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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STUART FERGUSON,  
LARIN GODFROY, TONY REID,  
JIM SADLER, and DAVID L. SCHIELE

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Appeal 2015-004833  
Application 12/836,705  
Technology Center 1700

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Before KAREN M. HASTINGS, GEORGE C. BEST, and  
N. WHITNEY WILSON, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner rejected claims 36–40 and 42–44 under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement and under 35 U.S.C. § 103(a) as obvious. Non-Final Act. (February 24, 2014). Appellants<sup>1</sup> seeks reversal of these rejections pursuant to 35 U.S.C. § 134(a). We have jurisdiction. 35 U.S.C. § 6(b). For the reasons set forth below, we AFFIRM.

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<sup>1</sup> Liqui-Box Corporation is identified as the real party in interest. Appeal Br. 1.

## BACKGROUND

The '705 Application describes a process for forming a pouch containing a flowable material, such as juice, milk, or wine. Spec. 1, 12. According to the Specification, evacuating headspace within the pouch extends the shelf life of the flowable material by limiting its exposure to oxygen. *Id.* at 2.

Claim 36 is representative of the '705 Application's claims and is reproduced below:

36. A series of pouches, each pouch having an evacuated headspace containing a flowable material formed according to a process, said process comprising the steps of:

- (A) providing a continuous tube of flexible and sealable film;
- (B) supplying the continuous tube with a predetermined amount of flowable material;
- (C) pinching said continuous tube above a sealing region so as to form a pinched portion of said continuous tube including providing an evacuation passage that passes through the pinched portion, said evacuation passage being formed by controlling the force applied to the pinched portion;
- (D) transversely compressing the continuous tube beneath said pinched portion with deflating jaws thereby evacuating said headspace between said pinched portion and said predetermined amount of flowable material wherein the air from the headspace passes through said pinched portion and flow of flowable material there-through is limited;
- (E) releasing said deflating jaws after evacuating said headspace before sealing said continuous tube; and
- (F) sealing said continuous tube at the sealing region to form a top seal of a previously formed pouch containing

flowable material and a bottom seal of a next-to-be filled pouch;

wherein said headspace in each pouch in said series of pouches has a volume equal to or less than about 4 percent by volume of said pouch; and

wherein said series of pouches has a fill-accuracy, measured in terms of variability in weight between pouches of said series of pouches, that is less than about 0.25% standard deviation.

Appeal Br. 16 (Claims App.).

### REJECTIONS

On appeal, the Examiner maintains the following rejections:

1. Claims 36–40 and 42–44 are rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement.  
Ans. 3.
2. Claims 36 and 37 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Murray<sup>2</sup> and Rondeau<sup>3</sup> or Condo.<sup>4</sup> Ans. 4.

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<sup>2</sup> WO 04/041656 A2, published May 21, 2004.

<sup>3</sup> US 4,887,411, issued Dec. 19, 1989.

<sup>4</sup> US 3,381,441, issued May 7, 1968.

3. Claim 38 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Murray, Shimizu,<sup>5</sup> and Anderson.<sup>6</sup>  
Ans. 7.
4. Claims 39, 40, and 42–44 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Murray and “DINKUM AUSSIES INVENTION WINE CASK.”<sup>7</sup> Ans. 8.
5. Claims 36, 37, and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sadler,<sup>8</sup> Murray, Seward,<sup>9</sup> Ylvisaker<sup>10</sup> and Rondeau or Condo. Ans. 9.
6. Claims 37 and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sadler and Jones.<sup>11</sup>  
Ans. 15.
7. Claim 38 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sadler, Shimizu, Anderson, and Jones.  
Ans. 16.

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<sup>5</sup> JP 08324592 A, published Dec. 10, 1996. We cite an English translation made of record on October 27, 2010.

<sup>6</sup> AU 8810080 A, published July 28, 1988.

<sup>7</sup> <http://www.dinkumaussies.com/INVENTION/Wine%20Cask.htm> made of record on October 27, 2010.

<sup>8</sup> US 5,231,817, issued Aug. 3, 1993.

<sup>9</sup> US 6,543,206 B2, issued Apr. 8, 2003.

<sup>10</sup> US 4,964,259, issued Oct. 23, 1990.

<sup>11</sup> US 6,554,164 B1, issued Apr. 29, 2003.

8. Claims 39, 40, 43, and 44 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sadler and “DINKUM AUSSIES INVENTION WINE CASK.” Ans. 17.
9. Claims 36, 37, and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wirsig,<sup>12</sup> Murray, Seward, Ylvisaker, and Rondeau or Condo. Ans. 18.
10. Claims 37 and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wirsig and Jones. Ans. 22.
11. Claim 38 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wirsig, Shimizu, Anderson, and Jones. Ans. 23–24.
12. Claims 39, 40, 43, and 44 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wirsig and “DINKUM AUSSIES INVENTION WINE CASK.” Ans. 25.

#### DISCUSSION

Appellants argue for the reversal of the rejections to claims 37–40 and 42–44 on the basis of limitations present in claim 36. *See* Appeal Br. 5–15. We, therefore, limit our analysis to the rejections to claim 36. Claims 37–40 and 42–44 will stand or fall with claim 36. 37 C.F.R. § 41.37(c)(1)(iv).

**Rejection 1.** Claim 36 recites the limitation “wherein said series of pouches has a fill-accuracy, measured in terms of variability in weight between pouches of said series of pouches, that is less than about 0.25% standard deviation.” This limitation was added to the ’705 Application by way of a January 30, 2014, Amendment. The Examiner rejected claims 36–

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<sup>12</sup> US 5,038,550, issued Aug. 13, 1991.

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40 and 42–44 under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement, alleging that the limitation is new matter.  
Ans. 3.

Appellants argue that “col. 11 of parent application US 7,779,612” provides sufficient support for the limitation because “the standard deviation for a 3000-g pouch is 7 g or less than 0.25% in terms of the weight of the pouch.” Appeal Br. 5; *see also* January 30, 2014, Remarks (citing Spec. Example 2). Therefore, according to Appellants, “[t]he matter added is not new matter . . . .” Appeal Br. 5.

To comply with the 35 U.S.C. § 112, ¶ 1, written description requirement, the applicant’s specification must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)). The inquiry into whether the description requirement is met is a question of fact. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976).

US 7,779,612, filed as divisional Application 12/074,571, contains no indication that Appellants were in possession of independent claim 36’s subject matter at the time the ’705 Application was filed. The disclosure in column 11 of US 7,779,612, cited by Appellants as support for their contention, is identical to the Comparative Example and Example 2 of the ’705 Application’s Specification. Spec. 18:24–19:12. These cited passages support, at most, that for the 3000 gram pouches produced, a fill-accuracy of 7 gram was reported. According to the cited passages, this single reported fill-accuracy provides the pouch weight standard deviation. Appellants have not adequately responded to the Examiner’s assertion that the Examples: (i)

do not clearly support the range of less than about 0.25% in terms of the pouch weight standard deviation, Ans. 3, and (ii) do not clearly show how the standard deviation was calculated without any disclosure as to the particular fill weights or volumes of more than one pouch. *See id.* at 26–27.

Thus, the Examiner’s rejection of claims 36–40 and 42–44 as containing new matter is supported by a preponderance of the evidence, and we affirm it.

**Rejection 2–Rejection 12.** On appeal, Appellants present substantially similar arguments for reversal of all eleven obviousness rejections maintained by the Examiner. *See* Appeal Br. 5–15. We affirm these rejections based upon the factual findings and reasoning set forth in the Examiner’s Answer, which we adopt. We add the following for emphasis.

In **Rejection 2**, **Rejection 5**, and **Rejection 9**, the Examiner found, Ans. 4–7; 9–15; and 18–22, that the applied prior art teaches each of the structural limitations of the product recited in claim 36, namely: (i) “wherein said headspace in each pouch in said series of pouches has a volume equal to or less than about 4 percent by volume of said pouch; and” (ii) “wherein said series of pouches has a fill-accuracy, measured in terms of variability in weight between pouches of said series of pouches, that is less than about 0.25% standard deviation.”

Appellants argue that **Rejection 2** should be reversed because, in either Murray, Rondeau or Condo, “[t]he necessary steps of Applicants’ process are not taught or suggested, e.g.,[,] forming an evacuation passage, compressing the tube that forms the pouch with deflating jaws to evacuate the head space and the formation of seals that do not entrap product and are tight and leak proof.” Appeal Br. 6.

Appellants argue for the reversal of **Rejection 5** because the claimed steps are neither taught nor suggested by Sadler, Murray, Seward, Ylvisaker, Rondeau, or Condo. *Id.* at 8–9. Therefore, according to Appellants, a pouch manufactured according to the primary reference Sadler’s teachings would exhibit “inferior quality.” *Id.* at 8. In particular, Appellants argue that “unless the steps ‘C’, ‘D’ and ‘E’ are followed[,] a pouch would not be formed that has the headspace and fill-accuracy as set forth in Claim 36.” *Id.*

Appellants argue that **Rejection 9** should be reversed because the claimed steps of (C), (D), or (E) are not taught or suggested by either Wirsig, Murray, Seward, Ylvisaker, Rondeau, or Condo. *Id.* at 11. Appellants further argue that in order “[t]o arrive at Applicants’ novel pouch, a person skilled in the art would need to follow the outlined steps of Claim 36.” *Id.* at 12.

We are not persuaded by these arguments. As the Examiner found, Ans. 5–6; 11–12; and 20, Murray teaches that the headspace is zero, i.e., less than 4% volume, because Murray’s container is 100% product. With respect to the limitation reciting the requisite fill-accuracy standard deviation range, the Examiner found Rondeau teaches that it is conventional to have variance between filled pouches of liquids of less than 0.25%. *See, e.g., id.* at 6 (citing Rondeau Abstract, 4:19; 4:26); *see also* Ans. 12, 21. Likewise, the Examiner found Condo teaches a fill-accuracy that is less than 0.25% standard deviation for liquid filled pouches. *See, e.g.,* Ans. 6 (citing Condo 9:18–20); *see also* Ans. 12, 21. Thus, we do not discern reversible error in the Examiner’s findings or in the Examiner’s conclusion that the applied prior art would have suggested the claimed series of pouches, each pouch

having an evacuated headspace containing a flowable material with the requisite headspace and fill-accuracy as set forth in Claim 36.

Appellants assert that “unless the steps ‘C’, ‘D’ and ‘E’ are followed[,] a pouch would not be formed that has the headspace and fill-accuracy as set forth in Claim 36.” *See, e.g.*, Appeal Br. 8; *see also* Appeal Br. 5, 6, 12, and 15. In so doing, Appellants are relying upon product-by-process limitations regarding the manufacture of the series of pouches. It has long been the law that such limitations do not add a patentable distinction when the claimed product is the same as the cited art’s product. *See In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.”). Appellants do not point to any evidence that the methods used to produce the series of pouches described in the applied prior art effect the properties of headspace accuracy and fill-accuracy variability of each pouch. Without such evidence, this assertion is not persuasive. *See Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (“[A]rguments of counsel cannot take the place of evidence lacking in the record.”).

#### CONCLUSION

For the reasons provided in the Examiner’s Answer, and above, we affirm the rejections of claims 36–40 and 42–44 of the ’705 Application.

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