

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAINER ROHR, NATHALIE VERRAC,
and MICHEL THIBAUT

Appeal 2008-0188
Application 10/652,770
Technology Center 3700

Decided: July 31, 2008

Before TERRY J. OWENS, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

A hearing was held on June 12, 2008, in which oral arguments were heard.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a manipulable tab used for opening a container that contains a promotional or decorative image. (Specification 2: 7-8.)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A can, comprising:
 - a can body comprising a side wall and a base and defining an interior region for containing a product;
 - an end for said can body having a scored portion for defining an opening in said end, the end having an upper surface; and
 - a manually manipulable tab secured to said end and having a first portion where the tab is attached to the end and a free distal second portion and first and second opposite sides, wherein said tab further comprises a tab surface extending across said tab between said first and second sides, said tab surface in said free distal second portion having a promotional or decorative image formed therein,
 - said promotional or decorative image formed as a combination of a void formed in the free distal second portion of the tab surface and adjacent laser etching of one or more features on said tab surface adjacent to said void, wherein the void exposes the upper surface of the end, wherein

the exposed upper surface of the end contributes to the promotional image.

THE REJECTIONS

The Examiner has made of record the following patents:

Pavely	US 5,359,766 B1	Nov. 1, 1994
Schubert	US 5,741,105	Apr. 21, 1998
Webb	GB 2,320,008 A	Jun. 10, 1998
Turner	US 5,967,726	Oct. 19, 1999
Stasiuk	US 6,105,806	Aug. 22, 2000
Forrest	US 6,161,717	Dec. 19, 2000
Thibaut	US 6,951,293 B2	Oct. 4, 2005

The following rejections are before us for review.

1. Claims 1-14 and 17-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stasiuk.
2. Claims 1-20 stand rejected under 35 U.S.C. § 35 U.S.C. § 103(a) as being obvious over Webb in view of Stasiuk.

ISSUE

The anticipation issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 1-14 and 17-20 under 35 U.S.C. § 102(b) as anticipated by Stasiuk. This anticipation issue turns on whether Stasiuk expressly or inherently discloses a promotional or decorative image formed as a combination of a void formed in the free distal second portion of a tab surface and adjacent laser etching of one or more features on the tab surface adjacent to the void, wherein the void exposes the upper surface of

the end, wherein the exposed upper surface of the end contributes to the promotional image.

The second issue before us is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting the claims 1-20 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Webb in view of Stasiuk.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Stasiuk discloses “[a] decorative tab according to the present invention may have at least one finger aperture associated therewith” (Stasiuk, col. 2, ll. 46-48.)

2. Although Stasiuk discloses that “[t]here is no need to have an aperture in the tab” (Stasiuk, col. 5, ll. 40-41) this sentence is part of a larger paragraph which also states:

However, the symbolic shape could also be achieved in an embodiment wherein the pull tab is not a continuously solid plate, has apertures, is not a planar member and is not a substantially flat sheet. The tab is preferably shaped to be recognized as a picture, trademark, icon, character, or other symbolic item.

(Stasiuk, col. 5, ll. 46-49.)

3. Stasiuk discloses:

A preferred apparatus for use in a tab decorating area is an optical device, preferably a laser, capable of generating a substantially permanent tab decoration on a tab or tab making

materials. For example, in making decorative or decorative-symbolic tabs for an aluminum container, anodized aluminum or aluminum coated with an organic coating may be used. Preferably, aluminum having an organic coating on at least one side is used. A plurality of coatings may also be used if a tab having multiple colors is desired. The anodized or coated aluminum is then treated with a laser that burns or etches a predetermined tab decoration into the tab or tab material such that aluminum shows through the coating or anodized layer. The laser may also be set such that a texture is provided. If multiple coatings are used, the laser may be set such that a portion of the top layer of coating is etched to a desired depth (preferably a depth exposing the second layer or bare aluminum) and the second layer is also etched to a desired depth exposing a successive layer or bare aluminum, etc Accordingly, one of ordinary skill in the art will appreciate that numerous modifications to the coatings and laser settings may be done to effect speed of production, clarity of the tab decorations, depth of the etch, and desired pattern colors. Presently preferred lasers are high powered lasers or lasers with precision marking capability, such as a 200 watt NDYAG (Neodymium Yttrium Aluminum Garnet) laser or a CO.sub.2 laser. The CO2 laser may be 600 watts.

(Stasiuk, col. 8, l. 58 - col. 9, l. 17.)

4. Stasiuk discloses in Figure 3A a tab 40 disposed immediately above the upper surface 21 of the container top 20 such that any void formed adjacent the end marked by lead line 43 (FF 1) would reveal the underlying surface disposed below it. (Stasiuk, Figure 3A.)

5. The Examiner found that a "...plurality of colors are disclosed in

col. 2 line 52 through col. 3 line 2 of Stasiuk. The three dimensional feature is the overall shape of the tab which may be designed to correspond with the logo (page 3 lines 12-13).” (Final Rej. 3.)

PRINCIPLES OF LAW

“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. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘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 to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 USC § 103, for anticipation is the epitome of obviousness. *See In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974); and *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982).

ANALYSIS

The rejections are affirmed as to claims 1-20.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Appellants' arguments against each of the rejections of independent claims 1, 8, and 17 are based on perceived deficiencies of Stasiuk. Inasmuch as Appellants raise the same issues with respect to each of these claims, we discuss these claims together, addressing each of Appellants' arguments in turn.

The rejections are affirmed as to claims 1, 8, and 17. Appellants do not provide a substantive argument as to the separate patentability of claims 2-7, 9-14 and 18-20 that depend from claims 1, 8, and 17 respectively. Claims 2-7, 9-14 and 18-20 thus fall with claims 1, 8, and 17. *See*, 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Anticipation rejection of claim 1-20 based on Stasiuk

Appellants argue:

[t]he key difference is that Stasiuk does not anticipate claim 1 or dependent claims therefrom because it does not describe a promotional end in which three structural elements combine to form the promotional image:

- (1) a void formed in a free distal portion of a tab secured to the can end;
- (2) adjacent laser etching of one or more features on the tab surface adjacent to the void (e.g., etching of a colored tab to reveal a base color of the tab stock), and
- (3) the upper surface of the end that is revealed via the void formed in the free distal portion of the end.

(Appeal Br. 9.) However, we cannot accept Appellants' contention that Stasiuk fails to disclose items 1, 2, and 3 *supra* because contrary to the above assertions Stasiuk does disclose: 1. that the tab can be formed as a decorative tab having at least one finger aperture associated therewith (FF 1); 2. that an apparatus for use in a tab decorating area is an optical device, preferably a laser, capable of generating a substantially permanent tab decoration on a tab or tab making materials (FF 2); 3 Stasiuk discloses in Figure 3A a tab 40 disposed immediately above the upper surface 21 of the container top 20 such that any void formed adjacent the end marked by lead line 43 (FF 1) would reveal the underlying surface disposed below it (FF 3). Thus, each of the three points enumerated above by Appellants as not being disclosed by Stasiuk are in fact part of the Stasiuk disclosure.

Appellants further argue that "None of the embodiments [in Stasiuk] meet the requirements of Claim 1. Figures 1 and 2 show a decorative tab formed as a pineapple. In this embodiment, Stasiuk mentions that there is no need to have an aperture in the tab. Col. 5 lines 40-41." (Appeal Br. 9.) However, continued reading of the paragraph in which this passage is found does show that Stasiuk states "...the symbolic shape could also be achieved in an embodiment wherein the pull tab is not a continuously solid plate, has

apertures, is not a planar member and is not a substantially flat sheet. The tab is preferably shaped to be recognized as a picture, trademark, icon, character, or other symbolic item.” (FF 2.) Thus, although Stasiuk states that there is no need to have an apertured tab, it nevertheless still discloses the option of the pull tab having an aperture in it, and we choose to read this option as disclosing a decorative tab with a void as required by the claims.

Appellants next argue that “[t]he Examiner cites to four passages in Stasiuk for teaching voids, but applicants submit that they do not teach a void as contributing to a promotional image.” (Appeal Br. 10.) We are unconvinced by this argument because Appellants are attempting to define patentability by distinguishing a promotional or decorative image from one which is not, which is a matter of marketing and perception based on the mind of the consumer. We find that the image of a pineapple shown in Figures 1 and 2 of Stasiuk may have a void formed in it (FF 1). Thus, the only issue remaining is whether the image of a pineapple with a void in it is a promotional image. Since any image may serve as a promotional image when appropriate marketing is used to support the promotion, or be seen by a viewer as decorative in the eye of the beholder, we find that pineapple tab in Stasiuk with a void in it is at least a decorative image and could serve as a promotional image if so marketed. We therefore sustain the rejection of claims 1-4 and 17-20 under 35 U.S.C. § 102(b) based on Stasiuk.

Rejection under 35 U.S.C. § 103(a) of Webb in view of Stasiuk

Appellants’ arguments directed to the shortcomings of Webb are not well taken because as found *supra*, Stasiuk disclose each and every limitation of independent claims 1, 8, and 17. Thus, Appellants are attacking the references individually when the rejection is based on a

combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968). Accordingly, we find that claims 1-14 and 17-20 are also obvious over Stasiuk for the reasons set forth *supra*. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for anticipation is the epitome of obviousness. *See Pearson*, 494 F.2d at 1402; and *Fracalossi*, 681 F.2d at 794.

With that said, in balance are claims 15 and 16 which were only rejected under 35 U.S.C. § 103(a) and which recite “a three-dimensional decorative feature in combination with said void and said etched feature.” The Examiner maintains that in Stasiuk “[t]he three dimensional feature is the overall shape of the tab which may be designed to correspond with the logo” (FF 5). It is not apparent, and Appellants have not challenged this finding why the tab could not be considered the three dimension feature in Stasiuk. Accordingly, Appellants have failed to show that the Examiner erred in rejecting the claims 15 and 16.

CONCLUSIONS OF LAW

We conclude:

1. We affirm the rejection of claims 1-14 and 17-20 under 35 U.S.C. § 102 (b) as being anticipated by Stasiuk.
2. We affirm the rejection of claims 1-20 under 35 U.S.C. § 103(a) as being obvious over Webb in view of Stasiuk.

DECISION

The decision of the Examiner to reject claims 1-20 is **AFFIRMED**.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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