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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/140,518	06/17/2011	Matthieu Ozanne	3712036-01299	8244
29157	7590	11/02/2016	EXAMINER	
K&L Gates LLP-Chicago P.O. Box 1135 CHICAGO, IL 60690			COX, STEPHANIE A	
			ART UNIT	PAPER NUMBER
			1791	
			NOTIFICATION DATE	DELIVERY MODE
			11/02/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHIEU OZANNE

Appeal 2015-004575
Application 13/140,518
Technology Center 1700

Before CHUNG K. PAK, JEFFREY T. SMITH, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1 through 7, 12 through 18, 23 and 24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

The subject matter on appeal is generally directed to a process for preparing a beverage in a beverage machine using a capsule comprising tea leaves. (Spec. 2, ll. 9–10.)

¹ Appellant identifies the Real Party in Interest as Nestec S.A. (Appeal Brief filed September 9, 2014, (“App. Br.”) 2.)

Details of the appealed subject matter are recited in representative claims 1 and 12, which are reproduced below from the Claims Appendix to the Appeal Brief:

1. A process for the preparation of a beverage in a beverage machine using a capsule comprising tea leaves, the process comprising:

a) introducing hot water delivered from a pumping and heating member in the capsule to submerge the tea leaves in the capsule enclosure;

b) letting the tea leaves soak;

c) introducing hot water into the capsule until the required volume of beverage is delivered; and

continuously delivering water from the pumping and heating member during the three steps and continuously introduced in the capsule from the beginning of step a) until the end of step c).

12. A process for the preparation of a beverage in a beverage machine using a capsule comprising tea leaves, the process comprising:

a) introducing hot water delivered from a pumping and heating member in the capsule to submerge the tea leaves in the capsule enclosure;

b) letting the tea leaves soak;

c) introducing hot water into the capsule until the required volume of beverage is delivered; and

continuously delivering water from the pumping and heating member during the three steps and at least partially sent to waste during step b).

In the Answer entered on January 20, 2015, (“Ans.”) the Examiner maintains the final rejection of claims 1–7, 12–18, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over the disclosures of U.S. patent application publication 2004/0197444 A1 published in the

name of Halliday et al. on October 7, 2004 (hereinafter referred to as “Halliday”).

DISCUSSION

Having considered the evidence on this appeal record and each of Appellant’s contentions, we affirm the Examiner’s § 103(a) rejection of claims 1–6 and 23 as unpatentable over Halliday for the reasons set forth in the Final Office Action entered June 18, 2014 (“Final Act.”) and the Answer, but reverse the Examiner’s § 103(a) rejection of claims 7, 12–18, and 24 as unpatentable over Halliday for the reasons set forth in the Appeal Brief. We add the discussion below primarily for emphasis and completeness.

Claims 1, 2, and 4–6²

Appellant does not dispute the Examiner’s finding that Halliday discloses a process for preparing a beverage (brewing process) that comprises introducing hot water from a pump and heating mechanism into a capsule containing tea leaves until a required volume of beverage is delivered. (*Compare* Final Act. 3 *with* App. Br. 5–7.) Nor does Appellant dispute the Examiner’s finding that Halliday discloses that this brewing process can include a fast or slow charge of the capsule with water with or

² We limit our discussion to those claims separately argued, and claims not separately argued stand or fall with the argued claims. 37 C.F.R. § 41.37(c)(1)(iv). Appellant argues claims 1, 2, and 4–6 as a group on the basis of claim 1. (*See generally* App. Br. 5–7.) Therefore, for the purposes of this appeal, we select claim 1 as representative, and decide the propriety of the rejection of claims 1, 2, and 4–6 based on claim 1 alone.

without a soaking step, and further includes brew/mixing and purge steps. (*Compare* Final Act. 3 *with* App. Br. 5–7.) Based on the above undisputed findings, the Examiner concludes that because Halliday discloses that the brewing process can be performed without a soaking step³, it would have been obvious to one of ordinary skill in the art to continuously deliver water during the brewing process to provide sufficient water to the beverage ingredients in a cartridge to meet all three steps, including the soaking step involving continuous delivery of water, recited in claim 1 to produce a desired volume of beverage. (Final Act. 3.)

Appellant argues that Halliday does not disclose or suggest continuously delivering water from the pump and heating mechanism during steps corresponding to steps a, b, and c recited in claim 1 because Halliday discloses that “soaking is obtained by implementation of a pause, which interrupts the flow of water.” (App. Br. 5–6.)

However, as the Examiner correctly finds, Halliday discloses a brewing process that does not involve a soaking period, or pause, that interrupts the flow of water. (Final Act. 3 *citing* Halliday Table 3.) Specifically, Halliday discloses a process for preparing tea that includes

³ The soaking steps in Halliday and claim 1 are described differently. While the soaking step in Halliday is defined as leaving water delivered to a capsule containing beverage ingredients for a predetermined period of time, the soaking step recited in claim 1 is defined as providing the continuous flow of water into a capsule containing tea leaves. *Compare* Halliday ¶ 214 *with* claim 1.

charging a cartridge containing tea leaves with water output from a water heater using a pump to provide a low rate of uninterrupted water flow, which Halliday refers to as a “slow charge without soak,” followed by a brewing/mixing step involving pumping additional water output from the heater through the cartridge to produce tea. (Halliday ¶¶ 17, 176, 177, 181 (Table 3), 208–213, 215.)

This continuous delivery of water during the slow charge without soak and brewing/mixing steps suggested by Halliday is within what is set forth by claim 1 which recites “continuously delivering water from the pumping and heating member during the three steps and continuously introduce[ing water] in the capsule from the beginning of step a) until the end of step c)” so as to allow soaking of the beverage ingredients to occur in step b) during this continuous flow of water into the capsule until a desired volume of tea is produced.” Claim 1, by requiring a flow of water from the beginning to the end and designating such flow of water as steps a), b), and c), without specifying the rate at which water flows continuously into the capsule during each of steps a, b, and c, encompasses Halliday’s suggested tea preparing process involving a continuous flow of water into a cartridge containing tea leaves. Although Appellant’s Specification describes preferred flow rates for these steps, such preferred embodiments in the Specification do not limit the scope of claim 1, which is broadly recited to include any flow rates for steps a, b, and c. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867 (Fed.

Cir. 1985) (“Generally, particular limitations or embodiments appearing in the specification will not be read into the claims.”); *In re Priest*, 582 F.2d 33, 37 (CCPA 1978), citing *In re Prater*, 415 F.2d 1393, 1405 (CCPA 1969) (We have consistently held that no “applicant should have limitations of the specifications read into a claim where no express statement of the limitations is included in the claim.”). The Specification also does not define the term “soaking” in step b) recited in claim 1 to exclude Halliday’s continuous delivery of water into a cartridge containing tea leaves until a desired volume of a tea is produced.

Accordingly, contrary to Appellant’s arguments, Halliday’s disclosure of an initial “slow charge without soak,” followed by a brewing/mixing step suggests continuously delivering water from the pump and heating mechanism into the cartridge until preparation of the tea is complete, corresponding to continuously delivering water into the capsule throughout the three steps recited in claim 1.

Appellant further argues that one of ordinary skill in the art would not have modified Halliday’s process to continuously deliver water during the brewing process in order to produce a beverage in a shorter amount of time as the Examiner supposedly asserts, because Halliday already solves the problem of faster beverage production by having a “fast charge” flow rate option. Appellant also contends that the Examiner’s supposed assertion that one of ordinary skill in the art would have modified Halliday’s process to

provide for continuous delivery of water “based on user preference” is an unsupported conclusory statement that cannot serve as the basis for an obviousness rejection.⁴ (App. Br. 6–7.)

However, as discussed above, Halliday suggests continuously delivering water from the pump and heating mechanism into the cartridge until preparation of the tea is complete, as recited in claim 1, and Halliday’s disclosures need not be modified to arrive at this suggestion. (Halliday ¶¶ 176, 177, 181 (Table 3), 208–213, 215.) It follows that Appellant’s arguments grounded in the Examiner’s supposed, proposed motivation for modifying Halliday’s disclosures are unpersuasive of reversible error.

We accordingly sustain the Examiner’s rejection of claims 1, 2, and 4–6 under § 103(a).

Claim 3

Claim 3 indirectly depends from claim 1 and recites that during step b), water is delivered from the pumping and heating member at a soaking flow of between 20 and 80 ml/min.

Appellant does not dispute the Examiner’s finding that Halliday discloses that the pump provides a maximum flow rate of 900 ml/min, and further discloses that the pump can be driven at a percentage of the

⁴ Contrary to Appellant’s arguments, we find no statement in the rejection of claim 1 in the Final Office Action indicating or suggesting that the Examiner proposes a modification of Halliday’s disclosures. (Final Act. 3.)

maximum flow rate. (*Compare* Final Act. 4 with App. Br. 7–8.) The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the optimum flow rate through routine experimentation to produce a beverage having the desired taste. (Final Act. 4.)

Appellant argues that Halliday discloses that “soaking is obtained by implementation of a **pause**, which interrupts the flow of water,” and Halliday therefore teaches that the flow rate during the soaking stage is 0 ml/min. (App. Br. 7.) Appellant further argues that Halliday teaches a “slow” flow rate of 325 ml/min, and even if one of ordinary skill would have been motivated to continuously deliver water from the pumping and heating member during the soaking stage to produce a beverage in a shorter amount of time as supposedly alleged by the Examiner, the flow rate recited in claim 3 (20–80 ml/min) would be at most 1/4 of the “slow” flow rate of Halliday, and would therefore be contrary to the Examiner’s proposed motivation of producing a beverage in a shorter period of time. (App. Br. 7–8.)

However, as the Examiner correctly finds, Halliday discloses that the pump provides a maximum flow rate of 900 ml/min, and Halliday further discloses that the flow rate of water can be a percentage of the maximum flow rate, and preferably can be 10% to 100% of the maximum flow rate. (Final Act. 4; Halliday ¶ 176.) Accordingly, Halliday impliedly discloses

that the flow rate of the water can be *any* percentage of 80 ml/min, including percentages below 10%, such as the flow rate recited in claim 3. *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (“[T]he fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.” (second alteration in original) (*quoting In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976))); *In re Boe*, 355 F.2d 961, 965 (CCPA 1966) (“All of the disclosures in a [prior art] reference must be evaluated for what they fairly teach one of ordinary skill in the art.”).

In addition, we agree with the Examiner that one of ordinary skill in the art reasonably would have understood that the flow rate of the water would affect the flavor of the tea produced, with a slower flow rate providing longer contact between the water and tea leaves to result in a stronger flavor, and a faster flow rate providing shorter contact between the water and tea leaves to result in a weaker flavor. Therefore, it would have been well within the ambit of one of ordinary skill in the art to determine a flow rate that would yield tea having the desired flavor, and in so doing, the skilled artisan reasonably would have arrived at the optimum flow rate recited in claim 3.

In further contesting the rejection of claim 3, Appellant repeats the same arguments advanced in connection with claim 1. (App. Br. 8.)

However, as discussed above, such arguments are unpersuasive of reversible error.

Therefore, we sustain the Examiner's rejection of claim 3 under § 103(a).

Claim 23

Claim 23 depends from claim 1 and recites that step b) is performed for a period of time that is 5 seconds to 50 seconds.

Appellant does not dispute the Examiner's finding that Halliday discloses that the delivery time for beverages can be between 5 and 120 seconds, depending on the type of beverage. (*Compare* Final Act. 5 with App. Br. 10–11.) Based on this undisputed finding, the Examiner concludes that one of ordinary skill in the art could determine an appropriate time period for step b) through routine experimentation depending on the desired strength of the beverage and the type of the beverage ingredients used. (Final Act. 5.)

Appellant argues that Halliday does not disclose or suggest a typical delivery time for tea beverages, much less a time period for soaking tea leaves. (App. Br. 10.) Appellant further argues that even if one of ordinary skill would have been motivated to continuously deliver water from the pumping and heating member during the soaking step to produce a beverage in a shorter amount of time as supposedly alleged by the Examiner, the soaking period of 5 to 50 seconds recited in claim 23 would be contrary to

the Examiner's proposed motivation of producing a beverage in a shorter period of time. (App. Br. 11.)

However, as discussed above, claim 1, from which claim 23 depends, places no limitation on the flow rates for steps a), b), and c), and we find no disclosure in the Specification that limits the flow rates of the three steps. As discussed above, Halliday discloses an initial "slow charge without soak," and any portion of Halliday's "slow charge without soak" lasting from 5 to 50 seconds for the type of beverage involved (i.e., tea leaves) therefore constitutes step b) as recited in claim 23 because claims 1 and 23 do not distinguish the flow rate of step b) from that of step a) or c) and only require continuous delivery of water during the three steps.

Accordingly, Appellant's arguments are unpersuasive of reversible error, and we sustain the rejection of claim 23 under 35 U.S.C. § 103(a).

Claim 7

The Examiner finds that "Halliday clearly teaches a filtering wall that extends below a median horizontal plane (i.e. it is inserted into the capsule) so that the overflow aperture is located above the place [*sic*: plane] (i.e. the beverage exits at the top of the capsule)." (Ans. 7.)

However, we agree with Appellant that the Examiner does not carry the burden of establishing a prima facie case of obviousness of the subject matter of claim 7. (App. Br. 8–10.) In particular, the Examiner does not demonstrate that Halliday discloses a capsule comprising an enclosure

containing tea leaves, a filtering wall defining at least one filtering side of the enclosure, and an overflow wall located in a path of the brewed liquid after the filtering wall and comprising at least one overflow aperture, in which the filter wall extends from below a median horizontal plane passing through the enclosure when the capsule is position so that the overflow aperture is located above the plane, as recited in claim 7. Although the Examiner appears to rely on the disclosures of paragraphs 106, 108, 116, 123, and 126 of Halliday,⁵ which refer to Halliday's Figures 8 and 11, as disclosing the subject matter of claim 7 (Final Act. 4), we find no disclosure in these portions of Halliday indicating that the filter 4⁶ extends from below a median horizontal plane passing through the enclosure 130 when the capsule is position so that the overflow aperture 55 is located above the plane, as recited in claim 7.

On this record, the Examiner simply does not identify any disclosure in Halliday that shows a filter extending from below a median horizontal plane passing through the enclosure to provide an overflow aperture above that plan, and we therefore do not sustain the Examiner's rejection of claim 7 under 35 U.S.C. § 103(a).

⁵ Although the Examiner cites to paragraphs 16 and 126 of Halliday in the Answer, the Examiner cites to paragraphs 106, 108, 116, 123, and 126 in the Final Office Action. (Ans. 7; Final Act. 4.)

⁶ Reference numerals refer to Figure 11 of Halliday.

Claims 12–18 and 24⁷

Independent claim 12 recites steps a), b), and c) that correspond to steps a), b), and c) recited in claim 1, and claim 12 further recites “continuously delivering water from the pumping and heating member [into a capsule containing tea leaves] during the three steps and at least partially sent [some of the water from the pumping and heating member] to waste during step b).”

The Examiner finds that Halliday discloses in paragraphs 168 and 169 that excess water not dispensed into a receptacle is collected and sent to waste, and the Examiner determines that this teaching constitutes disclosure of at least partially sending water to waste as recited in claim 12. (Final Act. 4.)

Paragraph 168 of Halliday describes the beverage preparation machine depicted in Figure 35 and indicates that the machine includes a dispense station 270 comprising a drip tray 272. Paragraph 169 explains that when a beverage is produced by the machine, a receptacle is preferably placed as close to the cartridge head 250 as possible to minimize spraying

⁷ For the purposes of this appeal, we select claim 12 as representative, which is the broadest claim of claims 12–18 and 24, and decide the propriety of the rejection of claims 12–18 and 24 under 35 U.S.C. § 103(a) based on claim 12 alone.

and splashing of the beverage leaving the machine. Paragraphs 168 and 169 of Halliday thus discloses that tea produced by the machine from water that flows through the cartridge and out of the cartridge head 250, which sprays and splashes and does not enter a receptacle, is collected in a drip tray.

Although claim 12 is grammatically awkward, it requires that the water from the pumping and heating member continuously delivered to a capsule containing tea leaves during the three steps recited in claim 12 be at least partially sent (diverted) to waste during step b). Consistent with the language of claim 12, Appellant's Specification also states that when water is at least partially sent to waste during step b), "[some] hot water is not introduced in the capsule" and is instead sent to waste. (Spec. 3, ll. 15–19.) Thus, sending water to waste in the manner recited in claim 12, as correctly interpreted, involves diverting some of the flow of water otherwise delivered to a capsule containing tea leaves to waste, without passing through the capsule during step b). The Examiner's interpretation to the contrary is unreasonable and inconsistent with the Specification. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (explaining that the broadest reasonable interpretation standard does not give the Patent Office an unfettered license to interpret the words in a claim without regard for the full claim language and the written description.); *In re Abbott Diabetes Care, Inc.*, 696 F.3d 1142, 1148-50 (Fed. Cir. 2012) (finding the Patent Office's construction unreasonably broad because it was "unreasonable and

inconsistent with the language of the claims and the specification”); *In re Baker Hughes, Inc.*, 215 F.3d 1297, 1303 (Fed. Cir. 2000) (explaining that the PTO cannot adopt a construction that is “beyond that which was reasonable in light of the totality of the written description” in the Specification).

Accordingly, we agree with Appellant that Halliday’s disclosure in paragraphs 168 and 169 of collecting sprayed or splashed tea in a drip tray that was prepared from water passed through a cartridge does not constitute at least partially sending water to waste in the manner recited in claim 12.⁸ Therefore, the Examiner’s evidence and explanation are insufficient to establish a prima facie case of obviousness for the subject matter recited in claim 12, and we accordingly do not sustain the rejection of claims 12–18 and 24 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the reasons set forth above, we affirm the Examiner’s decision rejecting claims 1–6 and 23 under § 103(a), but reverse the

⁸ We advise both the Examiner and Appellant that the recitation in claim 12 of “continuously delivering water...at least partially sent to waste during step b)” is, at best, grammatically incorrect. For the purposes of clarification, we encourage Appellant and the Examiner to amend claim 12 to correct the grammar consistent with the disclosure at page 3, lines 15–19 of the Specification, e.g., “continuously delivering water from the pumping and heating member into the capsule during the three steps and at least partially [diverting such water] to waste during step b).”

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Examiner's decision rejecting claims 7, 12–18, and 24 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)(1)(iv).

AFFIRMED-IN-PART