Administrative Patent Judge)


JEFFREY V. NASE)
Administrative Patent Judge)


MURRIEL E. CRAWFORD)
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