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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BORIS CHAUVET, FREDERIC MERTZ, and
ERIC MARTIN

Appeal 2015-005163
Application 13/577,107
Technology Center 1700

Before MICHAEL P. COLAIANNI, DONNA M. PRAISS, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Appellants² appeal under 35 U.S.C. § 134 from a rejection of claims 1–5, 7–9, and 14–21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ In our Opinion below, we refer to the Specification filed August 3, 2012 (“Spec.”), the Final Action mailed August 26, 2014 (“Final Act.”), the Appeal Brief filed November 26, 2014 (“App. Br.”), and the Examiner’s Answer mailed February 6, 2015 (“Ans.”).

² Appellants identify the real party in interest as Saint-Gobain Emballage. App. Br. 2.

The claims are directed to methods for applying a liquid to a rim of a container. Claim 1, reproduced below with disputed terms emphasized, is illustrative of the claimed subject matter:

1. A method for applying a liquid to a rim of a container, the method comprising:

contacting a rim of a container with a roller comprising a liquid, thereby transferring the liquid to the rim of the container,

wherein a surface of the roller comprises a tubular warp or weft knit, and the knit comprises a yarn having a metric number of between 1/002 Nm and 1/080 Nm,

wherein the container is a glass jar, a glass bottle, a glass flask, or a glass decanter, and

wherein the liquid is an adhesion promoter or a heat-sealing primer.

App. Br. Claims App'x i.

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

| | | |
|---------------------------------|--------------------|---------------|
| Nauta | US 3,539,671 | Nov. 10, 1970 |
| Deyrup | US 3,787,326 | Jan. 22, 1974 |
| Dembicki et al. ("Dembicki") | US 4,389,266 | June 21, 1983 |
| Graham et al. ("Graham") | US 4,396,655 | Aug. 2, 1983 |
| Rounsley | US 5,237,915 | Aug. 24, 1993 |
| Stanhope | US 2002/0065008 A1 | May 30, 2002 |
| Dilyard et al. ("Dilyard") | US 2008/0242524 A1 | Oct. 2, 2008 |

Sarah Veblen, *Know Your Knits / Samplings of Weft Knit and Warp Knit Fabrics*, 97 *Threads Magazine* 59–63 (2008)

REJECTIONS

The claims stand rejected under 35 U.S.C. § 103(a) as follows:

1. claims 1, 2, 4, 7–9, 14, 15, 18, 19, and 21 over Graham in view of Dilyard, and Veblen relied upon as evidence for claim 2;
2. claims 1, 2, 4, 7–9, 14, 15, and 18–20 over Dembicki in view of Dilyard as evidenced by Veblen and Deyrup;
3. claim 3 over Graham or Dembicki in the alternative, in view of Dilyard and further in view of Veblen;
4. claim 5 over Graham or Dembicki in the alternative, in view of Dilyard as applied to claim 4, and further in view of Stanhope;
5. claim 16 over Graham or Dembicki in the alternative, in view of Dilyard as applied to claims 1 or 8, and further in view of Rounsley;
6. claim 17 over Graham or Dembicki in the alternative, in view of Dilyard as applied to claims 1 or 8, and further in view of Nauta.

Final Act. 2, 4, 6–9.

OPINION

Graham, Dembicki, or both in the alternative, in addition to Dilyard, are applied against each of the claims on appeal. *See generally* Final Act.

The Examiner finds that Graham teaches a method of applying a liquid to a rim of a container the method comprising, contacting a rim of a container with a roller comprising a liquid, thereby transferring the liquid to

the rim of the container which may be a glass bottle or jar. Final Act. 2–3. Graham further teaches the liquid is an adhesion promoter or a heat-sealing primer (such as silane compound or bonding agent such as ethylene acrylic acid copolymer, polyethylene or hot melt adhesives). *Id.* at 3. Graham does not explicitly teach wherein the surface of the roller comprises a tubular warp or weft knit. *Id.*

The Examiner finds that Dembicki teaches a method of applying a liquid to a rim of a container, the method comprising, contacting a rim of a container with a roller comprising a liquid, thereby transferring the liquid to the rim of the container, wherein the container may be a glass bottle or jar. Final Act. 4–5. Dembicki further teaches the liquid is an adhesion promoter (such as chromium complex). *Id.* at 5. Dembicki does not explicitly teach wherein the surface of the roller comprises a tubular warp or weft knit.

Appellants do not challenge the Examiner’s findings with respect to Graham or Dembicki. *See generally* App. Br. Appellants note that “[o]ther than being more specific to an adhesion primer, Dembicki does not appear to be materially different from Graham.” *Id.* at 4.

Appellants’ challenge focuses on whether the Examiner erred in (1) combining Dilyard with Graham or Dembicki and (2) finding that Dilyard’s disclosure regarding nonwoven materials applies to woven materials and knits. App. Br. 5–15.

The Examiner finds that “Dilyard teaches a method of forming coating roller covers/surfaces” wherein the “rollers include a tubular warp or weft knit and provide a benefit in the roller art in that they are inexpensive, re-usable and shed resistant.” Final Act. 3, 5. According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of

invention to have incorporated the roller of Dilyard into the method of Graham (or Dembicki) as such an incorporation would predictably result in benefits based on expense, re-usability, and shed resistance. *Id.*

Appellants contend that the primary goal of Graham and Dembicki is to provide a liquid-tight seal on the mouth portion of a container. App. Br. 5. According to Appellants, Dilyard teaches that knits and wovens are prone to shedding, thus a person of ordinary skill in the art would not modify the rubber roller of Graham or the generic roller of Dembicki to have a surface of a tubular warp or weft knit, since shedding of the knit would likely preclude the formation of a liquid tight seal between the mouth of their containers and the sealing membrane. App. Br. 5–6. Appellants suggest that the modification of primary references Graham or Dembicki with secondary reference Dilyard would render the inventions of the primary references unsatisfactory for their intended purpose because shedding would preclude formation of a liquid-tight seal. *Id.* Therefore, there would be no suggestion or motivation to make the proposed modification. *Id.* (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *In re Hedges*, 783 F.2d 1038 (Fed. Cir. 1986)).

The Examiner accurately responds that Appellants' reference to shedding of knits and wovens is based on paragraph 4 of Dilyard, which is directed to the state of the prior art, not to Dilyard's invention. Ans. 2. The Examiner notes that Dilyard describes five embodiments that overcome the problems of the prior art, and four of these embodiments may comprise knit material. *Id.* (citing Dilyard ¶¶ 5–6.). According to the Examiner, Appellants' position that Dilyard's inventive roller comprises a knit material

that would lead to shedding is actually in direct opposition to what Dilyard teaches. Ans. 2.

Four of Dilyard's brief descriptions of the five general embodiments disclose a knit material in the outer or only layer discussed (*see* Dilyard ¶ 6), but only three of the more detailed descriptions of the general embodiments disclose that a knit material may be used in the outer or only layer. *See* Dilyard ¶ 19 (“an outer layer of sliver knit, woven, or other material”); ¶ 31 (“a single or multi-ply knitted, woven, or non-woven flexible (elastic) or semi-flexible (elastic) sleeve”); and ¶ 34 (“a single or multi-ply knitted, woven, or non-woven flexible and collapsible sleeve”). Nonetheless, Dilyard unambiguously teaches use of knitted material for the roller cover of the invention.

In addition, Dilyard's teachings regarding knits are not limited to sliver knits, as Appellants suggest. *See* App. Br. 9. Dilyard discloses multiple kinds of knitted fabrics, including weft knit and warp knit. Dilyard ¶ 32.

With respect to the limitation “the knit comprises a yarn having a metric number of between 1/002 Nm and 1/080 Nm,” the Examiner cites paragraph 9 of Dilyard as support for the finding that the reference discloses that “the fibers used can possess yarn of various metric number (denier) based on the intended application.” Final Act. 3. The Examiner acknowledges that Graham (or Dembicki) in view of Dilyard does not explicitly teach a metric number between 1/002 and 1/080 Nm, but determines that “it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a size within the claimed range since “[W]here the general conditions of a claim are disclosed in the

prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *Id.* at 3–4, 5–6 (quoting *In re Aller*, 220 F.2d 454, 456 (CCPA 1955)). The Examiner finds that Dilyard discloses a specific range, but teaches that “other ranges and values are possible,” thus establishes that the denier/metric number is recognized as a result effective variable in the art. Ans. 4 (quoting Dilyard ¶ 9).

Appellants dispute that the Examiner has established that the denier/metric number is a result-effective variable for knits. App. Br. 11. Appellants point out that the entirety of paragraph 9 of Dilyard relates to *non-woven* materials, including the disclosure that exemplary non-woven materials may have a denier of about 0.8 to 40. *Id.* at 8. According to Appellants, the range of deniers disclosed in Dilyard corresponds to 1/225 to 1/11250 Nm, the unit of measure expressed in the claims, which range does not overlap that of the claims. *Id.* at 8, 10, 14. In distinguishing *Aller*, Appellants argue that Dilyard discloses a litany of selections and variables, i.e., ordering of layers, the selection of fibers, woven or non-woven, and that any one of 13 properties of nonwoven materials may be varied. *Id.* at 11. Appellants further argue “[t]here is simply no teaching in Dilyard as to what the denier of the *nonwoven material* would impact.” *Id.* at 12. Appellants assert that the disclosure of Dilyard is “an invitation to experiment with a litany of variables related to nonwovens rather than knits and with no indication that any one of the variables is unsuitable and that they can all be anything under the sun.” *Id.* at 14.

We agree with Appellants that the Examiner has not identified any recognized result being optimized by varying the denier/metric number of non-woven materials, as described in Dilyard, thus denier/metric number has

not been shown to be a result-effective variable based on the record before us. Additionally, the Examiner has not shown that varying the denier/metric number of a non-woven fabric would have the same effect on a knit.

Because denier/metric number has not been shown to be a result-effective variable, the Examiner also has not established that modifying the denier/metric number disclosed by Dilyard for one material would have been a matter of routine optimization for one of ordinary skill in the art with respect to another material. *See In re Antonie*, 559 F.2d 618, 620 (CCPA 1977) (variable must be recognized as result-effective before routine optimization applies).

On this record and for the above reasons, we reverse the Examiner's rejection of independent claim 1. Because claims 2–5, 7–9, and 14–21 depend directly or indirectly from claim 1, we reverse the rejections of the dependent claims for the same reasons.

DECISION

For the above reasons, the Examiner's rejection of claims 1–5, 7–9, and 14–21 is REVERSED.

REVERSED