

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN A. BRIDGES

Appeal No. 97-4166
Application No. 08/478,647¹

ON REHEARING

Before CALVERT, MEISTER and GARRIS, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

ON REQUEST FOR REHEARING

The appellant requests we reconsider our decision mailed on September 16, 1998 wherein we (I) affirmed the rejection of claims 86, 88, 89, 95, 97 and 99 under 35 U.S.C. § 102(b) as

¹ Application for patent filed June 7, 1995. According to appellant, this application is a continuation of Application No. 07/980,113 filed November 23, 1992, now U.S. Patent No. 5,465,891 issued November 14, 1995; which is a continuation of Application No. 07/704,024 filed May 22, 1991, now abandoned.

Appeal No. 97-4166
Application No. 08/478,647

being anticipated by Parish, (II) reversed the rejection of claim 98 under 35 U.S.C. § 102(b) as being anticipated by Parish, (III) reversed the rejection of claims 86, 88-90, 95 and 97-100 under 35 U.S.C. § 102(b) as being anticipated by McKee, (IV) affirmed the rejection of claims 1, 54-57, 66-71, 73, 75-81, 83-86 and 88-96 under 35 U.S.C. § 103(a) based on the combined teachings of Hummer and McKee, (V) reversed the rejection of claims 72 and 97-100 under 35 U.S.C. § 103(a) based on the combined teachings Hummer and McKee, (VI) affirmed the rejection of claims 58 and 62 under 35 U.S.C. § 103(a) based on the combined teachings of Hummer, McKee and Fluharty and (VII) made a new rejection of claim 100 under 35 U.S.C. § 102(b) pursuant to our authority under the provisions of 37 CFR § 1.196(b). The request is apparently directed to our affirmance of rejections (I), (IV) and (VI), and to the new rejection of claim 100 (rejection (VII)). We have carefully reconsidered our decision in light of the arguments advanced; however, we find nothing therein to convince us that the decision was in error except that a typographical error

Appeal No. 97-4166
Application No. 08/478,647

appeared in line 19 of page 17 wherein "30" should have been -
- 36 --.

As to rejection (I) the appellant argues that there is "no teaching or suggestion in PARISH of any wedging means that is designed to achieve any wedging action" (request, page 14); however, this matter was fully treated on pages 5-7 of our decision. Moreover, as we pointed out with respect to the teachings of Parish on page 7 of our decision, in Parish

there is a sound basis to conclude that there will inherently be a two-point, spaced contact occurring at the wall 28 and "wedging means" 36 when the cup 14 is subjected to a tilting action in the manner claimed (including allowing "generally no more than eight degrees" tipping as set forth in dependent claim 88), and the burden shifts to the appellant to prove that it does not. *See, e.g., In re Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1432; *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 597 (CCPA 1980); and *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

Here, the appellant simply ignores this burden and argues that the arrangement of Parish does not result in a wedging action; however, counsel's arguments in the brief cannot take the place of evidence. *See In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), *In re Payne*, 606 F.2d 303,

Appeal No. 97-4166
Application No. 08/478,647

315, 203 USPQ 245, 256 (CCPA 1979) and *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

The appellant argues that surface 30 of Parish cannot be considered to be "substantially vertical" as set forth in independent claims 96 and 97. We must point out, however, that no such argument was advanced in the brief or reply brief, and the presentation of arguments for the first time in a request for rehearing (formerly reconsideration) is improper. *See In re Kroekel*, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed. Cir. 1986) and *Ex parte Hindersinn*, 177 USPQ 78, 80 (Bd. App. 1971). See also 37 CFR § 1.192(a):

Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences unless good cause is shown.

Accordingly, this argument will not be considered. Moreover, even if such an argument had been made, we are of the opinion that the lower portion of Parish's member 30 can be considered to be "substantially vertical" as broadly claimed.² This is

² The terminology in a pending application's claims is to be given its broadest reasonable interpretation. *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322

Appeal No. 97-4166
Application No. 08/478,647

particularly the case since the appellant's "substantially vertical surface" that is radially disposed inwardly from the container's outer surface appears to not be truly vertical (see, e.g., Fig. 5). In this regard, it should be noted that this radially inwardly disposed surface is depicted in Fig. 5 as closely conforming to the inwardly disposed surface 51 of the beverage container or can 50, which surface according to the appellant's own exhibit (the exhibit submitted with Paper No. 19, filed on April 29, 1997) has a significant departure from a truly vertical surface.

As to rejection (IV), the appellant urges that the limitation of wedge should be given its "normal and accustomed meaning," and cites a dictionary definition as authority for the contention that a "wedge" or "wedging means" as set in independent claims 1, 70, 81 and 86 requires "forcing or driving (an object) into something where it is tightly held" (request, page 3). It is, of course, true that "when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, ***unless it appears from***

(Fed. Cir. 1989).

Appeal No. 97-4166
Application No. 08/478,647

the specification or file history that they were used differently by the inventor" (emphasis added), *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Here, however, throughout the specification the appellant has used the terminology "wedge" or "wedging means" to mean that the beverage container contacts the holder at first and second points P1, P2 and thereby is **restrained from further or additional tipping** (see, e.g., page 4, lines 1 and 2; page 8, lines 10 and 11). Indeed, if the beverage container or can was "tightly held" as the appellant now argues, the beverage can, once tilted, would be tightly held in this tilted position and would not return to a vertical position and be "loosely disposed" in the cavity and removable therefrom in a vertical direction "without substantial frictional resistance" in the intended manner (see the arguments on page 8 of the request). For the reasons stated on pages 11 and 12 of our decision, we remain of the opinion that Hummer teaches a wedge or wedging means in the same sense as used in the specification.

Appeal No. 97-4166
Application No. 08/478,647

The appellant argues that we ignored the limitations in claims 57 and 91-96 which require that the relative diameters of the holder and beverage container are such that the beverage container is "loosely disposed" in the cavity and removable therefrom in a vertical direction "without substantial frictional resistance." However, we carefully pointed out on page 13 of our decision that Hummer in Fig. 7 clearly illustrates that the cavity (unnumbered in Fig. 7, but identified by the numerals 66, 68 in Fig. 6) of the holder is ***slightly larger*** than the beverage can 72. In view of this teaching, we do not believe that it can be seriously contended that Hummer's beverage can is not "loosely disposed" in the cavity and removable therefrom in a vertical direction "without substantial frictional resistance." In fact, as we expressly pointed out on page 14 of our decision

Hummer in Fig. 7 clearly shows the beverage container or can to be spaced from the wall of the cavity. Indeed, the appellant even relies upon this space or clearance in the "blow-up" of Fig. 7 on page 34 of the brief in order to achieve the depicted tilting movement of the beverage container or can. If such clearance did not exist, the beverage container or can could not be tilted in the manner depicted. The appellant simply cannot have it "both ways" as he is attempting to do.

Appeal No. 97-4166
Application No. 08/478,647

The appellant also argues that the element 64 of Hummer should not be considered to be a part of the "wall;" however, this matter was fully treated on page 12 of our decision.

With respect to claims 79, 83 and 88 the appellant argues that on pages 13 and 14 of our decision we improperly held:

the provision of eight degrees vis-à-vis the angle depicted in the "blow-up" of Fig. 7 of Hummer on page 34 of the brief solves no stated problem insofar as the record is concerned, leading us to conclude that such a provision is an obvious matter of design choice. **See *In re Kuhle***, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975).

According to the request, "in order to be an obvious design choice there must be motivation in the prior art to modify the prior art structure" (page 10), apparently reciting ***In re Antonie***, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) as authority for such a notion. ***Antonie***, however, was more narrowly concerned with the determination of the optimum or workable ranges in a recognized result-effective variable and does not stand for the broad proposition that the appellant attributes to it. As the court stated in ***In re Woodruff***, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990):

Nor can patentability be found in the difference in . . . ranges recited in the claims. The law is

Appeal No. 97-4166
Application No. 08/478,647

replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims These cases have consistently held that in such a situation, the applicant must show that the particular range is **critical**, generally by showing that the claimed range achieves unexpected results relative to the prior art range [Citations omitted.]

Here, the appellant merely broadly states in line 13 of page 8 of the specification that the "can 50 can only tip between 3E and 8E," but mentions no reason why such a range is important vis-à-vis other ranges (for example, the angle depicted in the "blow-up" of Fig. 7 of Hummer on page 34 of the brief). Apparently, the range is simply one that is "preferred;" however, "[m]erely because appellant's specification denotes those limitations as 'preferred' does not, without more, establish them as critical," ***In re Rauch***, 390 F.2d 760, 762, 156 USPQ 502, 503 (CCPA 1968). Insofar as the record is concerned, the angular range through which the beverage container is allowed to tilt, does "not specify a device which perform[s] and operate[s] any differently from the prior art," ***Gardner v. TEC Systems, Inc.*** 725 F.2d 1338, 1349, 220 USPQ 777, 786 (Fed. Cir. 1984), ***cert. denied***, 469 U.S. 830, 225

Appeal No. 97-4166
Application No. 08/478,647

USPQ 232 (1984). **See also *In re Troiel***, 274 F.2d 944, 948-49, 124 USPQ 502, 505 (CCPA 1960).

It is also the appellant's contention that our decision improperly indicated that Hummer fairly suggests a cavity that has a diameter of "approximately 2.165 inches" as set forth in claim 71. We disagree for the reasons stated on page 13 of our decision. In this regard, we observe that there is no claim limitation which requires that the "wall" be of this diameter throughout its entire height and, thus, there is no claim limitation which precludes the arrangement of Hummer wherein the lower portion of the wall has such a diameter. It is well settled that features not claimed may not be relied upon in support of patentability. ***In re Self***, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

With respect to rejection (VI), the appellant broadly asserts that there is no motivation to combine the teachings of Hummer and Fluharty; however, this argument was fully addressed on pages 16 and 17 of our decision.

Finally, as to rejection (VII), the appellant argues that surface "30" is on the base, rather than on the container as

Appeal No. 97-4166
Application No. 08/478,647

claimed. However, as we have noted above, this was a typographical error and "30" should have been -- 36 --. The surface 36 of Parish is clearly on the container and, for the same reasons set forth above concerning the surface 30 in rejection (I), can be considered to be "substantially vertical."

The appellant's request is granted to the extent of reconsideration and modification of the decision with respect to the above-noted typographical error, but is denied with respect to making any other changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES

Appeal No. 97-4166
Application No. 08/478,647

BRADLEY R. GARRIS)
Administrative Patent Judge)

bae

Appeal No. 97-4166
Application No. 08/478,647

Greenblum & Bernstein
1941 Roland Clarke Place
Reston, VA 20191