

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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHEL D'AMORE et al.

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Appeal No. 2000-0003  
Application No. 08/618,814

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HEARD: February 8, 2001

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Before McQUADE, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 14, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

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<sup>1</sup> Claim 5 was amended subsequent to the final rejection.

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BACKGROUND

The appellants' invention relates to a process for manufacturing a shaped metal beverage can. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Dolveck	3,759,205	Sept. 18,
1973		

Claims 1 to 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dolveck.

Claims 7 to 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dolveck.

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 (Paper

No. 12, mailed August 19, 1997) and the answer (Paper No. 21, mailed November 6, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed September 16, 1998) and reply brief (Paper No. 22, filed December 4, 1998) for the appellants' arguments thereagainst.

#### 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 which follow.

#### **The anticipation rejection**

We will not sustain the rejection of claims 1 to 6 under 35 U.S.C. § 102(b).

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. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1 reads as follows:

Process for manufacturing a shaped metal beverage can comprising a bottom and a peripheral wall which includes a succession of regions of different diameters, said peripheral wall being adapted to receive a lid set on said peripheral wall, said process comprising the following steps:

producing from a metal blank a cylindrical preliminary can comprising a bottom and a peripheral wall which has a diameter equal to a given diameter of a region of said peripheral wall of said shaped can;

effecting an operation reducing the diameter of the peripheral wall by shrinking a part of said peripheral wall of said preliminary can situated above said region of said given diameter of said peripheral wall to bring said part to a diameter which is smaller than said given

diameter; and effecting at least one expanding operation on a part of said peripheral wall situated above said region of said given diameter for producing said succession of regions of different diameters of said peripheral wall.

Dolveck discloses a process for making a hollow metallic article from a tubular blank closed at one end. Dolveck provides that the process deforms the entire periphery of the wall of the blank over its entire length from one end to the opposite end. Dolveck teaches (column 1, lines 10-12; column 5, lines 36-41) that the hollow metallic article obtained according to his process can be used not only as an aerosol container but also as a soda water bottle or a flower vase.

As shown in Figure 1 of Dolveck, a basic metal container 1 having a flat base and open at the opposite end 2 from the base, is made by a known drawing and pressing operation. This forms the basic tubular blank on which all the remaining operations are to be performed. The end 2 is trimmed by a metal cutter or grinding wheel, to any desired length to produce a container 1 as shown in Figure 2. Thereafter, a base 3 of container 1 is

formed to the shape shown in Figure 3. Then, the lower part of the container, that is, the part of the container between the base and the area of the smallest diameter, is obtained by a succession of forming operations. Lastly, the upper part of the container, that is, the part of the container that is situated between the upper neck and the area of smallest diameter is obtained by a succession of forming operations. From these forming operations, Dolveck teaches that it is possible to obtain containers shaped as shown in Figures 13, 14, 16, 19, 20, 21, 24 and 25.

The appellants argue (brief, pp. 3-5; reply brief, pp. 1-2) that the process of claim 1 is not anticipated by Dolveck since Dolveck requires deformation of the entire periphery of the wall of the the blank over its entire length from one end to the opposite end. We agree.

In our view, the three process steps of claim 1 are not readable on Dolveck. In that regard, while Dolveck does produce from a metal blank a cylindrical preliminary can comprising a base and a peripheral wall (i.e., the wall

extending upwardly from the base as shown in Figure 3) in which the peripheral wall has a given diameter, Dolveck does not teach or suggest that the diameter of the peripheral wall of the metal blank shown in Figures 1-3 be equal to a given diameter of **a region of the peripheral wall of the shaped can.** Thus, the first of the three process steps of claim 1 is not readable on Dolveck. The second of the three process steps of claim 1 is not readable on Dolveck since Dolveck does not teach or suggest effecting an operation reducing the diameter of the peripheral wall by shrinking a part of the peripheral wall of the preliminary can **situated above the region of the given diameter of the peripheral wall.** Likewise, the third of the three process steps of claim 1 is not readable on Dolveck since Dolveck does not teach or suggest effecting at least one expanding operation on a part of the peripheral wall **situated above the region of the given diameter.**

The examiner's position (answer, p. 2) that notwithstanding Dolveck's specific teaching that the entire peripheral wall is deformed, that Dolveck's Figures 3 to 6

show a region of the peripheral wall which remains at the original diameter while the peripheral wall above that region is reduced in diameter is, in our view, pure speculation. It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be 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. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

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. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In this case, it is our opinion that the examiner's position is based upon sheer speculation. Furthermore, it is our view

that Dolveck's Figures 3 to 6 do not show a region of the peripheral wall (the peripheral wall is the wall that extends upwardly from the base as shown in Figure 3) which remains at the original diameter while the peripheral wall above that region is reduced in diameter.

Since all the limitations of claim 1 are disclosed in Dolveck for the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 to 6 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

**The obviousness rejection**

We will not sustain the rejection of claims 7 to 14 under 35 U.S.C. § 103. Claims 7 to 14 depend from claim 1. Since the examiner has not set forth any reasoning as to why the subject matter of claim 1 would have been obvious at the time the invention was made to a person having ordinary skill in the art, we reverse the decision of the examiner to reject claims 7 to 14 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 7 to 14 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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