

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. NAHILL and BRIAN A. LYNCH

Appeal 2008-3018
Application 10/375,736
Technology Center 1700

Decided: June 30, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's final rejection of claims 7-14. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' invention is directed to a method of making a plastic preform assembly. The assembly is disclosed as being useful in forming plastic containers (Specification 1-2). Claim 7 is illustrative and reproduced below:

7. A method of making a preform assembly that includes the steps of:

(a) providing a molded plastic preform that has an open mouth, a neck surrounding said mouth with an external surface at a first diameter, an external flange at one end of said neck surrounding said mouth, and a preform body integrally molded with said neck at an end of said neck spaced from said flange, said body having a second external diameter greater than said first diameter;

(b) providing a circumferentially continuous molded plastic finish ring, and

(c) assembling said finish ring to said preform by stretching said finish ring while warm over said external flange to locate said finish ring over said external surface of said neck and shrinking by cooling said ring onto said neck such that said ring is secured to said neck by interference shrink fit, wherein said stretching comprises expanding said finish ring over an anvil having an outer surface with a diameter at said flange at least equal to that of said flange.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Lecinski	4,607,757	Aug. 26, 1986
Pedersen	EP 0 641 718 A1	Mar. 8, 1995

Claims 7-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pedersen in view of Lecinski. We substantially agree with the Examiner's fact finding, analysis, rebuttal of Appellants' arguments, and the obviousness conclusion reached in the Examiner's

Appeal 2008-3018
Application 10/375,736

Answer. Thus, we affirm substantially for the reasons set forth by the Examiner in the Answer. We offer the following for emphasis only.

Appellants argue the rejected claims together in the Appeal Brief. Thus, we select claim 7 as the representative claim on which we decide this appeal.

The Examiner has basically determined that Pedersen discloses a preform assembly method corresponding to the method of representative claim 7 that employs a tool (7) like Appellants' claimed anvil for assembling a ring (5) to a preform body (1) but for the lack of an express teaching that the plastic ring (5) that is stretched over a flange at opening (4) of a preform body (1) of Pedersen is in a warm condition such that, on subsequent cooling, the ring contracts or shrink fits to the neck (6) of the preform body, as required by representative appealed claim 7 (Ans. 3-4). Appellants do not specifically disagree with this determination by the Examiner, much less so in a manner that persuasively establishes error in this determination. See the Appeal Brief in its entirety.

The Examiner turns to asserted additional teachings of Lecinski for the representative claim 7 requirement of the ring (insert) being warm during the stretching thereof over a preform body flange together with the cooling of the warmed ring that follows from the use of such a warm ring. Here, the Examiner notes that Lecinski describes or suggests using a warmed (heated) insert (ring) during the placing of a ring over a container flange. Moreover, the Examiner basically asserts that Lecinski teaches or suggests locating the ring on a neck portion of a container and that cooling of the warmed ring will occur and a fixed interference fit of the cooled/shrunken ring on the container neck will ensue such that rotation of the ring is forestalled due to

the improved fit and/or interlock of the reduced size ring onto the neck portion of the container (Ans. 4).

Based on these asserted teachings of Lecinski in combination with Pedersen, the Examiner has taken the position that one of ordinary skill in the art at the time of the invention would have been led to use the warm ring and shrink fit technique of Lecinski in the ring affixing operation of Pedersen with a reasonable expectation of facilitating the ring stretching operation of Pedersen via the ring warming with the benefit of securing a good fit or fixture of the ring to the body neck of Pedersen, upon cooling, as suggested by Lecinski.

Appellants maintain that: (1) Pedersen and Lecinski are not combinable in that Pedersen is concerned with increasing the thickness of a container neck and Lecinski is concerned with a press-on closure assembly comprising an insert and a closure cap for a container; (2) the Examiner's proposed combination is based on impermissible hindsight; (3) there is no suggestion or motivation for the Examiner's proposed combination of references; and (4) the proposed combination would yield an inoperable process.

However, these arguments are not persuasive for the reasons stated by the Examiner (Ans. 4-8). We add that the Examiner's proposed combination is not based on a substitution of the insert and closure assembly (12) of Lecinski for the ring (5) of Pedersen but rather on the obviousness of providing heat or warming for the plastic ring (5) of Pedersen to facilitate the expansion of the ring (5) of Pedersen for assembly to the container perform body (1). The Examiner has found that such heating or warming of the ring (5) of Pedersen would ease expansion of the ring and would be

expected to result in a tighter fit of the ring to the neck of the preform body (1) (Ans. 5). Appellants have not effectively refuted these determinations of the Examiner by their allegations respecting the greater wall thickness desired by Pedersen and the asserted differences in the ring and neck design of Pedersen and the insert and closure assembly and neck design of Lecinski.

Moreover, the assertions with respect to a lack of suggestion or motivation for the Examiner's proposed combination are not persuasive. It is well settled that, under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). However, "analysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). See *DyStar Textilsfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) ("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself."). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 127 S. Ct. at 1739.

Here, the Examiner has identified a rationale for the proposed modification of Pedersen's method at several locations (Ans. 4 -7). The

Appeal 2008-3018
Application 10/375,736

Examiner's basis for the rejection has not been fairly refuted by Appellants unadorned remarks and speculations as presented in the Appeal Brief.

Furthermore, Appellants have not proffered any persuasive evidence to establish that an inoperable process would result from the Examiner's proposed modification or any evidence of secondary considerations to refute the prima facie case of obviousness made out by the Examiner.

On this record, we concur with the Examiner's obviousness determination.

CONCLUSION

The decision of the Examiner to reject claims 7-14 under 35 U.S.C. § 103(a) as being unpatentable over Pedersen in view of Lecinski is affirmed.

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).

AFFIRMED

tf/lS

RISSMAN JOBSE HENDRICKS & OLIVERIO, LLP
100 CAMBRIDGE STREET
SUITE 2101
BOSTON, MA 02114