

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK R. KIRKLAND

Appeal No. 97-0172
Application 08/173,560¹

ON BRIEF

Before CALVERT, COHEN and ABRAMS, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 15 to 17 and 21 to 24. The other claims in the application, 1 to 14 and 18 to 20, stand withdrawn from consideration under 37 CFR § 1.142(b) as being directed to a nonelected invention.

¹Application for patent filed December 22, 1993.

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The claims on appeal are drawn to a method of vending non-beverage foods and non-comestible items from vending machines configured to vend canned drinks. The claims are reproduced in Appendix A of appellant's reply brief (Paper No. 20, filed June 28, 1996).

The references over which the claims on appeal stand rejected are:

Mullin	3,043,474	Jul. 10, 1962
Rockola	5,080,256	Jan. 14, 1992
Sampson	5,199,598	Apr. 06, 1993

The claims on appeal stand rejected on the following grounds:²

(1) Claims 15 to 17 and 21 to 24, anticipated by Rockola, under 35 USC § 102(b);

(2) Claims 15 to 17, 21 and 24, unpatentable over Rockola in view of Mullin, under 35 USC § 103;

(3) Claims 15 to 17, 22 and 23, unpatentable over Rockola in view of Sampson, under 35 USC § 103.

Rejection (1)

²Rejections (2) and (3) are new grounds of rejection first raised in the examiner's answer.

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Rockola discloses a typical can beverage vending machine 10, having improvements in the can delivery mechanism. Although Rockola does not disclose that the cans vended by the machine are "filled with a material other than a liquid beverage", as recited in claim 15, the examiner asserts that the claims are anticipated because "the contents in this instance have no bearing on the manner in which the container is being dispensed from the machine" (final rejection, page 3), citing Ex parte Pfeiffer, 135 USPQ 31 (Bd. Apps 1961), and Ex parte Kangas, 125 USPQ 419 (Bd. Apps 1960).

We do not consider this rejection to be well taken. In order to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the present case, Rockola does not disclose, expressly or inherently, a container filled with a material other than a liquid beverage, and therefore does disclose the steps recited in claim 15 of "providing at least one container . . . filled with a material other than a liquid beverage", "providing a vending machine . . . being loaded with said at least one container containing a

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material other than a liquid beverage", and "vending selectively from said vending machine said at least one container containing other than a liquid beverage."

We do not regard the Pfeiffer and Kangas decisions as authority for disregarding the recitation in these steps that the container is filled with other than a liquid beverage. Neither In re Moreton, 288 F.2d 708, 129 USPQ 227 (CCPA 1961) nor In re Fong, 288 F.2d 932, 129 USPQ 264 (CCPA 1961), both cited in Pfeiffer, 135 USPQ at 33, supports such a position; rather, they hold that, as stated in Moreton, 288 F.2d at 709, 129 USPQ at 228:

since one cannot claim a new use per se, because it is not among the categories of patentable inventions specified in 35 U.S.C. 101, it is claimed as a method, as permitted by 35 U.S.C. 100(b).

In the present case, appellant's claimed invention is, in effect, a new use for known apparatus, i.e., using a canned liquid beverage vending machine to vend cans of non-liquid beverage materials, and has been properly claimed as a method. We do not consider that in this situation there is any justification for not following the rule that "all limitations

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must be considered and that it is error to ignore specific limitations distinguish-
ing over the references." In re Boe, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974). When all claimed limitations are considered, Rockola clearly does not anticipate the appealed claims.

Accordingly, rejection (1) will not be sustained.

Rejections (2) and (3)

The bases of these rejections are set forth on pages 5 to 7 of the examiner's answer. After fully considering the record in light of the arguments in the appellant's brief and reply brief, and in the examiner's answer and supplemental answer, we conclude that the rejections will not be sustained.

Appellant states at page 3 of the reply brief that he "does not contest the fact that products or material other than liquid beverages are placed in cans which are dispensable from a vending machine". However, this is not determinative of the question of obviousness of the claimed subject matter, as the examiner seems to assume. What is lacking in the applied prior art is any teaching or suggestion of filling a container, which is sized to contain a liquid beverage and

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dispensable from a canned drink vending machine, with something other than a liquid beverage.

Neither Mullin nor Sampson contains any such teaching, nor does

Rockola suggest that the disclosed beverage cans might contain anything other than beverages. Absent any such teaching or suggestion, a *prima facie* case of obviousness has not been established.

Rejection Under 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 23 and 24 are rejected for failing to comply with 35 USC § 112, second paragraph. These claims are indefinite in that while parent claim 15 recites "at least one container", claims 23 and 24 each recite "said containers". This recitation of plural containers thus has no antecedent basis. Also, it is not clear whether the term "is loaded" is intended to be a method step (i.e., "loading") or simply a description of the vending machine's contents.

Conclusion

The examiner's decision to reject claims 15 to 17 and 21 to 24 is reversed.

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Claims 23 and 24 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 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 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, 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:

(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

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

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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NEAL E. ABRAMS)	
Administrative Patent Judge)	

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Julie K. Morriss
Trask, Britt & Rossa
P.O. Box 2550
Salt Lake City, UT 84110