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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CURT GONZALES, DANIEL FRADL,
MARK A. RAMSDELL, and EDWARD SAVAGE

Appeal 2014-005936
Application 12/994,554¹
Technology Center 3700

Before MICHAEL C. ASTORINO, NINA L. MEDLOCK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–9 and 11–20; claim 10 is withdrawn. *See* Appeal Br. 4. We have jurisdiction under 35 U.S.C. § 6(b).

¹ “The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 11445 Compaq Center West Drive, Houston, TX 77070, U.S.A. (hereinafter ‘HPDC’). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.” Appeal Br. 2.

We AFFIRM.

ILLUSTRATIVE CLAIM

7. A fluid container, comprising:
- a housing having a chamber therein for holding a fluid and an outlet from the chamber;
 - a cap capping the outlet, the cap comprising a shell and an elastomeric liner lining a recessed part of the shell, the liner including:
 - a cylindrical sidewall;
 - a floor;
 - a first annular groove in the floor receiving the outlet;
 - a circular contact surface on the floor facing the sidewall and extending around one side of the first annular groove, the contact surface contacting an interior surface of the outlet; and
 - a second annular groove in the floor inside of and concentric with the first annular groove, the second groove configured to allow the floor to flex in toward the groove when pressure is applied to the contact surface;
 - wherein said contact surface includes a curved surface with a radius of curvature that varies around a circumference of said circular contact surface.

CITED REFERENCES

The Examiner relies upon the following references:

Gray et al. (hereinafter "Gray")	US 2,264,792	Dec. 2, 1941
Koch et al. (hereinafter "Koch")	US 5,555,988	Sept. 17, 1996
Whitley	US 7,163,115 B2	Jan. 16, 2007

Ohmi et al. (hereinafter “Ohmi”)	EP 0 029 729 A1	June 3, 1981
So et al. (hereinafter “So”)	JP 10-291326	Nov. 4, 1998

REJECTIONS

I. Claims 7–9 and 11–20² are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that the Appellants regard as the invention.³

II. Claims 1, 2, 7, 9, 11–16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over So and Ohmi.⁴

III. Claims 17 and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over So, Ohmi, and Whitley.

IV. Claims 3, 4, and 6 are rejected under 35 U.S.C. § 103(a) as unpatentable over So, Ohmi, and Koch.

V. Claims 5 and 8 are rejected under 35 U.S.C. § 103(a) as unpatentable over So, Ohmi, and Gray.

² Claim 10 is withdrawn. *See* Appeal Br. 4. The inclusion of claim 10 in the Final Office Action (at page 2) is regarded as inadvertent.

³ The Examiner rejects claims 7–20 under either 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph. Final Action 2. Because the Appellants’ application was filed before September 16, 2012, the pre-AIA version of the statute is applied herein.

⁴ Although omitted from the heading (Final Action 3), the Examiner’s discussion addresses claim 7 (*id.* at 4–5). Such omission is regarded as inadvertent. Additionally, the inclusion of claim 10 in the Final Office Action (at page 3) is regarded as inadvertent.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

Rejection I

Independent claim 7 and dependent claims 8, 9, and 11–20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite based upon two separate reasons — each of the reasons relating to distinct limitations of claim 7. Final Action 2. As explained below, the Appellants’ argument regarding one limitation at issue (“the contact surface”) is persuasive of error in the rejection, but the Appellants’ argument regarding the other limitation at issue (“the groove”) is not persuasive. Accordingly, the rejection of claims 7–9 and 11–20 under 35 U.S.C. § 112, second paragraph, is sustained.

1. “*the contact surface*”

According to the Final Office Action, the phrase “the contact surface” renders claim 7 indefinite because it is unclear whether a new element is introduced therewith, or whether antecedent basis resides in the earlier recitation of “a *circular* contact surface” (emphasis added). See Final Action 2; see also Answer 2–3. After the appearance of “the contact surface,” claim 7 recites both “*said* contact surface” and “*said circular* contact surface” (emphasis added), which contribute to the uncertainty. See Final Action 2; see also Answer 2–3.

The Appellants argue that, because there is only one “contact surface” recited in claim 7, a person of ordinary skill in the art would understand that

the initial recitation of “a circular contact surface” is the referent for “the contact surface,” “said contact surface,” and “said circular contact surface.” Appeal Br. 10–11; Reply Br. 4.

The Appellants’ argument is persuasive. A person of ordinary skill in the art would understand that the recitation of “a circular contact surface” provides antecedent basis for “the contact surface.” *See Ex parte Porter*, 25 USPQ2d 1144, 1145–46 (BPAI 1992) (“a controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”); *see also* MPEP § 2173.05(e). The rejection of claim 7 on this reason is not sustained.

2. “the groove”

The Final Office Action rejects claim 7 as indefinite, because it is unclear whether the phrase “the groove” refers to “a first annular groove” or “a second annular groove.” *See* Final Action 2; *see also* Answer 2–3.

The Appellants contend that, in the context of claim 7, it would be clear to one of skill in the art that “the groove” refers to the “second annular groove.” Appeal Br. 12; Reply Br. 5.

The Appellants’ argument is not persuasive. There is no textual indication in claim 7 that “the groove” refers to the “second annular groove,” rather than the “first annular groove.” *See* MPEP § 2173.05(e) (“[I]f two different levers are recited earlier in the claim, the recitation of ‘said lever’ in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended.”) Adding to the confusion, the expressions “a second annular groove,” “the first annular groove,” and “the second groove” all appear in the same paragraph as — but prior to — “the groove.” Therefore, the rejection of claim 7 on this basis is sustained.

Rejection II

Independent Claim 1 and Dependent Claim 2

Independent claim 1 stands rejected under 35 U.S.C. § 103(a), based upon So and Ohmi — Ohmi being relied upon particularly for the recited features of the “cap” including “a void adjacent to the contact surface such that a portion of the cap underlying the contact surface may flex into the void.” *See* Final Action 3–4.

The Appellants argue that it would not have been obvious to combine the teachings of So and Ohmi because Ohmi does not relate specifically to a fluid container “for an inkjet printing device,” as claim 1 recites, but “merely teaches a twist-on cap for the top of any liquid bottle.” Appeal Br. 17. The Appellants remark that, despite the significant length of time since Ohmi’s publication, “there is no showing that such technology as Ohmi is alleged to teach has ever been applied to inkjet fluid containers.” *Id.*

Further, the Appellants draw attention to the Specification’s statement that “[i]n a conventional shipping cap seal, there is no such relief to the inside of the contact surface when the container outlet is pressed into the elastomeric seal.” *Id.* (quoting Spec. ¶ 17). According to the Appellants, owing to the duty of candor, weight must be given to such a statement in the Specification that constitutes factual evidence of nonobviousness. Appeal Br. 17 (citing *In re Soni*, 54 F.3d 746 (Fed. Cir. 1995)).

In response, the Examiner’s Answer states that the Appellants’ assertions — including that provided in paragraph 17 of the Specification — are conclusory and unsupported by documentary evidence; therefore, such assertions are not substantively adequate to rebut the rejection. Answer 8–9.

Indeed, the Appellants offer no viable explanation for the position that Ohmi may not be relied upon in the rejection. For example, there is no attempt to demonstrate that Ohmi might constitute non-analogous art, or that it teaches away from the combination. Further, the Appellants' position contradicts the admission that Ohmi teaches a "cap for the top of *any* liquid bottle" (Appeal Br. 17 (emphasis added)) and, thus, could apply to So — which the Examiner cites for disclosing an inkjet printer fluid bottle (*see* Final Action 3).

The Appellants' citation to *Soni* is inapposite. Contrary to the Appellants' view (*see* Appeal Br. 17), the existence of the duty of candor does not mean that the Appellants' opinion regarding the operation of "conventional" devices (such as the referenced statement in paragraph 17 of the Specification) may negate factual findings regarding the teachings of a prior art reference — and *Soni* does not state otherwise. *See Soni*, 54 F.3d at 1750–51.

In view of the foregoing reasons, the Appellants' argument is unpersuasive of error in the rejection of claim 1.

The Appellants rely upon the same argument, in regard to dependent claim 2. Appeal Br. 18. Accordingly, the rejection of claims 1 and 2 under 35 U.S.C. § 103(a) is sustained.

*Independent Claim 7 and
Dependent Claims 9, 11, 14–16, 18, and 19*

The Appellants contend that the Examiner erred in rejecting claim 7 because neither of the cited references (whether alone or in combination) teaches or suggests claim 7's "elastomeric liner" including "a circular contact surface on the floor facing the sidewall and extending around one

side of the first annular groove,” “wherein said contact surface includes a curved surface with a radius of curvature that varies around a circumference of said circular contact surface.” Appeal Br. 14–16.

Specifically, the Appellants argue that, contrary to the Examiner’s findings (*see* Final Action 4–5), So lacks the recited “circular contact surface” and its “curved surface with a radius of curvature that varies around a circumference” thereof (*see* Appeal Br. 12–16; Reply Br. 6–11). The Appellants (Appeal Br. 15; Reply Br. 10) point out that So’s “ellipse truncated cone lobe 13” and “ellipse truncated cone slant face 14” (So ¶ 41) are both non-circular; thus, neither possesses the claimed features of the claimed “circular contact surface.” The Appellants assert that “an ellipse or oval is not a circle.” Reply Br. 10. In addition, the Appellants contend that these identified elements of So also lack the recited “radius of curvature that varies around a circumference of said circular contact surface.” Appeal Br. 13–14; Reply Br. 10.

The Examiner’s Answer interprets the “circular contact surface” limitation, in view of the Specification, and concludes that So teaches the limitation. Comparing the dimensions of “contact surface 64,” as depicted in Figures 8 and 11, with its dimensions, as depicted in Figures 9 and 10, the Examiner finds that the disclosed “contact surface 64” is not circular, but instead possesses what the Examiner calls a “circular oval shape.”

Answer 5. Further, the Examiner finds that the “contact surface 64” seals a “slant[ed]” outlet of the container disclosed in the Specification. *Id.* (citing Spec., Figs. 5–11). In view of these findings, the Examiner determines that the “structural similarity” between the devices in So and the Appellants’ Specification establishes a *prima facie* case of obviousness. *Id.* at 5–7.

The Examiner errs in the interpretation of the recited “circular contact surface.” Although the drawings that accompany a patent application may be relied upon for purposes of claim construction, the Federal Circuit has admonished that “patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000). *See also In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977) (“Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.”) The hazards of extracting meaning from patent drawings are apt to be compounded where, as here, one drawing is measured against another, so as to discern the shape of an item depicted in both drawings.

Moreover, the “circular contact surface” limitation is present in the version of claim 7 included with the original application (*see* Spec. 9), such that the Specification discloses an embodiment having a “contact surface” that is indisputably circular, notwithstanding whatever may be elicited from the drawings.

Furthermore, textual analysis of the claim language at issue suggests that the “circular contact surface” should be understood to be circular, as opposed to a “circular oval shape” or any other non-circular form. The use of the word “circular” stands in contrast with the less-exacting term “annular” that is used in various claims (*see* claims 4, 7, 14, 16–18, 20) and in the Specification (*see* Spec. ¶¶ 16, 21) to refer to various features of the disclosed or claimed embodiments. Likewise, the word “oval” is used explicitly in claim 19 (“the outlet has an oval shape”) and in the

Specification (*see id.* ¶ 14 (“an inner, facing surface 30 of outlet 20 transitions from a circular outer part 32 at rim 26 to an *oval* inner part 34 at opening 28” (emphasis added))). Such specific word choices further support the understanding that the “circular contact surface” of claim 7 should be construed as a *circular* feature.

We agree with the Appellants’ assertion that “an ellipse or oval is not a circle.” Reply Br. 10. Consequently, the “circular contact surface” claim limitation does not read on either of So’s eccentric elliptical elements — the “ellipse truncated cone lobe 13” and the “ellipse truncated cone slant face 14” (*see* So ¶ 41, Fig. 3b) — such that the Appellants’ argument is persuasive of error in the rejection of claim 7.

The Appellants also rely upon the arguments presented for claim 7 with regard to the rejection of its dependent claims 9, 11–16, 18, and 19. *See* Appeal Br. 16. Accordingly, the rejection of claims 7, 9, 11–16, 18, and 19 under 35 U.S.C. § 103(a) is not sustained.

Rejection III

In regard to dependent claims 17 and 20, the Appellants rely upon the arguments presented in regard to independent claim 7. Appeal Br. 20.

The additional reference (Whitley) relied upon in the rejection of claims 17 and 20 (*see* Final Action 6–7) does not cure the deficiency in the Examiner’s rejection of claim 7. Accordingly, the rejection of claims 17 and 20 under 35 U.S.C. § 103(a) is not sustained.

Rejection IV

Independent claim 3 recites, in part, a “fluid container” comprising a “cap” having a “floor” with a “protruding part” and “a ridge formed of a material on the floor, *said ridge being located under said protruding part so*

as to minimize knit lines during formation of said protruding part”
(emphasis added).

According to the Specification, a knit line is crack created during injection molding of an elastomeric part, when separate flows of the elastomer meet within the mold and solidify at an interface. Spec. ¶ 21. Knit lines in a sealing member can compromise the integrity of a seal formed therewith. *Id.* Referring to Figure 14 thereof, the Specification states: “It has been observed that ridge 70 in shell body cavity 46 will reduce the risk of knit lines forming in ridge 62 at contact surface 64 compared with the stepped topography for cavity bottom 74 shown in Figs. 8-11.” *Id.*

The Appellants argue (Appeal Br. 22; Reply Br. 17–18) that the Examiner erred in rejecting claim 3 because the identified corresponding structure of the Koch reference (“downwardly extending edge (2)” (Koch, col. 2, l. 3)) is not a “ridge” and there is no teaching or suggestion that it might “minimize knit lines” during the formation of Koch structure corresponding to the claimed “protruding part,” per claim 3.

According to the Examiner, the “ridge” is “functionally claimed to minimize knit lines during formation of said protruding part” (Final Action 8) and recognizing another advantage that “would flow naturally from following the suggestion of the prior art” cannot establish patentability where the claimed structure is obvious (Answer 10).

The Appellants’ argument is not persuasive of error in the rejection of claim 3 because the Appellants have not identified features of the claimed embodiment that might distinguish it from the prior art structure. Although features of an apparatus may be recited either structurally or functionally,

claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997). *See also Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (“[A]pparatus claims cover what a device *is*, not what a device *does*.”)

In regard to dependent claims 4 and 6, the Appellants rely upon the same arguments presented for independent claim 3. *See* Reply Br. 18. Consequently, the rejection of claims 3, 4, and 6 under 35 U.S.C. § 103(a) is sustained.

Rejection V

In regard to dependent claims 5 and 8, the Appellants rely upon the arguments presented in regard to their respective independent claims — claims 3 and 7. Appeal Br. 23.

The additional reference (Gray) relied upon in the rejection of claim 8 (*see* Final Action 9) does not cure the deficiency in the Examiner’s rejection of claim 7.

Accordingly, the rejection of claim 5 (depending from claim 3) under 35 U.S.C. § 103(a) is sustained and the rejection of claim 8 (depending from claim 7) under 35 U.S.C. § 103(a) is not sustained.

DECISION

We AFFIRM the Examiner’s decision rejecting claims 7–9 and 11–20 under 35 U.S.C. § 112, second paragraph.

We AFFIRM the Examiner’s decision rejecting claims 1–6 under 35 U.S.C. § 103(a).

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We REVERSE the Examiner's decision rejecting claims 7–9 and 11–20 under 35 U.S.C. § 103(a).

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

AFFIRMED