

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. KARSTEN,
KIAT-CHEONG TOH,
FREDERICK B. HADTKE,
INNA ALESINA and
DAVID W. BRADLEY

Appeal No. 2000-0513
Application 08/803,047

ON BRIEF

Before COHEN, McQUADE and GONZALES, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Richard A. Karsten et al. appeal from the final rejection of claims 1 through 32, all of the claims pending in the

application.¹ We reverse and enter a new ground of rejection.

THE INVENTION

The invention relates to "merchandising units for ordering of photofinishing services, displaying of associated photographic products, and storing of product inventory" (specification, page 1). Claim 1 is representative and reads as follows:²

1. A combined photofinishing storage, display, and ordering merchandising unit, comprising:

an order workstation having a front wall, a writing surface extending from said wall, a dispenser for dispensing order envelopes, and a collection bin for receiving filled order envelopes;

a pair of display sections for displaying of merchandise, one of said display sections being positioned on each side of said order workstation so as to define a storage area between said pair of display sections and workstation, at least one of said display sections being movable so as to allow access to

¹Claim 29 has been amended subsequent to the final rejection.

²The term "said display section" in claims 4, 6, 7, 12, 13, 19, 27 and 28 lacks a proper antecedent basis (the preceding claim language recites three display sections). This informality is deserving of correction in the event of further prosecution before the examiner.

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said storage area; and

a display tower disposed adjacent said writing surface
for highlighting a featured product.

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THE PRIOR ART

The references relied upon by the examiner to support the final rejection are:

Thurman	760,278	May 17, 1904
Fry	1,839,840	Jan. 5, 1932
Maldanis	5,244,266	Sep. 14, 1993

THE REJECTIONS

Claims 1 through 4, 7, 8, 10 through 12, 15 through 19, 22, 23, 25 through 27 and 29 through 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fry.

Claims 1, 9, 11, 14, 16, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Thurman.

Claims 5, 6, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fry.

Claims 13 and 28 stand rejected under 35 U.S.C. § 103(a)

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as being unpatentable over Fry in view of Maldanis.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 10 and 12) and to the examiner's answer (Paper No. 11) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1 through 4, 7, 8, 10 through 12, 15 through 19, 22, 23, 25 through 27 and 29 through 32 as being anticipated by Fry.

Fry discloses a vending machine having a cabinet-like construction composed of a lower base portion 1 and an upper column portion. The lower base portion 1 includes lockable front doors 2, a top 58 having sample display pockets 55 and coin slots 54 therein, and a coin hopper 62 and coin box 66 within the base portion beneath the coin slots. The upper column portion includes lockable rear doors 6, a top 17, front

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panels 16, and a plurality of columns 4. Each column consists of a U-shaped metal piece having side walls 7 and a back wall 8, shelves 10 dividing the column into a series of compartments 5 for holding the articles offered for sale, a front closure 15 slidable downwardly to sequentially uncover the articles and a mechanism operable upon deposit of the proper coin in the corresponding slot 54 for actuating the closure including a plunger 34, a plunger guide bracket 35 and a plunger handle 60.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert.

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denied, 465 U.S. 1026 (1984).

In applying Fry against claim 1, the examiner reads the claim limitations relating to the "collection bin" and the "pair of display sections" on Fry's coin hopper 62 and doors 2, respectively (see page 3 in the answer). Recognizing that Fry's express disclosure does not support this reading, the examiner relies on principles of inherency for justification (see page 5 in the answer). Given its disposition within the overall vending machine, however, the Fry coin hopper 62 cannot reasonably be said to inherently constitute a "collection bin for receiving filled order envelopes" as required by claim 1. Similarly, Fry's doors 2 cannot reasonably be said to inherently constitute "a pair of display sections for displaying of merchandise" as recited in claim 1. Moreover, Fry's doors 2 are not positioned on each side of an order workstation so as to define a storage area between the pair of display sections and a workstation as further required by the claim.

Independent claim 16 recites a combined photofinishing

storage, display and ordering merchandising unit comprising, inter alia, a "collection bin for receiving filled order envelopes" and "a pair of display sections for displaying of photographic merchandise." For the reasons explained above, the examiner's determination that these limitations read on Fry's coin hopper 62 and doors 2, respectively, is not well founded.³

Independent claim 29 recites a combined photofinishing storage, display and ordering merchandising unit comprising, inter alia, "a pair of display sections for displaying of merchandise." Given the other limitations in this claim, the examiner finds it necessary to read the claim language relating to the pair of display sections on Fry's plunger handles 60 (see page 3 in the answer). Suffice to say that like doors 2, handles 60 do not inherently constitute display sections of the sort recited in claim 29.

³While Fry's display pockets 55 arguably might constitute display sections of the sort recited in claim 16, the Fry machine still has no apparent structure responding to the "collection bin" limitation.

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Thus, the examiner's reading of claims 1, 16 and 29 on Fry is not well taken. Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 16 and 29, or of claims 2 through 4, 7, 8, 10 through 12, 15, 17 through 19, 22, 23, 25 through 27 and 30 through 32 which depend therefrom, as being anticipated by Fry.

II. The 35 U.S.C. § 102(b) rejection of claims 1, 9, 11, 14, 16, 24 and 26 as being anticipated by Thurman.

Thurman discloses a pharmaceutical dispensing case comprising a cabinet 1 rotatably mounted on a base 2 and a table 8 hingedly mounted on vertical members 7 of a rack 5 which is retractable with respect to the cabinet. The cabinet includes shelves 11 for drugs, drawers 12 for drugs or instruments and index card drawers 13 for keeping accounts or clinical histories. The base includes additional drawers 14.

From the examiner's perspective, claims 1, 9, 11, 14, 16, 24 and 26 read on Thurman because

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Thurman discloses a merchandising unit comprising: a front wall (8) and a writing surface (7) extending therefrom; a dispenser (12); a collection bin (11); a pair of slidably mounted display sections (14) which allow access to a storage area therebetween; a display tower (1); and a slot (13) for receiving cards [answer, page 4].

The examiner's finding here that Thurman's vertical rack member 7 meets the limitations in independent claims 1 and 16 relating to the "writing surface" under principles of inherency is clearly unreasonable.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1 and 16, or of claims 9, 11, 14, 24 and 26 which depend therefrom, as being anticipated by Thurman.

III. The 35 U.S.C. § 103(a) rejection of claims 5, 6, 20 and 21 as being unpatentable over Fry.

Claims 5 and 6, which depend ultimately from claim 1, and claims 20 and 21, which depend ultimately from claim 16, further define the display tower recited in their respective

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parent claims. The examiner's conclusion (see page 4 in the answer) that the additional display tower characteristics set forth in these dependent claims would have been obvious matters of engineering design choice does not cure the above noted deficiencies in the examiner's application of Fry against parent claims 1 and 16.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 5, 6, 20 and 21 as being unpatentable over Fry.

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IV. The 35 U.S.C. § 103(a) rejection of claims 13 and 28 as being unpatentable over Fry in view of Maldanis.

Claims 13 and 28 ultimately depend from claims 1 and 16, respectively, and further require a light for highlighting products.

Maldanis discloses a multipurpose, refrigerated food vending machine having lighting devices mounted near display windows 16 and doors 18 to illuminate the products in the machine (see column 5, lines 46 through 50).

Even if it is assumed for the sake of argument that it would have been obvious in view of Maldanis to provide Fry's machine with a light to highlight its products as proposed by the examiner (see page 4 in the answer), this modification also fails to cure the above noted deficiencies in the examiner's application of Fry against claims 1 and 16.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 13 and 28 as being unpatentable

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over Fry in view of Maldanis.

V. New ground of rejection.

Claims 16, 18 and 23 through 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Thurman.

Under principles of inherency, the limitations in independent claim 16 relating to the "order workstation," the "dispenser for dispensing order envelopes," the "writing surface," the "collection bin," the "pair of display sections" and the "display tower" read on, respectively, the area to the left of Thurman's case as shown in Figure 3, drawers 13, table 8, drawers 12, either of the opposite sets of shelves 11 or drawers 14, and the base 2/cabinet 1. The limitations in claim 18 relating to the display tower "base portion" and "case section" read on, respectively, Thurman's base 2 and cabinet 1. The limitations in claim 23 relating to the "movable" display section and in claim 24 relating to the "slidably mounted" display section read on Thurman's drawers 14. The limitation in claim 25 relating to the "dispenser"

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and the limitation in claim 26 relating to the "slot for receiving cards" read on Thurman's drawers 13. The limitation in claim 27 relating to the "cap section" reads on the top of Thurman's cabinet 1.

SUMMARY

The decision of the examiner to reject claims 1 through 32 is reversed; and a new rejection of claims 16, 18 and 23 through 27 is entered pursuant to 37 C.F.R. § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 C.F.R. § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 C.F.R. § 1.196(b) also provides that the appellants,

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WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

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(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED; 37 C.F.R. § 1.196(b).

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
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)) BOARD OF
PATENT)	APPEALS
	JOHN P. McQUADE)	AND
	Administrative Patent Judge)	
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