

*file
del*

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

SEP 30 1996

Ex parte Gerd Riedel

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 96-2392
Application 08/237,789¹

ON BRIEF

Before MEISTER, FRANKFORT and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Gerd Riedel (appellant) appeals from the final rejection of claims 1 through 7, all the claims remaining in the application.²

¹ Application for patent filed May 4, 1994.

² A first amendment subsequent to the final rejection filed on August 17, 1995 (Paper No. 7) has been denied entry. A second amendment subsequent to the final rejection filed on September 15, 1995 (Paper No. 10) has been entered.

Appeal No. 96-2392
Application 08/237,789

We reverse and enter a new rejection of claims 1 and 3 pursuant to 37 CFR 1.196(b).

Appellant's invention pertains to a package for photographic film wound into a cartridge, the details of which are clear from a reading of independent claim 1, reproduced below:

1. Package for photographic films wound into cartridges, said package is in the form of a cylindrical tub consisting of two identical tub halves each having an opening, and a support ring, the openings of the tub halves are pushed over said support ring, the support ring has a small height in comparison with the said tub halves, and said tub halves and said support ring are held together by snap-action connections³.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Bozek	3,447,711	June 3, 1969
Schwartz	4,756,424	July 12, 1988
Ram et al. (Ram)	5,215,192	June 1, 1993
Niecznik (German patent)	225,086	Apr. 1, 1943

³ Consistent with the appellant's disclosure and the claim language "consisting of" appearing earlier in claim 1, we consider the language "snap-action connections" as referring to the configuration of the interengaging portions of the tub halves and support ring rather than additional, separate, and discrete elements of the claimed package.

Appeal No. 96-2392
Application 08/237,789

The following reference, of record, is relied upon by this panel of the Board in making a new rejection pursuant to 37 CFR 1.196(b):

Akao

4,844,961

July 4, 1989

The examiner has made the following rejections:

(a) claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention;⁴

(b) claim 1 under 35 U.S.C. § 102(b) as being anticipated by either Bozek or Niecznik;

⁴ In the final rejection, claim 7 was also rejected under 35 U.S.C. § 112, second paragraph. Since this claim have been amended subsequent to final rejection in such a manner so as to apparently overcome the examiner's criticism of this claim, and since no mention of this rejection has been made by the examiner in the answer, we presume that the examiner has withdrawn the final rejection of claim 7 on this ground. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

Appeal No. 96-2392
Application 08/237,789

(c) claims 1 through 3 under 35 U.S.C. § 103 as being unpatentable over either Bozek or Niecznik in view of Schwartz; and,

(d) claims 4 through 7 under 35 U.S.C. § 103 "as being unpatentable over the prior art as applied to claims 1 and 3 above, and further in view of Ram et al." (answer, page 6).

Considering first the § 112 rejection of claim 2, the second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In this regard, the definiteness of the language in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.* In this instance, while the examiner may be technically correct in his observation that the term "the other snap-action connection" lacks a clear antecedent, we consider that when claims 1 and 2 are read in light of the disclosure by one of ordinary skill in the art, the meaning of the expressions "one

Appeal No. 96-2392
Application 08/237,789

snap-action connection" and "the other snap-action connection" in claim 2 would be quite evident.

As to the examiner's additional criticism that "[t]here is insufficient structure defined to render definite the functional 'released more easily than the other' limitation [of claim 2]" (answer, page 3), it is well settled that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971). Judging from the examiner's remarks as quoted above, it appears that his concern is with the breadth of claim 2 rather than with any indefinite language therein. The fact that claim 2 covers any and all packages conforming to the structural requirements of the claims and having snap-action connections arrangements where one connection "is released more easily than the other," as set forth in claim 2 does not make the claim indefinite. Instead, it simply makes the claim broad. Breadth, however, is not to be equated with indefiniteness. See, for example, *In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). Accordingly, we will not sustain the 35 U.S.C. § 112, second paragraph, rejection of claim 2.

Appeal No. 96-2392
Application 08/237,789

Turning to the § 102 rejection of claim 1, anticipation, within the meaning of 35 U.S.C. § 102, "requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). "A prior art disclosure that 'almost' meets that standard may render the claim invalid under § 103; it does not 'anticipate'." *Id.*

In rejecting claim 1 as being anticipated by either Bozek or Niecznik, the examiner states that "Bozek and Niecznik each disclose structure corresponding to structure described in the specification or equivalents thereof" (answer, sentence spanning pages 3 and 4). As is apparent from the cases cited above, this is not the test for anticipation. Claim 1 requires a package in the form of a cylindrical tub. Notwithstanding the examiner's view to the contrary, the device of Niecznik is not in the form of a cylindrical tub. Rather the tub halves 1, 2 and support element 3 of Niecznik cooperate to form a structure that is best described as a generally spherical container having flattened ends. On this basis alone, the § 102 rejection of claim 1 based on Niecznik cannot be sustained.

Appeal No. 96-2392
Application 08/237,789

Claim 1 also requires that the tub halves and support ring be held together by snap-action connections. While the examiner considers the frictional interengagement between the reinforcing band 13 and tub halves 11, 12 of Bozek to constitute a snap-action connection, we agree with appellant that Bozek does not disclose a snap-action connection. In this regard, consistent with the description found in appellant's specification on page 4 at lines 20 through 32, we consider that in the present case the term "snap-action connection" requires, at a minimum, a connection which is effected by an initial deflection of a portion of at least one of the tub half and support ring, followed by at least a partial return of the deflected portion to its original shape. In that there is no clear disclosure in Bozek of this type of coaction between the ring 13 and tub halves 11, 12, we cannot sustain the § 102 rejection of claim 1 based thereon.

The § 103 rejection of claims 1 through 3 as being unpatentable over either Bozek or Niecznik in view of Schwartz also cannot be sustained. With respect to Schwartz, in light of our interpretation above of what the claim language "snap-action connection" requires, we are in agreement with appellant that the

Appeal No. 96-2392
Application 08/237,789

coaction between Schwartz's protuberances 36 and the smooth internal cylindrical surfaces of the cups cannot fairly be considered a snap-action connection. Rather, as is clear from column 2, lines 31 through 43 of Schwartz, protuberances 36 merely facilitate the frictional holding of the cups 10, 10' to the connector coupling 20. In addition, with respect to the § 103 based on Niecznik and Schwartz, even if we were to accept the examiner position that Schwartz teaches a snap-action connection and that it would have been obvious to provide such a connection in Niecznik in view of Schwartz, the claimed subject matter would not result since the Niecznik device would not be in the form of a cylindrical tub as called for in claim 1.

Concerning claim 2, we simply do not agree with the examiner's determination that the claim requirement for "one snap-action connection that is released more easily than the other snap-action connection" would necessarily occur as a result of unavoidable imperfections in the fabrication of the tub halves. This constitutes an additional reason for not sustaining the § 103 rejection of claim 2.

Appeal No. 96-2392
Application 08/237,789

As to the § 103 rejection of claims 4 through 7 "as being unpatentable over the prior art as applied to claims 1 and 3 above, and further in view of Ram et al." (answer, page 6), even if we were to accept the examiner's position that Ram teaches the provision of foil over the containers of Bozek and Niecznik, as called for in claims 4 and 5, and the provision of a vaper seal in addition to whatever connections may exist between the tub halves and support rings of Bozek and Niecznik, as called for in claim 7, the claimed subject matter would not result for the reasons expressed above in our discussion of claim 1. Accordingly, the § 103 rejection of these dependent claims likewise cannot be sustained.

Pursuant to 37 CFR 1.196(b), we enter the following new rejection.

Claims 1 and 3 are rejected under 35 U.S.C. § 103 as being unpatentable over Schwartz in view of Akao, of record. Schwartz discloses a container comprising first and second identical halves 10, 10' and a support ring 20 small in height in comparison to the halves. Given that the identical halves 10, 10' each include a handle 14, 14' it is questionable whether the

Appeal No. 96-2392
Application 08/237,789

completed package, i.e., that which results when the halves are assembled with the support ring, is a cylindrical tub, as called for in claim 1. However, it would have been obvious to one of ordinary skill in the art to eliminate the handles of Schwartz's cups for the purpose of providing tumbler type containers 10, 10' instead of mugs or cups, the self evident advantages of such a modification including a reduction in the amount of material required to make the tumblers and simplified fabrication resulting from not having to mold handles as an integral part of the cups. In addition, suggestion for eliminating the handles 14 is seen in Schwartz's statement at column 2, lines 6-7 of the specification that "[e]ach cup 10 may be provided with a suitable conventional handle 14, 14'" (emphasis added). It would also have been obvious to one of ordinary skill in the art to provide snap-action connections of the type taught by Akao at, for example, Figures 5 through 8, in Schwartz for the purpose of more securely holding together the parts 10, 10' and 20. In this regard, note that Schwartz recognizes at column 2, lines 44 through 48 that other means may be provided to hold the cups in assembly with the connector. The resulting modifications to Schwartz would result in a container or package which corresponds to that of claim 1 in all respects. As to claim 3, we are of the view that it also

Appeal No. 96-2392
Application 08/237,789

would have been obvious to the ordinarily skilled artisan to make the halves 10, 10' and connector 20 of Schwartz of the same material as a matter of convenience.

In making this new rejection we took into account the arguments made by appellant in opposition to the examiner's rejections, as they might apply to the new rejection. For the most part, our position with respect to these arguments should be clear from our explanation of the new rejection. We add the following for the sake of providing a complete response to appellant's arguments. As to the claim 1 preamble recitation that the package is "for photographic films wound into cartridges," it is clear that, in this instance, the body of claim 1 is a self contained recitation of the structure of the device not depending for completeness on the preamble recitation (see *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951)). Here, the preamble is merely a statement of intended use which does not serve to distinguish the claimed device over the prior art. *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973) and *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). Furthermore, we see no reason why the container of

Appeal No. 96-2392
Application 08/237,789

Schwartz would not be fully capable of being used to store photographic films wound into cartridges.

Appellant's contention that the Schwartz patent is non-analogous art with respect to the claimed invention (see page 11 of the brief) also is not well taken. Prior art is analogous if it is within the field of the inventor's endeavor or is reasonably pertinent to the particular problem with which the inventor was involved. *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). The Schwartz reference is not within the field of the appellant's endeavor, packages for films wound into conventional cartridges. Because Schwartz is directed to multi-purpose container for holding a plurality of individual items, however, it is reasonably pertinent to the particular problem with which appellant was involved, i.e., to provide a convenient and reusable package for photographic film wound into a cartridge (specification, pages 2 through 4). Thus, Schwartz is analogous prior art which may be taken into account in evaluating the obviousness of the claimed invention.

Appeal No. 96-2392
Application 08/237,789

In summary, each of the examiner's rejections have been reversed, and a new rejection of claims 1 and 3 has been made pursuant to our authority under 37 CFR 1.196(b).

The decision of the examiner is reversed.

The new rejection under 37 CFR 1.196(b) should not be considered final for the purpose of judicial review.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR 1.197. Should appellant elect to have further prosecution before the Examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory

Appeal No. 96-2392
Application 08/237,789

Connolly and Hutz
P.O. Box 2207
Wilmington, DE 19899-2207