

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID ROBERT DUDEK, JOHN MELVYN LLOYD, DAVID
CAMPBELL MURRAY and PETER SANDIFORD

Appeal 2006-3321
Application 09/843,381
Technology Center 3600

Decided: February 21, 2007

Before ANITA PELLMAN GROSS, ROBERT E. NAPPI and ANTON W.
FETTING, *Administrative Patent Judges*.

ANTON W. FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-18. Claims 19-25 have been withdrawn from consideration. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We REVERSE and ENTER A NEW GROUND OF REJECTION
PURSUANT TO 37 CFR § 41.50(b).

BACKGROUND

The appellants' invention relates to a process and system for the customization of consumer products. (Spec 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A process for the customisation of consumer products, which comprises the steps of:
 - (a) preparing said customisable consumer products according to available selections made by a consumer of one or more components of said consumer products having product characteristics chosen by the consumer,
 - (b) optionally reconstituting said components with one or more other components, and
 - (c) dispensing from a vending system at a point-of-sale of said consumer products.

PRIOR ART

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

Partyka	US 5,941,363	Aug. 24, 1999
Seo	US 6,062,277	May 16, 2000
Whigham	US 6,584,309 B1	Jun. 24, 2003 (Dec. 16, 1999)
Hewlitt	US 6,598,631 B2	Jul. 29, 2003 (Apr. 25, 2001))
Hewlitt	US 6,615,880 B2	Sep. 9, 2003 (Apr. 25, 2001))

We also make of record the following reference:

Kondo US 4,815,633 Mar. 28, 1989

REJECTIONS

Claims 1-18 stand rejected under the judicially recognized doctrine of obviousness type double patenting for claiming an obvious variation of the subject matter claimed in another U.S. Patent.

Claims¹ 1, 2, 3, 6, 14 and 16 stand rejected under 35 U.S.C. § 102(e) as anticipated by Seo.

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as obvious over Seo and Partyka.

Claims 6-8 and 11-18 stand rejected under 35 U.S.C. § 103(a) as obvious over Seo and Whigham.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed Apr. 21, 2004) and the examiner's answer (mailed April 4, 2006) for the reasoning in support of the rejection, and to appellants' brief (filed January 9, 2006) and reply brief (filed June 2, 2006) for the arguments thereagainst.

¹ Although claim 8 was included in both the final rejection, p. 4, and the statutory basis for the rejection in the answer, p. 3, the examiner withdrew the 35 U.S.C. § 102 basis for rejecting claim 8, and retained the 35 U.S.C. § 103(a) basis, in the answer, p. 14.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow.

Claims 1-18 rejected under the judicially recognized doctrine of obviousness type double patenting for claiming an obvious variation of the subject matter claimed in another U.S. Patent.

The examiner rejected the claims under obviousness double patenting because "Seo discloses a customization controller 5, the system in the foregoing listed patents could include such a controller for effecting customization of product." (Final Rejection 2).

The appellants respond first by admitting that, as to the patents whose claims are asserted to be the source of the obviousness type double patenting, "[b]oth cited U.S. Patents were filed on the same day as the present application and therefore only a one-way determination is needed." (Br. 5).

Claim 1 of the '631 patent is:

1. A device for mixing of one or more concentrates and/or diluents at an interface between a container and a filling head of a vending machine as the container is filled using said filling head, comprising the combination of:
 - (i) a filling head component, comprising one or more concentrate and/or diluent inlet tubes, said inlet tubes being in fluid communication with a central chamber, said chamber comprising

therein a diverter, said diverter being such that the difference between the diameter of the diverter and that of the surrounding chamber is such that the cross-sectional area therebetween gradually increases in the direction of flow of the filling head component; and

(ii) a component located in a fill aperture of a container, said components being engageable with one another so as to provide a direct path from said filling head to the interior of the container.

Claim 1 of the '880 patent is:

1. A system for the mixing of one or more concentrates to form a product, comprising a vending machine, said vending machine comprising one or more diluent sources and one or more concentrate sources, said diluent and concentrate sources being in fluid communication with one or more mixing chambers, the mixing chamber being adapted to mix the diluent and concentrate sources prior to dispense, the product being selected from cleaning products and detergents, the vending machine further comprising one or more dispense points adapted to dispense the product into a storage container when the storage container is positioned for dispensing from the vending machine.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

The issue under contention is whether any of the claims under rejection are patentably indistinct from claim 1 in either of the '880 and '631 patents. (See Br. 5-6, Answer 4-9 and Reply Br. 6).

All of the independent claims in the present application require that a consumer product be prepared according to available selections made by a consumer of one or more components of said consumer products having product characteristics chosen by the consumer. This feature is not present in either of the '880 and '631 patents' claim 1. Therefore, no claim in the present application is patentably indistinct from claim 1 in each of the '880 and '631 patents. Therefore, we find the examiner's arguments to be unpersuasive.

Accordingly we do not sustain the examiner's rejection of claims 1-18 under the judicially recognized doctrine of obviousness type double patenting for claiming an obvious variation of the subject matter claimed in another U.S. Patent.

Claims 1, 2, 3, 6, 14 and 16 rejected under 35 U.S.C. § 102(e) as anticipated by Seo.

The issues under contention are

- whether Seo's vending machine prepares customisable consumer products according to available selections made by a consumer of one or more components of those consumer products having product characteristics chosen by the consumer

- whether Seo's vending machine optionally reconstitutes components with one or more other components

(See Br. 7-8, Answer 10-15 and Reply Br. 2-9).

The examiner contends that Seo's use of the plural form of "button" and the use of hot and cold water evidence the selection by a customer of one or more components. The plural form of "button" occurs in the paragraph

The product selecting unit 410 disposed with a plurality of buttons corresponding to respective products in the automatic vending machine serves to input a product selection signal to the controller 420 when the buttons are manipulated.

(Col. 3, lines 58-61)

A single product selection signal, not plural component selection signals, emanates from this sequence. Further, this portion gives no indication that different buttons represent different components. Similarly, there is no suggestion in Seo that a customer has a choice of hot or cold water for any given selection.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing

may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

There is nothing in Seo to indicate its buttons or water supplies necessarily prepare customisable consumer products according to available selections made by a consumer of one or more components of those consumer products having product characteristics chosen by the consumer. Accordingly we do not sustain the examiner's rejection of claims 1, 2, 3, 6, 14 and 16 under 35 U.S.C. § 102(e) as anticipated by Seo.

Claims 1-10 rejected under 35 U.S.C. § 103(a) as obvious over Seo and Partyka.

There is no controversy over whether Partyka makes up for Seo's deficiencies in the independent claims. The dependent claim rejections cannot be sustained where they fully incorporate the subject matter of the independent claims improperly rejected over the same art. Accordingly we do not sustain the examiner's rejection of claims 1-10 under 35 U.S.C. § 103(a) as obvious over Seo and Partyka.

Claims 6-8 and 11-18 rejected under 35 U.S.C. § 103(a) as obvious over Seo and Whigham.

There is no controversy over whether Whigham makes up for Seo's deficiencies in the independent claims. The dependent claim rejections cannot be sustained where they fully incorporate the subject matter of the independent claims improperly rejected over the same art. Accordingly we do not sustain the examiner's rejection of claims 6-8 and 11-18 under 35 U.S.C. § 103(a) as obvious over Seo and Whigham.

NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b)

Pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection:

Independent claims 1 and 6 are rejected under 35 U.S.C. § 102(b) as anticipated by Kondo.

Kondo shows

- (a) preparing customisable consumer products according to available selections made by a consumer of one or more components of those consumer products having product characteristics chosen by the consumer,
- (b) optionally reconstituting those components with one or more other components, and
- (c) dispensing from a vending system at a point-of-sale of those consumer products

in the Summary of Invention Col. 2, line 40 – Col. 3 line 39:

It is an object of this invention to provide an automatic vending machine wherein *different varietes [sic] of ground coffee powders or of coffee beans are stored separately and a straight coffee of any one of the varieties and a blended coffee of any combination of the varieties [sic] can be served as requested.*

It is another object of this invention to provide such an automatic vending machine wherein *coffee concentration can be selected as desired.*

It is still another object of this invention to provide such an automatic vending machine wherein *cream and/or sugar can be mixed to the coffee as desired.*

According to this invention, an automatic coffee vending machine can be obtained which comprises a plurality of chambers for storing coffee materials of different varieties, respectively, and a plurality of means for discharging the coffee materials from the plurality of chambers, respectively. *Powders of the coffee materials discharged by the discharging means are introduced into a coffee extractor by an*

introducing means. Hot water is also supplied to the extractor from a hot water supply means. [This reconstitutes optional components.] The automatic coffee vending machine further comprises money detecting means for generating a vending signal at a time when an amount of money as deposited by a purchaser is equal to or above a predetermined [sic] price, and *selection key means for selecting desirable one or more coffee variations contained in the plurality of chambers.* Electric control means is actuated by the vending signal from the money detection means and control the coffee extracting means, the coffee discharging means and the hot water supply means so as to *serve a straight coffee of the desired one variety or a blended coffee of the desired more than one varieties as selected by the selection key means.*

In the plurality of chambers, ground coffee powders or coffee beans may be stored. In storing coffee beans, the machine further comprises a coffee mill means for grinding beans discharged by the discharging means. The coffee mill means also operates under control of the electric control means.

According to this invention, the vending machine further comprises a sugar container, a cream container and cream and sugar discharging means. *Cream and sugar discharging means operate under control of the electric control means to supply cream and sugar to coffee extracted by the coffee extracting means.*

In an aspect of this invention, the automatic coffee vending machine comprises coffee concentration key means for *selecting a desirable coffee concentration level, sugar amount key means for selecting a desirable sugar amount and cream amount key means for selecting a desirable cream amount.* Memory means stores data of various cream amounts, various sugar amounts, different supply amounts of coffee material, and supply amount ratios of the different coffee varieties contained in the chambers [sic]. The electric control means reads out the data and controls the coffee material discharging means, the cream discharge means and the sugar discharge means *to serve a coffee with a concentration, sugar amount and cream amount as selected by the coffee concentration key means, the cream amount key means and the sugar amount key means.*

(emphasis added).

Thus, Kondo anticipates the subject matter of independent claims 1 and 6. The examiner should consider the patentability of the remaining dependent claims with respect to the art of record .

CONCLUSION

To summarize,

- The rejection of claims 1-18 under the judicially recognized doctrine of obviousness type double patenting for claiming an obvious variation of the subject matter claimed in another U.S. Patent is not sustained.
- The rejection of claims 1, 2, 3, 6, 14 and 16 under 35 U.S.C. § 102(e) as anticipated by Seo is not sustained.
- The rejection of claims 1-10 under 35 U.S.C. § 103(a) as obvious over Seo and Partyka is not sustained.
- The rejection of claims 6-8 and 11-18 under 35 U.S.C. § 103(a) as obvious over Seo and Whigham is not sustained.
- Pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection
 - Independent claims 1 and 6 are rejected under 35 U.S.C. § 102(b) as anticipated by Kondo.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50 (b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims: (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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

REVERSED
and
ENTERED A NEW GROUND OF REJECTION PURSUANT TO
37 CFR § 41.50(b).

ANITA PELLMAN GROSS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ROBERT E. NAPPI)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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