

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHIZU SHIMIZU, KAZUHITO SAKAI, CHIZUO SUZUKI, KAORU
KIKUCHI and KYOUKO TERADA

Appeal No. 1999-1625
Application No. 08/792,468

ON BRIEF

Before KRASS, FLEMING, and DIXON, ***Administrative Patent Judges***.
FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 13 through 36, all the claims pending in the application. Claims 1-12 and 37¹ have been cancelled.

The invention relates to a purchased commodity accommodating and transporting apparatus having a self scanning function and a

¹ We note that in Paper No. 3 filed September 11, 1995, original claims 1-12 were cancelled. Further, the Examiner's final rejection dated January 9, 1998, Paper No. 27, also includes a rejection for claim 37. However, in an after final amendment dated May 14, 1998, Paper No. 21, which was entered in response to Appellants filing of the Notice of Appeal and appeal brief, claim 37 was cancelled.

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method of purchasing using the same. The apparatus includes a transportable accommodation section (3), a commodity code reading section (2), a prepaid card (87) inputting processing section (83a), a commodity price retrieval section (91b) and a data updating section (83b) which are permanently fixed to the transportable accommodation section (3). See Appellants' specification on page 27, line 10, page 53, line 15 through page 54, lines 14, page 96, lines 5-15 and page 107, lines 7-20 and associated figures 10, 11, 24 and 29.

The independent claims 13, 27 and dependent claim 28 present in the application are reproduced as follows:

13. A purchased commodity accommodating and transporting apparatus having a self scanning function, comprising:

a commodity code reading section for reading a commodity code applied to a commodity;

a transportable accommodation section for accommodating therein and transporting a commodity whose commodity code has been read by said commodity code reading section;

a prepaid card inputting processing section for receiving a prepaid card and reading remains information of the prepaid card;

a commodity price retrieval section for retrieving the price of the commodity in accordance with the commodity code information read by said commodity reading section; and

a data updating section for registering a result obtained by subtraction of the price of the commodity retrieved by said commodity price retrieval section from the remains information read by said prepaid card inputting processing section as remains

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information of the prepaid card to update the remains information;

wherein, said commodity code reading section, said prepaid card inputting processing section, said commodity price retrieval section and said data updating section are permanently fixed to said transportable accommodation section.

27. A method of a purchasing commodities by a consumer using a transportable container, the consumer performing the steps of:

(a) selecting a first commodity to be purchased at a first selection site;

(b) reading a first commodity code of the first commodity at the first selection site, using a commodity code reader attached to the transportable container; and

(c) paying for the first commodity at the first selection site as a function of the first commodity code read in step (b), using a payment processor attached to the transportable container.

28. The method of claim 27, further comprising:

(d) selecting a second commodity to be purchased at a second selection site, different from the first selection site; and

(e) reading a second commodity code of the second commodity at the second selection site;

wherein step (c) includes paying for the second commodity as a function of the second commodity code read in step (e), using the payment processor attached to the transportable container.

References

The references relied on by the Examiner are as follows:

Ehrat	3,836,755	Sep. 17, 1974
Gogulski	4,071,740	Jan. 31, 1978
Collins, Jr.	5,149,947	Sep. 22, 1992

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Hehemann
(German document)

2,139,889

Feb. 22, 1973

Rejections at Issue

Claims 13-23, 27-30 and 32-36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Collins and Gogulski. Claims 24-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Collins, Gogulski and Ehrat. Claim 31 stands rejected under 35 U.S.C. § 103 as being unpatentable over Collins, Gogulski and Hehemann.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and New Appendix to the appeal brief² and the Answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 13 through 36 are properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of these claims.

² Appellants filed an appeal brief on October 15, 1998, Paper No. 26. On February 2, 1999, Appellants filed a reply brief, Paper No. 28, in response to the Examiner's answer, Paper No. 27, mailed December 2, 1998. Examiner entered the reply brief and mailed a notification, Paper No. 29, to Appellants on February 17, 1999.

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First, we will consider the rejection of claims 13 through 23, 27 through 30 and 32 through 36 under 35 U.S.C. § 103 as being unpatentable over Collins and Gogulski. At the outset, we note that Appellants have provided a statement, on page 4, lines 11-16 of the brief, that claims 13 through 23 stand and fall together, claims 27, 30 and 32 through 34 stand and fall together, claim 28 stands or falls alone, claim 29 stands or falls alone, claims 35 and 36 stand or fall together, claims 24 through 26 stand and fall together, and claim 31 stands or falls alone. 37 CFR § 1.192 (c)(7) (July 1, 1998) **as amended at** 62 Fed. Reg. 53196 (October 10, 1997), which was controlling at the time of Appellants' filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We further note that Appellants have argued claims 13 through 23 as a single group. See page 4, lines 18 and 19 of the brief. We will, thereby, consider Appellants' claims 13 through 23 as

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standing or falling together as a group, and we will treat claim 13 as a representative claim of that group. We will, thereby, consider Appellants' claims 27, 30 and 32 through 34 as standing or falling together, and we will treat claim 27 as a representative claim of that group. We also note that Appellants have argued claims 35 and 36 as a single group. See page 5, lines 1 and 2 of the brief. We will, thereby, consider Appellants' claims 35 and 36 as standing or falling together, and we will treat claim 35 as a representative claim of that group. Finally, we note that Appellants have argued claims 24 through 26 as a single group. See page 4, lines 18 and 19 of the brief. We will, thereby, consider Appellants' claims 24 through 26 as standing or falling together, and we will treat claim 24 as a representative claim of that group.

Appellants argue that Collins does not teach or suggest that "a commodity code reading section, a prepaid card inputting processing section, a commodity price retrieval section and a data updating section are permanently fixed to a transportable accommodation section" recited in claim 13. See page 6, lines 13-18 of the brief. Appellants do not disagree that Collins reads on commodity code reading, purchasing structure or a transporting accommodation section. See page 6, lines 1-12 of

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the brief. However, Appellants argue that Collins fails to teach that these structures are permanently fixed to the transportable accommodation section. See page 6, lines 13-18 of the brief.

As pointed out by our reviewing court, we must first determine the scope of the claims. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

We note that the claim recites the following:

comprising . . . said commodity code reading section, said prepaid card inputting processing section, said commodity price retrieval section and said data updating section are **permanently** fixed to said transportable accommodation section. (Emphasis added).

When we turn to the Appellants' disclosure to determine what is meant by the term "permanently fixed," we find very little disclosure of how these purchasing structures are "fixed." Specifically, we find that Appellants disclose that "the present invention is applied to such a scanning cart or shopping cart 100 . . . as a purchased commodity accommodating and transporting apparatus having a self-scanning function." See Appellants' disclosure page 53, lines 15-19 and figure 10. Further disclosed is "a basket member 102 . . . which serves as an accommodation section." See Appellants' disclosure page 53, lines 21-23 and figure 11. Additionally, Appellants' disclose that "[t]he cart

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section 101 further includes . . . a scanner 57 . . . a communication section 53. See Appellants' disclosure page 54, lines 7-11. Also disclosed by Appellants is that

[i]n order to prevent, in the POS system which employs the scanning cart 100 of such construction . . . such an unjust act of a customer accommodates as to accommodate a commodity into the basket member 102 without performing a reading of the commodity code . . . a control system of the scanning cart 100 and control section 60 are constructed in such a manner as shown in FIGS. 7 to 9.

See Appellants' disclosure page 55 line 25 to page 56 line 7. Also disclosed is that "an unjust act that customer accommodates a commodity 50 into the basket member 102 . . . without performing scanning intentionally can be prevented." See Appellants' disclosure page 63 lines 22-27. The only disclosure of purchasing structure being fixed to the cart is figure 10 which simply shows the structures 53-57 being on the cross bar of the cart 100. Therefore, we find that the claimed term "permanently fixed" is anything that attaches the purchasing structure to the cart.

We find that Collins discloses commodity code reading section (98), a prepaid card inputting processing section (88 and/or 90), a commodity price retrieval section and a data updating section (102, 104, 106, 80, 110) which are permanently

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fixed (i.e., rigidly mounted) to the transportable accommodation section (68, 46, 50). See column 3, lines 46-57, column 4, lines 30-58, column 5, lines 38-42 and figures 3, 5 and 7. Therefore, we find that Collins' teachings meet Appellants' claimed limitation of a "commodity code reading section, said prepaid card inputting processing section, said commodity price retrieval section and said data updating section are permanently fixed to said transportable accommodation section."

For claims 13 through 23, Appellants have not made any other arguments. 37 CFR § 1.192 (a) states:

Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Thus, 37 CFR § 1.192 provides that only the arguments made by Appellants in the brief will be considered and that failure to make an argument constitutes a waiver on that particular point. Support for this rule has been demonstrated by our reviewing court in *In re Berger*, No. 01-1129, Slip Opinion (Fed. Cir. 2002), wherein the Federal Circuit Court stated that because the

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Appellant did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. Thus, we will sustain the Examiner's rejection of claims 13 through 23.

Now we turn to the rejection of claims 27, 30 and 32 through 34 under 35 U.S.C. § 103 as being unpatentable over Collins and Gogulski. Appellants make the sole argument that,

neither Collins, Jr. '947 nor Gogulski suggest that a consumer himself or herself perform the necessary steps to purchase the commodity, and more particularly, the steps of selecting a commodity, reading the commodity code and paying for the commodity using a payment processor attached to a transportable container, all at a first selection site. See page 8, lines 23-37 of the brief.

In addition, Appellants further state that "both Collins, Jr. '947 and Gogulski require the use of a check-out station, a cashier, a point-of-sales terminal, etc., to purchase commodities." See page 8, lines 20 and 21 of the brief.

We find that Collins discloses that the invention "enables a check-out operation to occur anywhere in the store where an electrical receptacle 66 is located." See column 5, lines 49-51. Therefore, we find that Collins' scanning system attached to a cart (i.e., a transportable container) allows a purchaser to select a first commodity to be purchased at a first selection site, read the commodity code at said first selection site and

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pay for the commodity at said first selection site. Thus, we will sustain the Examiner's rejection of claims 27, 30 and 32 through 34.

Now we turn to the rejection of claim 28 under 35 U.S.C. § 103 as being unpatentable over Collins and Gogulski. Appellants make the argument that this claim is allowable due to its dependency on claim 27 and that, "none of the prior art references suggest selecting commodities at two different selection sites and paying for those commodities using a payment processor attached to the transportable container at one of the selection sites." See page 9, lines 7, 8 and 11-13 of the brief.

We note that claim 28 is dependent upon claim 27. As stated above, we find that Collins teaches that the invention "enables a check-out operation to occur anywhere in the store where an electrical receptacle 66 is located." See column 5, lines 49-51. Therefore, we find that Collins' scanning system attached to a cart (i.e., a transportable container) allows a purchaser to select a second commodity to be purchased at a second selection site, different from the first selection site, read a second commodity code of the second commodity at the second selection site and pay for the second commodity as a function of the second commodity code read at the second selection using the payment

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processor attached to the transportable container. Thus, we will sustain the Examiner's rejection of claim 28.

Now we turn to the rejection of claim 29 under 35 U.S.C. § 103 as being unpatentable under Collins and Gogulski. Appellants make the same argument that, this claim is allowable due to its dependency on claim 27 and the same argument that this claim is allowable because Collins fails to teach that "the commodity code reader and payment processor are permanently fixed to the transportable container." See page 9, lines 16-18 of the brief. For the same reasons above, we find that Collins teaches that the commodity code reader and payment processor are permanently fixed to the transportable container. Therefore, we will sustain the Examiner's rejection of claim 29 for the same reasons above.

Now we turn to the rejection of claims 35 and 36 under 35 U.S.C. § 103 as being unpatentable under Collins and Gogulski. Appellants make the same argument that, "the prior art fails to teach or suggest the use of any structure permanently attached to a transportable container for paying for selected commodities." See page 10 of the brief. For the same reasons above, we find that Collins teaches that the commodity code reader and payment processor are permanently fixed to the transportable container

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and therefore we will sustain the Examiner's rejection of claims 35 and 36.

Now we turn to the rejection of claims 24 through 26 under 35 U.S.C. § 103 as being unpatentable under Collins, Gogulski and Ehrat. Appellants make the argument that these claims are allowable due to their dependency on claims 13-23. See page 5, lines 21 and 22 of the brief. Therefore we will sustain the Examiner's rejection of claims 24 through 26 for the same reasons above.

Now we turn to the rejection of claim 31 under 35 U.S.C. § 103 as being unpatentable under Collins, Gogulski and Hehemann. Appellants state that "Heheman[n] does not correct the deficiencies noted above with respect to Collins, Jr., '947 and Gogulski." See page 9, lines 3-5 of the brief. For the same reasons above, we find that Collins teaches that the commodity code reader and payment processor are permanently fixed to the transportable container. Therefore, we sustain the Examiner's rejection of claim 31 for the reasons set forth above.

In view of the foregoing, we will sustain the decision of the Examiner rejecting claims 13 through 36 under 35 U.S.C. § 103. Accordingly, the decision of the Examiner is affirmed.

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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

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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