

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS P. LAMBERT,
and GREGORY A. LUDGATE

Appeal No. 96-0356
Application 08/163,635¹

ON BRIEF

Before COHEN, McQUADE and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 3-5, 7-9 and 11. Claims 2, 6, 10 and 14 have been canceled. Claims 12, 13, 15 and 16 are allowed. Appellants' claimed subject matter is an apparatus for moving a sheet. Claim 1 is exemplary of the subject matter on appeal and recites:

¹ Application for patent filed December 9, 1993.

Appeal No. 96-0356
Application 08/163,635

1. An apparatus for moving a sheet, including:
a first roller;
a second roller; and

means for rotating said first roller in a first direction, said rotating means being adapted to rotate said second roller simultaneously with said first roller and being adapted to enable said second roller to idle simultaneously with said first roller rotating in the first direction, said rotating means rotating said second roller in the first direction and in a second direction opposed to the first direction.

THE REFERENCES

The following references were relied on by the examiner:

Sato et al. (Sato)	4,105,199	Aug. 8, 1978
Tonomura et al. (Tonomura) ² (Japan)	59-97957	June 6, 1984

THE REJECTIONS

Claims 3-5, 7, 8 and 11 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sato.

Claims 1, 3, 9 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshinobu.

² Translation attached.

Appeal No. 96-0356
Application 08/163,635

Rather than reiterate the entire arguments of the appellants and the examiner in support of their respective positions, reference is made to the appellants' brief (Paper No. 12) and to the examiner's answer (Paper No. 13) for the full exposition thereof.

OPINION

In reaching our conclusions on the issues raised in this appeal, we have carefully considered appellants' specification and claims, the applied references, and the respective viewpoints advanced by the appellants and the examiner. These considerations lead us to make the determinations which follow.

As a preliminary matter we base our understanding of the appealed subject matter upon the following interpretation of the terminology employed in the claims. In claim 1, we understand the "first roller" as readable on the disclosed roller 96 and the "second roller" as readable on the disclosed roller 114. In keeping with this interpretation, we observe that roller 96 rotates in a first direction 126 and roller 114 rotates in the first direction 162 (See Figure 2) and a second direction 166 (See Figure 4). We interpret the rotating means to include roller 96 and gears 122, 124, 128, 129, 130, 136, 140 and 158. As such, when gear 158 engages gear 138 the second roller 114

Appeal No. 96-0356
Application 08/163,635

rotates in a first direction as depicted in Figure 2 and when gear 158 engages gear 140, the second roller 114 rotates in a second direction depicted in Figure 4. Figure 3 depicts a position wherein neither gear 138 nor gear 140 engage gear 158 so that roller 114 is idle.

In regard to the recitations in claim 3, gears 122, 128, 129 and 136 are interpreted to be the first drive means. Gears 130 and 140 are interpreted to be the second drive means and gear 158 is the third drive means.

We turn first to the examiner's rejection under 35 U.S.C. § 112. The examiner is of the opinion that the recitation in claims 3, 4 and 11 of a second drive means "for rotation in the second direction" is indefinite as it is unclear what element is to be rotated in the second direction. It is also the examiner's position that claim 3 is indefinite because it depends from a canceled claim.

We initially note that the purpose of the requirements stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection

Appeal No. 96-0356
Application 08/163,635

involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204 208 (CCPA 1970). The inquiry as stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) is:

. . . whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularly . . . [t]he definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

When the language "for rotation in the second direction" is analyzed in light of the disclosure, it clearly sets out and circumscribes a particular area with a reasonable degree of precision and particularity. As such, gears 130 and 140 of the second drive means both rotate in a direction opposite to the direction the first drive means rotates the first roller 96. This is clear from a reading of the specification at pages 12-13 and Figures 2-4.

As to the examiner's statement that claim 3 is indefinite because it depends on a canceled claim, we agree. We note that appellants has made no argument regarding this portion of the 35 U.S.C. § 112 rejection. As such we are constrained to affirm the rejection as it is directed to claim 3. However, we will not

Appeal No. 96-0356
Application 08/163,635

sustain this rejection as it is directed to claims 4, 5, 7, 8 and 11.

We turn next to the examiner's rejection of claims 1 and 3 under 35 U.S.C. § 102(b) as anticipated by Sato.

We initially note that it is not our practice to review prior art rejections of claims found to be indefinite under 35 U.S.C. § 112, second paragraph when such rejections are based on speculation as to the meaning of the terms employed and assumptions as to the scope of the claims. See In re Steele, 305 F.2d 859, 863, 134 USPQ 292, 295 (CCPA 1962). However, in this case, we are reasonably certain that claim 3 should depend from claim 1 instead of canceled claim 2 and as such we will address the prior art rejections on the basis of this assumption in the interest of judicial economy and to avoid piecemeal review.

In the examiner's opinion, Sato discloses:

first roller 23; second roller (pulley for belt 24, or, note lines 17-24 of col. 4); rotating means 36, 41-43, 46, 47, 39. Note idle position at col. 4, lines 10-16. [Paper No. 3, page 5]

Appellants argue that Sato:

does not teach that the rotating means rotates the second roller simultaneously with the first roller and also enables the second roller to idle simultaneously with the first roller rotating in the first direction ... Furthermore, there is no teaching that the

Appeal No. 96-0356
Application 08/163,635

rotating means rotates the second roller in the first direction and in the second direction opposite to the first direction. [Brief at page 9]

We disagree with appellants. Sato discloses and depicts in Figure 4 a main feed roller 23 (first roller) that rotates in a first direction indicated by P. Each of the rollers which form the pulley can alternately rotate in a direction QN (first direction) which is in the direction of P and in the direction Q (second direction) which is opposite to the P direction. Sato also discloses that belts 24 are set free thereby idling the rollers of the pulley from being driven during a shift of the sleeve 43 from engagement with one of the first and second pulleys 41 and 42 to engagement with the other and that a sheet of paper may be fed at this time from between the leftmost and rightmost positions of Figure 2. (Col. 4, lines 10-15). In view of the foregoing, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b). We will also sustain this rejection as it is directed to claim 3 as this claim stands or falls with claim 1 (Brief at page 7).

We turn next to the examiner's rejection of claims 1, 3, 9, and 11 under 35 U.S.C. § 102(b) as being anticipated by Yoshinobu. The examiner states:

JP '957, discloses: first - fifth rollers corresponding

Appeal No. 96-0356
Application 08/163,635

to the rollers on shafts 25, 71, 31, 29, 72 respectively; rotating means. (fig. 2). Note that during pivoting of frame 28, neither gear 21 nor 27 is in contact [with] gear 22 of the second roller. Thus, the second roller is in an idle state during this period. [Paper No. 5, page 3].

Appellants states that Yoshinobu:

. . . does not teach that the rotating means rotates the second roller simultaneously with the first roller and is adapted to enable the second roller to idle simultaneously with the first roller rotating in the first direction. Moreover, there is no teaching of the rotating means rotating the second roller in the first direction and in the second direction opposite to the first direction. [Brief at page 10].

We do not agree with appellants. Yoshinobu discloses and depicts in Figures 2 and 3 a roller (first roller) on shaft 25 and a roller 5 (second roller) which rotates simultaneously with the roller on shaft 25. Roller 5 rotates in the same direction as the roller on shaft 25 when the drive mechanism is in the position depicted in Figure 2. In addition, the examiner found that roller 5 is idled at least momentarily when the drive switching mechanism moves from the position depicted in Figure 2 to the position depicted in Figure 3. The roller 5 rotates in the opposite direction (second direction) to the direction of the rotation of the roller disposed of shaft 25 when the drive switching mechanism is in the position depicted in Figure 3.

Appellants' argument does not rebut the examiner's finding

Appeal No. 96-0356
Application 08/163,635

that roller 5 is idled when the drive mechanism moves between the position depicted in Figures 2 and 3. Thus, this finding of the examiner stands. Accordingly, in our view, Yoshinobu anticipates the claimed subject matter of claim 1.

In view of the foregoing, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Yoshinobu. We will also sustain this rejection as it is directed to claims 3, 9 and 11 as the appellants indicate that all the claims stand or fall together (Brief at page 7).

In Summary:

The examiner's rejection of claims 4-5, 7, 8 and 11 under 35 U.S.C. § 112, second paragraph is not sustained.

The examiner's rejection of claim 3 under 35 U.S.C. § 112, second paragraph is sustained.

The examiner's rejection of claims 1 and 3 under 35 U.S.C. § 102(b) as anticipated by Sato is sustained. The examiner's rejection of claims 1, 3, 9 and 11 under 35 U.S.C. § 102(b) as being anticipated by Yoshinobu is sustained.

No time period for taking any subsequent action in

Appeal No. 96-0356
Application 08/163,635

connection with this appeal may be extended under 37 CFR
1.136(a).

AFFIRMED-IN-PART

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

Appeal No. 96-0356
Application 08/163,635

RONALD ZIBELLI
XEROX CORP.
XEROX SQUARE 020
ROCHESTER, NY 14644