

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES CHANG and LUCY CHANG

Appeal No. 2005-1013
Application 09/767,155

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's non-final rejection (in Paper No. 11) of claims 1 through 7, all of the claims pending in this application.

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As noted on page 1 of the specification, appellants' invention relates to beverage cans for soft drinks, beer, juices and the like with an easy open lid, wherein the lid includes a score line with a particular relationship with the puncture point and contact point resulting in the required lifting force being reduced and thereby permitting a smaller pull-tab and a thinner gauge metal to be used. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix filed January 27, 2005 (Paper No. 19).

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

Perry	4,084,721	Apr. 18, 1978
Neiner	6,234,336	May 22, 2001

Claims 1 through 7 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the examiner considers that the limitation of "said lid having a diameter less than the cylindrical container" added to claim 1, lines 2-3, lacks any support in the originally filed specification and claims.

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Claims 1 through 7 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Perry in view of Neiner.

Rather than reiterate the full details of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we refer to the examiner's answer (mailed February 13, 2004) and appellants' brief (filed January 23, 2004) for a full exposition thereof.

OPINION

After careful consideration of appellants' specification and claims, the teachings of the applied prior art references and each of the arguments and comments advanced by appellants and the examiner, we have reached the determinations which follow.

Turning first to the examiner's rejection of claims 1 through 7 under 35 U.S.C. § 112, first paragraph, we note that the test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter. See In re Kaslow, 707

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F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) and Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). In this regard, we note that it is not necessary that the claimed subject matter under consideration be described identically in the specification, but the disclosure as originally filed must convey in some way to those skilled in the art that the applicants had at the time of filing invented the subject matter now claimed. See, In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) and In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

In the present case, the examiner has found that the recitation noted above as being added to claim 1, lines 2-3, is without support in the originally filed specification and claims. Like the examiner, we find nothing in the specification, claims and/or drawings of this application, as originally filed, that would have reasonably conveyed to the artisan that the inventors had possession of the now claimed subject matter at the time of filing the present application. Appellants' comments on pages 10-11 of the brief (Paper No. 14) concerning this rejection point to nothing in the original disclosure which reasonably evidences that appellants were specifically concerned with a cylindrical beverage container having an easy opening lid wherein the lid

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necessarily has "a diameter less than the cylindrical container," as now set forth in claim 1 on appeal. Although the specification, at page 4, mentions a problem with the prior art design concerning the difficulty of creating an initial puncture, and indicates that such a problem is compounded with the trend towards downsizing the lid diameter, we find nothing in the application regarding the relative diameter of a lid and the cylindrical container on which it is to be used.

Moreover, even if we assume, as appellants have indicated on page 10 of the brief, that a lid having a diameter less than the diameter of a cylindrical container is currently widely known in the art, we note that this fact alone is not a sufficient indication to one of ordinary skill in the art that such was in fact part of appellants' invention at the time of filing the present application. See, e.g., In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 474 (CCPA 1977) and also Lockwood v. American Airlines Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997), wherein the Court indicates that

Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed

and that

It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to

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speculate as to modifications that the inventor might have envisioned, but failed to disclose.

In light of the foregoing, the examiner's rejection of claims 1 through 7 under 35 U.S.C. 112, first paragraph, as lacking written description support in the originally filed disclosure will be sustained.

Regarding the examiner's rejection of claims 1 through 7 under 35 U.S.C. § 103(a) as being unpatentable over Perry in view of Neiner, the examiner points to the particular can closure or lid seen in Figure 28 of Perry, apparently as used on a container like that seen in Figure 1 of the patent, and urges that such a beverage can and closure/lid are fully responsive to that set forth in appellants' claims on appeal, except that the beverage can of Perry "is of the old type which does not teach the current technology of a can with a larger diameter than the lid and a lid with an indented portion surrounded by the score line" (answer, page 4). To account for such differences, the examiner points to Neiner, urging only that this patent "teaches this current can technology," particularly in Figures 1, 3 and 7. The examiner then contends that to modify the container and end wall of Perry to conform to the current container technology would have been

obvious to one of ordinary skill in the art to obtain the benefits of the Perry opening system in a current beverage container design.

Even assuming that it would have been obvious to use the Perry opening system (i.e., as shown in Fig. 28) in a current beverage container design wherein the lid has a diameter less than the diameter of the cylindrical container, we do not see that a beverage container like that set forth in claims 1 through 7 on appeal would have been the result. As appellants have argued (brief, page 6), the Perry patent teaches a two-step opening operation (see col. 11, lines 19-25), while the claims on appeal require a small pull tab "for engaging and opening the lid at the puncture point along the score line in a single operation." The examiner has not addressed this argued difference between the container resulting from the proposed combination of prior art as discussed above and the container required in appellants' claims on appeal. Thus, the examiner has not set forth a *prima facie* case of obviousness with regard to a beverage container as defined in the claims on appeal.

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Moreover, although the examiner has expressly noted that the old type container/lid of Perry does not teach or suggest an indented portion surrounded by the score line, we find nothing in the stated rejection which specifically addresses this limitation, no reference to where it might be found in the secondary patent to Neiner, and no indication of a reason why one of ordinary skill in the art at the time of appellants' invention would have found it obvious to modify the clearly different lid of Perry to include any such feature. In that regard, we note that the only structure located inside the score line of Perry is the raised boss (201) which is used during the second step of the opening operation therein (see col. 11, lines 24-25).

Since the examiner has not established that the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art, we will not sustain the examiner's rejection of claims 1 through 7 under 35 U.S.C. § 103(a).

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In summary:

The examiner's decision rejecting claims 1 through 7 under 35 U.S.C. § 112, first paragraph, based on failure to comply with the written description requirement has been sustained, while the rejection of claims 1 through 7 under 35 U.S.C. § 103(a) has not been sustained.

However, since at least one rejection of each of the claims on appeal has been sustained, it follows that the examiner's decision rejecting claims 1 through 7 of the present application is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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