

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DANNY H. KUIGHADUSH

Appeal 2007-1589
Application 09/669,245
Technology Center 3700

DECIDED: October 18, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and ERIC GRIMES,
Administrative Patent Judges.

SCHEINER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 15, 16, and 20-29, all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

DISCUSSION

The present invention “is generally related to an improved retractable straw for drinking containers . . . that allows a user to conveniently drink liquids out of a container” (Spec. 1).

Claims 15, 20, 22, and 26 are representative of the claimed subject matter:

15. A cap assembly, comprising:
 - a container having a plurality of sides and an opening disposed on a top portion of said container, said opening disposed at the top of a first one of said plurality of side walls, said opening covered by a cap positionable in an opened and closed position; and
 - an extendable straw, said straw having upper and lower portions, where said lower portion extends downwardly against said first side wall, and wherein said upper portion is coupled with an inner side of said cap so that when said cap is in an opened position, said straw is available at said opening for use.

20. A cap assembly as set forth in claim 15, wherein said cap is a scored finger portion.

22. A cap assembly, comprising:
 - a container having a plurality of sides and an opening disposed on a top portion of said container, said opening disposed at the top of a first one of said plurality of side walls, said opening covered by a cap positionable in an opened and closed position; and
 - an extendable straw, said straw having upper and lower portions, where said upper portion, coupled with an inner side of said cap, and said lower portion are connected by pleats, wherein the configuration between the upper and lower portions of the straw are such that the pleats are required to allow an unimpeded flow of liquid that passes through said straw and are further configured such that when said cap is in an opened position, said straw is available at said opening for use.

26. A cap assembly, comprising:
a container having a plurality of sides and an opening disposed on a top portion of said container, said opening disposed at the top of a first one of said plurality of side walls, said opening covered by a cap positionable in an opened and closed position; and
an extendable straw, said straw having upper and lower portions, where said lower portion is disposed along said first side wall, parallel to both the edges of and the plane of said first sidewall, and wherein said upper portion is coupled with an inner side of said cap so that when said cap is in an opened position, said straw is available at said opening for use.

The rejections to be reviewed on appeal are as follows:

- The rejection of claims 15, 16, 20, 21, and 26-29 under 35 U.S.C. §112, first paragraph, as containing new matter.
- The rejection of claims 15, 16, and 20-29 under 35 U.S.C. § 102(b) as anticipated by Wen.¹
- The rejection of claims 15, 16, and 20-29 under 35 U.S.C. § 102(e) as unpatentable over Cornell.²

New Matter

Claims 15, 16, 20, 21, and 26-29 stand rejected under 35 U.S.C. § 112, first paragraph. According to the Examiner, the limitations “[i]n claim 15 [], ‘downwardly against said first side wall’, and in claim 26 [] ‘lower portion is disposed along said first [s]ide wall, parallel to both the edges of and the plane of said first sidewall’ . . . [are] not described in the specification” (Answer 3).

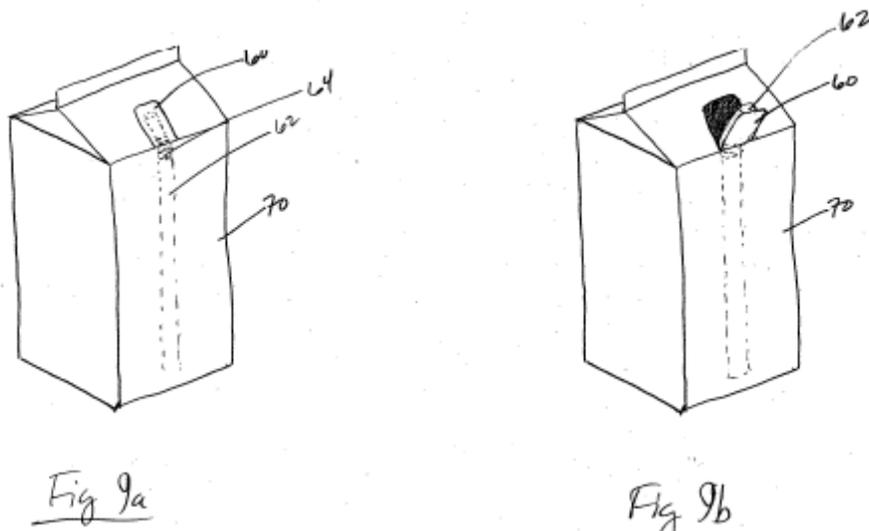
¹ U.S. Patent 5,482,202 to Wen, issued January 9, 1996.

² U.S. Patent 6,076,729 to Cornell et al., issued June 20, 2000.

In response to Appellant's assertion that "Figs. 9A and 9B, as filed provide sufficient support . . . for the elements of claims 15 and 26" (Appeal Br. 19), the Examiner argues that "Figures 9A and 9B merely show interrupted lines to indicate a straw is broadly located inside the container . . . [and] [t]he specific orientation of the lower portion of the straw . . . is not shown" (Answer 3).

We will reverse this rejection. As pointed out by Appellant, Figures 9A and 9B of the present specification are not merely two-dimensional views, but "are both perspective views of the straw within the container, which show not only that the lower portion of the straw is inside the container, but also convey[] a three dimensional perspective on the location of the straw within the container" (Reply Br. 6).

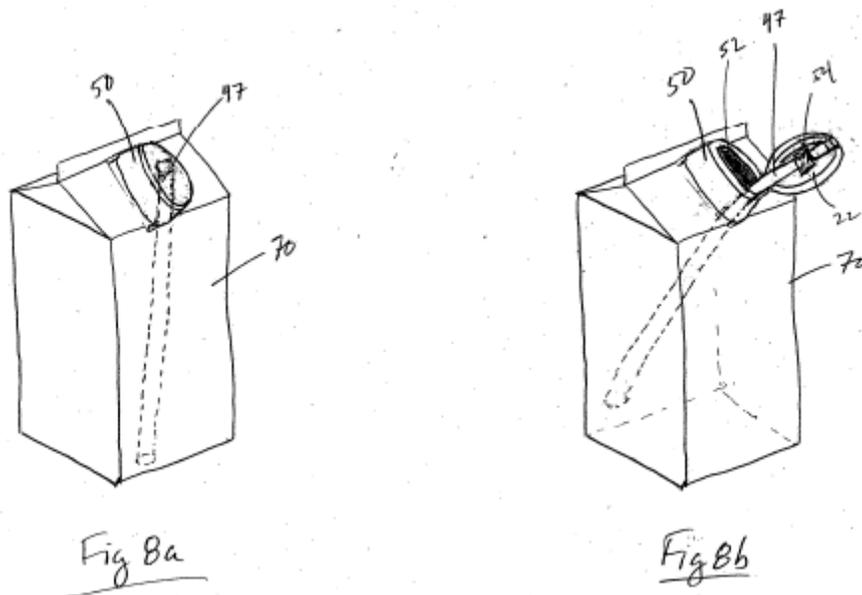
Appellant's argument is consistent with the Specification, which describes Figure 9A as "a perspective view of a cardboard beverage container with an integrated straw in a closed position," and Figure 9B as a view of the same in the open position (Spec. 6). Figures 9A and 9B are reproduced below:



In addition, Appellant has submitted the declarations³ of three persons with considerable experience interpreting structural drawings, all of whom conclude that Figures 9A and 9B unambiguously show a container with a straw extending against a wall of the container. For example, Sidi Berri, an assistant professor of mechanical engineering, who has “prepared, reviewed and interpreted many mechanical drawings” (Decl. I, ¶¶ 1 and 3), concludes that Figures 9A and 9B “clearly illustrate a straw that extends against the wall of the container[,] [because] [t]he dotted lines depicting the straw are extended in parallel with both sides of the surface of the wall the straw extends along . . . [thus] the distance from the top portion of the straw to each side of the wall is equal to the distance [from] the lower portion of the straw to each corresponding side” (*id.* at ¶ 7). This is in contrast to “Figs. 8A and 8B of the application . . . wherein the dotted lines representing the straw are not extended in parallel to the sides of a surface of the container . . . [and] represent a straw that is floating within the container” (*id.* at ¶ 8). Both Jacob Cohen and Daniel Kamel support their conclusions with similar factual underpinnings (Decl. II, ¶¶ 7 and 8; Decl. III, ¶¶ 6 and 7).

³ Declarations of Sidi Berri (Decl. I), Jacob Cohen (Decl. II), and Daniel Kamel (Decl. III), all originally submitted September 15, 2003, under the provisions of 37 C.F.R. § 1.132, and resubmitted September 8, 2005 with Appellant’s Appeal Brief.

Figures 8A and 8B of the present Specification, referred to in each of the declarations for the purpose of comparison, are, like Figures 9A and 9B, described as perspective views. Figures 8A and 8B, in which the dashed lines representing the lower portion of the straw are not parallel to the edges of a side wall, are reproduced below:



The Examiner has provided no factual support for the assertion that the specific location of the lower portion of the straw is not shown in Figures 9A and 9B. Similarly, the Examiner's cursory dismissal of the declarations as "fail[ing] to establish that the person giving the declaration is of 'ordinary skill in the art'" and as "based upon opinion and not fact" is itself unsupported by any facts, and therefore untenable on its face.

The rejection of claims 15, 16, 20, 21, and 26-29 under the first paragraph of 35 U.S.C. § 112 is reversed.

Anticipation by Wen

Claims 15, 16, and 20-29 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wen.

According to the Examiner, “Wen shows all of the structure as recited in the claims . . . [including] the straw with pleats” (Answer 3).

With respect to claims 15, 16, 20, and 21, Appellant argues that “there is no teaching or suggestion in [] Wen . . . that discloses a lower portion of [a] straw extending downwardly along a first sidewall” (Appeal Br. 25).

With respect to claims 26-29, Appellant argues that “there is no teaching or suggestion in [] Wen . . . that discloses a lower portion of a straw disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall” (*id.*).

We agree with Appellant. In our view, Wen shows that the straw in Wen’s drink box either extends diagonally from the top of one side, to the bottom of the opposite side (Figure 1-4), or extends vertically from a point at some distance from any one side (Figures 5-7).

Accordingly, the rejection of claims 15, 16, 20, 21, and 26-29 under 35 U.S.C. § 102(b) as anticipated by Wen is reversed.

Claims 22-25, however, stand on a different footing because they do not require a straw extending downwardly along a first side wall. Appellant argues that Wen does not disclose “an upper portion [and] lower portion of a straw connected by pleats, *such that the pleats are required* to allow an unimpeded flow of liquid that passes through said straw” (Appeal Br. 25). According to Appellant, Wen’s “pleats are not required for unimpeded flow

According to Wen, “[t]he straw **20** includes an upper end portion **21**, a lower end portion **22** and a middle portion **23**” (Wen, col. 2, ll. 38-39). “The upper end portion **21** is secured to a superimposition area **15** of the upper sealing edge **11** . . . The lower end portion **22** is attached on the lower sealing edge **12** in a like manner . . . The middle portion **23** may suitably be in a form of bellows and is shaped and situated between the two end portions **21** and **22** to permit an unrestrained conveying of drink in the container” (*id.* at col. 2, ll. 39-47).

We find that the “bellows” in Wen’s Figure 4 are “pleats,” and are required for unrestrained, i.e., unimpeded, flow between the upper and lower portions of the straw. Appellant has not identified any other aspect of claim 22 that is not described by Wen.

Accordingly, the rejection of claims 22-25 under 35 U.S.C. § 102(b) as anticipated by Wen is affirmed.

Anticipation by Cornell

Claims 15, 16, and 20-29 stand rejected under 35 U.S.C. § 102(e) as anticipated by Cornell.

Again, with respect to claims 15, 16, 20, 21, and 26-29, Appellant argues that “there is no teaching or suggestion in . . . Cornell . . . that discloses a lower portion of [a] straw extending downwardly along a first sidewall” or “a lower portion of a straw disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall” (Appeal Br. 25).

The Examiner “does not disagree with these arguments” (Answer 5), but contends “if applicant[’s] specification and drawings are found to be

fully supportive of these limitations, then figure 8A of Cornell must be considered to fully anticipate” (*id.*).

We disagree with the Examiner. Cornell’s Figure 8A is a “front elevational view of a container” (Cornell, col. 2, l. 1). As explained by Appellant, “[a] dotted line on a front elevation can not show position within a container, because it offers only [a] two, not [a] three dimensional perspective” (Reply Br. 6). Cornell’s Figure 8B is a side elevational view of the same container (Cornell, col. 2, l. 3), and “clearly show[s] that [the] straw is not attached to or parallel to the side wall of the container” (Reply Br. 6). On the other hand, Figures 9A and 9B of the present invention are three-dimensional perspective drawings that clearly show that the straw extends downwardly against the side wall, parallel to the plane and two edges of the side wall.

Accordingly, the rejection of claims 15, 16, 20, 21, and 26-29 under 35 U.S.C. § 102(e) as anticipated by Cornell is reversed.

With respect to claims 22-25, which do not include the limitations regarding the orientation of the straw in the container, Appellant argues that Cornell’s “pleats are unnecessary because the lower portion of the straw is free to move about the inside of the container” (Appeal Br. 25). However, Cornell’s Figures 26-30, at the very least, illustrate drink containers wherein the straws are too long for the closed containers, and must be folded for storage, and extended for use, by means of “corrugations”, e.g., **726** in Figure 26.

We find that the “corrugations” in the straws shown in Cornell’s Figures 26-30 (at least) are “pleats,” and are required for unimpeded flow

between the upper and lower portions of the straws. Appellant has not identified any other aspect of claims 22-25 not described by Cornell.

Accordingly, the rejection of claims 22-25 under 35 U.S.C. § 102(e) as anticipated by Cornell is affirmed.

SUMMARY

The Examiner's rejection of claims 15, 16, 20, 21, and 26-29 under the first paragraph of 35 U.S.C. § 112 is reversed.

The rejection of the claims under 35 U.S.C. § 102(b) as anticipated by Wen is reversed with respect to claims 15, 16, 20, 21, and 26-29, but affirmed with respect to claims 22-25.

The rejection of the claims under 35 U.S.C. § 102(e) as anticipated by Cornell is reversed with respect to claims 15, 16, 20, 21, and 26-29, but affirmed with respect to claims 22-25.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART

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