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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TORSTEN BRANDENBURGER, GERHARD GREIER, and ISMAEL RAHIMY

Appeal 2016-005585
Application 12/663,930
Technology Center 1700

Before ROMULO H. DELMENDO, DONNA M. PRAISS, and JANE E. INGLESE, *Administrative Patent Judges*.

INGLESE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants[1] appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3–9, 11, and, 20–24.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Appellants' claimed invention is generally directed to a preform for producing a container for holding fluids for medical applications. App. Br. 2. Claim 1 illustrates the subject matter on appeal and is reproduced below:

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[1] Appellants identify the real party in interest as Fresenius Kabi Deutschland GmbH. Appeal Brief filed September 16, 2015 ("App. Br."), 1.
[2] Claims 10 and 12–17 stand withdrawn from consideration. Final Office Action entered March 6, 2015 ("Final Act"), 2.

> 1. A preform for producing a container for holding fluids for medical applications by stretching and blow-moulding of said preform into a container, the preform comprising:
>
> a neck portion which has an opening,
>
> a wall portion,
>
> a floor portion, and
>
> a first sub-section of an annular hanger and a second sub-section of said annular hanger being integrally formed on the underside of said floor portion, the first sub-section including a first free end, the second sub-section including a second free end, wherein the first free end and the second free end are maintained in a spaced apart state by a mechanical bias.

App. Br. 19 (Claims Appendix).

Appellants request review of the final rejection of claims 1, 3–9, 11, and 20–24 under 35 U.S.C. § 103(a) as unpatentable over Uehara et al. (EP 0483671 A2, published May 6, 1992) and Schlatter (US 2005/0017004 Al, published January 27, 2005), which was maintained by the Examiner in the Answer entered March 10, 2016 ("Ans."). Claims 1, 3–9, 11, and 20–24 also stand rejected under pre-AIA 35 U.S.C. § 112, ¶ 2, as indefinite (Ans. 3), but, as further discussed below, Appellants do not contest this ground of rejection.

DISCUSSION

Upon consideration of the relied-upon evidence in this appeal and each of Appellants' contentions, we affirm the Examiner's rejection of claims 1, 3–9, 11, and 20–24 under 35 U.S.C. § 103(a) as unpatentable over Uehara and Schlatter.

We add the following discussion primarily for emphasis.

Claims 1, 4, 8, 11, 20, and 21

Appellants argue claims 1, 4, 8, 11, 20, and 21 as a group. App. Br. 2–10. Therefore, for the purposes of this appeal, we select claim 1 as representative, and claims 4, 8, 11, 20, and 21 will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv) (2015).

The Examiner finds that Uehara discloses a preform used to mold a container having a hanger such as an intravenous drip bottle. Final Act. 5; Uehara col. 1, ll. 5–8. The Examiner finds that Uehara discloses that the preform comprises a barrel portion 22a (wall), a connection 24 connected to the bottom end of the barrel 22a (floor), and a circular ring-like hanger 26 connected to the connection 24. Final Act. 5; Ans. 18; Uehara col. 6, ll. 6–7, 14–20; Fig. 1.

The Examiner finds that Uehara does not disclose that the hanger 26 comprises first and second subsections that each include free ends maintained in a spaced apart state by a mechanical bias, but the Examiner relies on Schlatter for suggesting this feature. Final Act. 6–7. Specifically, the Examiner finds that Schlatter discloses a dispensing container comprising a clasp (hanger) that allows the container to be detachably connected to a variety of objects. Final Act. 6; Schlatter ¶¶ 2, 17. The Examiner finds that Schlatter discloses that the clasp 32 includes first 48 and second 50 arms having free ends that are maintained in a spaced apart state. Final Act. 6; Schlatter ¶ 25; Fig. 1.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of Appellants' invention to replace the circular ring-like hanger in the preform disclosed in Uehara with a clasp as

taught by Schlatter to allow a container produced with Uehara's modified preform to be detachably connected to an object as taught by Schlatter. Final Act. 8; Ans. 14–15.

Appellants argue that the Examiner's rationale for the proposed modification of Uehara's preform is flawed because there "is no objective evidence to support the idea that Uehara's bottle is difficult to detach from wherever it has been hung." App. Br. 4–5. Appellants contend that the intended use of Uehara's bottle is to be hung from a rod by passing the hanger through the end of the rod, and Appellants argue that the bottle is very easily detached by passing the hanger back over the end of the rod. App. Br. 5.

However, the Examiner's rationale for the proposed modification of Uehara's preform is not based on the difficulty of detaching a bottle produced with the preform from where it has been hung as Appellants assert, but is based on the advantage of allowing a bottle produced with the modified preform to be detached from an object to which it has been hung. Final Act. 8; Ans. 14–15. Schlatter discloses that the clasp on the dispensing container allows the container to be attached and detached from a variety of articles, including objects having a closed loop such as a lanyard or a key ring. Schlatter ¶¶ 2, 17. One of ordinary skill in the art would have recognized that Uehara's closed, annular hanger cannot be hung from an object containing a closed loop, and would also have understood that replacing the hanger in Uehara's preform with a clasp as disclosed in Schlatter would allow a container produced with the modified preform to be hung and detached from a wider variety of objects, including objects that

include a closed loop. Appellants' arguments are therefore unpersuasive of reversible error.

Appellants further argue that the Examiner's rationale for the proposed modification of Uehara's preform is also flawed because a bottle produced with Uehara's preform is intended to function the same way as a bottle produced with Appellants' preform in which the free ends are joined together before the bottle is used. App. Br. 5–6. Appellants contend that the proposed replacement of the hanger in Uehara's preform with the clasp disclosed in Schlatter would not provide "the alleged advantage of greater detachability" because one skilled in the art would join the free ends of a bottle produced with such a preform before use. App. Br. 6.

However, claim 1 does not recite that the free ends of the first and second sub-sections are joined before use, and Appellants' arguments are therefore based on subject matter that is not claimed. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("[A]ppellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims."). Moreover, Appellants do not direct us to any disclosure in Schlatter indicating or suggesting any reason to join the free ends of the arms of the clasp before use of the dispensing container. App. Br. 5–6. In fact, Schlatter discloses that "[w]hile the use of two arms 48, 50 in accordance with the present invention optimizes attachment to various support structures, the two arms further provide for improved strength." Schlatter ¶ 30. Schlatter thus discloses successful use of the dispensing container for its intended purpose without joining the arms of the container. Appellants' arguments are therefore unpersuasive of reversible error.

Appellants further argue that Uehera teaches away from a preform as recited in claim 1 whose use necessitates two manufacturing steps to produce a bottle: a first molding step followed by a second step of joining the ends. App. Br. 6–7. Appellants contend that Uehera discusses the disadvantages of a prior art method disclosed in JP 62-273822 that requires an additional step to form a hanger, and Appellants assert that Uehera thus denigrates the need to have more than one step in making a bottle. App. Br. 7.

However, claim 1 recites a preform and does not recite steps for manufacturing a bottle from the preform, much less recite a manufacturing process that involves joining the ends of a bottle produced with the preform. Appellants' arguments therefore lack persuasive merit because they are directed to subject matter that is not recited in claim 1. *Self*, 671 F.2d at 1348.

Appellants further argue that the modification of Uehera's preform proposed by the Examiner involves cutting through the hanger to introduce a slit into the ring. App. Br. 7–8. Appellants contend that such a modification would render a bottle produced from such a preform unsuitable for its intended purpose of hanging from a pole because the modified hanger would very likely no longer support a filled bottle. App. Br. 9.

However, as discussed above, the Examiner proposes modifying Uehera's preform by replacing the circular ring-like hanger in the preform with a clasp as taught by Schlatter, and the Examiner does not propose introducing a slit into Uehera's hanger as Appellants assert. Final Act. 8; Ans. 14–15. As also discussed above, Schlatter discloses that the clasp on the dispensing container allows the container to be attached to a variety of

articles, including a lanyard or a key ring, and discloses that the clasp provides improved strength. Schlatter ¶¶ 2, 17, 30. Accordingly, one of ordinary skill in the art would have understood that a bottle produced from Uehera's preform modified as proposed by the Examiner would be suitable for hanging from various objects, including a pole. Appellants' arguments are therefore unpersuasive of reversible error.

Appellants further argue that the preform recited in claim 1 allows a bottle with a hanger to be made more easily because the two-subsections facilitate easier manufacturing of a bottle from the preform. App. Br. 3. Appellants contend that this "surprising improvement in manufacturability" is not at all suggested by the combined disclosures of Uehera and Schlatter. App. Br. 6.

However, on this record, Appellants do not meet their burden of showing that the claimed preform imparts results that would have been unexpected by one of ordinary skill in the art at the time of their invention. *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972) ("the burden of showing unexpected results rests on he who asserts them"). Appellants do not direct us to any statement in their Specification attesting to the unexpected nature of the asserted improvement in manufacturability, or to any other persuasive evidence or averment evincing that this improvement would have been unexpected by one of ordinary skill in the art at the time of their invention. App. Br. 2–18. Absent such evidence or averment, Appellants cannot meet their burden. *See, e.g., In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997) ("Geisler made no such assertion [that results were unexpected] in his application. Nor did Geisler submit any such statement through other evidentiary submissions, such as an affidavit or declaration under Rule 132 .

. . Instead, the only reference to unexpected results was a statement by Geisler's counsel . . . that Geisler's results were 'surprising.'").

We accordingly sustain the Examiner's rejection of claims 1, 4, 8, 11, 20, and 21 under 35 U.S.C. § 103(a).

Claims 3 and 5

Claim 3 depends from claim 1 and recites, *inter alia*, that the first and second sub-sections are in the form of flat strips of a rectangular cross-section.

Claim 5 depends from claim 4, which recites that first and second free ends of the first and second sub-sections are integrally formed on the underside of the floor portion of the preform forming a common base piece that is integrally formed on the underside of the floor portion. Claim 5 recites, *inter alia*, that the base piece is in the form of a flat body.

With respect to claim 3, Appellants argue that one of ordinary skill in the art would have construed the term "flat" to mean lacking a slope, and Appellants contend that Schlatter's first 48 and second 50 arms do not meet this definition of the term "flat." App. Br. 10–11. With respect to claim 5, Appellants argue that Uehara's connection 24 is cylindrical and is not a flat body or base piece as recited in claim 5. App. Br. 11–12.

However, even if Appellants are correct in their assertion that Schlatter's first and second arms are not "flat" according to how this term would be interpreted by one of ordinary skill in the art in view of Appellants' Specification, and are correct in their assertion that Uehara's connection 24 is cylindrical rather than flat, a claimed difference in shape from the prior art does not make a product nonobvious in circumstances where the claimed shape is not of functional significance and accomplishes

the same purpose as the prior art. *In re Dailey*, 357 F.2d 669, 672–3 (CCPA 1966) (holding that the configuration of a claimed disposable plastic nursing container was a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant).

On this record, Appellants do not demonstrate that the recited flat shape for the first and second sub-sections and for the base piece of the claimed preform is of any functional significance or serves a unique or critical purpose. App. Br. 2–18. Nor do Appellants demonstrate that a flat shape for the first and second sub-sections and for the base piece provides any unexpected result or advantage. App. Br. 2–18. Accordingly, changing the shape of Schlatter's first 48 and second 50 arms and connection 24 to a flat shape would have been a design choice that was well within the level of one of ordinary skill in the art at the time of Appellants' invention. *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (use of claimed feature solves no stated problem and presents no unexpected result and "would be an obvious matter of design choice within the skill of the art" (citations omitted)).

Appellants further argue that the Examiner's statement[3] that a change of shape is a mere design choice is "a conclusion not a reason" and falls squarely within *KSR*'s prohibition of "mere conclusory statements." App. Br. 12–13.

However, "[i]f a person of ordinary skill in the art can implement a predictable variation [of a known work], § 103 likely bars its patentability."

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[3] The Examiner stated that "it should be noted that change of shape is generally considered as a matter of design choice, absent persuasive evidence that the particular configuration was significant. MPEP 2144.04." Advisory Action issued May 13, 2015, 2.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 417 (2007).[4] As discussed above, it is well-settled that such predictable variations include changes in shape, and a particular shape is therefore an obvious matter of design choice absent evidence that the shape has a functional significance or serve a unique or critical purpose. On this record, Appellants provide no such evidence for the flat shape of the first and second sub-sections and base piece, and Appellants' arguments are therefore unpersuasive of reversible error.

Accordingly, we sustain the Examiner's rejection of claims 3 and 5 under 35 U.S.C. § 103(a).

Claim 6

Claim 6 depends from claim 1 and recites that the first and second free ends of the first and second sub-sections are in the form of ends that are to be welded and whose end-faces are arranged opposite one another.

Appellants argue that the Examiner does not provide evidence to support the finding that the free ends of Schlatter's arms 48, 50 are capable of being welded. App. Br. 13–15. Appellants contend that that there is no disclosure in Schlatter indicating that the arms 48, 50 can be welded, and contend that this feature is not inherent in Schlatter's disclosures because one of ordinary skill in the art would have understood that there are many materials that cannot be welded, and the ends of the arms 48, 50 could be made of such materials. App. Br. 14–15.

However, as discussed above, the Examiner relies on Schlatter's disclosure of a clasp that allows a container to be detachably connected to a variety of objects and proposes substituting the ring-like hanger of Uehara's

[4] *KSR,* 550 U.S. at 418 (2007).

preform with a clasp as taught by Schlatter. Final Act. 6–8; Ans. 14–15. Thus, the modification proposed by the Examiner would result in an alteration in the shape of the preform disclosed in Uehara, and would not involve modifying Uehara's preform to produce it from materials disclosed in Schlatter. Uehara discloses that suitable materials for producing the preform include polypropylene and polyethylene terephthalate (PET) (Uehara col. 8, ll. 9–15), which are the same materials disclosed in Appellants' Specification as suitable for forming the preform recited in claim 6. Spec. 7, ll. 1–4. Therefore, contrary to Appellants' arguments, because the ends of the arms of Uehara's preform modified as suggested by Schlatter are made of a material that Appellants' Specification indicates can be used to produce the preform recited in claim 6, the ends of the arms of Uehara's preform modified as suggested by Schlatter are capable of being welded.

Appellants further argue that the end faces of Schlatter's arms 48, 50 are not arranged opposite one another as recited in claim 6. App. Br. 15–16. Appellants contend that one of ordinary skill in the art would have interpreted end faces that are "opposite" each other to exclude Schlatter's arms 48, 50 in view of Figures 1, 3, and 4 of their application and the description at page 7, lines 14–15 of their Specification of end faces 4F and 4G shown in Figure 1 that are "situated opposite and close to one another." *Id.*

However, we find no definition or limiting description in Appellants' Specification of end faces that are arranged "opposite" one another. The drawings and the portion of the Specification that Appellants cite describe various illustrative, non-limiting embodiments of Appellants' invention, and

do not limit end faces that are arranged "opposite" one another to any particular configuration. Therefore, we interpret end faces that are arranged opposite one another according to the plain and ordinary meaning of the term "opposite", which is "set over against something that is at the other end or side of an intervening line or space."[5] Based on this plain and ordinary meaning of "opposite," we discern no error in the Examiner's finding that the end faces of Schlatter's arms 48, 50 illustrated in Schlatter's Figure 1 are arranged "opposite" one another. Final Act. 7. We accordingly sustain the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a).

Claim 7

Claim 7 depends from claim 1 and recites, *inter alia*, that the first and second ends of the first and second sub-sections each have a projecting piece.

Appellants argue that the Examiner does not identify a projecting piece in Schlatter's dispensing container, and contend that the Examiner instead "suggests that the arms **48, 52** [*sic*: 50] have an angled profile." App. Br. 16–17 (emphasis in original). Appellants argue that "there is no logical connection between having an angular profile and projecting." App. Br. 17.

However, the Examiner explicitly finds that Schlatter's arms 48, 50 include a straight section and an angled or arched portion, and the Examiner finds that the angled or arched portions of the arms project from the straight portions and thus constitute projecting pieces. Final Act. 11; Ans. 20. We find no definition or limiting description of a "projecting" piece in

[5] *Merriam-Webster's Collegiate Dictionary*, 10th Edition, 2000.

Appellants' Specification, and the plain and ordinary meaning of a "projecting" piece is a piece that protrudes or extends beyond or above a surface.[6] Because the Examiner's finding that the arched portion of Schlatter's arms 48, 50 are projecting pieces is consistent with this plain meaning, Appellants' arguments are unpersuasive of reversible error. We accordingly sustain the Examiner's rejection of claim 7 under 35 U.S.C. § 103(a).

Claims 9 and 22–24[7]

Claim 9 depends from claim 1 and recites that the first and second free ends of the first and second sub-sections take the form of end-pieces that are to be connected together by positive interengagement. Claim 22 depends from claim 1 and recites that the first and second sub-sections are configured to be connected together upon application of an external force to overcome the mechanical bias.

Appellants argue that no evidence exists to support the Examiner's finding that Schlatter's arms 48, 50 are capable of being connected together by positive interengagement and by application of an external force. App. Br. 17–18.

However, it is well-settled that language in an apparatus claim directed to its intended use that does not structurally limit the claimed apparatus components or patentably differentiate the claimed apparatus from

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[6] *Oxford English Dictionary.com*, https://en.oxforddictionaries.com/definition/protrude (last visited March 28, 2017).

[7] Appellants argue claims 22–24 as a group. App. Br. 2–10. Therefore, for the purposes of this appeal, we select claim 22 as representative of this groups of claims, and claims 23 and 24 will stand or fall with claim 22. 37 C.F.R. § 41.37(c)(1)(iv) (2015).

an otherwise identical prior art apparatus, will not support patentability. *See, e.g., In re Schreiber*, 128 F.3d at 1477–79 ("Schreiber's contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known" and "the Board [correctly] found that the Harz dispenser [for dispensing lubricating oil] would be capable of dispensing popcorn in the manner set forth in claim 1 of Schreiber's application."). As discussed above, the modification of Uehara's preform proposed by the Examiner would result in an alteration in the shape of the preform in view of Schlatter's disclosures, and would not involve modifying Uehara's preform to produce it from materials disclosed in Schlatter. Final Act. 8; Ans. 14–15. Because Uehara discloses that suitable materials for producing the preform are the same materials disclosed in Appellants' Specification as suitable for forming the preform recited in claims 9 and 22, the Examiner has a reasonable basis for finding that Schlatter's arms 48, 50 are capable of being connected together by positive interengagement and by application of an external force. *Compare* Uehara col. 8, ll. 9–15, *with* Spec. 7, ll. 1–4.

Appellants' arguments do not demonstrate that Uehara's preform modified as suggested by Schlatter is incapable of performing the intended uses recited in claims 9 and 22. App. Br. 17–18. Therefore, Appellants do not identify reversible error in the Examiner's finding that these intended uses do not patentably distinguish the claimed preform from the preform suggested by the combined disclosures of Uehara and Schlatter. We accordingly sustain the Examiner's rejection of claims 9 and 22–24 under 35 U.S.C. § 103(a).

Reply Brief

Appellants argue in the Reply Brief that the Examiner introduces new factual findings in the Answer for claim 3, and thus assert in essence that the Examiner raises a new ground of rejection in the Answer. Rep. Br. 5. We do not address this argument because such issues are reviewable by petition under 37 C.F.R. § 1.181, and are therefore not within the jurisdiction of the Board. *Ex parte Frye*, 94 USPQ2d 1072, 1078 (BPAI 2010) (precedential).

Rejection of Claims 1, 3–9, 11, and 20–24 under 35 U.S.C. § 112, Second Paragraph

We summarily sustain this rejection without comment because Appellants do not contest it. App. Br. 2–18; 37 C.F.R. § 41.37(c)(1)(iv) (requiring that "arguments shall explain why the examiner erred as to each ground of rejection . . . [and that] any arguments or authorities not included in the appeal brief will be refused consideration by the Board"); *see also Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (explaining that summary affirmance without consideration of the substantive merits is appropriate where an appellant fails to contest a ground of rejection).

Objection to Claims 6, 7, 9, 20, 21, 23, and 24

We do not address the Examiner's objections to these claims because they are not within the jurisdiction of the Board. 37 C.F.R. § 1.181

DECISION

We affirm the Examiner's rejection of claims 1, 3–9, 11, and, 20–24 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).

AFFIRMED