

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte RICHARD M. AMENDOLEA

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Appeal No. 2004-0193  
Application No. 09/165,272

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ON BRIEF

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Before STAAB, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 15 to 19, 21, 24, 29 and 32 to 34. Claims 1 to 14, 22, 23, 25, 26, 30, 31 and 36 to 41 have been allowed. Claims 20, 27, 28 and 35, the only other claims pending in this application, have been objected to as depending from a non-allowed claim.

We REVERSE.

BACKGROUND

The appellant's invention relates to an article transporting and escapement device for articles having at least one aperture, or the like, therethrough (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Joschko	3,248,005	Apr. 26, 1966
Riccardo et al. (Riccardo)	4,589,811	May 20, 1986

Claim 32 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Joschko.

Claims 15 to 19, 21, 24, 29, 33 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Riccardo.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the third Office action (Paper No. 8, mailed May 6, 2001), the fourth Office action (Paper No. 15, mailed October 29, 2002) and the answer (Paper No. 17, mailed March 24, 2003) for

the examiner's complete reasoning in support of the rejections, and to the supplemental brief (Paper No. 16, filed February 5, 2003) for the appellant's arguments thereagainst.

### OPINION

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

#### **The anticipation rejection**

We will not sustain the rejection of claim 32 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 32 reads as follows:

An article segregating device for open-ring type articles, comprising:

a guide member extending along a conveying path and supporting each article,  
said guide member decreasing in cross-section at a selected location along said conveying path such that selected articles fall off said guide member at said selected location.

Joschko's invention relates generally to vending apparatus and is more particularly directed to vending apparatus and control apparatus therefor which is adapted to selectively vend one of a plurality of articles to be vended, one at a time, in such a manner whereby like articles are vended, or dispensed, in the same order in which they are stored. Figure 5 illustrates an embodiment in which a motor means 126 is mounted on a mounting member 128 which is held rigidly in a position with respect to further mounting member 124 which may be suitably mounted inside of an enclosure member 11. Motor means 126 is connected to a flexible shaft portion 123, having a diameter  $T$ , through suitable connecting means 125. A further shaft portion 122 is comprised of a helical screw element which is nonrotatably connected to flexible portion 123 and to shaft portion 121 which is of substantially the same minor diameter as portion 122. A further portion 127 at the right-hand end is adapted to be loosely journaled in an opening therefor in member 124 so that the shaft is free to rotate in accordance with the output of motor means 126. A plurality of articles 40A to 40Z are shown suspended in position on the shaft by tabs 50 (see Figure 7). Article 40A is shown in position as it is about to be dispensed into a delivery chute 133. Flexible

portion 123 is of a size, T, so as to allow the dispensing of articles carried by the tabs 50 through the slots 52 provided therefor. Flexible portion 123 is made of a flexible material so that portions 121 and 122 may be inclined to allow the articles stored on portion 121 to move toward the left end as viewed in Figure 5 by the force of gravity.

The appellant argues (supplemental brief, pp. 9-10) that (1) claim 32 is directed towards an article segregating device for open-ring type articles which comprises a guide member decreasing in cross-section at a selected location along a conveying path in which selected articles fall off the guide member at the selected location; and (2) there is no article segregating device in the vending machine of Joschko and there is no structure that segregates open-ring type articles by having only selected articles fall off the guide member at the desired location.

The examiner's response to this argument (answer, p. 5) is that

clearly there is no segregating in the claim language of claim 32 or is there any segregating structure as argued. The "selected location" as claimed would be at the vending position in Joschko. Furthermore, claim 32 only discusses a single selected location, so there really is no segregating claim 32.

"[A] claim preamble has the import that the claim as a whole suggests for it."

See Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d

615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Where an appellant uses the claim

preamble to recite structural limitations of his claimed invention, the USPTO and courts give effect to that usage. See id.; Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Conversely, where an appellant defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. See Bell Communications, 55 F.3d at 620, 34 USPQ2d at 1820; Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the application to gain an understanding of what the inventor actually invented and intended to encompass by the claim. See Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966; Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). The inquiry involves examination of the entire application record to determine what invention the appellant intended to define and protect. See Bell Communications, 55 F.3d at 621, 34 USPQ2d at 1821 (looking to patent specification to determine whether claimed invention includes preamble recitations); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (examining "patent as a whole"); Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA, 944 F.2d 870, 880, 20 USPQ2d 1045, 1053 (Fed. Cir. 1991) (looking to claims, specification, and drawings); Gerber

Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 689, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (noting that preamble recitations provided antecedent basis for terms used in body of claim); Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966 (considering the specification's statement of the problem with the prior art); Kropa, 187 F.2d at 152, 88 USPQ at 481 (noting that preamble sets out distinct relationship among remaining claim elements).

Inspection of the entire record in this case reveals that "article segregating device" is, in fact, a structural limitation of claim 32 requiring the device to be able to segregate articles via the claimed decrease in cross-section of the guide member at the selected location. In our opinion, to read claim 32 indiscriminately to cover all guide members having a decrease in cross-section at a selected location would be divorced from reality. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure. Rather, those words do give "life and meaning" and provide further positive limitations to the invention claimed.

In view of the above-noted determinations, we conclude that Joschko does not anticipate the subject matter of claim 32. Accordingly, the decision of the examiner to reject claim 32 under 35 U.S.C. § 102(b) is reversed.<sup>1</sup>

### **The obviousness rejection**

We will not sustain the rejection of claims 15 to 19, 21, 24, 29, 33 and 34 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 15, 16 and 33, the independent claims subject to this ground of rejection, read as follows:

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<sup>1</sup> The examiner should consider a search of class 209 (Classifying, Separating, and Assorting Solids), especially subclass 707 (Items separated by tipping, rolling, or sliding off support under force of gravity), for the subject matter of claim 32.

15. A article transporting and escapement device comprising:  
at least two substantially parallel guide members extending along a conveying path of an article wherein each said guide member is adapted to be received through an aperture of the article; and  
at least one escapement assembly comprising at least two guide member supports for selectively engaging said guide members at spaced locations along said guide members, at least one of said supports being engaged with each said guide member at any given time, wherein each of said guide member supports includes a pair of gripping arms simultaneously engaging opposite sides of said guide members.
16. An escapement assembly for use in a device for transporting articles having apertures defined therethrough along a guide member over an extended length, wherein the guide member is received through at least one of the apertures of the article, comprising:  
at least three guide member supports for selectively engaging the guide member at spaced locations along said extended length of guide member, at least one of said supports being engaged with and supporting the guide member at any given time.
33. A method of conveying a workpiece along a conveying path comprising the steps of  
a) positioning a workpiece on at least one internal guide member, wherein the guide member is received within an aperture of the workpiece;  
b) conveying the workpiece along the guide member along the conveying path;  
c) selectively engaging the guide member at spaced locations along the conveying path by at least three guide member supports, wherein at least one guide member support is engaging and supporting the guide member at any given time.

Riccardo's invention relates to an automatic device for supplying reels of wrapping material to a utilizer machine. As shown in Figures 1-2, the automatic device 1 is provided a magazine 4, disposed in a position adjacent to the utilizer machine 3, for a plurality of reserve reels 2, and a reel carrier for transferring the individual reels to the

utilizer machine. The magazine 4 comprises a shaft 7 for supporting the reels through their tubular spindle, and at least two support elements 5 and 6 for the shaft which can be removed one at a time from this latter under the control of respective mutually independent operating means, in such a manner as to enable the reels to slide towards the reel carrier.

In the rejection under 35 U.S.C. § 103 before us in the appeal, the examiner (third Office action, p. 4) ascertained that Riccardo "fails to teach two parallel guide members along the conveying path for one article" and concluded that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide two guide members instead of one in order to accommodate a different shape (a wider article which would require two guide members for more stability) article being conveyed, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955)."

With respect to claim 15, the appellant argues (supplemental brief, pp. 10-11) that the examiner's proposed modification of Riccardo to have two parallel guide members is based on hindsight knowledge derived from the appellant's own disclosure.<sup>2</sup>

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<sup>2</sup> The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

We agree. The teachings of the applied prior art (i.e., Riccardo) do not suggest more than one guide member (i.e., Riccardo's shaft 7). The examiner's determination to provide more than one guide member has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.<sup>3</sup>

With respect to claims 16 and 33, the appellant argues (supplemental brief, pp. 11-13) that Riccardo does not teach or suggest the claimed three guide member supports since Riccardo teaches only two guide member supports (i.e., support elements 5 and 6). We agree. In fact, the examiner's proposed modification of Riccardo as set forth in the rejection under 35 U.S.C. § 103 (third Office action, p. 4) does not even find that the claimed three guide member supports would have been obvious at the time the invention was made to a person of ordinary skill in the art. As such, the examiner has failed to establish a prima facie case of obviousness with respect to claims 16 and 33. As to the examiner's belated attempt to establish the

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<sup>3</sup> When obviousness is based on a single prior art reference, there still must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

obviousness of claims 16 and 33 in the response to arguments section of the answer<sup>4</sup> (p. 5), the teachings of Riccardo do not suggest more than two support elements (i.e., guide member supports). The examiner's determination to provide Riccardo with more than two support elements has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.

For the reasons set forth above, the decision of the examiner to reject independent claims 15, 16 and 33, and claims 17 to 19, 21, 24, 29 and 34 dependent thereon, under 35 U.S.C. § 103 is reversed.

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<sup>4</sup> The examiner stated that "[b]y extending the shaft of Riccardo from the upper end (ref, numeral 8 in Riccardo[s] figure 1 []), it would have been obvious to add another guide support in order to handle more reels."

CONCLUSION

To summarize, the decision of the examiner to reject claim 32 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 15 to 19, 21, 24, 29, 33 and 34 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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BLYNN L. SHIDELER  
WEBB ZIESENHEIM BRUENING LOGSDON  
ORKIN & HANSON  
436 SEVENTH AVE-700 KOPPERS BUILDING  
PITTSBURGH, PA 15219

JVN/jg