

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGEKI TAKAHASHI
and NIHEI KAISHITA

Appeal No. 2002-1908
Application 09/097,013

HEARD: February 19, 2003

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Shigeki Takahashi et al. appeal from the final rejection (Paper No. 21) of claims 1 through 11, all of the claims pending in the application.

THE INVENTION

The invention relates to "an apparatus and method for aligning a multiplicity of [electronic] chip parts in a row and

delivering them" (specification, page 1). Representative claim 1 reads as follows:¹

1. An apparatus useful for aligning parts, comprising:
 - a part-holding chamber for accommodating a number of chip parts, said part-holding chamber having a bottom having an inner surface;
 - at least one chute groove formed at least in the inner surface of the bottom of said part-holding chamber and acting to orient chip parts in a given direction and cause them to slide successively downward, said at least one chute groove having a depth;
 - a gate port formed at the lower end of said at least one chute groove and permitting said chip parts sliding downward in a given posture along said chute groove to pass one by one;
 - at least one discharge passage for aligning the passed chip parts in a line and discharging said parts; and
 - a clogging-removing means movably positioned in said part-holding chamber, the clogging-removing means including first and second portions positioned to move adjacent to said gate port, the first and second portions having at least one leading edge, at least one trailing edge, and a gap separating the at least one leading edge and the at least one trailing edge, the length of the gap being greater than the at least one chute groove depth, the clogging-removing means for urging any chip part that is halted in said gate port in an abnormal posture toward a

¹ The terminology in claims 1 and 10 defining the clogging-removing means as including a "leading edge," a "trailing edge" and a "gap" has no antecedent basis in the descriptive portion of the specification as required by 37 CFR § 1.75(d)(1). Consistent with the explanation advanced on pages 2 and 3 in the main brief and with the further definition of the clogging-removing means in dependent claim 3 as comprising plural claw portions, we understand the subject terminology in claims 1 and 10 as being readable on the appellants' disclosure of adjacent claw portions 11b on rotary drum 11. Given this interpretation, and the language in parent claim 3, the references in dependent claims 5 and 6 to "at least one claw" are somewhat discordant. These informalities should be corrected in the event of further prosecution.

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direction different from a direction in which the chip parts are discharged when chip parts are contained in said least one chute groove and when said clogging-removing means is moved in a direction away from the discharge passage.

THE REJECTIONS

Claims 1 through 3, 5 through 7 and 9 through 11 stand rejected under 35 U.S.C. § 102(f) as being anticipated by U.S. Patent No. 6,161,676 to Takahashi et al. (Takahashi '676).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi '676 in view of U.S. Patent No. 2,078,659 to Gualtiere.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi '676 in view of U.S. Patent No. 4,057,137 to Hansen et al. (Hansen).

Claim 4 stands rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling specification.

Claims 1, 2 and 8 through 11 stand rejected under the judicially created doctrine of obviousness-type double patenting over the claims in U.S. Patent No. 6,112,937 to Takahashi et al. (Takahashi '937).

Attention is directed to the appellants' main and reply briefs (Paper Nos. 25 and 28) and to the examiner's final rejection (Paper No. 21) and main and supplemental answers (Paper

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Nos. 26 and 30) for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(f) rejection of claims 1 through 3, 5 through 7 and 9

35 U.S.C. § 102(f) provides that a person shall be entitled to a patent unless "he did not himself invent the subject matter sought to be patented." This is a derivation provision which prohibits one from obtaining a patent on that which is derived from someone else whose possession of the subject matter is inherently "prior." OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1401-02, 43 USPQ2d 1641, 1644 (Fed. Cir. 1997).

In the present situation, the appellants, Shigeki Takahashi and Nihei Kaishita, filed the instant application in the United States on June 15, 1998, claiming the benefit of foreign priority with respect to Japanese applications filed respectively on June 19, 1997 and May 18, 1998. The Takahashi '676 patent matured from an application filed in the United States by Shigeki Takahashi, Nihei Kaishita and Akira Nemoto on July 1, 1999, claiming the benefit of foreign priority with respect to Japanese applications filed respectively on July 6, 1998 and August 27, 1998. The Takahashi '676 patent characterizes the component

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feeder described in one of the appellants' Japanese priority applications as being somewhat problematic (see column 1, lines 26 through 57) and goes on to disclose and claim an allegedly improved component feeder differing from that disclosed and claimed in the instant application.

Against this background, the examiner has rejected appealed claims 1 through 3, 5 through 7 and 9 through 11 under § 102(f) because

[t]he claimed invention was first invented by the three inventors of Takahashi et al. '676. While the earliest filing date of Takahashi et al '676 is after the earliest filing date of this case, the fact is that the inventors of Takahashi et al '676 signed a declaration when they filed the U.S. national application, in the same manner as the inventors of this application have, that they were the first to invent the claimed subject matter. Since the applicants in Takahashi et al '676, their assignee (same as in this application) and their U.S. legal representatives (same as in this application) permitted Takahashi et al '676 to issue without notifying the USPTO that the inventors of Takahashi et al '676 were not the first inventors, it is reasonable to assume that the inventors of Takahashi et al '676 are the first to invent their claimed subject matter [final rejection, page 2].

To the extent that it can be understood, the examiner's logic does not even remotely support the proposition that the appellants derived the subject matter set forth in appealed claims 1 through 3, 5 through 7 and 9 through 11 from the

inventors named in the Takahashi '676 patent. Presumably, these inventors are, as assumed by the examiner, the first to invent the subject matter claimed in the Takahashi '676 patent. As pointed out above, however, this claimed subject matter differs from that recited in appealed claims 1 through 3, 5 through 7 and 9 through 11. Moreover, that the appealed claims might be readable on the disclosure of the Takahashi '676 patent is of no moment, and is not surprising given the background discussion in the patent. In short, the Takahashi '676 patent simply does not provide the evidentiary basis necessary to establish a prima facie case of derivation.²

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(f) rejection of claims 1 through 3, 5 through 7 and 9 through 11 as being unpatentable over Takahashi '676.

II. The 35 U.S.C. § 103(a) rejections of claims 4 and 8

Inasmuch as neither Gualtiere nor Hansen cures the above noted deficiency in the examiner's application of Takahashi '676 to reject parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 4 as being

² This being so, it is unnecessary to delve into the merits of the appellants' 37 CFR § 1.132 declaration filed May 24, 2002 (Paper No. 27) to rebut the derivation rejection.

unpatentable over Takahashi '676 in view of Gualtiere or the standing 35 U.S.C. § 103(a) rejection of dependent claim 8 as being unpatentable over Takahashi '676 in view of Hansen.

III. The 35 U.S.C. § 112, first paragraph, rejection of claim 4

Claim 4 further defines the aligning apparatus recited in parent claim 1 as comprising a rotary member which is capable of being rotated intermittently. The underlying specification indicates that the rotary member (rotary drum 11), which is driven by an electric motor 24 and a pulley/belt arrangement 20 through 22, may be continuously or intermittently rotated, and "[w]hen the rotary drum 11 is rotated intermittently, it is preferable that not only the rotary drum 11 is stopped but also it is rotated a little in the opposite direction" (page 16, lines 7 through 10).

According to the examiner, "[t]he disclosure on page 16 lines 6-12 is insufficient to enable one to make and use the intermittent and intermittent with a reverse movement step systems" (final rejection, page 3). The examiner further explains that "while the claim only mentions 'rotated intermittently' . . . [t]his disclosure requires that the intermittent rotation be coupled with a reverse movement step" (answer, page 4).

The dispositive issue with respect to enablement is whether the disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

Claim 4 does not call for the rotary member to be capable of reverse movement. Contrary to the position taken by the examiner, the specification (page 16) only states that it is preferable, not required, that the rotary drum's intermittent rotation be accompanied by rotation in the opposite direction. Be this as it may, however, the examiner has not cogently explained, nor is it apparent, why the appellants' disclosure would not have enabled a person of ordinary skill in the art to make and use without undue experimentation an aligning apparatus having the relatively simple and straightforward structure recited in claim 4, whether or not it is capable of reverse rotation.

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Accordingly, we shall not sustain the standing 35 U.S.C.
§ 112, first paragraph, rejection of claim 4.

IV. The obviousness-type double patenting rejection of claims 1,
2 and 8 through 11

The claims in the Takahashi '937 patent pertain to a chip part aligning apparatus and method involving a swingable plate or member, an element which is not recited in appealed claims 1, 2 and 8 through 11. Conceding that these appealed claims and the claims in the Takahashi '937 patent are not identical, the examiner nonetheless contends that "they are not patentably distinct from each other because the claims only differ in obvious variations in breadth and scope" (final rejection, page 3). The examiner, however, has failed to proffer any evidence to substantiate this conclusion.

Hence, we shall not sustain the standing obviousness-type double patenting rejection of claims 1, 2 and 8 through 11 in view of the claims in the Takahashi '937 patent.

SUMMARY

The decision of the examiner to reject claims 1 through 11 is reversed.

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REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	INTERFERENCES
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JOHN P. MCQUADE)	
Administrative Patent Judge)	

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