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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1997-4441
Application 08/370,095[1]

ON BRIEF

Before THOMAS, BARRETT, and DIXON, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

[1] Application for patent filed January 9, 1995, entitled (as amended in Paper No. 5) "Checkweigher Which Weighs Product Suspended By Flange," which is a continuation of Application 07/942,647, filed September 9, 1992, now U.S. Patent 5,434,366, issued July 18, 1995.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 3-7, 9, and 11.

We reverse.

BACKGROUND

The disclosed invention is directed to method and apparatus for weighing products having an outwardly extending flange.

Claim 1 is reproduced below.

> 1. In a checkweigher for use in weighing products having a footprint and an outwardly projecting flange of either a circular or oval configuration above said footprint, said checkweigher having a weigh pan vertically deflectable to provide a signal indicative of the weight of said products and a product conveyor having a pair of parallel, product supporting conveyor elements arranged to move across and in surface engagement with said weigh pan for transporting said products one at a time across said weigh pan to effect weighing thereof, the improvement comprising in combination:
>
> said conveyor elements being arranged to underengage with said flange of said product only immediately adjacent the periphery of said flange of said product while said product is moving across said weigh pan, and said weigh pan having a length in a direction of movement of said conveyor elements corresponding essentially to the length of said products, as measured in said direction of movement.

The Examiner relies on the following prior art references:

Brook	4,163,488	August 7, 1979
Born et al. (Born)	4,802,571	February 7, 1989
Harwood et al. (Harwood) (UK Patent Application)	2,160,985	January 2, 1986

Claims 1, 3-7, 9, and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Claims 1, 3-7, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Born and Brook.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Born, Brook, and Harwood.

We refer to the Final Rejection (Paper No. 9) (pages referred to as "FR__") and the Examiner's Answer (Paper No. 14) (pages referred to as "EA__") for a statement of the Examiner's position and to the Appeal Brief (Paper No. 13) (pages referred to as "Br__") for a statement of Appellant's arguments thereagainst.

OPINION

35 U.S.C. § 112, second paragraph

The Examiner states (FR2): "The limitation that the 'weigh pan' has a length that is essentially the length of the products to be weighed is indefinite because the length of the weigh pan is based on an unspecified product with an unspecified length. See MPEP § 2173.05(b) and Ex parte Brummer, 12 USPQ2d 1652 (Bd. Pat. App. & Inter., 1989)."

Appellant argues that apparatus claims 1, 3-6, and 11 are definite because "checkweighers are designed for weighing a particular product having given dimensions, including a predetermined length in their direction of movement across the weigh pan" (Br8) and "[a] checkweigher manufacturer, seller, or user can readily ascertain whether the limitation as to weigh pan length is met because the checkweigher is configured for a stream of like-sized products having known dimensions" (Br8).

The Examiner responds that it cannot be determined whether a checkweigher will infringe because the product being weighed is not part of the claimed subject matter (EA4-5).

We understand the Examiner's position, but we view the claim language in question as being very broad rather than

indefinite. Although the actual dimensions of the lengths are not specified, it is known when the weigh pan has a "length . . . corresponding essentially to the length of said products" (claim 1). Thus, the limitations are definite. This is different from the facts in Brummer where for given spacing between front and rear wheels, it was impossible to determine "the height of the rider that the bicycle was designed for." For example, for a 4' wheel spacing it could not be determined whether the spacing was designed for a 5'4' rider (using the 75 percent value) or designed for a 6'8" rider (using a 60 percent value). It is the language "that the bicycle was designed for" that rendered the claim indefinite.

The apparatus claims at issue are very broad because the product is not claimed as part of the apparatus and the relationship between the length of the product to be measured and the length of the weigh pan is a mere statement of intended use; i.e., the checkweigher is intended for use with a product having a length about the same length as the weigh pan. Statements of intended use do not serve to distinguish structure over the prior art. See In re Pearson,

494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). Appellant recognizes that "products are not a structural part of the claimed apparatus" (Br10). All prior art checkweighers should meet the claim limitation of "said weigh pan having a length in a direction of movement of said conveyor elements corresponding essentially to the length of said products, as measured in said direction of movement" (claim 1), and the similar limitation of claim 11, because nothing structurally prevents them from being be used with products having a length corresponding essentially to the length of the weigh pan. For example, prior art checkweighers where the conveyor elements do not engage the periphery of the product (as in the example in Chart I, specification, page 7) can be used to weigh products having a length "corresponding essentially to" the length of the weigh pan by using a slower speed since the effective package length ("pl") is still less than the overall package length. No distinguishing speed, settling time, or pitch limitations are recited. The claims

are broad, not indefinite. The rejection of apparatus claims 1, 3-6, and 11 is reversed.

Appellant argues that method claims 7 and 9 are definite because "products are acted upon (weighed) in the claimed method" (Br10). We agree that the method claims are definite because "providing said weigh pan with a length in said direction of movement not substantially greater than a length of said products as measured in said direction of movement" (claim 7) states a definite relationship between the lengths of the product and the weigh pan. Because the method acts on the product, the length limitation is not just a statement of intended use and it is necessary to show the claimed relationship between the lengths. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) ("While Mathis' apparatus may be capable of being modified to run the way Mills' apparatus is claimed, there must be a suggestion or motivation in the reference to do so."). We conclude that the method claims are definite. The rejection of claims 7 and 9 is reversed.

35 U.S.C. § 103(a)

Born discloses supporting the product by its flange for conveying purposes but does not include any weighing means. Brook discloses transporting poultry carcasses using a specially designed shackle having a transversely extending pin which engages the weigh pan. Appellant argues (Br12):

> The combination of these references suggests the use of an intermediate support mechanism, i.e. specially designed shackles, connecting the products to an overhead conveyor in a manner whereby a portion of the support mechanism engages an overhead weigh pan. While supporting the product by its flange for conveying purposes is taught, supporting the product by its flange for weighing purposes is not proposed.

The Examiner states that "[t]he motivation for the proposed combination seems adequately explained in the final rejection and the applicant apparently has not explained why the combination is improper" (EA7).

We find no disclosure or suggestion in Brook that would have motivated one of ordinary skill in the art to weigh the products in Born by underengaging the flange of the product with conveyor elements while the product is moving across a weigh pan as claimed. The reasons in the Final Rejection are conclusory and fail to address the significant differences in structure between the claimed invention and Brook which discloses using a specially designed shackle. Although the

transversely extending pin 24 in Brook could be compared to the flange of a product, we think that comparison and, thus, the combination, can only be derived using hindsight. Because we find no motivation for the combination, the rejection of claims 1, 3-7, and 9 is reversed. Nevertheless, we also address the arguments as to the length limitation.

Appellant further argues that the references fail to teach or suggest the limitation concerning weigh pan length (Br12):

> Born et al lacks weighing means, and thus is silent as to weigh pan length. In Brook, the weigh pan 18 is not designed to correspond essentially to the length of the products because the length of poultry carcasses, by nature, varies from carcass to carcass. The length of weigh pan 18, and its relationship to carcass length in the direction of travel, is neither discussed nor shown in the drawing figures.

The Examiner states that "the limitation in the claims of the present application that the length of the weigh pan is based on a length of an unspecified product with an unspecified length, is so vague it is meaningless in the patentable sense" (EA6). As discussed in connection with the § 112, second paragraph, rejection, we consider the length limitation broad, not indefinite. Thus, the Examiner errs to

the extent that no weight is given to the limitation in the patentability analysis.

The Examiner states that the length limitation is a statement of intended use which does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations (EA6). We agree that the length limitation is a statement of intended use in the apparatus claims. However, since we find no motivation in Brook to provide a checkweigher in Born, we do not reach the intended use issue. As to method claims 7 and 9, the method operates on the product and the Examiner has not provided any reasoning why the claimed length limitation would have been obvious. We think that one of ordinary skill in the checkweighing art had sufficient knowledge to appreciate that a weigh pan length equal to the product length is the minimum possible weigh pan length because otherwise more than one product at a time might be on the weigh pan. We further believe that one of ordinary skill in the checkweighing art would have known that a weigh pan length equal to the product length could be used in prior art checkweighers because the effective product length ("pl") is less than the weigh pan length ("wpl"), if one was willing

to accept the slower speed. Although not discussed, the support plate 18 in Brook which forms the weigh pan appears to be about the same length as the distance between rods 11 and 12. However, none of these reasons have been advanced by the Examiner. In any case, we find no motivation in the references for the combination.

We have considered Harwood with respect to claim 11 but find that it does not cure the deficiencies in Born and Brook. Accordingly, the rejection of claim 11 is reversed.

CONCLUSION

The rejections of claims 1, 3-7, 9, and 11 are reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

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