

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH L. BERGER

Appeal No. 1998-2066
Application No. 08/315,629

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
NASE and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1 through 20. These claims constitute all of the claims pending in this application.

The appellant submitted two amendments (Paper Nos. 29 and 36) subsequent to the final rejection, but neither amendment has been entered. See the Advisory Actions mailed November 7, 1997

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(Paper No. 34) and December 18, 1997 (Paper No. 37).

We AFFIRM-IN-PART.

The subject matter on appeal is directed to a beverage can "which facilitates comfortable dribble-free consumption of the contained beverage" (specification, page 2). A substantially correct copy of claims 1 through 20 appears in an appendix attached to the brief.¹ Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A beverage container comprising:

a circular top portion secured to a cylindrical wall by a rim, said top portion having means including said rim and to provide an opening for consumption of a beverage in said container;

an indentation extending from said rim along said wall at least for a distance equal to the distance said opening in said top portion is spaced from said rim, said indentation being positioned below said rim at a location adjacent said opening in said top, and within the surface area of said indentation there being no portion extending away from the interior volume of said beverage container beyond where said indentation and said wall meet.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kohnle	Des. 282,442	Feb. 04, 1986
Carmichael	3,420,367	Jan. 07, 1969
Brown	4,024,981	May 24, 1977

¹ Claim 14, as reproduced on pages iv and v of the appendix, contains a typographical error. The first line on page v should read "sidewall positioned between said bottom and said top, said."

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Yu	4,925,050	May 15, 1990
Muller	5,301,830	Apr. 12, 1994
		(filed Apr. 03, 1992)

The following rejections are before us for review:

(I) claims 1 through 4 and 8 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention;

(II) claim 7 stands rejected under 35 U.S.C. § 135(b) as not having been made prior to one year from the date on which the Muller patent was granted;

(III) claims 1, 7 and 14 through 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kohnle;

(IV) claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Yu.

(V) claim 7 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Muller.

(VI) claims 1 through 6, 8, 9, 11, 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carmichael in view of Brown; and

(VII) claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohnle in view of Brown.

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The full text of the examiner's rejections and the responses to the arguments presented by the appellant appears in the answer (Paper No. 35), while the complete statement of the appellant's arguments can be found in the brief (Paper No. 28).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Rejection (I)

The examiner's reasons for rejecting the claims are found in the answer at pages 3 and 4. The amendments filed subsequently to the final rejection were intended to avoid the rejection under 35 U.S.C. § 112, second paragraph (brief, pages 1 and 4). However, the amendments have not been entered, supra. Since the appellant does not contest this ground of rejection, we are constrained to sustain this rejection.

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Rejection (II)

Appealed claim 7 stands rejected on the ground that it is barred to the appellant by 35 U.S.C. § 135(b) because it was made on June 2, 1995 (see Paper No. 4), more than one year after the April 12, 1994 issuance date of the Muller patent, and the appellant was not claiming "the same" or "substantially the same subject matter" at some time prior to one year after the issuance of the Muller patent. Specifically, the examiner determined in the final rejection mailed June 10, 1997 (Paper No. 25, page 4) that appellant's original claims 1 through 5 were substantially different from claim 1 of the Muller patent, because the appellant's original claims 1 through 5 did not contain any language directed to "a circumferential groove having a first radial depth and a second radial depth extending further radially inwardly than said first radial depth."

The appellant asserts (brief, page 11) that his original claims 1 through 5 are for substantially the same subject matter as appealed claim 7 and were pending before the Office during the "critical period."

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For purposes of comparison, appealed claim 7, which corresponds to claim 1 of the Muller patent, as well as the appellant's original claims 1 and 5 are reproduced in an appendix attached to this decision.

In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim. Corbett v. Chisholm, 568 F.2d 759, 766, 196 USPQ 337, 343 (CCPA 1977); In re Sitz, 331 F.2d 617, 625, 141 USPQ 505, 511 (CCPA 1964); Stalego v. Heymes, 263 F.2d 334, 335, 120 USPQ 473, 475 (CCPA 1959). The fact that the application claim may be broad enough to cover the patent claim is not sufficient. In re Frey, 182 F.2d 184, 186-187, 86 USPQ 99, 102 (CCPA 1950).

Our review of the file history of the Muller patent reveals that the "circumferential groove having a first radial depth and a second radial depth" limitation at issue is material. Muller inserted this limitation in his claim 1 in response to, and to avoid, a prior art rejection by the examiner. In the remarks accompanying the amendment adding the limitation, Muller stated that the amendment included language conforming "to arguments previously presented for distinguishing the present invention

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over the prior art" (Paper No. 12, filed July 2, 1993). See also the "Examiner Interview Summary Record," (Paper No. 11, mailed July 2, 1993). The insertion of this limitation to overcome the examiner's prior art rejection is strong, if not conclusive, evidence of materiality. Parks v. Fine, 773 F.2d 1577, 1579, 227 USPQ 432, 434 (Fed. Cir. 1985).

On comparison of claim 7 and the appellant's original claims 1 through 5, we agree with the examiner that the subject matter of original claims 1 through 5 is directed to an invention that is not substantially the same as the invention claimed in claim 7. We find that none of the appellant's original claims 1 through 5 contains any express language directed to "a circumferential groove having a first radial depth and a second radial depth extending further radially inwardly than said first radial depth," which limitation we think is a material part of the subject matter of claim 7 based on the file history of the Muller patent, supra.

In view of the above, the rejection of claim 7 based on 35 U.S.C. § 135(b) will be sustained.

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Rejection (III)

We next turn to the examiner's rejection of claims 1, 7 and 14 through 18 based on 35 U.S.C. § 102(b) as being anticipated by Kohnle. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). After fully considering the Kohnle reference, we agree with the examiner that the subject matter of claim 1 is anticipated by the reference, but that Kohnle does not anticipate claims 7 and 14 through 18.

The examiner describes Kohnle as disclosing

. . . a beverage container comprising a circular top secured to a cylindrical wall by a rim, an opening provided by a pull tab in the top, a radially inwardly extending circumferential groove having at least a first radial depth and an indentation extending in part into the circumferential groove (see figures 7 and 13) extending inwardly a second radial depth greater than the radial depth of the circumferential groove (see figures 8 and 14). (Answer, pages 6 and 7)

The appellant argues that the rejection of claim 1 is moot in view of the amendments filed subsequent to the final rejection adding the limitation, "an indentation in a portion of said rim" (brief, page 6).

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The amendments filed subsequently to the final rejection have not been entered, supra, and, thus, the limitation referred to by the appellant is not present in claim 1. Since the appellant does not otherwise contest the § 102 rejection of claim 1 based on Kohnle, we are constrained to sustain this rejection.

With respect to claim 7, the appellant argues that Kohnle does not show or describe a pull tab as recited in the claim (brief, page 7). We agree. The top of the beverage can disclosed in Kohnle is shown in Figures 4, 10 and 16. We cannot locate a pull tab in any of those figures and the examiner has not informed us where a pull tab can be found in Kohnle.

The appellant also argues that Kohnle fails to show a "second" indentation in the container sidewall which (a) includes the joint securing the top to the upper portion of the sidewall and the ridge and (b) extends continuously downward from the top as recited in claim 14 (id. at 6). Again, we agree with the appellant. The rim or joint securing the top and the upper portion of the sidewall is not shown as being flat or indented in any of Figures 4, 10 and 16 of Kohnle. Further, the "second" indentation in each of the embodiments shown in Kohnle is spaced

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from the top, i.e., a portion of the ridge is shown between the top and the edge of the indentation nearest to the top. Thus, the "second" indentation of the reference does not extend "continuously downward from said top" as required by claim 14.

In view of the above, the rejection of claims 7 and 14 under 35 U.S.C. § 102(b) as being anticipated by Kohnle will not be sustained. Claims 15 through 18 are dependent on claim 14 and, therefore, contain all of the limitations of that claim. Thus, it follows that we will also not sustain the rejection of claims 15 through 18.

Rejection (IV)

The examiner describes Yu as teaching

a beverage can comprising a circular top 2 joined by a rim to a cylindrical side wall 1, a means to provide an opening 4 and a mouth conforming indentation formed in the side wall located adjacent the opening (see figure 2). (Answer, page 7)

The appellant argues that

Yu does not appear to describe a can having a "rim" [n]or does Yu describe a can with a top portion "having means including an indentation in a portion of said rim . . .", etc. as required by claim 1. (Brief, page 7) (Emphasis original)

Our review of Yu reveals that the reference clearly discloses a beverage container comprising a circular top portion

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secured to a cylindrical wall by a rim.² Yu's sidewall or lateral portion is shown as joining the top portion at the edge of the top portion. The fact that Yu does not show the rim or edge as being indented is of no moment, since claim 1 on appeal contains no such requirement.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Yu will be sustained.

Rejection (V)

Appealed claim 7 also stands rejected under 35 U.S.C. § 102(e) as clearly anticipated by Muller. The examiner points out that claim 7 is identical to claim 1 of the Muller patent.

The appellant argues that the § 102(e) rejection is avoided by virtue of a 37 CFR § 1.131 declaration of the appellant.

The argument is not well taken. 37 CFR § 1.131(a)(1) reads, in part:

When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. 102(a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in Section 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the

² Webster's Third New International Dictionary of the English Language, Unabridged, G. & C. Merriam Co., Springfield, MA, 1971 defines "rim" as "1a. the outer often curved or circular edge or border of something."

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subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. (Emphasis added)

As clearly expressed in § 1.131, an affidavit or declaration under § 1.131 may not be used to overcome a rejection based on a patent which qualifies as prior art under 35 U.S.C. § 102(e), if the claim under rejection and the patent claim the same patentable invention. The appellant does not dispute that rejected claim 7 and claim 1 of the Muller patent claim the same patentable invention or that the Muller patent qualifies as prior art under 35 U.S.C. § 102(e). Therefore, the appellant's § 1.131 declaration may not be used to overcome the 35 U.S.C. § 102(e) rejection based on the Muller patent. The appellant's only recourse is an interference proceeding. Unfortunately, as a result of the appellant's failure to claim the same or substantially the same subject matter within one year of the issuance of the Muller patent, an interference proceeding is barred by 35 U.S.C. § 135(b) (see Rejection (II), supra).

Accordingly, we are constrained to sustain the § 102(e) rejection of claim 7 based on the Muller patent.

Rejection (VI)

We will next consider the § 103(a) rejection of claims 1 through 6, 8, 9, 11, 13 and 20 based on Carmichael in view of Brown.

Each of independent claims 1, 5, 8 and 20 recites a beverage container having an indentation along or in the cylindrical wall or sidewall. At pages 8 and 9 of the brief, the appellant disputes the examiner's determination (answer, page 7) that Carmichael teaches "an indentation 10 and a flattened rim portion 14."

We agree with the appellant that Carmichael neither teaches nor suggests an indentation in the sidewall 10. In the embodiment illustrated in Figure 1, Carmichael actually discloses a container having a circular³ sidewall 10 and flattened chimes or rims 11 and 11a. There is simply no teaching or suggestion in Carmichael of an indentation in the sidewall 10. In fact, one of the purposes of the flat surfaces on adjacent chimed caps taught by Carmichael is to eliminate the possibility of indentations in the sidewall (col. 2, lines 49-53).

³ See col. 3, line 20 and col. 4, line 5.

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We have also considered the Brown reference, but find no teaching or suggestion therein that makes up for the deficiencies of Carmichael noted above. It therefore is our conclusion that the combined teachings of Carmichael and Brown fail to establish a prima facie case of obviousness with regard to the subject matter of independent claims 1, 5, 8 and 20, and, it follows, of dependent claims 2 through 4, 6, 9, 11 and 13.

Accordingly, the § 103(a) rejection of claims 1 through 6, 8, 9, 11, 13 and 20 based on Carmichael in view of Brown will not be sustained.

Rejection (VII)

Finally, we turn to the § 103(a) rejection of claim 17 based on Kohnle in view of Brown.

Claim 17 is dependent on claims 14 and 15, and therefore, includes the limitations in claim 14 found lacking in Kohnle (see Rejection (III), supra). The Brown reference does not make up for the deficiencies of Kohnle. It therefore is our conclusion that the combined teachings of Kohnle and Brown fail to establish a prima facie case of obviousness with regard to the subject matter of dependent claim 17.

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Accordingly, the § 103(a) rejection of claim 17 based on Kohnle in view of Brown will not be sustained.

SUMMARY

The decision of the examiner to reject claims 1 through 4 and 8 through 20 under 35 U.S.C. § 112, second paragraph, is affirmed.

The decision of the examiner to reject claim 7 under 35 U.S.C. § 135(b) is affirmed.

The decision of the examiner to reject claims 1, 7 and 14 through 18 under 35 U.S.C. § 102(b) as being anticipated by Kohnle is affirmed with respect to claim 1, but reversed with respect to claims 7 and 14 through 18.

The decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) as being anticipated by Yu is affirmed.

The decision of the examiner to reject claim 7 under 35 U.S.C. § 102(e) as being anticipated by Muller is affirmed.

The decision of the examiner to reject claims 1 through 6, 8, 9, 11, 13 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Carmichael in view of Brown is reversed.

The decision of the examiner to reject claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Kohnle in view of Brown is reversed.

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The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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APPENDIX

Claim 7

In a container that is in the form of a beverage-containing can and has a top, bottom, and side portion interconnecting said top and bottom, with said top being provided with opening means for providing to a consumer access to contents of said can, the improvement wherein:

said side portion is provided with a circumferential groove having a first radial depth and a second radial depth extending further radially inwardly than said first radial depth, said groove being disposed adjacent to said can, with said second radial depth having a shape that is essentially adapted to a lower lip anatomy of a consumer;

said opening means includes a pull tab for removing a pull-out section to form a pour-out hold [sic: hole]; and

said second radial depth being disposed only in the immediate vicinity of said pour-out hole.

Original Claim 1

A beverage container comprising:

a circular top portion secured to a cylindrical wall by a rim, said top portion having means to provide an opening for consumption of a beverage in said container;

an indentation means extending from said rim along said wall at least for a distance equal to the distance said opening in said top portion extends from said rim portion, said indentation means being positioned below said rim at a location adjacent said opening in said top, and within the surface area of said indentation means there being no portion extending away from the interior volume of said beverage container beyond where said indentation means and said wall portion meet.

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Original Claim 5

A beverage container comprising a flat top portion having a perimeter, a wall portion jointed to said perimeter of said top portion,

said top portion having means to provide an opening for consumption of a contained beverage from said container,

said container further comprising an indentation in said top portion to accommodate the nose of a consumer of a contained beverage from said container, and

an indentation in said wall portion to accommodate the lower lip of a consumer of a beverage from said container.