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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/008,471	04/24/2014	Bary L. Zeller	29610-102026-US	5854
109813	7590	01/31/2019	EXAMINER	
Fitch, Even, Tabin & Flannery, LLP			NGUYEN, THANH H	
120 South LaSalle Street			ART UNIT	
Suite 2100			PAPER NUMBER	
Chicago, IL 60603-3406			1792	
			MAIL DATE	
			DELIVERY MODE	
			01/31/2019	
			PAPER	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BARY L. ZELLER, RICHARD P. APISCOPA,
GREG A. WISEMAN, SARITA V. PORBANDARWALA, and
THOMAS A. GIBSON

Appeal 2018-002654
Application 14/008,471
Technology Center 1700

Before JEFFREY T. SMITH, CHRISTOPHER C. KENNEDY, and BRIAN
D. RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION ON APPEAL

SUMMARY

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–25, 36–40, and 42. We have jurisdiction. 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is Koninklijke Douwe Egberts B.V. which is co-owned by Mondelez International and Acorn Holdings. Appeal Br. 3. Appellants state that Acorn Holdings is a subsidiary of JAB Holdings Company. *Id.*

STATEMENT OF THE CASE²

Appellants describe the invention as relating to an improved filter for use in a closed or open brewing system (for example, for brewing coffee). Spec. ¶¶ 2–8. Claim 1, reproduced below with emphases added to certain key recitations, is illustrative of the claimed subject matter:

1. A beverage cartridge for use in a beverage maker, comprising:

a chamber, said chamber having at least one substantially enclosed portion, said at least one substantially enclosed portion having a base with a perimeter and a wall connected to said perimeter of said base, **said chamber receiving and housing undegassed coffee** therein;

a beverage filtering device, having a filter carrier device operatively connected to said chamber, said filter carrier being positioned within said chamber;

a filter element made of a liquid-permeable material and having a first surface and a second surface positioned oppositely to said first surface,

said second surface being at least partially attached to said filter carrier, **said filter element having a plurality of microperforations formed in the filter element by at least one of piercing and scoring**, said plurality of microperforations extending from said first surface to said second surface of said filter element; and

a sealing element connected to the wall of said chamber whereby said beverage cartridge is sealed and thereby enclosed;

whereby said beverage filtering device increases the permeability of fluid flowing through said beverage cartridge during brewing.

² In this Decision, we refer to the Final Office Action dated March 15, 2017 (“Final Act.”), the Appeal Brief filed August 15, 2017 (“Appeal Br.”), the Examiner’s Answer dated November 15, 2017 (“Ans.”), and the Reply Brief filed January 16, 2018 (“Reply Br.”).

Appeal 2018-002654
Application 14/008,471
Appeal Br. 19 (Claims App'x.).

REFERENCES

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

Bentley et al. ("Bentley")	US 4,853,234	Aug. 1, 1989
Hargraves et al. ("Hargraves")	US 4,966,780	Oct. 30, 1990
Simon et al. ("Simon")	US 5,871,644	Feb. 16, 1999
Fond	US 5,897,899	Apr. 27, 1999
Halliday et al. ("Halliday")	US 7,287,461 B2	Oct. 30, 2007
Yoakim et al. ("Yoakim")	WO 2008/148650 A1	Dec. 11, 2008
Bongers et al. ("Bongers")	US 2010/0068361 A1	Mar. 18, 2010

REJECTIONS

The following rejections are before us on appeal:

Rejection 1. Claims 1–14, 16–22, 24, 25, 36, and 38–40 under 35 U.S.C. § 103 as unpatentable over Halliday in view of Yoakim, Bentley, and Hargraves. Ans. 3.

Rejection 2. Claims 15, 23, and 37 under 35 U.S.C. § 103 as unpatentable over Halliday in view of Yoakim, Bentley, and Hargraves in further view of Fond. *Id.* at 9.

Rejection 3. Claim 42 under 35 U.S.C. § 103 as unpatentable over Halliday in view of Yoakim, Bentley, and Hargraves in further view of Bongers and Simon. *Id.* at 9.

ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellants and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential), cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”). After considering the evidence presented in this Appeal and each of Appellants’ arguments, we are not persuaded that Appellants identify reversible error. Thus, we affirm the Examiner’s rejections for the reasons expressed in the Final Office Action and the Answer. We add the following primarily for emphasis.

The Appellants do not separately argue any individual rejection or claim. *See, e.g.*, Appeal Br. 17. We therefore limit our discussion to the Examiner’s first rejection and claim 1. All remaining claims on appeal stand or fall with that claim. 37 C.F.R. § 41.37(c)(1)(iv) (2013).

The Examiner rejects claim 1 under 35 U.S.C. § 103 as unpatentable over Halliday in view of Yoakim, Bentley, and Hargraves. Ans. 3. The Examiner finds that Halliday generally teaches the recited beverage filtering device with filter element. Ans. 3–4 (citing Halliday). The Examiner finds that Halliday teaches “uses a filter 4 that has perforations to allow liquid to pass, which could be construed as ‘microperforations,’ [Halliday] is silent to specifically reciting ‘microperforations’ positioned [as recited in claim 1].” Ans. 4. The Examiner finds that Yoakim teaches a capsule with micro scale openings and teaches that control of the number and size of the openings improves the interaction between the food substance and water. *Id.* (citing Yoakim). The Examiner determines that because “both Halliday and Yoakim are drawn to beverage capsules with filtering means, it would have

been obvious to one having ordinary skill in the art to provide micro perforations, as taught by Yoakim, on the filter element to provide an improved interaction between the food substance and water.” *Id.*

The Examiner also finds that Halliday is “silent to specifically reciting ‘undegassed’ coffee therein. *Id.* at 5. The Examiner finds that Bentley teaches “fresh roasted coffee grounds in sealed containers” and Hargraves teaches packaging fresh roasted ground coffee as quickly as possible without undergoing substantial off gassing. *Id.* at 5 (citing Bentley and Hargraves). The Examiner determines “it would have been obvious to one having ordinary skill in the art to seal fresh coffee grounds in a cartridge after it has been roasted and grounded in order to retain the desirable volatile aroma and reduce oxidation.” *Id.* at 5.

We first address claim construction. Appellants argue that claim 1’s recitation of microperforations “formed in the filter element by at least one of piercing and scoring” is entitled to patentable weight. Appeal Br. 15–16. The recitation is written in a product-by-process format: the structure of the microperforations is defined “at least in part in terms of the method or process by which [they are] made.” *Smithkline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1315 (Fed. Cir. 2006) (internal quotes and citation omitted). Appellants do not dispute that these are product-by-process recitations.

Accordingly, the recitation limits the scope of the claim, but “determination of patentability is based on the product itself,” not on “its method of production.” *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). “If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *Id.*

For product-by-process claims, the Examiner “bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than would be the case when a product is claimed in the more conventional fashion.” *In re Fessmann*, 489 F.2d 742, 744 (CCPA 1974). Thus, “when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable.” *Id.* (quote and citation omitted). Once the examiner establishes a prima facie case of anticipation or obviousness, the burden “to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product” shifts to the Appellants. *Thorpe*, 777 F.2d at 698 (citation omitted).

Here, Appellants attack the Examiner’s prima facie obviousness position by arguing that the proposed combination of Halliday and Yoakim would not result in claim 1’s microperforations. Appeal Br. 12–13, 15–16; Reply Br. 5–6. In particular, the Appellants argue that Yoakim describes openings between fibers of a material rather than microperforations. *Id.* The Examiner, however, finds that an embodiment of Yoakim teaches micro scale slots or holes rather than only teaching openings between fibers. Ans. 10–11. The preponderance of the evidence supports the Examiner’s position. *See, e.g.*, Yoakim 3:1–8 (teaching a “gastight material” that has outlet openings once in opened for use in the beverage production device), 4:1–16 (describing openings whose size (on the micro scale) can be adjusted to improve interaction between food substance and water), 4:33–5:1 (explaining that use of a meshed material is merely one “possible mode” of Yoakim).

Appellants also argue that Halliday teaches away from perforations because it seeks to avoid a “short-circuit” that prevents all water from passing through the beverage material. Appeal Br. 13. The Examiner, however, finds that the Halliday short-circuit discussion refers to preventing liquid from flowing around the filter entirely. Ans. 11. The Examiner’s position is supported by the preponderance of the evidence. Halliday 10:3–9 (teaching ensuring no “short-circuits” through the spokes and rim to ensure passage of the water through the filter). Appellants have not persuasively explained how Halliday teaches that perforations in its filter should be avoided; just to the contrary, Halliday expressly teaches that liquid must be able to pass through its filter. *Id.*

With respect to claim 1’s product-by-process language (“microperforations formed in the filter element by at least one of piercing and scoring” (emphasis added)), Appellants argue that openings 18 of Yoakim between fibers would be visibly distinguishable from microperforations formed by piercing or scoring. Appeal Br. 16; Reply Br. 8–10. Appellants do not, however, present an argument that the micro scale slots / holes of Yoakim are structurally distinguishable from microperforations formed by piercing or scoring, and Appellants present no evidence as to this point. The Examiner correctly determines that Appellants have not adequately established a structural difference between the claimed product-by-process feature and the openings of Yoakim. Ans. 13–14.

Appellants also argue that the combined references would not include undegassed coffee because (1) Bentley merely teaches “fresh roast and ground coffee” which is not synonymous with undegassed coffee and because (2) Hargaves teaches problems associated with sealing undegassed

Appeal 2018-002654
Application 14/008,471

coffee in a container. Appeal Br. 12–15. Claim 1, however, does not positively recite “undegassed coffee” as part of the recited “beverage cartridge for use in a beverage maker.” Appeal Br. 19 (Claims App’x.) Rather, claim 1 recites a “chamber receiving and housing undegassed coffee therein.” *Id.* This recitation structurally limits claim 1 only by requiring a chamber capable of receiving and housing an undegassed coffee. *See In re Schreiber*, 128 F.3d 1473, 1476–8 (Fed. Cir. 1997) (affirming Board’s conclusion that claims directed at popcorn dispenser were anticipated in view of dispenser designed to dispense liquids such as oil). Because Appellants do not persuasively argue that the combined art does not teach such a chamber, Appellants do not establish reversible error.

We further note that, in the alternative, even if claim 1 did positively require undegassed coffee as part of the recited apparatus, Appellants still have not established reversible error in the Examiner’s rejection. In particular, Hargraves teaches the benefit of undegassed coffee. Final Act. 4 (citing Hargraves 4:57–64; 5:53–57). Bentley’s teaching of packaging “fresh roast and ground coffee” further suggests that the coffee is not completely undegassed. *Id.* (citing Bentley 1:23–28). Fresh coffee has a desirable aroma (Hargraves Abstract), and the aroma comes from off gassing. If Bentley’s fresh roast and ground coffee was completely degassed, it would have no desirable aroma and thereby would not be fresh. We agree with the Examiner that “fresh” in this context is temporal (Ans. 12); if substantially time lapses after roasting and grinding (and time would result in degassing), the coffee is no longer fresh.

Although Hargraves does indicate that the prior art experienced difficulties with regard to sealing gassed coffee, Hargraves also indicates that those difficulties could be overcome. Ans. 13 (citing Halliday 17:3–16).

Appeal 2018-002654
Application 14/008,471

Appellants emphasize that Hargraves teaches a solution specific to the Hargraves container regarding eliminating an undesirable hissing noise when gas is released (Reply Br. 8), but the record does not indicate that such a noise would exist in the context of a Halliday/Yoakim beverage maker. Moreover, even if a person of skill thought noise was a potential downside, this noise would not necessarily outweigh Hargrave's expressed benefits of undegassed coffee. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) ("a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine").

DECISION

For the above reasons, we affirm the Examiner's rejections of claims 1–25, 36–40 and 42.

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