

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES EDWARD CARTER

Appeal No. 2003-0104
Application No. 09/659,792

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 13 and 15. Claim 14, the only other claim pending in this application, is not rejected.¹

We REVERSE and REMAND.

¹ The rejections of claim 14 raised in the final rejection were withdrawn by the examiner on page 2 of the answer.

BACKGROUND

The appellant's invention relates to an insulated container for a beer keg (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claims 1, 7 and 11, the independent claims on appeal, read as follows:

1. An insulated container for keg beer, wherein the improvement comprises a securement on the container for a spigot of a keg tap, the securement comprising a band (15) into which a spigot-handle (25) may be maintained hooked by twist on the spigot resulting from weight of a spigot tube (21) and any beer in the tube acting from a combined center of gravity outwards from the container, with a spigot spout (27) pointing downwards.
7. An insulated container for keg beer, wherein the improvement comprises a pocket on the container for beer cups, the pocket having a closed bottom.
11. An insulated container for keg beer, wherein the improvement comprises the container sized for a tight fit with a keg and an airflow passageway to allow air flow into the container when the keg is removed.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Leslie	4,759,077	July 19, 1988
Pulli	6,082,896	July 4, 2000
Hussain	GB 2 221 292 A	Jan. 31, 1990

Claims 1 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Leslie.

Claims 1, 2, 5, 7, 9 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Pulli.

Claims 3, 4, 6, 8 and 10 to 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pulli in view of Hussain.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 5, mailed August 14, 2001) and the answer (Paper No. 11, mailed May 9, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed March 19, 2002) and reply brief (Paper No. 12, filed July 5, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection based on Leslie

We will not sustain the rejection of claims 1 and 5 under 35 U.S.C. § 102(b) as being anticipated by Leslie.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant's argue (brief, pp. 4-5; reply brief, pp. 1-2) that there is no basis to conclude that a spigot-handle could interact with the handles 14 of Leslie in the manner claimed. We agree. In that regard, the claimed band into which a spigot-handle may be maintained hooked by twist on the spigot resulting from weight of a spigot tube and any beer in the tube acting from a combined center of gravity outwards from the

container, with a spigot spout pointing downwards is not readable on² the handles 14 of Leslie. While the handles 14 of Leslie's insulated carrier may be a band which in a general sense would be inherently capable of securing the spigot of a keg tap as alleged by the examiner (final rejection, p. 3), there is no basis to conclude, and the examiner has not even alleged, that the handles 14 of Leslie's insulated carrier are inherently capable of maintaining a spigot-handle therein hooked by twist on the spigot resulting from weight of a spigot tube and any beer in the tube acting from a combined center of gravity outwards from the container, with a spigot spout pointing downwards. Thus, the claimed band is structurally and functionally different than the handles 14 of Leslie's insulated carrier.

Since all the limitations of independent claim 1 and claim 5 dependent thereon are not met by Leslie for the reasons set forth above, the decision of the examiner to reject claims 1 and 5 under 35 U.S.C. § 102(b) is reversed.

The anticipation rejection based on Pulli

We will not sustain the rejection of claims 1, 2, 5, 7, 9 and 15 under 35 U.S.C. § 102(e) as being anticipated by Pulli.

² The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d at 772, 218 USPQ at 789, it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 1, 2 and 5

The appellant argues (brief, p. 5; reply brief, pp. 1-2) that there is no basis to conclude that a spigot-handle could interact with the handles 38 of Pulli in the manner claimed. We agree. In that regard, the claimed band into which a spigot-handle may be maintained hooked by twist on the spigot resulting from weight of a spigot tube and any beer in the tube acting from a combined center of gravity outwards from the container, with a spigot spout pointing downwards is not readable on the handles 38 of Pulli. While the handles 38 of Pulli's insulated container may be a band which in a general sense would be inherently capable of securing the spigot of a keg tap as alleged by the examiner (final rejection, p. 3), there is no basis to conclude, and the examiner has not even alleged, that the handles 38 of Pulli's insulated container are inherently capable of maintaining a spigot-handle therein hooked by twist on the spigot resulting from weight of a spigot tube and any beer in the tube acting from a combined center of gravity outwards from the container, with a spigot spout pointing downwards. Thus, the claimed band is structurally and functionally different than the handles 38 of Pulli's insulated container.

Since all the limitations of independent claim 1 and claims 2 and 5 dependent thereon are not met by Pulli for the reasons set forth above, the decision of the examiner to reject claims 1, 2 and 5 under 35 U.S.C. § 102(e) is reversed.

Claims 7, 9 and 15

The appellant's argue (brief, p. 5; reply brief, p. 2) that there is no basis to conclude that Pulli's sleeve 34 for supporting cups has a closed bottom. We agree. The examiner's position (answer, p. 4) that Pulli's sleeve 34 inherently has a closed bottom is without support. The examiner correctly points out that claim 1 of Pulli recites "a cup sleeve attached to said outer layer, said cup sleeve being a pocket completely external to said body section." However, we disagree with the examiner that Pulli's use of the term "pocket" in describing the cup sleeve implicitly requires a closed bottom. Thus, the claimed pocket having a closed bottom is structurally different than the sleeve 34 on Pulli's insulated container.

Since all the limitations of independent claim 7 and claims 9 and 15 dependent thereon are not met by Pulli for the reasons set forth above, the decision of the examiner to reject claims 7, 9 and 15 under 35 U.S.C. § 102(e) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 3, 4, 6, 8 and 10 to 13 under 35 U.S.C. § 103 as being unpatentable over Pulli in view of Hussain.

Claims 3, 4, 6, 8 and 10

The decision of the examiner to reject dependent claims 3, 4, 6, 8 and 10 under 35 U.S.C. § 103 is reversed for the reasons provided above with respect to independent claims 1 and 7. We have reviewed the reference to Hussain applied in this rejection under 35 U.S.C. § 103 but find nothing therein which makes up for the deficiencies of Pulli discussed above with respect to claims 1 and 7.

Claims 11 to 13

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.

Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In the rejection under 35 U.S.C. § 103, the examiner determined (final rejection, p. 4) that based on Hussain's teaching of hole 7 in the bottom of an insulated can holder it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bottom of Pulli's insulated container with an airflow passageway in order to facilitate removal of the keg from the insulated container.

The appellant's argue (brief, pp. 5-6; reply brief, p. 2) that there is no motivation for modifying Pulli's insulated container by the teachings of Hussain since Pulli's insulated container does not provide a tight fit to the keg since the container is designed to retain ice and water. We agree. Without a tight fit between a keg and Pulli's insulated container there is no need for a hole to be provided in the bottom of Pulli's insulated container in order to facilitate removal of a keg from the insulated container. In our view, the only suggestion for modifying Pulli in the manner proposed by the examiner stems from hindsight knowledge derived from the appellant's own disclosure.

The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 11 to 13 under 35 U.S.C. § 103 is reversed.

REMAND

We remand the application to the examiner for the following further considerations:

- (1) Determine if Leslie's teaching (column 4, lines 24-27) that "the keg may be smaller than the dimensions of cavity 18, thereby allowing space for ice cubes to surround the keg" teaches or suggests to a person of ordinary skill in the art that the cavity 18 can be sized to provide a tight fit with a keg;
- (2) Determine if the airflow passageway recited in claim 11 is readable on a top opening of an insulated carrier/container wherein when a keg is removed from the carrier/container air is allowed to flow into the carrier/container via the top opening;
- (3) Based upon the above-noted determinations, determine whether or not claims 11 and 12 are anticipated by Leslie;

(4) Based upon the above-noted first determination, determine whether or not claims 11 to 13 would have been obvious at the time the invention was made to a person of ordinary skill in the art from the combined teachings of Leslie and Hussain;

(5) Determine if the pocket of claim 7 is readable on storage pouch 36 of Pulli which appears to have a closed bottom as shown in Figures 1, 2 and 7-9;

(6) Based upon determination (5), determine whether or not claims 7, 9 and 15 are anticipated by Pulli; and

(7) If claim 7 is anticipated by Pulli, determine whether or not claims 8 and 10 would have been obvious at the time the invention was made to a person of ordinary skill in the art from the combined teachings of Leslie, Hussain and Pulli.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 5 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claims 1, 2, 5, 7, 9 and 15 under 35 U.S.C. § 102(e) is reversed; and the decision of the examiner to reject claims 3, 4, 6, 8 and 10 to 13 under 35 U.S.C. § 103 is reversed. In addition, we have remanded the application to the examiner for further considerations.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Aug. 2001).

REVERSED; REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
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