

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte MICHAEL E. COUGHLIN, ARPITA BANERJEE, LAWRENCE E. GUERRA,
KEITH W. KUDERA, RONALD A. LEONARD, HAMID MASSALI,
DAVID M. MCDONALD and FRED T. STEINBACH

Appeal No. 2004-0376
Application No. 09/457,286

ON BRIEF

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

DECISION ON APPEAL

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

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a system for automatically storing and dispensing pre-packaged pharmaceutical products and other products (specification, p.

1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

van Elten et al. (van Elten)	4,787,803	Nov. 29, 1988
Killinger	5,364,220	Nov. 15, 1994
Yuyama et al. (Yuyama)	5,988,858	Nov. 23, 1999

Claims 1 to 8, 10 to 14, 16 and 18 to 20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by van Elten.

Claims 1 to 8, 10 to 14, 16 to 24 and 26 to 29 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Killinger.

Claims 23 to 25, 29, 30 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Killinger.

Claims 3 to 6, 9 to 12, 15, 16 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over van Elten in view of Yuyama.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 15, mailed February 18, 2003) and the answer (Paper No. 19, mailed July 15, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed May 5, 2003) and reply brief (Paper No. 20, filed July 21, 2003) 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.

The anticipation rejection based on van Elten

We will not sustain the rejection of claims 1 to 8, 10 to 14, 16 and 18 to 20 under 35 U.S.C. § 102(a) as being anticipated by van Elten.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The appellants argue (brief, pp. 11-15) that van Elten does not disclose a transporter enclosed by and moveable within a substantially enclosed cabinet for transporting products between the product conveyors and the infeed/outfeed mechanism as set forth in claims 1 to 8, 10 to 14, 16 and 18 to 20. As set forth in this rejection, the examiner believes (final rejection, p. 2) that (1) the claimed "substantially enclosed cabinet" is readable on van Elten's compartment 3; (2) the "product conveyors" are readable on van Elten's conveyors 5; (3) the "infeed/outfeed mechanism" is readable on either van Elten's supply conveyor 1 and exit conveyor 13 or swing elevator 9 and transferring device 17 or supply conveyor 1 and collecting

conveyor 19; and (4) the claimed "transporter enclosed by and moveable within the substantially enclosed cabinet" is readable on van Elten's elevator 9 or transferring device 17.

After reviewing the disclosure of van Elten, we find ourselves in agreement with the appellants that van Elten does not disclose a transporter enclosed by and moveable within a substantially enclosed cabinet for transporting products between the product conveyors and the infeed/outfeed mechanism as set forth in claims 1 to 8, 10 to 14, 16 and 18 to 20. van Elten's elevator 9 is movable on rails 8 along one side of the compartments 3 of storage staging 2 as shown in Figure 1. As such, van Elten's elevator 9 is not enclosed by and movable with the compartments 3 of storage staging 2. van Elten's transferring device 17 receives crates from distribution conveyor 16 and transfers the crates to an accumulating conveyor 18 along one side of the compartments 3 of storage staging 2 as shown in Figure 1. As such, van Elten's transferring device 17 does not transport products between the van Elten's conveyors 5 (i.e., the product conveyors) and the infeed/outfeed mechanism.

For the reasons set forth above claims 1 to 8, 10 to 14, 16 and 18 to 20 are not anticipated by van Elten. Accordingly, the decision of the examiner to reject claims 1 to

8, 10 to 14, 16 and 18 to 20 under 35 U.S.C. § 102(a) as being anticipated by van Elten is reversed.

The anticipation rejection based on Killinger

We will not sustain the rejection of claims 1 to 8, 10 to 14 and 16 to 20 under 35 U.S.C. § 102(a) as being anticipated by Killinger. We sustain the rejection of claims 21 to 24 and 26 to 29 under 35 U.S.C. § 102(a) as being anticipated by Killinger.

The appellants sole argument against this rejection (brief, pp. 15-16) is that Killinger does not disclose a substantially enclosed cabinet. As set forth in this rejection, the examiner believes (final rejection, p. 2) that the claimed "substantially enclosed cabinet" is readable on Killinger's cabin 1.

After reviewing the disclosure of Killinger, we find ourselves in agreement with the appellants that Killinger does not disclose a "substantially enclosed cabinet." As shown and described, Killinger's cabin 1 comprises a three-dimensional frame and is shaped like an open box or crate (column 7, lines 20-22). As such, Killinger's cabin 1 is not a substantially enclosed cabinet as set forth in claims 1 to 8, 10 to 14 and 16 to 20. However, claims 21 to 24 and 26 to 29 do not recite a "substantially enclosed cabinet."

Instead, claims 21 to 24 and 26 to 29 recite a "cabinet." In our view, the term "cabinet" is readable on Killinger's cabin 1.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 8, 10 to 14, 16 to 24 and 26 to 29 under 35 U.S.C. § 102(a) as being anticipated by Killinger is affirmed with respect to claims 21 to 24 and 26 to 29 but reversed with respect to claims 1 to 8, 10 to 14 and 16 to 20.

The obviousness rejection based on Killinger

We will not sustain the rejection of claims 23 to 25, 29, 30 and 31 under 35 U.S.C. § 103 as being unpatentable over Killinger.

In this rejection (final rejection, pp. 4-5), the examiner rejected claims 23 to 25, 29, 30 and 31 under 35 U.S.C. § 103 as being unpatentable over Killinger.¹ The examiner ascertained that while the limitations of claims 23 to 25, 29, 30 and 31 were not taught by Killinger, the limitations of claims 23 to 25, 29, 30 and 31 would have been obvious to a person of ordinary skill in the art.

¹ The examiner refers to a number of references of record that have not been applied in the rejection under appeal. These references will be given no consideration since they were not included in the statement of the rejection. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

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).

In this rejection, the examiner has not presented any evidence that would have led one of ordinary skill in the art to have modified Killinger to arrive at the subject matter of claims 23 to 25, 29, 30 and 31. Accordingly, the examiner has not presented a prima facie case of obviousness.

For the reasons set forth above, the decision of the examiner to reject claims 23 to 25, 29, 30 and 31 under 35 U.S.C. § 103 as being unpatentable over Killinger is reversed.

The obviousness rejection based on van Elten and Yuyama

We will not sustain the rejection of claims 3 to 6, 9 to 12, 15, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over van Elten in view of Yuyama.

As set forth above in our review of the anticipation based on van Elten, van Elten does not disclose a transporter enclosed by and moveable within a substantially enclosed cabinet for transporting products between the product conveyors and the infeed/outfeed mechanism as set forth in claims 1 to 8, 10 to 14, 16 and 18 to 20.

The teachings of Yuyama would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified van Elten to have a transporter enclosed by and moveable within a substantially enclosed cabinet for transporting products between the product conveyors and the infeed/outfeed mechanism as set forth in claims 3 to 6, 9 to 12, 15, 16 and 20. Accordingly, the examiner has not presented a prima facie case of obviousness.

For the reasons set forth above, the decision of the examiner to reject claims 3 to 6, 9 to 12, 15, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over van Elten in view of Yuyama is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 8, 10 to 14, 16 and 18 to 20 under 35 U.S.C. § 102(a) as being anticipated by van Elten is reversed; the decision of the examiner to reject claims 1 to 8, 10 to 14, 16 to 24 and 26 to 29

under 35 U.S.C. § 102(a) as being anticipated by Killinger is affirmed with respect to claims 21 to 24 and 26 to 29 but reversed with respect to claims 1 to 8, 10 to 14 and 16 to 20; the decision of the examiner to reject claims 23 to 25, 29, 30 and 31 under 35 U.S.C. § 103 as being unpatentable over Killinger is reversed; and the decision of the examiner to reject claims 3 to 6, 9 to 12, 15, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over van Elten in view of Yuyama is 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

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	AND
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