The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DOMENIC BELCASTRO

Appeal No. 2004-0235
Application No. 09/873,583

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 to 24, 29, 30 and 37 to 41.[1] Claims 25 to 28 and 31 to 36 have been objected to as depending from a non-allowed claim. Claims 1 to 20 have been canceled.

We REVERSE.

[1] While the examiner has approved entry of the amendment after final rejection to claim 41 (Paper No. 10, filed September 12, 1995), we note that this amendment has not been clerically entered.

BACKGROUND

The appellant's invention relates to a sealable cup for holding and dispensing drinkable fluids. More particularly, the invention relates to an improved arrangement for a sealable cup which seals automatically to prevent spillage of fluids therefrom when the cup is not in use (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Hughes	2,107,442	Feb. 8, 1938
Grimard	5,702,019	Dec. 30, 1997
Bachman et al. (Bachman)	5,890,621	Apr. 6, 1999

Claim 30 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Hughes.

Claims 21 to 23, 29 and 37 to 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hughes in view of Grimard.

Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hughes in view of Grimard and Bachman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 18, mailed April 22, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 17, filed January 28, 2003) and reply brief (Paper No. 19, filed June 26, 2003) for the appellant's arguments thereagainst.

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 make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claim 30 under 35 U.S.C. § 102(e).

To support a rejection of a claim under 35 U.S.C. § 102(e), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 30 reads as follows:

> A self-sealing drinking container, comprising:
> a cup body having a hollow interior for holding and dispensing a liquid;
> a lid assembly sealingly engagable with said cup body, said lid assembly having a first opening;
> a first valve housed within a first cage member which is removably located in said first opening for selectively sealing said first opening, said first valve comprising:
>> a first valve seat;
>> a flexibly resilient first diaphragm member seated at said first valve seat, said first diaphragm member having a central hub portion protruding from a surface opposite said first valve seat;
>> a first locator having a first portion and a second portion, said second portion being disposed in said raised central hub portion of said first diaphragm member; and
>> wherein said first diaphragm member is sealingly seated at said first valve seat below a first predetermined level of fluid pressure differential applied thereon.

Hughes' invention relates to feeding bottles and attachments therefor for use by infants, invalids or animals. Figures 1-5 show one embodiment of Hughes' invention in which a body fitment is shaped for insertion in or attachment to the mouth of a bottle 2 in any suitable way to divide the space bounded by the bottle and a teat 3 into two chambers 4, 5 conveniently referred to hereinafter as the bottle chamber and the teat chamber. The former acts as a reservoir from which the supply of milk or other liquid food is drawn, while the latter acts as a pumping chamber. In the illustrated form, the body fitment consists of a tapered plug 6 to fit in the bottle mouth and "make joint" therewith, without or with a flange 7 at the outer part to abut against the outer face of

the mouth of the bottle. The dimensions if desired being such that the flange 7 is or may be surrounded and held in position by the large end of the teat. Communication between the chambers is effected by one or more passages 9 which connect the inner face of the plug 6 next to the bottle chamber with the outer face and are controlled by a one-way device or valve such as rubber disc 10 which moves in the manner of a flap to open or seal the outer ends of the passages 9 at the appropriate times. The rubber disc 10 is anchored to a central pin 11 via a peripheral groove 12. The inner end of the pin 11 is provided with a retaining head 13.

The appellant argues (brief, pp. 8-9) that Hughes does not anticipate claim 30 since Hughes does not disclose the claimed central hub portion. We agree. Claim 30 requires the first valve to include, inter alia, a flexibly resilient first diaphragm member having a central hub portion protruding from a surface opposite the first valve seat and the second portion of the first locator to be disposed in the raised central hub portion of the first diaphragm member. As clearly shown in Figures 1 and 4, Hughes' rubber disc 10 does not have the claimed central hub portion protruding from a surface opposite the first valve seat and in which the second portion of the first locator is disposed. The examiner's position (answer, p. 6) that the claimed flexibly resilient first diaphragm member having a central hub portion is readable on Hughes' rubber disc 10 and the rounded outer end of pin 11 (i.e., the end of pin 11 remote from the retaining head 13

and beyond groove 12) is without merit and even if correct would still not anticipate claim 30 since the limitation that the second portion of the first locator is disposed in the raised central hub portion of the first diaphragm member would not be met.

For the reasons set forth above, the decision of the examiner to reject claim 30 under 35 U.S.C. § 102(e) is reversed.

The obviousness rejections

We will not sustain the rejections of claims 21 to 24, 29 and 37 to 41 under 35 U.S.C. § 103.

Claims 21 to 24, 29 and 37 to 41 all include the limitation that the diaphragm member has a plurality of stiffening ribs formed thereon. In the rejections under 35 U.S.C. § 103 (answer, p. 3) the examiner ascertained that Hughes' rubber disc did not have the claimed stiffening ribs and concluded that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have provided Hughes' rubber disc with the stiffening ribs in view of the teachings of Grimard.

The appellant argues that the teachings of Grimard would not have suggested modifying Hughes' rubber disc to include stiffening ribs. We agree.

Grimard's invention relates to a vial having a resealable membrane assembly activated by a medical delivery device for efficient transfer of fluid to or from a vial. The resealable membrane assembly features a membrane 40 which is displaceable between an open position (Figures 3, 6, 7) and a closed position (Figures 2, 4) relative to vial 10. When the membrane is disposed in its open position, a fluid path 54 is established between luer tip 62 and open top 12 of the vial, permitting free fluid flow between syringe 60 and the interior of vial 10. Likewise, fluid path 54 is closed when membrane 40 is returned to its closed position, preventing fluid flow through luer connector hub 32, and isolating the interior of vial 10 from the ambient environment. To facilitate fluid flow between luer tip 62 and open top 12 of the vial, one or more fluid channels 45 are defined between ribs 47 on central area 42 of membrane 40. Fluid channels 45 form part of fluid path 54 openable between luer tip 62 and open top 12 of the vial. Fluid channels 45 effectively communicate fluid supplied or aspirated via luer tip 62 with portions of membrane 40 outside of central area 42.

In our view, the teaching of Grimard to provide a membrane with ribs to define fluid channels does not provide the necessary teaching or suggestion[2] to have made it

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[2] When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. See In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted).

obvious at the time the invention was made to a person of ordinary skill in the art to have modified Hughes' rubber disc to include stiffening ribs. Thus, the only suggestion for modifying Hughes in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 21 to 24, 29 and 37 to 41 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 30 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 21 to 24, 29 and 37 to 41 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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