UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RICHARD N. FARGO

Appeal No. 2006-0224
Application No. 09/571,827

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 and 11[1]. As set forth in the answer, (page 2) "Claims 2 and 6 have been cancelled. Claims 8-10 are allowed. Claims 4, 5 and 7 are objected to as containing

[1] Concurrent with the filing of the reply brief (July 26, 2005) appellant filed an amendment cancelling claim 4 and adding the limitations of objected to claim 4 to independent claim 3, from which claim 11 depends. In a subsequent communication from the examiner (August 26, 2005), the examiner states that the amendment dated July 26, 2005 has been entered, and that only claim 1 remains on appeal.

allowable subject matter, but being dependent upon a rejected claim."

We REVERSE.

BACKGROUND

The appellant's invention relates to an elevator with escalator-like passenger flow (specification, page 1).

Claim 1 is the sole claim on appeal, and is reproduced as follows:

> 1. A passenger conveying system comprising:
> a plurality of cabs movable between two floors, each of said cabs having a first door for entering and a second door for exiting;
> said cabs being arranged such that a passenger enters one of said cabs through said first door in a forward direction at one of said two floors, and then exits said one of said cabs through said second door moving in said forward direction at the second of said two floors; and
> said system having at least three cabs, with a control attempting to keep one cab waiting at each of said two floors with a third cab moving between said two floors.

The prior art reference of record relied upon by the examiner in rejecting the appealed claim is:

Kato	JP 10-246020A	Sep. 14, 1998

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by JP'020.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed June 2, 2005) for the examiner's complete reasoning in support of the rejection, and to the brief (filed September 14, 2004) and reply brief (filed July 26, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant’s arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by JP ('020). It is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists whether there was a recognition that it could be used to perform the claimed function. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The examiner's position is set forth on page 3 of the answer.

Appellant asserts (brief, page 5) that claim 1 requires that there be at least three cabs with a control attempting to keep one cab waiting at each of the two floors with a third cab moving between the two floors. The examiner's position (answer, page 4) is that "the limitation a control 'attempting to' in claim 1, line 8 is not a positive recitation, and thus as long as any elevator systems with a control should be capable of 'attempting' to maintain the cabs at each of the two floors with a third moving between the two floors." Appellant asserts (brief, page 5) that "the claim clearly requires that a control attempt to maintain the cabs at each of the two floors with a third moving

between the two floors. Whether a control is 'capable' of this or not, is irrelevant. The reference must disclose a control that is programmed to achieve this feature.

The Japanese reference does not." Appellant additionally asserts (reply brief, page 2) that "[t]he claim language is a positive recitation. That control is 'attempting' necessarily limits the control to one programmed to achieving this goal. There is nothing in the prior art that discusses any benefit from the claimed positioning, nor is there any control that would 'attempt' to achieve that positioning. Simply, nothing in the prior art meets this limitation. The Japanese control would not 'attempt' to do anything outside its programming."

From our review of the claim, we find that the language "said system having at least three cabs, with a control attempting to keep one cab waiting at each of said two floors with a third cab moving between said two floors" sets forth a broad recitation of structure, and is a positive limitation, albeit broad, that cannot be ignored. Note that to meet the claim, it is not necessary that the controller of JP('020) actually keep two elevators in place in their floors while moving a third elevator between the floors. All that is required is

that the controller be capable of attempting to carry out the language set forth in the claim. In paragraph 4 of JP('020), the reference discloses that "[i]n the case of this kind of elevator, when a passenger pushes a button on a given floor to call the car, a controller controls the hoist in response to said call so as to send the car to the corresponding floor. If another call is made at another floor after said call was already made, the controller moves the car according to the call." The reference additionally discloses, as shown in figure 1, that the hoist is used to move one set of elevators down as the other set is brought up, and vice versa. As we find no disclosure in JP('020), and none has been brought to our attention by the examiner, of the system ever being capable of attempting to move a third elevator between floors while keeping the other two elevators in place, we are not persuaded by the examiner's assertion (answer, page 4) that any elevator system with a control should be capable of attempting to maintain the cabs at each of the two floors with a third moving between the two floors. Accordingly, we find that JP('020) fails to anticipate the language of claim 1. The rejection of claim 1 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 under 35 U.S.C. § 102(b) is reversed.

REVERSED

JEFFREY V. NASE Administrative Patent Judge	)
MURRIEL E. CRAWFORD Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

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