

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 DAVID L. LEE and AMAR N. NEOGI

Appeal No. 2004-1206
Application No. 09/826,473

ON BRIEF

Before KIMLIN, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's refusal to allow claims 16 through 26 as amended subsequent to the final rejection (see the amendment dated Apr. 18, 2003, Paper No. 9, entered as per the Advisory Action dated May 6, 2003, Paper No. 12, with the examiner indicating that the rejections under section 112, ¶1 and ¶2, have been overcome as well as all rejections based on Hein III et al., U.S. Patent No. 5,542,529; see the Brief, page 2). Claims 1-15 are the only other claims pending in this application and stand withdrawn from

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consideration by the examiner as directed to a non-elected invention (Answer, page 2, ¶(3)). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a packaging container in which the outer surface of the container has been directly printed in color using at least two transparent inks, where no more than two of the inks are permitted to be primary process colors (Brief, pages 2-3). Appellants state that the claims should be grouped in five groups as listed on page 3 of the Brief. To the extent these groups of claims have been separately argued by appellants, we consider these groups of claims separately. See 37 CFR § 1.192(c)(7)(2002). Independent claim 16 is representative of the invention and is reproduced below:

16. A packaging container having inner and outer surfaces in which the outer surface has been directly printed in color using at least two overprinted transparent inks, of which no more than two of the ink colors have been selected from cyan, magenta, or yellow process primary colors.

The examiner has relied upon the following references in support of the rejections on appeal:

Gerstner et al. (Gerstner)	5,037,682	Aug. 06, 1991
Agostini et al. (Agostini)	5,095,819	Mar. 17, 1992
Wolfe et al. (Wolfe)	5,193,456	Mar. 16, 1993
Akao et al. (Akao)	6,190,744	Feb. 20, 2001

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Claims 16 and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wolfe (Answer, page 4). Claims 16 and 18-25 stand rejected under 35 U.S.C. § 102(b) as anticipated by Gerstner (*id.*). Claim 17 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Gerstner in view of Akao (Answer, page 6). Claim 26 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Gerstner in view of Agostini (Answer, page 7). We *affirm* all of the rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. *The Rejection under § 102(b) over Wolfe*

The examiner finds that Wolfe discloses a packaging container having inner and outer surfaces which has been directly printed in color using at least two transparent inks, of which no more than two have been selected from the process primary colors of cyan, magenta or yellow (Answer, page 4, citing col. 1, ll. 13-20, and col. 10, ll. 53-66).

Appellants argue that Wolfe is directed to printing on a cylindrical beverage can, and does not teach or disclose a "packaging container" as that term is defined in the specification (Brief, page 4).

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It is implicit in any review of the examiner's anticipation analysis that the claim must first have been correctly construed to define the scope and meaning of any contested limitations. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). The examiner finds that the claimed "packaging container" includes the cylindrical beverage cans disclosed by Wolfe (Answer, pages 8-9) while appellants argue that this term is limited to the "conventional corrugated shipping containers or containers formed from paperboard" as set forth on page 2, ll. 13-15, of the specification (Brief, page 4). During ex parte prosecution, the claim language must be read as broadly as reasonably possible, as it would have been understood by one of ordinary skill in the art, enlightened by any definitions or guidelines found in the specification. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *and In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995). The relevant portion of appellants' specification reads as follows (page 2, ll. 13-15):

The term "packaging container" should be read to include conventional corrugated shipping containers or containers formed from paperboard [underlining added].

Accordingly, we agree with the examiner that, given the broadest reasonable interpretation, one of ordinary skill in this art

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would have construed the term "packaging container" to include the packaging container for liquid beverages taught by Wolfe and not limited this term to the exemplary conventional corrugated paperboard shipping containers taught by the specification. In other words, one of ordinary skill in this art would have recognized that appellants' specification taught what was *included* as a "packaging container" but the specification did not exclude other packaging containers known in the art.

Appellants argue that Wolfe does not teach or disclose appellants' requirement that no more than two inks may be cyan, magenta or yellow process primary colors (Brief, page 4). This argument is not well taken. As correctly argued by the examiner (Answer, page 9), Wolfe only uses two transparent inks and thus must meet the claimed requirement.

Appellants argue that Wolfe is directed to an apparatus for printing on cylindrical beverage cans and thus is not analogous art (Brief, pages 4-5). As also correctly noted by the examiner (Answer, page 9), arguments that the prior art reference is non-analogous art are not germane to a rejection based on section 102. See *In re Self*, 671 F.2d 1344, 1350-51, 213 USPQ 1, 7 (CCPA 1982).

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For the foregoing reasons, the reasons set forth in the Answer, as well as the claim construction discussed above, we determine that the examiner has established that Wolfe describes every limitation of claim 16 within the meaning of section 102(b). With regard to the rejection of claim 21 under section 102(b) over Wolfe, we note that claim 21 merely limits claim 16 to two transparent inks. As found by the examiner (Answer, pages 4 and 9), Wolfe discloses two transparent inks used in the direct printing of the outer surface of the beverage can. Therefore we affirm the rejection of claims 16 and 21 under 35 U.S.C. § 102(b) over Wolfe.

B. The Rejection under § 102(b) over Gerstner

The examiner finds that Gerstner discloses a packaging container having an inner and outer surface formed from paperboard in which the outer surface has been directly printed in color using at least two transparent inks, of which no more than two of the inks have been selected from cyan, magenta or yellow process primary colors (Answer, page 4). The examiner also finds that Gerstner discloses metallic ink and opaque white-pigmented ink layers which serve as masking colors for the transparent colorant layer(s) (*id.*).

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Appellants argue that Gerstner does not even mention "transparent" inks, nor is it disclosed that at least two transparent inks are applied *directly* to the outer surface of the packaging container (Brief, page 5). Appellants' arguments are not persuasive. As noted by the examiner, the term "directly" as recited in claim 16 on appeal is not limited to a paperboard surface in contact with transparent inks (Answer, page 10). Appellants' specification teaches that overprinted transparent inks may be used in combination with underlying or overlying opaque inks as a masking layer (page 2, ll. 15-18 and 28-30; page 4, ll. 4-6; and page 5, ll. 23-24). The specification does not define the term "directly" (specification, page 2, l. 26). Therefore, applying the claim construction analysis as described above, the broadest reasonable interpretation of "directly" as recited in claim 16 on appeal would include inks printed so as to contact the outer surface *and* inks printed overlying a masking layer ink on the outer surface of the substrate. *See In re Morris, supra*. In view of our claim construction, we agree with the examiner that Gerstner discloses inks which are printed in a manner included within the scope of claim 16 on appeal.

The examiner agrees with appellants that Gerstner does not recite that the inks are "transparent" (Answer, page 10).

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However, the examiner sets forth convincing technical reasoning as to why the inks disclosed by Gerstner must be transparent (Answer, pages 10-11). Appellants have not disputed this reasoning. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); and *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990).

Appellants also argue that Gerstner fails to teach or disclose the requirement that no more than two inks may be cyan, magenta or yellow process primary colors (Brief, page 6). This argument is not well taken since Gerstner specifically exemplifies only one process primary color (yellow), and thus the claimed requirement is met (see col. 3, ll. 47-50).

For the foregoing reasons and those reasons stated in the Answer, as well as the claim construction discussed above, we determine that the examiner has established that Gerstner describes every claim limitation of claim 16 on appeal within the meaning of section 102. With respect to claim 18, we note that Gerstner discloses that a suitable substrate is paperboard (col. 3, l. 22). With respect to claim 19, as noted above, Gerstner discloses use of at least one opaque ink in combination with the transparent inks (Brief, page 8; Answer, page 4; see Gerstner, col. 3, l. 51-col. 4, l. 18). With regard to appellants'

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arguments for claims 24 and 25 (Brief, page 9), we agree with the examiner that Gerstner discloses that the paperboard substrate is either not pretreated and left unbleached or the substrate is solid bleached and thus a white wood pulp fiber (Answer, page 5; Gerstner, col. 3, ll. 25-33).

For the foregoing reasons, we affirm the examiner's rejection of claims 16 and 18-25 under 35 U.S.C. § 102(b) over Gerstner.

C. The Rejections under § 103(a)

We adopt the examiner's findings of fact and conclusions of law as stated in the Answer at pages 6-8, 11-12 and 15-16, regarding the rejections based on section 103(a) over Gerstner in view of Akao and Gerstner in view of Agostini. Appellants merely repeat their arguments with respect to Gerstner as discussed above and state that Akao and Agostini do not remedy the deficiencies in this primary reference (Brief, pages 6 and 10). With regard to appellants' argument concerning the motivation to combine Gerstner and Agostini (Brief, page 10), we adopt the examiner's comments from pages 15-16 of the Answer.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the

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totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm both rejections on appeal based on section 103(a).

D. Summary

The rejection of claims 16 and 21 under 35 U.S.C. § 102(b) over Wolfe is affirmed. The rejection of claims 16 and 18-25 under 35 U.S.C. § 102(b) over Gerstner is affirmed.

The rejection of claim 17 under 35 U.S.C. § 103(a) over Gerstner in view of Akao is affirmed. The rejection of claim 26 under 35 U.S.C. § 103(a) over Gerstner in view of Agostini is affirmed.

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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

Edward C. Kimlin)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Terry J. Owens)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
Thomas A. Waltz)	
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