

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 PETR MASEK
and ALAIN RIESTERER*

Appeal No. 2006-1213
Application 10/396,557

HEARD: May 23, 2006

Before KIMLIN, WARREN and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the rejection of appealed claims 19 through 22 under 35 U.S.C. § 103(a) as being unpatentable over Favre in view of Kishpaugh, Southall and Dalton (answer, pages 3-5).¹

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

¹ Claims 19 through 22 are all of the claims in the application.

The claimed method encompassed by representative independent claim 19² involves the steps of puncturing a food substance containing cartridge with at least one puncture member of an extraction device in a part of the cartridge containing “a solids retention member,” and after “injecting an extraction fluid to open another portion of the cartridge” so as to extract the food from the cartridge, “removing the puncture member from the opening, such that the solids retention member retains the solid substance within the interior of the” cartridge. Dependent claim 20 specifies that “the solids retention member . . . recloses when the puncture member is removed,” and dependent claim 22 specifies that “the solids retaining member comprises a fabric.”

In order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellants’ disclosure. See generally, *In re Kahn*, 441 F.3d 977, 985-88, 78 USPQ2d 1329, 1334-37 (Fed. Cir. 2006); *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Cartridges or capsules containing solid food preparations for use in dispensing machines, wherein the contents are extracted with a fluid under pressure, are known in the art as seen from Favre and acknowledged by appellants in the specification (page 1, ll. 22-28). Appellants further acknowledge the problem of retaining unextracted solid substances in the cartridge or capsule

² We suggest that upon further prosecution of the appealed claims subsequent to this appeal, the examiner consider the language “[a] method for preparing extracting,” “a food product that comprises the food substance and a solid substance” and “extraction of the to food” in the preamble, first clause and second clause of claim 19, respectively.

when changing the cartridge or capsule, thus soiling the dispensing machine. Indeed, on this record, appellants have not established that one of ordinary skill in this art would not have recognized the problem in the routine use of the known cartridges or capsules in dispensing machines and thus, would not have been motivated to solve it. *See In re Nomiya*, 509 F.2d 566, 574, 184 USPQ 607, 613 (CCPA 1975) (“The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution.”); *In re Ludwig*, 353 F.2d 241, 243, 147 USPQ 420, 421 (CCPA 1965); *In re Goodman*, 339 F.2d 228, 232-33, 144 USPQ 30, 33-34 (CCPA 1964).

We cannot agree with the examiner that one of ordinary skill in this art in solving the known problem would have been motivated to combine Kishpaugh, Southall and Dalton with Favre. This is because, as appellants point out, the disclosures of Kishpaugh, Southall and Dalton are drawn to such dissimilar fields of endeavor and directed to solutions for different problems that the subject matter thereof would not have logically commended itself to one of ordinary skill in the art addressing the known problem. *See generally, Kahn*, 441 F.3d at 985-88, 78 USPQ2d at 1334-37; *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433-34; *Rouffet*, 149 F.3d at 1358, 47 USPQ2d at 1458; *Pro-Mold and Tool Co.*, 75 F.3d at 1573, 37 USPQ2d at 1629-30; *see also In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering the problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve.”).

Indeed, one of ordinary skill in the art would not have considered using the “gas-permeable intermediate package member” of Kishpaugh even if the same retains dry granular materials during evacuation of the container since the problem involving puncturing the container and injecting an extraction solution is not addressed; the shut-off valve assembly for filter cartridges of Southall even if the same can be useful in removing spent cartridges from coffee-makers, since valve assemblies are not part of the problem addressed; and the matrix septum material of Dalton is used to retain a liquid in a different environment, wherein the

material is punctured by a needle for the insertion of fluid into an essentially empty container after which the needle is withdrawn and the fluid remains within the container, none of which addresses the problem to be solved. Indeed, as appellants point out, even if the references were combined by one of ordinary skill in the art, the same would not have provided all of the steps specified in claim 19. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

Accordingly, we agree with appellants that the examiner has not established a *prima facie* case over the applied references, and accordingly, we reverse the ground of rejection.

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)
Administrative Patent Judge)
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CHARLES F. WARREN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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