

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. TIMSON

Appeal No. 96-2280
Application 08/263,392¹

ON BRIEF

Before FRANKFORT, STAAB and McQUADE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claim 21 in this continuation application for reissue of U.S. Patent No. 5,027,968. Claims 1-12, 18 and 19,

¹ Application for patent filed June 20, 1994. According to appellant, this application is a continuation of Application 08/083,491 filed June 28, 1993, now abandoned, which is a reissue of U.S. Patent No. 5,027,968 issued July 2, 1991, based on Application 07/606,564 filed October 31, 1990.

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the only other claims remaining in the application, have been allowed.

Appellant's invention pertains to a container construction "having a cover which includes strip means which promotes ease of manual removal of the cover from the container when the cover is severed from the container" (specification, column 1, lines 10-13). As further explained in the specification at column 1, lines 53-63:

The present invention provides a container construction with a top having a handle in the form of a strip or a plurality of strips. The strips are prestressed and secured to the container in a manner such that when the container top is cut about its periphery when opening the container, the strip or strips, under the prestressing forces, lift away from the container top to a position where they can be easily grasped. The requirement of manual force to lift the strips away from the container is eliminated so the container contents are not disturbed when the top is removed from the container.

Claim 21 sets forth the appealed subject matter as follows:

21. A sealed container having a permanently fixed solid cover to a body having a volume containing a material, said cover being free of holes and being free of a molded indentation, a grasping member comprising at least one flexible strip means having a first portion adhered to an exposed surface of said cover, said at least one strip means having a free second end, said at least one strip means having a stress bias so that said second end is positioned away from said cover where it can be easily grasped when no force is applied to said strip, said cover being severable from said body by being cut, said strip means being sufficiently flexible that it can contact said cover without losing said stress bias when said sealed container is stacked with a second sealed container on said cover.

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The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Asmus	3,981,412	Sept. 21, 1976
Simon	5,052,568	Oct. 1, 1991
		(filed March 27, 1990)

Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Asmus in view of Simon.

The examiner considers that Asmus discloses a container and cover construction that corresponds in all respects to the claimed subject matter, except that the cover 10 of Asmus is not free of a molded indentation. In particular, the examiner notes Figure 4 of Asmus where the tab 112 is illustrated as being slightly spaced from the cover, and concludes that the tab of Asmus is stress biased and sufficiently flexible, such that it can contact the cover without losing its stress bias when the sealed container is stacked with a second container on the cover, as called for in the claim.

With respect to the limitation calling for the cover to be free of a molded indentation, the examiner cites Simon for its disclosure of a foil cover 17 free of holes and molded indentations. The examiner concludes that it would have been obvious to one of ordinary skill in the art to have employed the foil cover 17 of Simon in Asmus, motivated by the cost savings

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and gas impermeability of Simon's foil material. Implicit in the rejection is the examiner's position that the Asmus device modified in the above proposed manner would correspond in all respects to the claimed subject matter.

We have carefully reviewed appellant's invention as described in the specification, the appealed claim, the prior art applied by the examiner, and the respective positions advanced by the examiner and appellant. As a consequence of this review, we will not sustain the standing § 103 rejection of claim 21. Our reasons follow.

First, we find no clear teaching in the applied references which would indicate that the ordinarily skilled artisan would have been motivated by hopes of cost savings and gas impermeability to use a foil cover material like that of Simon in Asmus. The cover of Asmus is made of a particular plastic material selected for its very low permeability to gases and vapors, and its ability to burn cleanly and completely in incinerating equipment, thus facilitating its disposal as compared to metals and glass (column 1, line 54 through column 2, line 3; column 2, line 60 through column 3, line 50). Thus, permeability is not seen as a problem in Asmus, and it is not clear that the foil material of Simon would be as environmentally

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friendly as the particular plastic material of Asmus. Further, there is nothing in the references which would indicate that the foil cover material of Simon would be less costly than Asmus' cover material, or that it would be suitable for use in Asmus' intended environment (unfrozen foods and beverages, particularly carbonated soft drinks and beer). Accordingly, we do not find the examiner's rationale in support of the proposed modification of Asmus to be well founded.

Second, assuming *arguendo* that the ordinarily skilled artisan would have been motivated to combine the foil cover of Simon with the container closure of Asmus, and, presumably, eliminate the molded indentations 13, 16 of Asmus in the process, it is not apparent to us why the tab of Asmus would be retained. In this regard, Asmus' tab 12 is specifically provided to initiate tearing of the cover along the indentation lines 13, 16 (column 4, lines 11-35). Thus, the tab 12 and molded indentations of Asmus work together to facilitate removal of the cover. Based on the teachings of the references themselves, without benefit of appellant's disclosure, there would not appear to be any need for a tab in Asmus if the molded indentations were eliminated. Where prior art references require a selective combination to render obvious a claimed invention, there must be

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some reason for the combination other than hindsight gleaned from the invention disclosure, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). In the fact situation before us, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of the applied references to incorporate the metal foil cover of Simon in the container closure of Asmus while retaining the tab 12.

Third, we do not believe that the examiner has provided a sound basis in fact and/or technical reasoning to support his determination that the tab of the modified Asmus device would be stress biased and sufficiently flexible such that the characteristics of the tab called for in the appealed claim would necessarily flow from the teachings of the prior art. The examiner appears to presume that the tab of the modified device would be made of a thermoplastic material like that of Asmus rather than a metal foil material like that of Simon. Why this is so is not clear, especially since Asmus teaches that the tab should preferably be made of the same material as the top (column 3, lines 58-63), and the examiner's proposed modification involves "employing the foil cover teaching of Simon in the construction of the device of Asmus" (answer, page 4).

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In any event, the examiner merely notes that the material of the tab of Asmus is described as being "flexible" and that, in one of Asmus' embodiments (see Figure 4), a tab is shown that is positioned away from the cover. We fail to see how these disclosures justify the examiner's determination that the tab of Asmus necessarily possesses the characteristics of the claimed subject matter. This is especially so where the specification of Asmus also describes the thermoplastic material from which the tab may be made as being "tough, high-impact strength thermoplastic" (column 2, line 61), "relatively inelastic" (column 3, line 59), "tough, flexible, but otherwise inelastic" (column 5, lines 41-42), and, as having "inherent stiffness" (column 6, line 62; column 8, line 4).

Under the 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. *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

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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.

The fact that the Asmus reference discloses a tab made of somewhat flexible material that may (Figure 4) or may not (Figures 1 and 6) be positioned away from the cover does not, in our view, necessarily mean that the tab of a closure "employing the foil cover teaching of Simon in the construction of the device of Asmus" (answer, page 4) would have a grasping means comprising a strip "having a stress bias so that said second end is positioned away from said cover where it can be easily grasped when no force is applied to said strip" and such that the strip is "sufficiently flexible that it can contact said cover without losing said stress bias when said sealed container is stacked with a second sealed container on said cover," as called for in claim 21. The examiner's determination to the contrary is unduly speculative, in our view.

In light of the foregoing, we will not sustain the examiner's § 103 rejection of claim 21 as being unpatentable over Asmus in view of Simon.

The decision of the examiner is reversed.

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REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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Paul J. Cook
8 Washington Street
Manchester, MA 01944