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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/526,200	08/06/2009	Rolf Müller	060077/370130	4480
826	7590	08/29/2018	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			HURST, JONATHAN M	
			ART UNIT	PAPER NUMBER
			1799	
			NOTIFICATION DATE	DELIVERY MODE
			08/29/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROLF MÜLLER

Appeal 2017-010735
Application 12/526,200
Technology Center 1700

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant¹ appeals under 35 U.S.C. § 134 from the Examiner's rejections of pending claims 24–45. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellant states that the invention relates to a receptacle for accepting nutrient media, including nutrient solutions or nutrient substrates, the receptacle including a dish and a cover, which engage one another to form a more or less closed chamber. (Spec. 1, ll. 3–10.)

Claim 24, reproduced below, is illustrative of the claimed subject matter (emphasis added):

24. A receptacle for accepting nutrient media, said receptacle comprising:

a dish and a cover, which closes the dish, the dish and the cover each comprising a bottom (dish bottom and cover bottom), implemented in the form of a circular surface, and a circular ring wall (dish wall and cover wall), which protrudes from the bottom, and one of the walls having an inner diameter at least slightly larger than the outer diameter of the other wall, so that one wall may be slipped over the other to close the dish;

engagement means, which prevent unintentional detachment of the dish and the cover upon mutual engagement, being assigned to the dish and the cover, and the engagement means of the dish being implemented to at least partially encompass or engage the engagement means of the cover,

wherein the engagement means of the cover or the dish comprises a flange having two adjacent sides, with each side having a wedge face of a different height or different inclination than that of the other adjacent side, the two adjacent sides

¹ According to the Appellant, the real party in interest is Heipha GmbH. (Appeal Brief filed January 23, 2017, hereinafter “Appeal Br.,” 1.)

intersecting at approximately half of the length of the flange, so that the engagement means of the cover has a different clamping and sealing force depending on which side of the flange is engaged with the engagement means of the dish or the cover, and wherein the engagement means are insertable via constant sliding contact between the engagement means of the cover relative to the engagement means of the dish from either the left side or the right side of the flange.

(Appeal Brief, Claims Appendix 15.)

THE REJECTIONS

The Examiner rejected the claims as follows:

Claims 24–45 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement;

Claims 24–35 and 38–44 under pre-AIA 35 U.S.C. § 103(a) as obvious over Carski (US 3,158,553, issued November 24, 1964) (hereinafter “Carski”);

Claims 36 and 45 as obvious over Carski further in view of Ervin (US 5,021,351, issued June 4, 1991) (hereinafter “Ervin”); and

Claim 37 as obvious over Carski further in view of Bedingham et al. (US 6,756,225 B2, issued June 29, 2004) (hereinafter “Bedingham”).

(Non-Final Rejection, mailed October 21, 2016, (hereinafter “Office Act.”) 2–19; Examiner’s Answer, mailed June 15, 2017, (hereinafter “Ans.”).)

Written Description

The Examiner found that three particular recitations in claim 24 lack written description support, and as a result are indicative of new matter added to the claim. (Office Act. 3–5.) We discuss the Examiner’s findings in turn.

“two adjacent sides intersecting at approximately half the length of the flange”

The Examiner found that the recitation in claim 24 of “two adjacent sides intersecting at approximately half the length of the flange” lacks written description support in the originally filed Specification. (Office Act. 3.) In particular, the Examiner found that the originally filed Specification does not make any reference to any specific length of any portion of the engagement means and does not describe any intersection of adjacent sides of a flange, and as a result the added claim limitation constitutes new matter. (*Id.* at 3–4.)

Appellant contends that Figures 1, 3, and 4a depict flanges (7, 10), each having a defined shape, which is relatively long and thin, and having a defined length. (Appeal Br. 4–5.) Appellant also points to the Specification for support, and in particular, page 4, lines 19–22, which describes the engagement means of the cover as having wedge faces of different inclinations insertable approximately halfway from both sides and having different clamping and sealing actions. (Appeal Br. 5–6.)

We agree with Appellant. As pointed out by Appellant, the Specification describes: “engagement means of the cover have wedge faces of different heights and different inclinations, insertable approximately

halfway from both sides having different clamping and sealing actions, so that the engagement means of the cover are insertable from both sides with different clamping and sealing actions.” (Spec. 4, ll. 19–22.) In this regard, the Specification describes the “engagement means” may be a “flange.” (Spec. 4, ll. 6–7, 8, ll. 9–15, Figs. 3a, 3b, 4a, 4b.) Accordingly, the Specification provides sufficient written description support for the recitation “two adjacent sides intersecting at approximately half of the length of the flange:” in claim 24. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (a patent applicant 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.” (emphasis omitted)).

“engagement means are insertable via constant sliding contact”

The Examiner also found that the recitation in claim 24 that the “engagement means are insertable via constant sliding contact . . .” is not supported by the Specification. (Office Act. 4.) The Examiner explained that the Specification as originally filed does not make any mention of any “sliding contact” between engagement means, and if the engagement inherently requires some form of sliding contact, such contact need not be constant, and as a result the added claim limitation constitutes new matter. (*Id.*)

Appellant contends that the Specification discloses that the operation of the receptacle involves rotating the cover relative to the dish, where the engagement means of the dish “clamp” the engagement means of the cover, and that one of ordinary skill in the art would understand this engagement occurs through “constant sliding contact” between the engagement means of

the cover and the dish. (Appeal Br. 6–7, citing Spec. p. 4, ll. 13–15 and 19–22, and p. 8, ll. 9–12.)

We agree with Appellant. Initially, we observe that *in haec verba* support for the claimed subject matter is not required in order to satisfy the written description requirement, but rather the disclosure must convey with reasonable clarity that the inventor was in possession of the invention. *Purdue Pharm. L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323–24 (Fed. Cir. 2000). In the instant case, we are of the view that one of ordinary skill in the art would have immediately understood that the Specification, by describing that the engagement means of the cover and the dish having a “clamping and sealing action[]” caused by, e.g., insertion of the engagement of the cover in the engagement means of the dish, and rotation in relation to the dish, provides written description support for the “constant sliding contact” recited in claim 24. (Spec. 4, ll. 19–29.) Indeed, as the Specification makes clear, the flanges have a shoulder, which is responsible for the retention and clamping action when the engagement means, such as catch lugs are inserted. (Spec. 8, ll. 9–17; Figs. 2b, 5a, 5b.) Therefore, one of ordinary skill in the art would have understood that Appellant was in possession of the “constant sliding contact” recited in the claims at the time the application was filed.

“engagement means of the cover or the dish comprises a flange having two adjacent sides, with each side having a wedge face of a different height or different inclination”

The Examiner found that although claim 24 recites that the engagement means of the cover or the dish comprises a flange with two

adjacent sides, each side having wedge faces of different heights or inclinations, the Specification does not provide support for such an arrangement with respect to the dish. (Office Act. 4–5.) The Examiner also found that the Specification does not describe wedge faces of different heights or inclinations on adjacent sides, and that this feature is not inherent, and as a result the added claim limitations constitute new matter. (*Id.* at 5.)

Appellant argues that this limitation is supported by the Specification, such that one of ordinary skill in the art would have understood that either the cover or dish can contain the engagement means, and that the flange would have two adjacent sides with each side having a wedge face of a different height or inclination. (Appeal Br. 7–8, citing Spec. p. 3, ll. 1–4 and 14–21, p. 4, ll. 19–22.)

We agree with Appellant. In particular, the Specification describes that “[i]t is only essential that engagement means are assigned to both the dish and also the cover” (Spec. 3, ll. 1–4.) The Specification also makes clear that the cover may overlap the dish or the dish may overlap the cover such that one of ordinary skill in the art would have understood that the wedge faces of different heights or inclinations could be on either the dish or the cover. (Spec. 3, ll. 10–28.) With respect to a flange with two adjacent sides, each side having wedge faces of different heights or inclinations, we are of the view that the Specification provides support for this limitation as further discussed above. (Spec. 4, ll. 19–29.)

In sum, we are persuaded by Appellant’s arguments that the Specification provides sufficient written description support for claim 24, and as a result we reverse the Examiner’s rejection of claims 24–45 under

35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.

Obviousness

Claims 24–35 and 38–44

The Examiner found that, *inter alia*, that Carski discloses engagement means that prevent unintentional detachment of the dish and the cover upon mutual engagement, where Carski discloses a cover comprising flange having two adjacent sides each having a different height or inclination such that the engagement means of the cover has a different clamping and sealing force depending on which side of the flange is engaged with the engagement means of the dish. (Office Act. 6–7.)

Appellant contends that Carski does not disclose or render obvious to include a different clamping or sealing force depending on which side of the flange is engaged with the engagement means. (Appeal Br. 12.) Appellant argues that Carski is designed to provide a vented or open condition and that the only condition where the apparatus in Carski is sealed is when the engagement means in Carski are not engaged. (Appeal Br. 12–13.) Appellant argues that it would not have been obvious to have modified Carski, because the engagement means is used to create an unsealed or open condition. (Appeal Br. 13–14.)

Therefore, the dispositive issue on appeal is:

Did the Examiner err in finding that Carski discloses an engagement means that “prevent[s] unintentional detachment of the dish and the cover upon mutual engagement” and where the engagement means contains all of the structural limitations recited in claim 24?

DISCUSSION

We are persuaded by Appellant's argument that Carski fails to disclose the engagement means as recited in claim 24. That is, the Examiner acknowledged in the Answer that "[t]here is no structure in Carski which physically fuses the lid to the dish." (Ans. 11.) Appellant contends that the Examiner's position is indicative that the engagement means of Carski does not prevent unintentional detachment of the dish and the cover upon mutual engagement as required by claim 24. (Reply Brief filed August 15, 2017, hereinafter "Reply Br.," 5–6.)

We agree with Appellant on this point. Carski discloses an arrangement where projections present on a dish engage with faces of the wedge-shaped bodies present on a cover, where the projections enter notches serving as a detent structure to maintain the cover in an elevated position relative to the dish. (Col. 2, ll. 49–69; Figs. 2–5.) In this arrangement, and consistent with the Examiner's position, the cover disclosed in Carski appears to merely sit on top of the dish. (Figs. 4, 5.) We have not been directed to any particular disclosure in Carski that would serve to prevent unintentional detachment of the dish and the cover upon mutual engagement as recited in claim 24.

Thus, although the Examiner relies on the different positions of the projections in Carski relative to the wedge shaped bodies and notch detent mechanism for the different clamping and sealing conditions recited in claim 1 (Ans. 14), Carski fails to disclose the limitation recited in claim 24 that the engagement means prevents unintentional detachment of the dish as the flange engagement means insertable via constant sliding contact.

As a result, we reverse the Examiner's rejection of claim 24. Because claims 25–35 and 38–44 depend from claim 24, we reverse the Examiner's rejection of those claims as well.

Claims 36, 37, and 45

The Examiner's reliance on Ervin and Bedingham in order to reject dependent claims 36, 37, and 45 do not remedy the deficiencies identified above with respect to claim 24. Therefore, we reverse the Examiner's rejections of these claims for the same reasons.

DECISION

The Examiner's rejections of claims 24–45 are reversed.

REVERSED