

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD T. ZIMMERMAN JR.,
WILLIAM S. SMITH JR.
and ANDREW B. McLANDRICH

Appeal No. 2005-1180
Application No. 09/791,298

ON BRIEF

Before HANLON, WALTZ and KRATZ, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-56, all of the claims pending in the application. The claims on appeal are directed to a carton for storing a self-heating meal assembly and a beverage container comprising a closable insulating first compartment and a second compartment for storing the beverage container.

References

Peiker	2,512,963	Jun. 27, 1950
Cramer	2,808,191	Oct. 1, 1957
Pickard et al. (Pickard)	5,220,909	Jun. 22, 1993
Sorensen et al. (Sorensen)	6,401,927	Jun. 11, 2002
Chihara (JP '628A)	200023628A	Jan. 25, 2000

Issues on appeal

- (1) Claims 1-4, 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Peiker.
- (2) Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and JP '628A.
- (3) Claim 56 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, JP '628A and Pickard.
- (4) Claims 5, 6, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer.
- (5) Claims 11-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Sorensen.
- (6) Claims 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Sorensen and Cramer.
- (7) Claims 20-23, 26-28, 38-42 and 45-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Pickard.

(8) Claims 24, 25, 29, 30, 43, 44, 48 and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Cramer.

(9) Claims 31-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Sorensen.

(10) Claims 36 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard, Sorensen and Cramer.

Grouping of claims

Appellants group the claims on appeal as follows (Brief, p. 12):

- Group 1: Claims 1-4, 7 and 8
- Group 2: Claims 50-56
- Group 3: Claims 5 and 9
- Group 4: Claims 6 and 10
- Group 5: Claims 11-15
- Group 6: Claim 16
- Group 7: Claims 17-19
- Group 8: Claims 20-23, 26-28, 38-42 and 45-47
- Group 9: Claims 24, 29, 43 and 48
- Group 10: Claims 25, 30, 44 and 49
- Group 11: Claims 31-36
- Group 12: Claim 37

The examiner disagrees with this grouping but fails to suggest an alternative grouping.¹

See Answer, p. 3. Therefore, for purposes of appeal the claims stand or fall as follows:

¹ The examiner appears to be troubled by repetitive arguments made in the brief. We note that repetitive arguments appear to be made with respect to identical or substantially identical dependent claims. However, the independent claims from which these claims depend differ in scope.

- (1) Claims 2-4, 7 and 8 stand or fall with the patentability of claim 1.
- (2) Claims 51-55 stand or fall with the patentability of claim 50.
- (3) Claim 56 stands or falls alone.²
- (4) Claim 9 stands or falls with the patentability of claim 5.
- (5) Claim 10 stands or falls with the patentability of claim 6.
- (6) Claims 12-15 stand or fall with the patentability of claim 11.
- (7) Claim 16 stands or falls alone.
- (8) Claims 18 and 19 stand or fall with the patentability of claim 17.
- (9) Claims 21-23, 26-28, 38-42 and 45-47 stand or fall with the patentability of claim 20.
- (10) Claims 29, 43 and 48 stand or fall with the patentability of claim 24.
- (11) Claims 30, 44 and 49 stand or fall with the patentability of claim 25.
- (12) Claims 32-35 stand or fall with the patentability of claim 31.
- (13) Claim 36 stands or falls alone.³

² Appellants group claims 50-56 together. However, claims 50-55 are subject to a different ground of rejection than claim 56. As explained in In re McDaniel, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1466 (Fed. Cir. 2002), an applicant has the right to have each contested ground of rejection reviewed and measured against the scope of at least one claim within the group of claims subject to that ground of rejection. Therefore, the patentability of claim 56 will be considered separately from the patentability of claims 50-55.

³ Appellants group claims 31-36 together. However, claims 31-35 are subject to a different ground of rejection than claim 36. Therefore, the patentability of claim 36 will be

(14) Claim 37 stands or falls alone.

Discussion

A. Rejection of claims 1-4, 7 and 8

Claims 1-4, 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Peiker. Claim 1 is directed to a carton for storing a self-heating meal assembly and a beverage container and reads as follows:

1. A carton for storing a self-heating meal assembly and a beverage container, said carton comprising:
 - a closable and insulating first compartment,
 - said first compartment having a first top wall and a first flap covering a first opening to said first compartment and a first securing means for releasably securing said first flap in a first closed position,
 - a second compartment for storing the beverage container,
 - a hole in a second top wall of said second compartment for holding the beverage container.

The examiner sets forth the prima facie case of anticipation on pages 4 though 5 of the

Answer. Specifically, the examiner explains that (Answer, p. 4):

Peiker teaches a carton comprising a closable first compartment with a top wall (Figure 1, right-side #25), the walls of the first compartment inherently providing some degree of conductive insulation, a first flap on the side having a tab (Figure 1, right-side #14 & 17), a second compartment with a top wall (Figure 1, left-side #25), holes in the top walls (Figure 1, #32), a second flap on the side having a tab (Figure 1, left #14 & 17), a beverage container (column 3, line 46; Figure 1), and a third open compartment (Figure 1, center area).

Appellants argue that Peiker does not "anticipate or disclose an insulating [first]

considered separately from the patentability of claims 31-35. McDaniel, 293 F.3d at 1384, 63 USPQ2d at 1466.

compartment." See Brief, p. 12.

"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). In this case, Peiker does not expressly describe that the first compartment of the disclosed carton is insulating. However, Peiker discloses that the carton is constructed of paperboard. See col. 1, lines 36-38. Therefore, as pointed out by the examiner, the first compartment inherently provides some degree of conductive insulation. See Answer, p. 4.

Appellants do not dispute that paperboard inherently has insulating properties. In fact, appellants recognize that paperboard is an insulator. See Specification, p. 1, line 29 - p. 2, line 3. Nevertheless, appellants argue that one of ordinary skill in the art would not have expected the first compartment of Peiker to be insulating because the top wall of the compartment has large holes which allow heat to escape. Appellants maintain that the insulating compartment, as claimed, does not have holes in the top wall as in Peiker. See Brief, p. 13; Reply Brief, pp. 1-2.

Significantly, claim 1 does not expressly exclude a compartment having holes in a top wall as in Peiker, and appellants have failed to establish that an "insulating first compartment" is inherently devoid of holes. See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988) (limitations appearing in the specification will not be read into the claims); cf. Kooi v. DeWitt, 546 F.2d 403, 409, 192 USPQ 268, 273 (CCPA 1976) (for doctrine of inherency to provide

support for DeWitt, he has the burden of showing that penetration of silicon oxide layer into silicon body inevitably occurs when the process steps are followed). Furthermore, the claims do not specify the degree of insulation provided by the "insulating first compartment."

Peiker discloses that each hole in the first compartment receives and supports a container charged with either a hot or cold drink. See col. 4, lines 32-35. In use, the hole is at least partially closed by the container, and the paperboard inherently provides some degree of insulation to the portion of the container received in the first compartment. See Figures 1 and 3 of Peiker. Therefore, contrary to appellants' arguments, the holes in the first compartment of Peiker do not prevent the cardboard carton from insulating a container but rather facilitate such insulation.

For the reasons set forth above, we agree with the examiner that Peiker inherently describes an "insulating first compartment."⁴ Therefore, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Peiker is affirmed. Since claims 2-4, 7 and 8 stand or fall with the patentability of claim 1, the rejection of claims 2-4, 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by Peiker is also affirmed.

B. Rejection of claims 50-55

⁴ We further note that the preamble recites "[a] carton for storing a self-heating meal assembly." This language is merely a statement of intended use and fails to patentably distinguish the claimed carton from the carton disclosed in Peiker. See In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (the preamble of a claim does not limit the scope of the claim where it merely states a purpose or intended use).

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and JP '628A. Claim 50 is directed to a self-heating meal assembly comprising a carton comprising (1) a first compartment having an aperture in a first top wall, (2) a second compartment having a hole in a second top wall for holding a beverage container and (3) a heating container from a self-heating meal assembly disposed through and held by the aperture in the first top wall.

Appellants argue that the references relied upon do not disclose the following limitation recited in claim 50 (Brief, p. 14):

[A] heating container from a self-heating meal assembly and containing a hot meal which had been heated in a first compartment and the heating container disposed through and held by an aperture in a first top wall of a first opening to the first compartment.

Structurally, claim 50 requires a "heating container" which contains a hot meal and is disposed through and held by an aperture in a first top wall of a first compartment in the carton. Peiker discloses a meal carton having an aperture in a first top wall of a first compartment for holding a cup-shaped container. See Figure 1. Peiker does not disclose that a hot meal is contained in the cup-shaped container. Nevertheless, the examiner relies on JP '628A for its teaching of heating a pre-packaged meal in a cup-shaped container. See Answer, p. 5.

JP '628A discloses (p. 8):⁵

⁵ We rely upon and cite from a full English translation of this document, of record as PTO 05-153.

In a store without a cooking space like in a convenient store, for example, rice (3) may be cooked and sauce (4) may be prepared in a factory, for example, the rice (3) and the sauce are first packed in a container (2) and frozen, and then shipped to each store, thawed by a microwave, for example, and then offered.

The examiner concludes that it would have been obvious to one having ordinary skill in the art to incorporate the cup-shaped container of JP '628A into the aperture in the first compartment of the meal carton disclosed in Peiker to prevent possible spillage of the cooked meal contained therein. See Answer, pp. 5-6.

There appears to be no dispute that the cup-shaped container in JP '628A is a "heating container."⁶ Nevertheless, appellants argue that the container disclosed in JP '628A is not "a heating container from a self-heating meal assembly." According to appellants, the phrase "from a self-heating meal assembly" is a structural limitation. See Brief, p. 15.

However, the examiner argues, and we agree, that (Answer, p. 12):

Phrases such as "from a self-heating meal assembly" are merely preferred methods of using the claimed product. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the

prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647. MPEP 2114.

In this case, JP '628A discloses a heating container as required by claim 50. As for the

⁶ The examiner argues, and appellants do not dispute, that the broadest reasonable interpretation of the term "heating container" is a vessel which can be heated. Since food was heated in the cup-shaped container of JP '628A, we agree with the examiner that the container of JP '628A is a "heating container." See Answer, p. 12.

preferred method of using the claimed invention, there is no reason to believe that a heating container from a self-heating meal assembly could not have been disposed through and held by the aperture in the top wall of the first compartment in the carton of Peiker.⁷

Likewise, the recitation "which had been heated in the first compartment" is a preferred method of using the claimed invention. As discussed above, the heating container in JP '628A contains a pre-packaged meal and is heated in a microwave. The examiner indicates that the heating container disclosed in JP '628A could have been heated in a microwave in the cardboard carton of Peiker. See Answer, p. 6. Appellants have not challenged this finding.

For the reasons set forth above, the rejection of claim 50 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and JP '628A is affirmed. Since claims 51-55 stand or fall with the patentability of claim 50, the rejection of claims 51-55 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and JP '628A is also affirmed.

C. Rejection of claim 56

Claim 56 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the

⁷We further note that the preamble of claim 50, reciting "[a] self-heating meal assembly," does not give life and meaning to the claim, especially since the claim fails to recite a heating means. Cf. Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (Court concluded that preamble reciting "[a]n abrasive article" gave life and meaning to count reciting "[a]n abrasive article comprising abrasive grains and a hardened binder...").

combination of Peiker, JP '628A and Pickard. Claim 56 is dependent on claim 55 and requires a carton comprising a third compartment which contains packaged foods.

The examiner explains that food is contained in the third compartment of the meal carton disclosed in Peiker. However, the food is not packaged. The examiner relies on the teachings of Pickard to establish that it was known in the art to include packaged foods in meal cartons. The examiner concludes that it would have been obvious to one of ordinary skill in the art to incorporate the packaged foods disclosed in Pickard into the meal carton of Peiker to provide better preserved and more appealing food for the consumer. See Answer, pp. 6-7. Appellants have failed to establish otherwise. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“[a]fter a prima facie case of obviousness has been established, the burden of going forward shifts to the applicant”). Therefore, the rejection of claim 56 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, JP '628A and Pickard is affirmed.

D. Rejection of claims 5 and 9

Claims 5 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer. Claim 5 reads as follows:

5. A carton as claimed in claim 2 further comprising scored lines in said first top wall, said scored lines outlining an aperture area and being capable of forming an aperture by cutting along said scored lines.

The examiner recognizes that the carton disclosed in Peiker has holes in the first top wall of the first compartment rather than scored lines outlining an aperture area as required by

claim 5. However, the examiner points to Cramer as teaching a meal assembly carton having scored lines or partial perforations in a top wall which outline aperture areas that may be pushed through the top wall of the tray "as needed" to create apertures. See Figure 4, reference numeral 24; col. 2, lines 21-24. The examiner concludes that (Answer, p. 7):

It would have been obvious to one of ordinary skill in the art to incorporate the scored apertures of Cramer into the invention of Peiker since both are directed to meal assembly cartons, since Peiker already included a top wall with apertures (Figure 1, #32), as well as score lines (Figure 1, #28-29 & 35), since scored aperture areas were commonly used in meal cartons as shown by Cramer (Figure 4, #24), and since the scored aperture areas of Cramer can be removed as needed, thereby preserving more of the carton's strength if all of the apertures are not required.

Appellants argue that neither Peiker nor Cramer disclose an "insulating first compartment" as required by claim 1. Brief, p. 16. We disagree. For the reasons set forth in section "A." above, Peiker inherently describes an "insulating first compartment."

Appellants further argue that Peiker and Cramer teach away from each other. First, appellants argue that Peiker does not disclose locking members as in Cramer which facilitate removal of the perforated areas 24. Second, appellants argue that Peiker discloses a tray with openings. Therefore, it is not feasible to punch out perforated areas as in Cramer. Finally, appellants argue that the tray in Cramer is not divided into multiple compartments as in Peiker. See Brief, pp. 16-17.

Significantly, one cannot show nonobviousness by attacking the references individually, as appellants have done, where the rejection is based on a combination of references. In re

Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Thus, Peiker and Cramer must not be read in isolation but rather must be considered for what their combined teachings would have fairly suggested to one of ordinary skill in the art. See Syntex (U.S.A.) LLC v. Apotex, Inc., 407 F.3d 1371, 1380, 74 USPQ2d 1823, 1830 (Fed. Cir. 2005) (a prior art reference that does not specifically refer to one element of a combination does not, per se, teach away).

In this case, the examiner recognizes that Peiker discloses a tray with holes in a top wall. See circular openings 32 in Figure 1. However, the examiner relies on the teachings of Cramer to establish that perforated aperture areas were commonly used in meal cartons instead of holes and can be pushed through the top wall of the tray "as needed" to preserve the strength of the tray. See col. 2, lines 21-24. The examiner concludes that one of ordinary skill in the art would have been motivated to modify the holes in the tray of Peiker with the perforated aperture areas in Cramer to preserve the strength of the tray in Peiker.

Appellants argue that the suggestion or motivation to modify the tray of Peiker is without foundation or support in the prior art. See Brief, p. 17. To the extent that the suggestion or motivation set forth by the examiner is not expressly stated in Cramer, the suggestion to make the proposed modification is reasonably within the knowledge of one of ordinary skill in the art. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (suggestion to modify may come explicitly from statements in the art, the knowledge of one of ordinary skill in the art or may be implicit from the prior art as a whole). Appellants have failed to present any evidence to the contrary. See In re Schulze, 346 F.2d 600, 602, 145

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USPQ 716, 718 (CCPA 1965) (arguments in the brief do not take the place of evidence in the record).

Finally, appellants argue that neither Peiker nor Cramer disclose a "meal carton." Rather, appellants argue that Peiker and Cramer disclose "serving trays" which are designed to carry food. See Brief, p. 16.

This argument is not persuasive. Appellants have failed to distinguish the structural limitations imparted by the term "meal carton" from the structural limitations imparted by the term "serving tray." Furthermore, as explained in In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969), during examination claims are to be given the broadest reasonable interpretation consistent with the specification. The examiner points out that the broadest reasonable interpretation of the term "meal carton" includes any container that can support food items, and both Peiker and Cramer teach this concept. See Answer, p. 14. Appellants have failed to establish otherwise.

For the reasons set forth above, appellants have failed to rebut the prima facie case of obviousness set forth by the examiner on page 7 of the Answer. See Piasecki, 745 F.2d at 1472, 223 USPQ at 788 (“[a]fter a prima facie case of obviousness has been established, the burden of going forward shifts to the applicant”). Therefore, the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer is affirmed. Since claim 9 stands or falls with the patentability of claim 5, the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer is also affirmed.

E. Rejection of claims 6 and 10

Claims 6 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer. Claim 6 reads as follows:

6. A carton as claimed in claim 5 wherein said scored lines define bendable aperture flaps suitable to be bent inward.

Appellants argue that neither Peiker nor Cramer discloses scored lines defining bendable aperture flaps suitable to be bent inward as required by claim 6. See Brief, p. 18. The examiner, on the other hand, argues that Peiker discloses bendable flaps and for support points to Figure 4, reference numeral 31. See Answer, p. 7.

The bendable flaps in Peiker referred to by the examiner are not in the first top wall of the carton as required by claim 6. See 37 CFR § 1.75(c) (2004) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”). Nevertheless, as discussed above, Cramer discloses a meal carton comprising scored lines or partial perforations in a top wall which outline aperture areas 24 as required by claim 5. One of ordinary skill would have understood that aperture areas 24 could be partially or completely detached from the top wall of the carton by bending or pushing aperture areas 24 inward. Thus, the scored lines or partial perforations outlining aperture areas 24 in Cramer define bendable aperture flaps suitable to be bent inward as required by claim 6.

Appellants also argue that neither Peiker nor Cramer disclose an insulating compartment. Brief, p. 18. We disagree. For the reasons set forth in section "A." above, Peiker

inherently describes an insulating compartment.

For the reasons set forth above, the rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer is affirmed. Since claim 10 stands or falls with the patentability of claim 6, the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer is also affirmed.

F. Rejection of claims 11-15

Claims 11-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Sorensen. See Answer, pp. 7-8.

Claim 11 is dependent on claim 1. Claims 1 and 11 read, in part, as follows:

1. A carton . . . comprising:
a closable and insulating first compartment,
said first compartment having a first top wall and a first flap covering a
first opening to said first compartment

11. A carton as claimed in claim 1 wherein:
said first flap includes said first top wall of said first compartment

Claims 1 and 11 are inconsistent where, on the one hand, claim 1 requires the first compartment to have a first top wall AND a first flap, and on the other hand, claim 11 requires the first flap to INCLUDE the first top wall of the first compartment. Before this panel can decide whether to affirm or reverse the rejection of claims 11-15, the examiner and appellants need to resolve this issue. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. § 103 on these assumptions). Therefore, the rejection of

claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Sorensen is remanded. Since claims 12-15 are dependent on claim 11, the rejection of claims 12-15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Sorensen is also remanded. See 37 CFR § 1.75(c) (2004) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”).

G. Rejection of claim 16

Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Sorensen and Cramer. See Answer, p. 8.

Claim 16 is dependent on claim 13. The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Sorensen has been remanded. See section “F.,” supra. Therefore, the rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Sorensen and Cramer is also remanded. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”).

H. Rejection of claims 17-19

Claims 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Sorensen and Cramer. See Answer, p. 8.

Claim 17 is dependent on claim 16, claim 18 is dependent on claim 17, and claim 19 is dependent on claim 18. The rejection of claim 16 under 35 U.S.C. § 103(a) as being

unpatentable over the combination of Peiker, Sorensen and Cramer has been remanded. See section “G.,” supra. Therefore, the rejection of claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Sorensen and Cramer is also remanded. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”).

I. Rejection of claims 20-23, 26-28, 38-42 and 45-47

Claims 20-23, 26-28, 38-42 and 45-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Pickard. Claim 20 reads as follows:

20. A self-heating meal assembly, said assembly comprising:
a carton comprising;
a closable insulating first compartment containing a self-heating meal,
said first compartment having a first top wall and a first flap covering a
first opening to said first compartment and a first securing means for releasably
securing said first flap in a first closed position,
a second compartment containing a beverage container,
a hole in a second top wall of said second compartment suitable for
holding said beverage container.

Peiker discloses a carton for holding a meal comprising a closable insulating first compartment and a second compartment for holding a beverage container. See Figure 1. The examiner recognizes that the meal in Peiker is not self-heating. Nevertheless, the examiner relies on the teachings of Pickard to establish that self-heating meals were known in the art. The examiner concludes that one of ordinary skill in the art would have been motivated to incorporate a self-heating meal as in Pickard into the carton of Peiker to eliminate the need "to operate an oven or other cooking device in order to prepare the meal." See Answer, p. 9.

Significantly, claim 20 requires the self-heating meal to be contained in the first compartment of the carton. The examiner does not address this limitation. See Answer, p. 9. In any event, a review of Peiker by this panel reveals that the first compartment of the carton in Peiker does not contain comestibles characteristic of a meal. Rather, Peiker discloses that an open, central "third compartment" located between the first and second compartments accomodates sandwiches, chips and the like. See col. 4, lines 39-44. On this record, it is not apparent why one of ordinary skill in the art would have been motivated to incorporate the self-heating meal of Pickard into the first compartment of the carton disclosed in Peiker. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (the examiner bears the initial burden of presenting a prima facie case of unpatentability). Therefore, the rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Pickard is reversed.

Claims 21-23, 26-28, 38-42 and 45-47 depend from claim 20 and stand or fall with the patentability of claim 20. Therefore, the rejection of claims 21-23, 26-28, 38-42 and 45-47 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Pickard is also reversed.

J. Rejection of claims 24, 29, 43 and 48

Claims 24, 29, 43 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable

over the combination of Peiker, Pickard and Cramer. See Answer, pp. 9-10.

Claim 24 is dependent on claim 23, claim 29 is dependent on claim 28, claim 43 is dependent on claim 42, and claim 48 is dependent on claim 47. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”). Cramer fails to cure the deficiencies noted above in section “I.” Therefore, the rejection of claims 24, 29, 43 and 48 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Cramer is reversed.

K. Rejection of claims 25, 30, 44 and 49

Claims 25, 30, 44 and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Cramer. See Answer, pp. 9-10.

Claim 25 is dependent on claim 24, claim 30 is dependent on claim 29, claim 44 is dependent on claim 43, and claim 49 is dependent on claim 48. The rejection of claims 24, 29, 43 and 48 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Cramer has been reversed. See section “J.,” supra. Therefore, the rejection of claims 25, 30, 44 and 49 as being unpatentable over the combination of Peiker, Pickard and Cramer is also reversed. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”).

L. Rejection of claims 31-35

Claims 31-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the

combination of Peiker, Pickard and Sorensen. See Answer, p. 10.

Claim 31 is dependent on claim 20, and claims 32-35 are ultimately dependent on claim 20. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”). Sorensen fails to cure the deficiencies noted above in section "I." Therefore, the rejection of claims 31-35 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Sorensen is reversed.

M. Rejection of claim 36

Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard, Sorensen and Cramer. See Answer, pp. 10-11.

Claim 36 depends from claim 35 which ultimately depends from claim 20. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”). Cramer fails to cure the deficiencies noted above in section "I." Therefore, the rejection of claim 36 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard, Sorensen and Cramer is reversed.

N. Rejection of claim 37

Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the

combination of Peiker, Pickard, Sorensen and Cramer. See Answer, pp. 10-11.

Claim 37 depends from claim 36. The rejection of claim 36 under 35 U.S.C. § 103 as being unpatentable over the combination of Peiker, Pickard, Sorensen and Cramer has been reversed. See section “M.,” supra. Therefore, the rejection of claim 37 under 35 U.S.C. § 103 as being unpatentable over the combination of Peiker, Pickard, Sorensen and Cramer is also reversed. See 37 CFR § 1.75(c) (2003) (“Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”).

Other issues

The rejection of claim 31 under 35 U.S.C. § 103 as being unpatentable over the combination of Peiker, Pickard and Sorensen has been reversed. However, we note that claims 20 and 31 appear to be inconsistent. Specifically, claim 20 recites a carton comprising a first compartment having a first top wall AND a first flap. Claim 31, on the other hand, depends from claim 20 and requires the first flap to INCLUDE the first top wall of the first compartment.

Upon return of this application to the jurisdiction of the examiner, we urge the examiner to consider whether one of ordinary skill in the art would have understood the scope of claim 31. Any consideration of this issue should also include claims 32-37 which ultimately depend from claim 31. It is important that the examiner recognize that the reversal of the rejections of claims 31-35 and claims 36 and 37 under 35 U.S.C. § 103(a) does not preclude the examiner from exploring this newly raised issue, and, if appropriate, rejecting claims 31-37 under 35

U.S.C. § 112, second paragraph.

We further note that the rejections of claims 11-15 and claims 16-19 under 35 U.S.C. § 103(a) have been remanded for reasons similar to those discussed here. See sections "F." through "H.," supra. However, in the case of claims 11-19, "it is essential to know what the claims do in fact cover" before the rejections under 35 U.S.C. § 103(a) can be properly considered. Steele, 305 F.2d at 862, 134 USPQ at 295. In contrast, the rejections of claims 31-35 and claims 36 and 37 under 35 U.S.C. § 103(a) are reversed for reasons which do not relate to the inconsistency noted above, i.e., the location of the self-heating meal. See section "I.," supra.

Conclusion

The rejection of claims 1-4, 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by Peiker is affirmed. The rejection of claims 50-55 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and JP '628A is affirmed. The rejection of claim 56 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, JP '628A and Pickard is affirmed. The rejection of claims 5, 6, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Cramer is affirmed. The rejection of claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker and Sorensen is remanded. The rejection of claims 16-19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Sorensen and Cramer is remanded. The rejection of claims 20-23, 26-28, 38-42 and 45-47 under 35 U.S.C. § 103(a) as being unpatentable over

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the combination of Peiker and Pickard is reversed. The rejection of claims 24, 25, 29, 30, 43, 44, 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Cramer is reversed. The rejection of claims 31-35 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard and Sorensen is reversed. The rejection of claims 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Peiker, Pickard, Sorensen and Cramer is reversed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49,960 (Aug. 12, 2004), 1286 Off. Gaz. Pat. & Trademark Office 21 (Sept. 7, 2004)) provides:

Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

Regarding any affirmed rejection, 37 CFR § 41.52(a)(1) (2004) provides, "Appellant may file a single request for rehearing within two months of the date of the original decision of the Board."

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection(s), including any

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timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (2004).

AFFIRMED-IN-PART; REVERSED-IN-PART;
and REMANDED-IN-PART

ADRIENE LEPIANE HANLON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

ALH:dal

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