

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. HOZA, JAMES C. FOLSOM and ROBERT E. GODFREY

Appeal No. 1998-2358
Application No. 08/396,243¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Judge*, MEISTER, and CRAWFORD, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11 and 15-24. Claims 12-14, the only other claims present in the application, have been indicated as being allowable subject to

¹ Application for patent filed March 1, 1995.

the requirement that they be rewritten to include all the subject matter of the claims from which they depend.

We AFFIRM-IN-PART.

The appellants' invention pertains to (1) a stacker for stacking forms, (2) a cart for transporting forms received from the stacker and (3) a system utilizing such a stacker and cart. Independent claims 1, 11 and 21 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Anderson, Jr et al. (Anderson) 1975	3,883,131	May 13,
Breski et al. (Breski) 1983	4,416,653	Nov. 22,
Chandhoke et al. (Chandhoke) 17, 1985	4,541,763	Sep.
Schultz et al. (Schultz) 29, 1991	5,061,233	Oct.
Cardenas 1993	5,190,281	Mar. 2,

The claims on appeal stand rejected under 35 U.S.C. § 103 in the following manner:

(1) Claims 1, 6 and 8-10 as being unpatentable over Cardenas in view of Breski;

(2) Claims 2-5 and 7 as being unpatentable over Cardenas in view of Breski and Schultz;

(3) Claims 11 and 15-19 as being unpatentable over Cardenas in view of Chandhoke;

(4) Claim 20 as being unpatentable over Cardenas in view of Chandhoke and Schultz;

(5) Claims 21 and 23 as being unpatentable over Chandhoke;

(6) Claim 22 as being unpatentable over Chandhoke in view of Anderson; and

(7) Claim 24 as being unpatentable over Chandhoke in view of Schultz.

The examiner's rejections are explained on pages 4-19 of the answer. The arguments of the appellants and examiner in support of their respective positions may be found on pages 5-22 of the brief, pages 1-6 of the reply brief and pages 20-30 of the answer.

OPINION

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions

advanced by the appellants in the brief and reply brief, and by the examiner in the answer. As a consequence of this review, we will reverse Rejections (2) through (7). With respect to Rejection (1), we will sustain the rejection of claims 1 and 10 and reverse the rejection of claims 6, 8 and 9. Our reasons for these determinations follow.

Rejection (1):

Considering first the rejection of claims 1 and 10, the appellants note that (1) claim requires the tines to be inclined with respect to the vertical in such a manner that the tine free ends form the lowest portion of the top surface thereof and (2) the reason for this arrangement is that the stacker is designed to operate with a cart having tines. Thereafter, the appellants urge that the examiner's proposed modification "would either render Cardenas inoperable for performing its intended function, or less operable" (brief, page 6). The brief also states that:

The Breski et al reference is totally irrelevant to the claimed invention. There is nothing about Breski et al that would teach one of ordinary skill in the art that he or she should go specifically against the teachings of Cardenas and instead of providing the tines tilted in the manner illustrated in the Cardenas' drawings in order to hold the forms in place should tilt [sic] the tines downwardly. The fact that Breski et al may for some obscure reason totally irrelevant to Cardenas be moved into a position where the shelf 19 can be pivoted about pins 41,42 to adjust the backward tilt angle (see column 3, lines 18-25) does not provide any motivation for one of ordinary skill in the art to provide a base with supports for Cardenas so that the tines and the side walls are inclined with respect to the vertical more than two degrees and tilted in a second dimension so the free ends of the tines are substantially the lowest portion of the top surfaces.

Breski et al are primarily directed to a compactor 50,80, and do not suggest a forward tilt of the forms collected.

Not only do Breski et al not provide any suggestion to one of ordinary skill in the art to go specifically against Cardenas' teachings and instead provide the invention, even if Breski et al are combined with Cardenas what is set forth in claim 1 does not insue since neither Breski et al nor Cardenas teach the particular base including support portions as recited in claim 1. [Pages 6 and 7.]

We are unpersuaded by the appellants' contentions. It is true that Cardenas teaches a stacking device with the free ends of the tines tilted upwardly (see, e.g., Fig. 1). Breski, however, in the embodiment of Figs. 4-6 teaches that the stack (and hence the tines) may be tilted downwardly in order that the uppermost edge of the forms in the stack may be engaged by a compacting fingers 102,102a (which are mounted on a crankshaft 81) for the purpose of providing a sharply and compactly folded stack of forms (see, generally, columns 1 and 2). A combined consideration of Cardenas and Breski would have fairly suggested to one of ordinary skill in this art to provide the stacker of Cardenas with downwardly extending tines and compacting fingers as taught by Breski in the embodiment of Figs. 4-6. Breski's stated purpose of "increasing the

sharpness of the fold and the compactness of the stack" (see, e.g., column lines 22 and 23) would serve as more than ample motivation to combine the teachings of Cardenas and Breski.

While of course Breski does not tilt or incline the tines downwardly for the same purpose as that of the appellants, we observe that "[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor" (*In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)) and all the utilities or benefits of the claimed invention need not be explicitly disclosed by the prior art references to render the claim unpatentable under section 103 (*see In re Dillon*, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir. 1990) (in banc), *cert. denied*, 500 U.S. 904 (1991)). *See also In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996) ("the motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness").

As to the appellants' contention that neither Breski nor Cardenas teach the specific base recited in claim 1, Breski teaches a base 43,44 having pivot pins 41,42 (i.e., "support portions") that allow the side walls 29,30 to be inclined in an angularly adjusted position (see column 3, lines 18-25). In this regard, we note that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)).

With respect to claim 10, the appellants argue that Breski does not teach tines which are between 5-20 degrees; however, the embodiment of Figs. 4-6 of Breski illustrates tines which appear to be inclined within the claimed range, thus satisfying this limitation. *See Ex parte Lee*, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993) and *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 779 (Fed. Cir. 1985).

In any event, as the court set forth in *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), citing *Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 n.3, 28 USPQ2d 1652, 1655 n.3 (Fed. Cir. 1993): "when the difference between the claimed invention and the prior art is the range or value of a particular variable, then a *prima facie* rejection is properly established when the difference in range or value is minor." See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990).

In view of the foregoing, we will sustain the rejection of claims 1 and 10 under 35 U.S.C. § 103 based on the combined teachings of Cardenas and Breski.

We now turn to the rejection of claims 6, 8 and 9. With respect to claim 6, the examiner notes that Cardenas teaches a pair of chains 56 and 59. However, as the appellants have correctly noted, chain 99 is for moving feed zone fork 88 while chain 56 is for moving support fork 60. Thus, Cardenas does not fairly suggest the specific elevator mechanism set forth in claim 6. With respect to claims 8 and 9, the examiner contends that Cardenas discloses a "forms position sensor" at 200.

Sensor 200, however, senses the location of the extension section 82 (a part of the machine) rather than the forms (see column 10, lines 40 and 41). In view of the above, we will not sustain the rejection of claims 6, 8 and 9 under 35 U.S.C. § 103 based on the combined teachings of Cardenas and Breski.

Rejection (2):

The examiner contends that it would have been obvious to one of ordinary skill in the art to

mount the sensor of Schultz et al. on the base of Cardenas in order to properly position a cart in relation to the stacker of Cardenas so that the transfer of forms to the cart can be properly achieved. [Answer, page 8.]

We will not support the examiner's position. While Schultz discloses a cart for receiving stacked forms, Schultz receives the forms from an entirely different type of device than that of Cardenas, and we find no suggestion to combine the teachings of these two references as proposed by the examiner. Moreover, Schultz does not teach a sensor mounted on or adjacent the **base** "for sensing positioning of a cart in operative association with said forms-supporting tines" as

required by claim 2. Rather, Schultz simply senses when the cart is full and shuts off the folder 11 (see, e.g., column 2, lines 21-34, and column 6, lines 61-65). With respect to claim 7, we observe that Schultz sets off an alarm 59 when the cart is full rather providing an indicator lamp. Therefore, we will not sustain the rejection of claims 2-4 and 7 under 35 U.S.C. § 103 based on the combined teachings of Cardenas, Breski and Schultz.

Rejections (3) and (4):

Both of these rejections are based on the examiner's view that Chandhoke discloses a "cart" and that it would have been obvious to employ the "cart" of Chandhoke with the stacker of Cardenas "in order to transport the stacks of forms to a desired location and to provide forms handling means which will allow the stacking process to occur smoothly and continuously" (answer, page 11). We must point out, however, that terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them. ***In re Bond***, 910 F.2d 831, 833, 15 USPQ2d 1566,

1567 (Fed. Cir. 1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In our view, the examiner is attempting to expand the meaning of "cart" beyond all reason. That is, Chandhoke discloses a *stacker* 14 which is mounted on wheels and, consistent with the appellants' specification, we can think of no circumstances under which one of ordinary skill in this art would construe Chandhoke's stacker to correspond to a cart as defined by the claims under consideration. Moreover, there is neither reason nor need to provide Cardenas with a stacker as taught by Chandhoke, since Cardenas already has a stacker 10. From our perspective, the examiner has impermissibly relied upon the appellants' own teachings for a suggestion to combine the teachings of Cardenas and Chandhoke in the manner proposed.

With respect to Rejection (4), we have carefully reviewed the teachings of Schultz but find nothing therein which would overcome the deficiencies of Cardenas and Chandhoke that we have noted above.

For the reasons stated above, we will not sustain the rejections under 35 U.S.C. § 103 of claims 11 and 15-19 based on the combined teachings of Cardenas and Chandhoke (Rejection (3)) and claim 20 based on the combined teachings of Cardenas, Chandhoke and Schultz (Rejection (4)).

Rejections (5) through (7):

Each of these rejections is bottomed on the examiner's view that:

Chandhoke et al. does not disclose a second forms-engaging face or a second plurality of cart tines, where individual cart tines are substantially coplanar. It would have been obvious to one having ordinary skill in the art at the time of [sic] the invention was made to employ a second forms-engaging face and a second plurality of cart tines in the invention of Chandhoke et al., since it has been held that the mere duplication of essential working parts of a device involves only routine skill in the art, and because by providing a second forms-engaging face and a second plurality of cart tines would double the capacity of a single cart. [Answer, page 17.]

We do not support the examiner's position. It is well settled that in order to establish a **prima facie** case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the

modification needed to arrive at the claimed invention (*see, e.g., In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)). As we have noted above in Rejections (3) and (4), Chandhoke discloses a stacker and not a "cart" as the examiner asserts, and there is simply nothing which would fairly suggest providing Chandhoke with a second stacking face.

With respect to Rejections (6) and (7), we have carefully reviewed the teachings of Anderson and Schultz, but find nothing therein which would overcome the deficiency of Chandhoke that we have noted above.

In summary:

With respect to Rejection (1), the rejection under 35 U.S.C. § 103 based on the combined teachings of Cardenas and Breski is (a) affirmed with respect to claims 1 and 10 and (b) reversed with respect to claims 6, 8 and 9.

Rejections (2) through (7) are all reversed.

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

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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