

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES KENNETH WALLACE, DAVID C. KAMP,
and WILLIAM E. FILLMORE

Appeal No. 2001-0079
Application No. 09/092,702

ON BRIEF

Before RUGGIERO, LALL, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 7-10, 19-22, 25, and 26. Claims 11 and 23 have been allowed, and claims 1-6, 12-18, and 24 have been canceled.

The disclosed invention relates to a liquid containment and dispensing device having a self-contained pump. The device has the capability of dispensing the liquid in small doses, such as the dispensing of printing ink for use in an ink jet printer.

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More particularly, the device has a protective shell which houses a flexible pouch which contains the ink or other liquid to be dispensed.

Claim 7 is illustrative of the invention and reads as follows:

7. In a liquid containment and dispensing device having a rigid, generally cup-shaped outer shell with an open end, a chassis secured to the open end of the shell, the chassis having a pumping mechanism with a liquid inlet thereinto and a liquid outlet therefrom, wherein the chassis has a perimetrical wall, the improvement wherein:

the perimetrical wall of the chassis fits snugly within the open end of the shell, one of the perimetrical wall of the chassis and the open end of the shell having at least one outwardly projecting bead, the other of the perimetrical wall of the chassis and the open end of the shell having at least one radially inwardly projecting recess, the at least one bead being received in the at least one recess in a snap fit.

The Examiner relies on the following prior art:

Muscala	4,758,456	Jul. 19, 1988
Gross	5,246,147	Sep. 21, 1993
Oda et al.	5,552,816	Sep. 03, 1996
		(filed May 28, 1993)
Ujita et al. (Ujita)	EP 0 562 717 A1	Sep. 29, 1993
(Published European Patent Application)		

Claims 7-10, 19-22, 25, and 26 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Gross in view of Oda with respect to claims 7, 19, 25, and 26, Gross in view of Muscala with respect to claims 8 and 20, and Gross in view of Ujita with respect to claims 9, 10, 21, and 22.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for their respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 8-10, 20-22, 25, and 26. We reach the opposite conclusion with respect to claims 7 and 19. Accordingly, we affirm-in-part.

¹ The Appeal Brief was filed February 28, 2000 (Paper No. 10). In response to the Examiner's Answer dated May 2, 2000 (Paper No. 11), a Reply Brief was filed May 30, 2000 (Paper No. 12), which was acknowledged and entered by the Examiner as indicated in the communication dated July 3, 2000 (Paper No. 13).

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Appellants' arguments in response to the Examiner's obviousness rejection of the appealed claims are organized according to a suggested grouping of claims indicated at page 4 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We consider first the Examiner's obviousness rejection of independent claims 8 and 20 directed to the permanent securing of the cap, chassis, and shell components of the claimed liquid dispensing device through the use of an adhesively applied label. Appellants assert that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for the Examiner's proposed combination of the Gross and Muscala references has not been established. Upon careful review of the applied prior art, we are in agreement with Appellants' stated position in the Briefs. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260,

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1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

It is our view that, while a showing of proper motivation does not require that a combination of prior art teachings be made for the same reason as Appellants to achieve the claimed invention, we can find no motivation for the skilled artisan to apply the heat shrink label seal of Muscala to the liquid dispenser of Gross. As pointed out by Appellants (Brief, page 8), Muscala is directed to a cap and bottle seal which must be removed in order to access the contents. We fail to see how the cap and bottle seal disclosure of Muscala would have any relevance to the liquid dispensing device structure of Gross. There is nothing in the disclosure of Gross to indicate that security considerations and ease of seal removal, the problems addressed by Muscala, were ever a concern. It is our opinion that the only basis for applying the teachings of Muscala to the liquid dispenser device structure of Gross comes from an improper attempt to reconstruct Appellants' invention in hindsight. Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claims 8 and 20 over the combination of Gross and Muscala is not sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 9, 10, 21, and 22 based on the

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combination of Gross and Ujita, we do not sustain this rejection as well.² In addressing the features of these claims, which include limitations directed to a thin film valve heat staked to a top portion of the pumping mechanism chassis to prevent backflow from the pumping mechanism to the liquid pouch, the Examiner asserts (Answer, page 5) the obviousness to the skilled artisan of applying the thin film valve teachings of Ujita to the liquid dispensing device of Gross.

It is apparent from our review of the Gross reference, however, that motivation to add a backflow prevention valve to Gross is lacking since Gross already discloses such a valve (check valve V₂). Further, it is our opinion that even assuming, arguendo, that proper motivation were established for combining Gross with Muscala, the resulting structure would not satisfy the requirements of claims 9, 10, 21, and 22. As pointed out by Appellants (Brief, pages 9 and 10), no teaching of heat staking of the thin film valve in Ujita is provided, with Ujita instead disclosing only the use of a liquid seal. We further agree with Appellants that the applied prior art is silent as to the

² The Examiner and Appellants should review the present dependence of claim 22 on independent claim 19. Claim 22 is directed to the details of the thin film configuration which has clear antecedent reference in independent claim 21, but not independent claim 19.

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specific arrangement set forth in claims 10 and 22 in which heat staking is provided between the ends of the shorter of the two opposed pair of sides of the thin film.

We are aware that the Examiner (Answer, pages 9 and 12) suggests that the particular manner of attaching the thin film valve to the chassis panel would merely be "a mechanical design expedient." In our view, the Examiner's reliance on design considerations as a basis for the proposed modification of the combination of Gross and Ujita is not well founded. Appellants' disclosed intended function of assuring a secure backflow valve closure with reduced flexing can only be achieved through the particular valve attachment features set forth in claims 9, 10, 21, and 22.

We find that the Examiner's assertion that the specific claimed manner of attaching the thin film valve to the chassis panel would be a matter of mechanical design expedient is totally devoid of any support on the record. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

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We also do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 25 and 26 directed to the "outwardly bowed" configuration of the longer pair of opposed sides of the dispensing device outer shell. Although the Examiner (Answer, page 7), asserts ". . . changing the shape of the shell for the purpose of avoiding warpage problems is considered to be a common practice or a mechanical design expedient for an engineer depending upon a particular environment . . . , " we find no evidence of record to support such a conclusion. "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35, in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006-07 (Fed. Cir. 2002).

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We next consider the Examiner's obviousness rejection of claims 7 and 19 based on the combination of Gross and Oda and note that, while we found Appellants' arguments to be persuasive with respect to the Examiner's rejection of claims 8-10, 20-22, 25, and 26 discussed supra, we reach the opposite conclusion with respect to claims 7 and 19. Our review of the Examiner's stated position (Answer, page 7) reveals that the Examiner has pointed out the teachings of the prior art references, has reasonably indicated the perceived differences between this applied prior art and the claimed invention, and has provided reasons as to how and why this prior art would have been modified and/or combined to arrive at the claimed invention. In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence or arguments which persuasively rebut the Examiner's prima facie case of obviousness. Arguments which Appellants could have made but elected not to make in the Briefs have not been considered in this decision (note 37 CFR § 1.192).

Appellants' arguments in response (Brief, page 6; Reply Brief, page 2) focus on the contention that the applied Gross and

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Oda references do not recognize Appellants' realized advantage from the claimed snap fit connection of achieving a secure fit between the chassis and the shell of the dispensing device without providing a true hermetic seal. We would point out, however, that it is not necessary that references be combined for the same reason as Appellants. The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the same advantage or result discovered by Appellants. See In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972); In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

We would further point out that, although Appellants' arguments rely on the achieved result of avoiding the need for a connection with a true hermetic seal, no such requirement appears in rejected claims 7 and 19. In our view, Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28

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(Fed. Cir. 1997). For the above reasons, since the Examiner's prima facie case of obviousness remains un rebutted by any convincing arguments of Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 7 and 19 is sustained.

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of the appealed claims, we have sustained the rejection of claims 7 and 19, but have not sustained the rejection of claims 8-10, 20-22, 25, and 26. Therefore, the Examiner's decision rejecting claims 7-10, 19-22, 25, and 26 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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