UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/294,373	12/06/2005	Brian J. Chisholm	184569-3083	6208

50787 7590 02/25/2013
STRADLEY RONON STEVENS & YOUNG, LLP
30 VALLEY STREAM PARKWAY
GREAT VALLEY CORPORATE CENTER
MALVERN, PA 19355-1481

EXAMINER
ROGERS, MARTIN K

ART UNIT	PAPER NUMBER
1747	

MAIL DATE	DELIVERY MODE
02/25/2013	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN J. CHISHOLM

Appeal 2011-010239
Application 11/294,373
Technology Center 1700

Before RICHARD E. SCHAFER, JEFFREY T. SMITH and MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 13 through 21. We have jurisdiction under 35 U.S.C. § 6.

Appellant's invention is directed to an apparatus for reforming the upper portion of a plastic container. Spec. ¶ [0001]. Claim 13 is illustrative of the subject matter on appeal and is reproduced below:

> 13. An apparatus for reforming an upper portion of a blow molded plastic container, comprising:
>
> a previously formed and cooled plastic container having an upper portion and a lower portion, the upper portion previously formed by a blow molding process selected from the group consisting of extrusion blow molding and reheat blow molding;
>
> a non-contact heat source adapted to soften selectively the upper portion of the plastic container but not the lower portion of the plastic container; and
>
> first and second reforming tools spaced apart from the heat source and defining a cavity between the first and second reforming tools receiving the plastic container after the upper portion has been softened, the first and second reforming tools adapted to compress only the softened upper portion between the first and second reforming tools, without rotating relative to the plastic container, to reform the upper portion with high geometrical and dimensional tolerances required for the capping and/or sealing of the container.

The Examiner relied on the following references in rejecting the appealed subject matter:

Greitzer	US 3,464,582	Sept. 2, 1969
Ayres	US 3,947,204	Mar. 30,1976
Ohlsson	US 4,151,024	Apr. 24, 1979

Torsten	US 5,067,888	Nov. 26, 1991
Sirianni	US 5,582,957	Dec. 10, 1996
Beck	US 6,126,886	Oct. 3, 2000
Moriuchi	JP 61-116513 A	June 4, 1986

Appellant, App. Br. 3-4, requests review of the following rejections from the Examiner's final office action:

I. Claims 13-21 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

II. Claims 13-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriuchi and Ohlsson.

III. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriuchi, Ohlsson and Beck.

IV. Claims 13-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beck, Greitzer, and Ayres or Torsten.

OPINION

Rejection under 35 U.S.C. § 112, first paragraph (written description)

The Examiner contends that the Specification "does not convey to one of ordinary skill in the art at the time of the invention that the preform is heated in a separate location and then transported so that it is received by the forming tools." Ans. 4. The Examiner further contends that paragraphs 20 and 24 and Figures 1 and 2 of the Specification are insufficient to provide written descriptive support for the disputed claim language because no mention is made of conveying a heated container to the forming tools. *Id*.

Appellant argues that "Figures 1-4 depict an exemplary method and apparatus. In other words, they illustrate a sequence of steps as to how an apparatus is used in practice." App. Br. 6-8. We are unpersuaded by Appellant's arguments and agree with the Examiner that the Specification

does not convey to one of ordinary skill in the art the claimed apparatus structure recited by the disputed claim language. The portion of the Specification identified by Appellant does not establish the location of the container prior to being received by the forming tools. Thus, this evidence does not convey that Appellant was in possession of a preform that is heated in a separate location and then transported so that it is received by the forming tools.

Accordingly we affirm the rejection under 35 U.S.C. § 112, first paragraph.

The Prior Art Rejections

The dispositive issue for this appeal is: Did the Examiner err in determining that the combination of Moriuchi and Ohlsson would have led one skilled in the art to an apparatus for reforming an upper portion of a plastic container as required by the subject matter of independent claim 13?[1]

After review of the respective positions provided by Appellant and the Examiner, we answer the question in the negative and AFFIRM for the reasons presented by the Examiner and add the following.

The Examiner found that Moriuchi discloses an apparatus for reforming the upper portion of a previously formed and cooled molded container having first and second reforming tools defining a cavity between the first and second reforming tools which compress the upper portion of a container without rotating relative to the plastic container. Ans. 5-7. The Examiner also found that Moriuchi does not disclose how the preform is

[1] We will limit our discussion to independent claim 13. Appellant has not argued the dependent claims separately. Accordingly, claims not argued separately will stand or fall together with independent claim 13.

heated prior to the reforming steps. *Id*. at 5. The Examiner found that Ohlsson teaches it was well known in the art to heat just the necessary portion of the previously formed and cooled container with a non-contact heater when reforming only a portion of a container. *Id*. at 6. The Examiner found that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a non-contact heater, as taught by Ohlsson, in the apparatus of Moriuchi because it is a well-known process for heating a portion of a container prior to reforming the heated portion. *Id*.

Appellant's principal argument is that the proposed combination of Moriuchi and Ohlsson does not teach or suggest an apparatus comprising a previously formed and cooled plastic container as required by the subject matter of independent claim 13. App. Br. 6-8. That is, neither Moriuchi nor Ohlsson discloses a previously formed and cooled plastic container having an upper portion and a lower portion, the upper portion previously formed by a blow molding process selected from the group consisting of extrusion blow molding and reheat blow molding. *Id*. at 8-9. In support of this argument, Appellant provides the Declarations by Garrett Pennington and John Tobias and technical manual excerpts[2] to establish that the containers of Moriuchi and Ohlsson are formed as part of a continuous process and are not previously formed as required by the claimed invention. *Id*.

[2] The Declarations by Garrett Pennington and John Tobias filed on April 6, 2010, were entered and considered by the Examiner in the non-final Office Action of April 23, 2010. The subsequent Declaration by Garrett Pennington and the technical manual excerpts filed July 23, 2010, were entered and considered by the Examiner in the Final Office Action of September 29, 2010.

Appellant's arguments and evidence for patentability are not persuasive. The Examiner correctly argues that Appellant's arguments and evidence are directed to elements being worked upon by the apparatus. Ans. 6-7, 15-17. Appellant has not adequately explained how the container structure distinguishes the elements of the claimed apparatus from the elements of the apparatus of Moriuchi or why the structure of the container distinguishes the structure of the claimed apparatus from the apparatuses of the prior art. See, e.g., In re Otto, 312 F.2d 937, 939-40 (CCPA 1963); In re Rishoi, 197 F.2d 342, 344-45 (CCPA 1952) ("[T]here is no patentable combination between a device and the material upon which it works.").

Moreover, a person of ordinary skill in the art would have been capable of adapting Ohlsson's non-contact heater for use in the device of Moiruchi to heat the upper portion of a container given that Moiruchi requires the container to be in plastic state to form the flanges. Moiruchi 5, Fig. 3-5. *See In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985) (skill is presumed on the part of one of ordinary skill in the art); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969). Appellant has not adequately explained why one skilled in the art could not use the non-contact heater of Ohlsson in the device of Moiruchi.

Therefore, we find no error in the Examiner's obviousness determination. Accordingly, we sustain the rejection of claims 13-20 under 35 U.S.C. § 103(a) as unpatentable over Moriuchi and Ohlsson for the reasons given above and by the Examiner.

The Examiner additionally rejected dependent claim 21 under 35 U.S.C. § 103(a) as unpatentable over Moriuchi, Ohlsson and Beck. Ans. 8-9. In addressing the limitations of claim 21, the Examiner found that Beck

teaches that it is well known to create a flange on either a vertically extending upper portion of a container or to pre-equip the container with a flange portion prior to the reforming step. *Id*. at 8.

We have considered Appellant's arguments (App. Br. 12-13) for this rejection and are unpersuaded by them because they do not address the reasons for which the Examiner relied on Beck. Accordingly, we also affirm the rejection of claim 21 for the reasons given above and by the Examiner.

The Examiner also presented a parallel rejection of claims 13-21 as unpatentable under 35 U.S.C. § 103(a) over Beck, Greitzer, and Ayres or Torsten. Ans. 9. We refer to the Examiner's Answer for a statement of the Examiner's rejection. *Id*. at 9-12.

Appellant's principal argument for this rejection is the same as discussed above, i.e. that the prior art does not include a previously formed and cooled container. App. Br. 14-15. We are again unpersuaded by this argument and direct Appellant's attention to our prior discussion on this issue. We limit any additional discussion to specific arguments not addressed above.

Appellant argues that modifying Beck in view of the above noted secondary references would also render Beck's apparatus unsatisfactory for its intended purpose because it would convert Beck's curling apparatus to a compression apparatus. *Id.* at 15-17.

We are also unpersuaded by this argument and agree with the Examiner's reasoning (Ans. 18-19). Appellant has not disputed the Examiner's findings that the Beck's non-preferred embodiment of a container with a flange but without a curled lip could be reformed by means other than curling given the disclosure of Greitzer. Ans. 9-10, 19.

Accordingly, we sustain this rejection as well for the reasons given above and presented by the Examiner.

ORDER

The rejection of claims 13-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejection of claims 13-20 under 35 U.S.C. § 103(a) as unpatentable over Moriuchi and Ohlsson is affirmed.

The rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over Moriuchi, Ohlsson and Beck is affirmed.

The rejection of claims 13-21 under 35 U.S.C. § 103(a) as unpatentable over Beck, Greitzer, and Ayres or Torsten is affirmed.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136.

AFFIRMED

bar