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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/716,726	03/12/2007	Masataka Hamada	NIS-055	7260

32628 7590 01/16/2013
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EXAMINER

SUAREZ, ERNESTO A

ART UNIT	PAPER NUMBER
3653	

MAIL DATE	DELIVERY MODE
01/16/2013	PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MASATAKA HAMADA, KAZUHISA
MOCHIZUKI, TETSUYA NODA, SEIJI NISHIZAWA, and
OSAMU JINZA

Appeal 2010-007031
Application 11/716,726
Technology Center 3600

Before: JOHN C. KERINS, GAY ANN SPAHN, and
CHARLES N. GREENHUT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 14-17. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to a sheet conveying device and image processing apparatus. Claim 14, reproduced below with emphasis added, is illustrative of the claimed subject matter:

14. A sheet conveying device, comprising:

a first conveying roller pair for transferring a sheet, a second conveying roller pair for transferring the sheet, said second conveying roller pair being arranged on a downstream side of the first conveying roller pair in a sheet transferring direction at a predetermined distance away therefrom, a substantially linear conveying path for guiding the sheet from the first conveying roller pair to the second conveying roller pair, first and second guide rollers spaced apart from each other in the sheet transferring direction and disposed between the first and second conveyer roller pairs, said first and second guide rollers being located on one side relative to a straight line extending between nip points of the first and second conveying roller pairs, and projecting partly to the other side beyond the straight line so that *the first and second guide rollers rotate by the sheet contacting thereto*, and an ultrasonic sensing device for sensing overlapping sheets transferred in the conveying path, said ultrasonic sensing device being located between the first and second guide rollers.

REJECTION

Claims 14-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Minoru (US 2001/0042956 A1, pub. Nov. 22, 2001) and Iizawa (JP 03003844 A, pub. Jan. 9, 1991). Ans. 3.

OPINION

The Examiner interprets Minoru's "rollers (34, 36)" as the first and second guide rollers according to independent claims 14 and 17. Presumably, it is either the upper (34a, 36a) or lower (34b, 36b) set of these rollers, as viewed in Minoru's Figure 5, that are so interpreted by the Examiner, since each of claims 14 and 17 require these rollers to be on one side of a line between the nip rollers. It is undisputed that Minoru's rollers 34a, 34b, 36a, 36b are motor driven so that roller 36a may be driven more slowly than the others to thereby cause a bulge A in the upper form 30a should multiple forms 30 have mistakenly been left unseparated by the form separator 18. Minoru p. 3, para [0061]; p. 4, paras. [0066]-[0067]. Thus, it is clear that, in Minoru, it is the forms that must be capable of being moved by rotation of the rollers under the influence of the motor, not vice versa. While the claims recite comprising and are thus, open ended, and do not expressly preclude the rollers from being motor driven (Ans. 8), the functional recitation emphasized above implies that the first and second guide rollers must at least be capable of rotating by the sheet contacting thereto. *See e.g., In re Benson*, 418 F. 2d 1251, 1254 (CCPA 1969) ("We do not construe the claims as requiring [the actual performance of the recited function], but only that it . . . permit such use and that it not possess any characteristic which would prevent such use."). If Minoru's rollers could be rotated by a form or sheet it would hinder or prevent those rollers from creating the desired bulge. The Examiner has not supplied any reasoning or evidence to demonstrate why one of ordinary skill in the art would understand Minoru's rollers to meet this limitation. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir.

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1990); *Ex parte Skinner*, 2 USPQ 2d 1788, 1789 (PTAB 1986).

Accordingly, we cannot agree with the Examiner that the claim would cover a device having Minoru's rollers 34a, 34b, 36a, 36b as the recited "guide rollers."

DECISION

The Examiner's rejection is reversed.

REVERSED

JRG