

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 RICHARD BROTHERS

Appeal No. 2004-0314
Application 09/965,496

ON BRIEF

Before PAK, OWENS, and KRATZ, *Administrative Patent Judges*.
Patent Judges.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the refusal to allow claims 4-6 as amended after final rejection. Claim 7, which is the only other claim pending in the application, has been allowed.

THE INVENTION

The appellant's claimed invention is directed toward "covered food containers wherein a structural feature of the container receives a matching structural component of the cover to provide a temporary resting location for the cover when access

to the interior of the container is required" (specification, page 1, lines 10-13). Claim 4 is illustrative:

4. In a food container having a removable cover with a first cover support, said first cover support and a surface of said food container forming a sealed relation, the improvement comprising:

a secondary cover support formed in said removable cover;
and

a secondary mounting platform formed in said food container, said mounting platform of a configuration to receive and selectively retain said secondary cover support of said removable cover in a manner exposing a substantial portion of said food container to outside access, wherein said container and said removable cover are substantially rectangular, said container further comprising:

a cover handle extension formed along a side of said removable cover; and

a retaining slot formed within said container, said retaining slot having a raised edge support surface forming a lower surface thereof, said support surface of substantially matching configuration to an outer edge of said cover handle extension,

whereby said removable cover may selectively be received and retained by said receiving slot upon insertion of said cover handle extension therein, and wherein said retaining slot comprises:

an inner retaining wall located within said food container;
and

an outer retaining wall spaced from said inner retaining wall and forming an outer wall of said food container,

wherein said inner retaining wall is not of uniform height along a length thereof.

The examiner argues that Wewetzer's compact is made of plastic, and that plastics are sufficiently resilient that the pintle can be pulled out of the slotted channels (31) of the plug and reinserted without breaking the pintle or the plug (answer, page 5). The examiner is relying upon the pintle and the plastic around the openings of the slotted channels inherently having the required resiliency. When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986). The examiner points out that Wewetzer teaches that "[p]rojecting from the central portion of the outer flange of the cover is a rib **40** adapted to engage in a locking groove **41** of corresponding length, the resiliency of the parts permitting the rib to flexibly engage in the groove, whereby to seat the cover tightly against the shoulder **18** in its closed

position" (col. 3, lines 46-52). The examiner argues that it appears that all plastic parts of Wewetzer's compact are made of the same plastic and that, consequently, the pintle and the plug have the same resiliency as the rib and the locking groove (answer, pages 5-6). The examiner's argument is deficient in that the examiner has not established that 1) an amount of resiliency which is sufficient for engaging the rib with the locking groove is sufficient for removing the pintle from the plug's slotted channels without breaking the pintle or the plug, and 2) the ability of the pintle to be removed from the plug without breaking the pintle or the plug depends only upon the resiliency of the plastic, rather than also depending upon other factors such as the relative sizes of the pintle's diameter and the plug's slotted channel openings and the thickness of the plastic at the slotted channel openings. The examiner has not provided evidence or technical reasoning which shows that factors such as Wewetzer's relative pintle diameter/slotted channel opening sizes and the plastic thickness around the channel's slotted openings necessarily are such that there is sufficiently resiliency that the pintle can be removed from the plug's slotted channels without breaking the pintle or the plug.

The examiner points out that Wewetzer states that "[a]

further object of the invention is to provide an improved cover structure and hinging arrangement therefor by which it may be attached in a container" (col. 1, lines 10-13), and argues that the term "may" "provides the possibility that the cover is not attached and therefore could not be deemed non-removable" (answer, page 6). At approximately the time Wewetzer's application was filed, "may" could indicate either ability or possibility.¹ The examiner has not explained why, in view of Wewetzer's teaching that the parts are secured together (col. 3, lines 56-59), one of ordinary skill in the art would have interpreted "may be attached" as meaning that the hinged cover possibly is attached rather than meaning that the hinging arrangement enables the cover to be attached.

The examiner argues that even if Wewetzer's cover is attached, when it is attached using an adhesive it can be removed by melting, dissolving or cutting away the adhesive, and then can be reattached by using fresh adhesive, and when it is attached by heat and pressure it can be removed and reattached by heating the plastic to expand it sufficiently to permit removal and

¹See *Webster's New International Dictionary of the English Language* 1517 (G. & C. Merriam Co., 2nd ed. unabridged, 1940), a copy of which is provided to the appellant with this decision.

Appeal No. 2004-0314
Application No. 09/965,496

reinsertion of the plug (answer, pages 6-7). The examiner, however, has not provided evidence that Wewetzer's cover is removable by the techniques set forth by the examiner. The mere possibility or probability that the cover can be removed in the ways proposed by the examiner is not sufficient for establishing a *prima facie* case of inherency. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Moreover, the term "removable" in the appellant's claim 1 is interpreted not in a vacuum but, rather, in light of the application disclosure and the prior art. See *In re Kroekel*, 504 F.2d 1143, 1146, 183 USPQ 610, 612 (CCPA 1974); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238-39 (CCPA 1971). The appellant's disclosure indicates that the cover is freely removable, not removable only after adhesive is removed or the container or cover is expanded by being heated, and the examiner has not provided prior art which shows that one of ordinary skill in the art would have interpreted "removable" in the context of removing a removable cover from a food container as including such adhesive removal and thermal expansion techniques.

For the above reasons we find that the examiner has not carried the burden of establishing a *prima facie* case of anticipation of the appellant's claimed food container.

Appeal No. 2004-0314
Application No. 09/965,496

Appeal No. 2004-0314
Application No. 09/965,496

DECISION

The rejection of claims 4-6 under 35 U.S.C. § 102(b) over
Wewetzer is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

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Appeal No. 2004-0314
Application No. 09/965,496

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