

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID R. SERGEANT

Appeal No. 98-2414
Application 08/507,339¹

ON BRIEF

Before COHEN, FRANKFORT and NASE, Administrative Patent
Judges.

¹ Application for patent filed October 2, 1995. According to appellant, the application is a National stage application under 35 U.S.C. § 371 of PCT GB94/00335, filed February 18, 1994.

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FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 through 16 and 25 through 27. Claims 17 through 24, the only other claims remaining in the application, have been objected to, but are indicated to be allowable subject to the requirement that they be rewritten in independent form to include all the limitations of the claim(s) from which they depend. Claims 1 through 11 have been canceled.

Appellant's invention is directed to a sheet material end closure for a container, such as a beverage container, and to a method for forming said container end closure. Independent claims 12 and 26 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

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

Faulkner (British specification)	609,907	Oct. 8, 1948
Saunders (PCT)	WO 91/09784	July 11, 1991

Claims 12 through 16 and 25 through 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saunders in view of Faulkner.

Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 18, mailed January 9, 1998) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 17, filed December 15, 1997) and reply brief (Paper No. 19, filed February 28, 1998) for appellant's arguments thereagainst.

OPINION

In arriving at our decision in this appeal, we have carefully considered appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the rejection of claims 12 through 16 and 25 through 27 under 35 U.S.C. § 103 before us on appeal cannot be sustained. Our reasoning for this determination follows.

In the present case, the examiner has taken the position (answer, page 3) that

Faulkner teaches a punching and drawing process which is used to form metallic hollow objects from sheet material which is the basic process used to form metal containers and end walls in the container industry. Faulkner specifically states that in the punching and drawing process, that material which is deformed from the flat material (i.e. the material of the closure other than the center panel) becomes thinner. It is therefore obvious to one having ordinary skill in the art that the end closure of Saunders which is formed by a process based upon the Faulkner process would inherently possess [sic] a center panel which was thicker than the

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portions of the closure outside of the center panel.

Contrary to the examiner's view, there is no evidence in this record that the end closure of the metal container seen in Saunders "is formed by a process based upon the Faulkner process." While Saunders refers to a "shell forming stage" (page 4) there are no details of exactly what constitutes such a shell forming stage and certainly no indication that the shell forming stage of Saunders is in any way "based upon the Faulkner process," as the examiner urges. Moreover, as appellant has argued and demonstrated in the brief and reply brief, even if the end closure of Saunders may have been formed by a punching and

drawing process, the evidence before us in this case is woefully inadequate to support the examiner's position that the end closure of Saunders formed by such a process would "inherently possess [sic] a center panel which was thicker than the portions of the closure outside of the center panel." Like appellant, we particularly note that the Taube et al.

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patent attached to the appeal brief and Exhibit B attached to the reply brief weigh heavily against the examiner's asserted position on inherency. We also note the lack of any response from the examiner addressing the evidence submitted by appellant.

It is our view that the examiner's position with regard to the formation of the end closure of Saunders is based on conjecture, speculation and hindsight reasoning. One of ordinary skill in the art viewing the Saunders disclosure and that of Faulkner (relating to kitchen and cooking utensils) would not have been led to the inevitable conclusion that the end closure of the container in Saunders would have the configuration claimed by appellant in independent claims 12 and 26 on appeal. See In re Oelrich, 666 F.2d 578, 212 USPQ 303 (CCPA 1981). This conclusion is bolstered by the fact that Figures 9, 10 and 14 of Saunders each show the end closure therein as having a generally

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uniform thickness in the central region and the outer annular rim or edge portion thereof (e.g., near 21). Since this important feature of appellant's claimed subject matter is not explicitly present in the Saunders reference, and is not inherent therein, even when the teachings of Saunders are considered in light of Faulkner, we cannot sustain the examiner's rejection of claims 12 through 16 and 25 through 27 under 35 U.S.C. § 103.

In summary, the decision of the examiner rejecting claims 12 through 16 and 25 through 27 under 35 U.S.C. § 103 has been reversed.

REVERSED

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	APPEALS AND

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