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for publication and is not binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JEFFREY J. ZETTLE et al.

Appeal No. 2004-1271
Application No. 09/370,913

HEARD: August 18, 2004

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellants' request for rehearing[1] of our decision mailed August 31, 2004, wherein we affirmed the examiner's rejection of claims 1, 3 to 5, 9 to 12, 15 to 17 and 19 to 22 under 35 U.S.C. § 102(b); reversed the examiner's rejection of claims 8, 18 and 25 under 35 U.S.C. § 102(b); and affirmed the examiner's rejection of claims 6, 7, 13, 14, 23 and 24 under 35 U.S.C. § 103

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[1] Filed October 20, 2004.

Independent claim 1 is directed to a lid for use with a bowl and recites a venting feature in terms of the lid's interaction with the bowl, but does not affirmatively recite the bowl as a separate element of the claim. Independent claims 9 and 19 are directed to the entire container, including both the lid and the bowl, and also recite the venting feature.

In our decision, we expressly found that the Dokoupil container "only vents during the process of securing the lid 24 to the container 12 and not necessarily when the lid 24 is secured or loosely placed on the container." (Decision, p. 8.) However, because claim 1 was "directed to the lid, per se, and not the combination of the lid with a bowl" (Decision, p. 8), we held that claim 1 was inherently anticipated by the Dokoupil lid because such a lid was "clearly capable of being loosely placed on a suitable bowl" so as to provide venting. (Decision, pp. 8-9.) In view of the appellants grouping of claims 1, 3 to 7, 9 to 17 and 19 to 24, we affirmed the rejections of claims 3 to 7, 9 to 17, and 19 to 24, which the appellants had grouped together with claim 1 in their appeal brief.

The request for rehearing is limited to claims 9 to 17 and 19 to 24, which are directed to the combination of a lid and a bowl. Specifically, the appellants request that we reverse the rejections of claims 9 to 17 and 19 to 24 in view of our express finding that the examiner's only substantive reason for rejecting those claims (i.e., that the Dokoupil

lid would have inherently allowed for venting if it were loosely placed on the Dokoupil container) was without basis.

We have carefully considered the arguments raised by the appellants in their request for rehearing and those arguments do persuade us that under the facts of this case, in the interests of justice, it would be appropriate for us to separately consider the rejections of claims 9 to 17 and 19 to 24. Since Dokoupil's container only vents during the process of securing the lid 24 to the container 12 and not necessarily when the lid 24 is secured or loosely placed on the container, claims 9 to 17 and 19 to 24 (directed to the combination of a lid with a bowl) are not inherently anticipated by the Dokoupil lid or obvious therefrom. Accordingly, the decision of the examiner to reject claims 9 to 12, 15 to 17 and 19 to 22 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 13, 14, 23 and 24 under 35 U.S.C. § 103 is reversed.

In light of the foregoing, the appellants' request for rehearing is granted to the extent the decision of the examiner to reject claims 9 to 12, 15 to 17 and 19 to 22 under 35 U.S.C. § 102(b) has been reversed and the decision of the examiner to reject claims 13, 14, 23 and 24 under 35 U.S.C. § 103 has been reversed. The decision of the examiner to reject claims 1 and 3 to 5 under 35 U.S.C. § 102(b) remains affirmed; the decision of the examiner to reject claims 8, 18 and 25 under 35 U.S.C. § 102(b) remains

reversed; and the decision of the examiner to reject claims 6 and 7 under 35 U.S.C. § 103 remains affirmed.

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

REQUEST FOR REHEARING - GRANTED

NEAL E. ABRAMS Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

S.C. JOHNSON & SON, INC.
1525 HOWE STREET
RACINE, WI 53403-2236

JVN/jg