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3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			KIM, CHRISTOPHER S	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN C.P. JOSEPH, MICHAEL J.R. ADAMS,
NEIL DELBRIDGE, and MICHAEL W. HOWCROFT

Appeal 2018-008282
Application 13/863,028
Technology Center 3700

Before ANNETTE R. REIMERS, BRANDON J. WARNER, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 2, 4–8, 28, and 29. *See* Appeal Br. 5–12. Claims 9–27 have been withdrawn. *See id.* at 5. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to the “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as the assignee, “3M Innovative Properties Company, which is a wholly-owned subsidiary of 3M Company.” Appeal Br. 1.

CLAIMED SUBJECT MATTER

Appellant’s disclosed invention “concerns improvements in or relating to liquid spraying apparatus such as a spray gun,” specifically “the connection between the spray gun and a reservoir containing the liquid to be sprayed,” and “has particular . . . application to a releasable connection for detachably mounting the reservoir on the spray gun.” Spec., p. 1, ll. 14–18. Claim 1, reproduced below with emphasis and line breaks added for clarity, is the sole independent claim appealed and is representative of the subject matter on appeal.

1. A lid for a reservoir of a gravity feed spray gun, the lid comprising[:]
 an integral spout for direct connection to a socket of the gravity feed spray gun,
 said spout having a first cylindrical portion, provided with a non-threaded connector formation comprising a releasable connection for the socket of the spray gun that can be *engaged with/disengaged from* the socket of the spray gun by *relative axial movement [and]² by relative angular movement involving less than one complete turn about a connection axis*;
 the non-threaded connector formation *comprising a helical projection* for co-operating with a lug on a spray gun body to cause the integral spout to move into the socket of the spray gun,
 wherein an abutment is provided at an end of the helical projection *to provide an end stop to limit rotation of the lid relative to the lug.*

² We understand the recited structure of the connector formation (e.g., the helical projection) to necessarily involve *both* relative axial movement *and* relative angular movement between the spout and the spray gun, such that the recited “and/or” must be interpreted as conjunctive. *See, e.g.*, Figs. 48–52; Spec., p. 34, l. 22 – p. 35, l. 18. Accordingly, either Appellant or the Examiner is encouraged to formalize this revision upon return of jurisdiction over this application.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Kirby US 6,250,688 B1 June 26, 2001

REJECTIONS

The following rejections are before us for review:

- I. Claims 1, 2, 4–8, 28, and 29 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Final Act. 4–5.
- II. Claims 1, 2, 4–8, 28, and 29 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. *Id.* at 5.
- III. Claims 1, 2, 4–8, and 29 stand rejected under 35 U.S.C. § 102(b) as anticipated by Kirby. *Id.*
- IV. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirby. *Id.* at 6.

ANALYSIS

Rejection I – Enablement

The Examiner rejected all the pending claims under 35 U.S.C. § 112, first paragraph, finding that the Specification did not “reasonably provide enablement for all forms of releasable connection” between the spray gun and the spout integrally connected to the claimed lid. Final Act. 4. The Examiner recognized, however, that Appellant’s Specification *does* enable “the specifically disclosed non-threaded engagement” between the spray gun and spout described in the claims. *Id.*

Insofar as the substance of the enablement requirement is concerned, the dispositive issue is whether Appellant's disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. *In re Strahilevitz*, 668 F.2d 1229, 1232 (CCPA 1982). Some factors to be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

Here, the Examiner did not articulate any findings or analysis, such as by consideration of any of the *Wands* factors, to show that, in the absence of such description in the Specification, a person of ordinary skill in the art would have been unable to make and use the claimed invention without undue experimentation. Further, we agree with Appellant that the Examiner misstated the contours of the claimed invention. That is, the claims are not directed toward "all forms of releasable connection between two connectors," but specifically to a "non-threaded connector formation *comprising a helical projection* for co-operating with a lug on a spray gun body to cause the integral spout to move into the socket of the spray gun." Appeal Br., Claims App. (emphasis added).

Accordingly, based on the record before us, the Examiner has not met the burden of establishing that claims 1, 2, 4-8, 28, and 29, lack enablement.

On this basis, we do not sustain the rejection of these claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Rejection II – Indefiniteness

In determining whether a claim is definite under 35 U.S.C. § 112, second paragraph, “[t]he USPTO, in examining an application, is obliged to test the claims for reasonable precision.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014). “[A] claim is indefinite when it contains words or phrases whose meaning is unclear.” *Id.* at 1322 (citing MPEP § 2173.05(e)).

The Examiner determined that all of Appellant’s pending claims “fail[] to particularly point out and distinctly claim the subject matter” of the invention. Final Act. 5. In particular, the Examiner found that “the recitation ‘a helical projection’ appears to be a double inclusion of the ‘releasable connection’ recited” previously in the claims. *Id.*

But Appellant persuasively argues that, in light of the Specification, a person of ordinary skill in the art would understand the term “releasable connection” as used in the claims to refer to the “the relationship . . . between the spout and the socket of the spray gun.” Reply Br. 6. We agree that the “‘releasable connection’ refers to the state/type of connection provided by the connector formation and is not a structural sub-element” of the claims. *Id.*

Because the “releasable connection” and “helical projection” phrases are not distinct structural elements, the Examiner erred in finding that claim language to create a double inclusion. Accordingly, because we are able to define the scope of the claims, we do not sustain the rejection based on indefiniteness.

Rejections III & IV – Anticipation by or Obviousness over Kirby

Appellant’s invention relates to a system of mounting a reservoir to a spray gun (such as for applying spray paint in vehicle body repair shops). *See Spec.*, p. 1, ll. 17–19. All the pending claims recite a “lid for a reservoir of a gravity feed spray gun,” where the lid is directed to providing a releasable quick-fit connection between the reservoir and the spray gun. *See Appeal Br.*, Claims App.; *Spec.*, p. 2, l. 29 – p. 3, l. 3. The Examiner found that claims 1, 2, 4–8, and 29 were anticipated by Kirby (Rejection III) and that the modification of dependent claim 28—an externally threaded portion of the spout—was rendered obvious by Kirby’s disclosure (Rejection IV). Final Act. 5–6.

Appellant argues, however, that the term “lid” provides a specific structure for the claimed invention, and Kirby simply does not disclose a “lid” as claimed. *Appeal Br.* 7–10. In short, we agree. It is true, as the Examiner stated, that the term “lid” first appears in the preamble of independent claim 1 (and each claim depending therefrom). Final Act. 5; *see Appeal Br.*, Claims App. But Appellant persuasively points out that the term “lid” is also used elsewhere in the claims and “gives life, meaning, and vitality” to the claims. *See Appeal Br.* 7 (citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). We agree with Appellant that “the lid structure provides ‘an understanding of what the inventors actually invented and intended to be encompassed by the claim.’” *Appeal Br.* 7 (quoting *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed Cir. 1989)). That is, the claimed lid acts as a *lid*—it covers a reservoir containing a substance (such as paint) and

provides an integral connection by which the reservoir can be attached by way of a quick-release connector to a spray gun.

We disagree with the Examiner's finding that Kirby, which discloses an inline coupling member (as might be used to connect a hose), can be considered to disclose a "lid." The Examiner took the position that the term "lid" means merely a cover and denotes no structure, and Kirby's coupling member "covers" the opening to which it connects. Ans. 7-8. But words have meaning. One of ordinary skill in the art would understand that there is a structural difference between an inline coupling member or adapter that merely connects components, as disclosed in Kirby, and a lid that both covers a reservoir and integrally includes a spout with a helical connection, as claimed here.

Therefore, the Examiner has not established by a preponderance of the evidence that Kirby, as relied upon in the rejection presented, discloses a lid, as required by the claims. Further, the Examiner did not articulate any reason why it might have been obvious to modify Kirby's coupling member to form a lid in the obviousness rejection of claim 28. *See* Final Act. 6. Rejections based on obviousness must rest on a factual basis; in making such a rejection, the Examiner has the initial burden of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

Accordingly, based on the record before us, we do not sustain the Examiner's anticipation rejection of claims 1, 2, 4-8, and 29 under 35 U.S.C. § 102(b). Similarly, the Examiner has not met the burden of

establishing a proper case of obviousness based on Kirby, so we likewise do not sustain the rejection of dependent claim 28 under 35 U.S.C. § 103(a).

DECISION

We REVERSE the Examiner's decision rejecting claims 1, 2, 4–8, 28, and 29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

We REVERSE the Examiner's decision rejecting claims 1, 2, 4–8, 28, and 29 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We REVERSE the Examiner's decision rejecting claims 1, 2, 4–8, and 29 under 35 U.S.C. § 102(b) as anticipated by Kirby.

We REVERSE the Examiner's decision rejecting claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Kirby.

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4–8, 28, 29	112 ¶ 1	Enablement		1, 2, 4–8, 28, 29
1, 2, 4–8, 28, 29	112 ¶ 2	Indefiniteness		1, 2, 4–8, 28, 29
1, 2, 4–8, 29	102(b)	Kirby		1, 2, 4–8, 29
28	103(a)	Kirby		28
Overall Outcome				1, 2, 4–8, 28, 29

REVERSED