

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(2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENZION LANDA
and ODED SAGIV

Appeal No. 1997-2118
Application 08/119,163

HEARD: MARCH 9, 2000

Before HAIRSTON, FLEMING and DIXON, Administrative Patent
Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
36, 39, 43, 45, 47, 49, 51 and 53. Claims 20, 22 through
33, 35 and 54 through 56 have been allowed.

The disclosed invention relates to a dispensing container
for dispensing liquid toner concentrate.

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Claim 36 is the only independent claim on appeal, and it reads as follows:

36. A dispensing container for dispensing a material such as liquid toner concentrate comprising:

a canister;

said movable partition disposed within the canister, movable partition defining a first space containing liquid toner concentrate and a second space between the movable partition and the canister;

for when said a first valve communicating with said first space allowing egress of material from said first space first valve is activated; and

for second the second a second valve communicating with said second space allowing ingress of pressurized fluid into said space when said second valve is activated; wherein the canister is a rigid enclosure having first and second

communication openings in the opposite end portions thereof, said first valve being disposed within said first communication opening and said second valve being disposed within said second communication opening.

The references relied on by the examiner are:

Uhlig 1978	4,098,434	July 4,
Landa 1993	5,208,637	May 4,

(filed Aug. 22, 1990)

Claims 36, 39, 43, 45, 47, 49, 51 and 53 stand rejected under 35 U.S.C. § 103 as being unpatentable over Landa and Uhlig.

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Reference is made to the briefs and the answers for the respective positions of the appellants and the examiner.

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OPINION

The obviousness rejection of claims 36, 39, 43, 45, 47, 49, 51 and 53 is reversed.

According to the examiner (Answer, pages 4 and 5):

[A]ll of the broadly claimed structure of the dispensing container, per se, is disclosed by the patent to Landa except for the use of a second valve in communication with the second space of the canister for allowing the ingress of pressurized fluid into said second space. More specifically, the patent to Landa discloses the use of a rigid canister 70 (Fig. 2) for dispensing a material such as liquid toner wherein a movable partition 74 (Fig. 2) disposed within said canister defines a first space (lower portion of canister) containing liquid toner concentrate and a second space (upper portion of canister) between the movable partition and the canister; and a first valve 92 (Fig. 2) communicating with the first space of the canister for allowing egress of said material or liquid from said first space when said first valve is activated.

With the exception of valves positioned at opposite end portions of the canister, the examiner is of the opinion (Answer, pages 5 and 6) that all of the claimed structure is disclosed by Uhlig.

Based upon the teachings of Landa and Uhlig, the examiner concludes (Answer, pages 8 through 11) that it would have been obvious to one of ordinary skill in the art to simplify

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and reduce the cost of manufacturing the Landa toner dispenser 66, 70 (Figures 1 and 2, respectively) by using a fluid pressure means and cooperating valve means as taught by Uhlig in lieu of the mechanical pressure means 72, 74 and 88 (Figure 2) of Landa. The examiner also concludes (Answer, pages 9 through 11) that it would have been obvious to one of ordinary skill in the art to place the dispensing valve 68 in Uhlig (Figure 8) on the opposite end of the dispenser 55 to use the forces of gravity to aid in the dispensing of the liquid as suggested by Landa.

Appellants argue (Brief, page 16) that the examiner has not presented a convincing line of reasoning that would have led one of ordinary skill in the art to modify the two references to arrive at the claimed invention. According to the appellants (Brief, pages 12, 17 and 18; Reply Brief, pages 6 and 8) there is a complete lack of motivation for making any of the modifications proposed by the examiner. Appellants additionally argue (Brief, page 15) that "the only teaching or suggestion that would lead one having ordinary skill in the art to arrive at Appellants' invention is within Appellants' disclosure."

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We agree with appellants' arguments. Whether or not the modified Landa canister will be cheaper to manufacture and will result in a canister that is simple to operate is purely a matter of speculation on the part of the examiner. Inasmuch as Landa discloses horizontally mounted toner containers 66 (Figure 1), and Uhlig only discloses dispensing nozzles at the top of the fluid dispensers, neither reference before us takes advantage of the "forces of gravity." As a result thereof, the examiner has not shown a teaching of having valves at opposite ends nor has the examiner provided a convincing line of reasoning concerning the same. Thus, in the absence of appellants' disclosed and claimed invention, nothing in the record before us supports the examiner's proposed modifications of the applied references.

In summary, the examiner has not established the prima facie obviousness of the claimed invention.

DECISION

The decision of the examiner rejecting claims 36, 39, 43, 45, 47, 49, 51 and 53 under 35 U.S.C. § 103 is reversed.

REVERSED

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KENNETH W. HAIRSTON)	
Administrative Patent Judge)	APPEALS AND
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

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FLEMING, Administrative Patent Judge, Dissenting:

While I appreciate the position of the Majority, I would have affirmed the rejection of claims 36, 39, 43, 45, 47, 49, 51 and 53 under 35 U.S.C. § 103 as being unpatentable over Landa and Uhlig.

The Majority has not disputed that the Examiner has shown that the combination of Landa and Uhlig teaches all of the claimed structure recited in Appellants' claims. Thus, the only issue is whether the Examiner properly found a suggestion in the prior art to combine Landa and Uhlig. The Federal Circuit states that "[t]he 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, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

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Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), citing In re Rinehart, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in Para-Ordnance Mfg., Inc. V. SGS Importers Int'l, Inc., 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996), that for the determination of obviousness, the Court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." Id., 73 F.2d at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1552-53, 220 USPQ 303, 311-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In addition, our reviewing Court requires the Patent and Trademark Office (PTO) to make specific findings on a suggestion to combine prior art references. In re Dembiczak, 175 F.3d 994, 1000-01, 50 USPQ2d

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1614, 1617-19 (Fed. Cir. 1999).

It is the Majority's opinion that the Examiner is merely speculating that the Landa canister will be cheaper to manufacture and will result in a canister that is simple to operate. The majority also places great weight on the Examiner's comment that it would have been obvious to one of ordinary skill in the art to place the dispensing valve 68 in Uhlig on the opposite end of the dispenser 55 to use the force of gravity to aid in dispensing of the liquid as suggested by Landa.

While I agree with the Majority that the Examiner's statements are misleading, I note that the Examiner states on page 8 of the Examiner's Answer that it would have been obvious to one of ordinary skill in the art to modify the Landa container 66 shown in Figure 2 by replacing the Landa's mechanical pressure means 72, 74 and 88 with the Uhlig's pressure means 64, 65 and 63 shown in Figure 8 to obtain Appellants' claimed invention. The Examiner's stated reason that one of ordinary skill in the art would have a desirability to do this modification is to reduce the cost of manufacturing the dispenser system.

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I note that Landa teaches in column 2, lines 43 through 44, that the preferred embodiment of the invention is to include a replaceable enclosure which is the container 66 shown in Figure 2. Landa further teaches that container 66 is replaced by a fully charged container in column 6, lines 67 and 68. Thus, the Landa container 66 is a disposable item. Uhlig teaches in column 1, lines 36 through 40 that one of the problems of prior art throw away dispensers is that it creates an additional economic problem of garbage or trash disposal. Uhlig further teaches that the cost of the dispenser structure is high when the dispenser includes sophisticated type designs. I note that Landa's dispenser structure is a sophisticated design wherein the throw away dispenser is a metal container including the mechanical pressure means. Uhlig teaches in column 1, lines 58 through 63, that their invention provides an inexpensive flexible bag to hold the dispensing product. After the product is dispensed, the inner bag may be easily disposed of and replaced. Uhlig teaches that their invention provides ecological advantages since only the inner bag has to be thrown away. From these teachings, I would have found that one of ordinary skill in the art would

