UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/897,782	05/20/2013	Scott Cooper	19217 US	8974

27081 7590 02/12/2018

OWENS-ILLINOIS, INC.
ONE MICHAEL OWENS WAY
Plaza One - Legal Department
PERRYSBURG, OH 43551-2999

EXAMINER
XU, XIAOYUN

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
02/12/2018	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT COOPER

Appeal 2017-005537
Application 13/897,782
Technology Center 1700

Before: ADRIENE LEPIANE HANLON, JEFFREY T. SMITH, and JANE E. INGLESE, *Administrative Patent Judges.*

INGLESE, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1, 5–10, 21–27, and 29–35. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

---

[1] Appellant identifies Owens-Brockway Glass Container, Inc., as the real party in interest. Appeal Brief, filed November 1, 2016 ("App Br"), 2.

STATEMENT OF THE CASE

Appellant claims a package that includes a container, a product dispensably disposed within the container, a closure for the container, and an indicator carried by the container, the closure, or both the container and the closure. App. Br. 4–5. Independent claims 1 and 24 illustrate the subject matter on appeal and are reproduced below:

> 1. A package that includes:
> a container,
> a product dispensably disposed within said container,
> a closure for said container, and
> an indicator carried by said container, said closure, or both said container and said closure,
> wherein said indicator indicates whether or *not said product within said container is authentic or counterfeit* when said indicator is exposed to a sample of said product by producing a response when *a predetermined chemical compound is detected in said sample of said product that is known to be associated with an authentic product* and that has not been added to said product for identification or authentication purposes.
>
> 24. A package that includes:
> a container,
> a product dispensably disposed within said container,
> a closure for said container, and
> an indicator carried by said container, said closure, or both said container and said closure,
> wherein, when said indicator is wetted with a sample of said product, said indicator provides an indication as to whether *said product disposed within said container is authentic or counterfeit* by producing a visual response when said indicator detects the presence of *a predetermined chemical compound that is known to be associated with an authentic product*.

App. Br. 26 (Claims Appendix) (emphasis added).

The Examiner sets forth the following rejections in the Non-Final Office Action entered April 8, 2016 ("Office Act."), and maintains the rejections in the Examiner's Answer entered December 15, 2016 ("Ans."):

I. Claims 1, 5–9, 21–31, and 33–35 under 35 U.S.C. § 103 as unpatentable over Green et al. (US 2006/0035288 Al, published February 16, 2006) in view of Gan (US 2009/0128803 Al, published May 21, 2009); and

II. Claims 10 and 32 under 35 U.S.C. § 103(a) as unpatentable over Green in view of Gan and Lin (US 2006/0154414 Al, published July 13, 2006).

DISCUSSION

Upon consideration of the evidence relied upon in this appeal and each of Appellant's contentions, we procedurally reverse the Examiner's rejections of claims 1, 5–10, 21–27, and 29–35 under 35 U.S.C. § 103, and enter a new ground of rejection against these claims under 35 U.S.C. § 112(b).

Rejections I and II

Claim 1 recites that the "indicator indicates whether or not said product within said container is authentic or counterfeit when said indicator is exposed to a sample of said product by producing a response when a predetermined chemical compound is detected in said sample of said product that is known to be associated with an authentic product." And independent claim 24 similarly recites that the "indicator provides an indication as to whether said product disposed within said container is authentic or counterfeit by producing a visual response when said indicator detects the presence of a predetermined chemical compound that is known to be

associated with an authentic product."

In view of the limited description provided in Appellant's Specification (discussed below), we are unable to ascertain the metes and bounds of an "authentic or counterfeit" product and "a predetermined chemical compound" "that is known to be associated with an authentic product" as these phrases are used the context of claims 1 and 24. Spec. ¶¶ 22, 23, 37, and 38. We therefore cannot determine what is, and what is not, encompassed by these phrases. Consequently, we cannot determine the propriety of the Examiner's 35 U.S.C. §103 rejections of claims 1 and 24 and their dependent claims (5–10, 21–23, 25–27, and 29–35) because to do so would require considerable speculation with regard to the metes and bounds of the claimed subject matter, and such speculation would not be appropriate. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Accordingly, we procedurally reverse the rejections of claims 1, 5–10, 21–27, and 29–35 under 35 U.S.C. § 103 and enter a new ground of rejection against these claims under 35 U.S.C. § 112(b), set forth below. We emphasize that this is a technical reversal of the rejections under 35 U.S.C. § 103, and is not a reversal based upon the merits of the rejections.

New Rejection Under 35 U.S.C. § 112, second paragraph

Claims 1, 5–10, 21–27, and 29–35 are rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter that the inventor regards as the invention.

The evaluation of a claim with respect to prior art begins with understanding the meaning of the claim. Our reviewing court has instructed that "[i]t is the applicants' burden to precisely define the invention, not the

PTO's. . . . . [35 U.S.C. § 112(b)] puts the burden of precise claim drafting squarely on the applicant." *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). After giving claims a broadest reasonable interpretation consistent with the Specification, if the metes and bounds of the claimed subject matter cannot be determined, the claims are indefinite and should be rejected. *In re Packard,* 751 F.3d 1307, 1310 (Fed. Cir. 2014).

The metes and bounds of an "authentic or counterfeit" product and "a predetermined chemical compound" "that is known to be associated with an authentic product" as these phrases are used in the context of claims 1 and 24 cannot be ascertained from Appellant's original disclosure, for at least the following reasons.

First, we find no limiting description of "product" in the Specification. The Specification discloses that "the present disclosure can be used to indicate whether *a variety of different types of products* dispensably disposed within containers are authentic or counterfeit." Spec. ¶ 37. The only products exemplified in the Specification are wine or liquor. The Specification specifically states that *"[f]or example*, the anti-counterfeit indicator 40 can be used to establish the authenticity of fine wine or liquor." *Id.* Thus, the Specification does not place any restriction on the type of "product dispensably disposed within said container." Therefore, under a broadest reasonable interpretation consistent with Appellant's Specification, the "product" recited in claims 1 and 24 can be *any* product dispensably disposed within a container, such as wine, liquor, motor oil, perfume, grape juice, urine, blood, transmission fluid, baby formula, or insect repellent. *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (During prosecution of patent applications, "the PTO must give claims their

broadest reasonable construction consistent with the [S]pecification. . . . Therefore, we look to the [S]pecification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.").

Second, we do not find a limiting description or definition in Appellant's Specification of an "authentic" product and a "counterfeit" product. The Specification states that the "indicator is configured to produce a response when it detects the presence of a certain substance or chemical compound in the aforementioned product." Spec. ¶ 22 (reference numerals omitted). Appellant's Specification goes on to state that:

> For example, the indicator *may be* configured to detect the presence of *certain* chemical compounds that are known to be associated with authentic products. In such case, a positive response by the indicator would indicate that the product dispensably disposed within the container is authentic, and the absence of a response would indicate that the product is counterfeit. The indicator also *may be* configured to detect the amount of *certain* chemical compounds in a product, *for example* to determine if the amount corresponds to the amount associated with an authentic product. *In another example*, a response *may be* produced when the indicator detects the presence of a *certain* substance or chemical compound that is known to be associated with a counterfeit product.

Spec. ¶¶ 22, 23 (emphasis added) (reference numerals omitted).

Appellant's Specification also states that "[a] chemical compound, or the amount of a chemical compound that is known to be associated with a certain product *may be* a compound or amount that is normally present, or can be expected to be present, in a product that has been produced by a *certain* process using *certain* ingredients." Spec. ¶ 23 (emphasis added). Appellant's Specification does not describe the basis for determining the "certain" substances or chemical compounds, the "certain" processes, or the

"certain" ingredients. Rather, Appellant's Specification indicates that the indicator *may* distinguish authentic from counterfeit products by detecting the presence of *certain* unspecified chemical compounds that are known to be associated with unspecified authentic products, which *may be* an unspecified compound or unspecified amount that is normally present, or can be expected to be present, in an unspecified product that has been produced by a certain unspecified process using certain unspecified ingredients. In thus setting forth how the indicator "may" distinguish authentic from counterfeit products, Appellant's Specification does not describe any *limiting* characteristics or features of an "authentic" product that distinguish it from a "counterfeit" product.

Third, Appellant's Specification does not describe predetermined chemical compounds that are known to be associated with a given (authentic or counterfeit) product. Appellant's Specification indicates that "[i]n *one embodiment* the indicator 40 *may be* formulated to establish the authenticity of a wine or liquor product by indicating whether or not certain 'signature' chemical compounds are present in the product, and/or if the signature chemical compounds are present in appropriate amounts." Spec. ¶ 38 (emphasis added). The Specification goes on to state that "[e]xamples of 'signature' chemical compounds in products include flavor compounds, e.g., alcohol or phenol compounds." *Id.* However, beyond this non-limiting example of unspecified "alcohol or phenol compounds," the Specification does not provide guidance as to what "predetermined" chemical compounds are "known to be associated with" a given (authentic or counterfeit) product. In other words, Appellant's Specification does not describe the basis for determining the "certain" substances or chemical compounds, the "certain"

processes, or the "certain" ingredients associated with the "products" encompassed by the claimed invention.

Accordingly, due to the unlimited nature of the "product" recited in claims 1 and 24, and the lack of disclosure in Appellant's Specification of a limiting distinction between an "authentic" product and a "counterfeit" product, one of ordinary skill in the art would be unable to determine the meaning of an "authentic or counterfeit" "product" as recited in claims 1 and 24. In addition, because the nature of an "authentic" product is unclear, one of ordinary skill in the art would also be unable to determine if a "predetermined chemical compound" is "known to be associated with an authentic product," as also recited in claims 1 and 24. Claims 1 and 24 are therefore of indefinite scope, and we accordingly reject claims 1, 5–10, 21–27, and 29–35 under 35 U.S.C. § 112(b).

DECISION

We enter a new ground of rejection against claims 1, 5–10, 21–27, and 29–35 under 35 U.S.C. § 112(b), and we reverse the Examiner's rejections of these claims under 35 U.S.C. § 103 for the procedural reasons stated above, rather than for substantive reasons.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b), which provides that a "NEW GROUND OF REJECTION pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

REVERSED
NEW GROUND OF REJECTION PURSUANT TO
37 C.F.R. § 41.50(b)