



# 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.
12/937,868	11/23/2010	Alain Mariller	88888-000001-US-NP	6195
27572	7590	10/23/2019	EXAMINER	
Harness Dickey (Troy) P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			HOANG, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3761	
			NOTIFICATION DATE	DELIVERY MODE
			10/23/2019	ELECTRONIC

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sto-ptomail@hdp.com  
troymailroom@hdp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* ALAIN MARILLER

---

Appeal 2019-000131  
Application 12/937,868  
Technology Center 3700

---

Before CHARLES N. GREENHUT, WILLIAM A. CAPP, and  
LISA M. GUIJT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 3–5, 8, 10, 11, 13, 15, 18, 20–30, 32–34, 36, and 38. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

---

<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as the Ethical Coffee Company. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

The claims are directed to a capsule for beverage preparation.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A capsule and a capsule cage for preparing a coffee beverage,

(a) the capsule comprising a hollow element designed to contain a ground coffee serving, the hollow element comprising a side wall, an upper face, a lower face comprising a discharge membrane, and a lip in the form of a collar, wherein the side wall having a bottom portion is continued at the bottom portion to form the lip as a single piece, and wherein the lip is oriented in a plane that intersects the side wall,

(b) the capsule cage comprising a lower edge portion, wherein prior to softening, only the lower edge portion of the capsule cage contacts only the lip, which is a flat laterally extending surface, to form a seal, and wherein the portion of the lip directly in contact with the lower edge of the capsule cage is the single piece with the side wall of the capsule,

(c) the lip not being soft at room temperature and the lip softening when placed in contact with hot water, whose temperature is compatible with good quality of the coffee and above room temperature, flowing during the preparation of the coffee beverage to improve the seal between the lip and the lower portion of the capsule cage, and

(d) the flat laterally extending surface of the lip laterally extending past inner and outer surfaces of the lower edge portion of the capsule cage during sealing deformation of the lip, at least a portion of the lip being in contact with the outer surface of the lower edge portion of the capsule cage as a result of the softening of the lip.

## REFERENCES

The prior art relied upon by the Examiner is:

<b>Name</b>	<b>Reference</b>	<b>Date</b>
Ozasa	US 2005/0236415 A1	Oct. 27, 2005
Pierce	US 2007/0181591 A1	Aug. 9, 2007
Bardazzi	US 2008/0141865 A1	Jun. 19, 2008
Yoakim	EP 1654966 A1	May 10, 2006
Rapparini	WO 2006111807 A1	Oct. 26, 2006

## REJECTIONS

Claims 1, 3–5, and 20–25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 2.

Claims 1, 3, 5, 8, 10, 13, 15, 18, 20–30, 32–34, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoakim, Ozasa, and Rapparini. Final Act. 4.

Claims 4, 11, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoakim, Ozasa, Rapparini, Bardazzi, and Pierce. Final Act. 23.

## OPINION

### *Indefiniteness*

The claims subject to the indefiniteness rejection under 35 U.S.C. § 112 are argued as a group for which claim 1 is representative under 37 C.F.R. § 41.37(c)(1)(iv). The Examiner determined that, in regards to defining the water temperature range of claim 1, “[t]he term ‘good quality of the coffee’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.” Final Act. 2–4. The Examiner’s initial determinations is consistent with MPEP

Appeal 2019-000131  
Application 12/937,868

§ 2173.05(b)(I) which indicates that when a term of degree is employed in a claim there should be some indication in the Specification or extrinsic evidence available to demonstrate that the term provides the claim with “objective boundaries” for those skilled in the art. *See, e.g., Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014) (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2130 & n.8 (2014) (additional citation omitted).

Appellant asserts that “[t]he temperature for a ‘good quality’ of the coffee is well defined in the industry and not indefinite.” App. Br. 23. If this statement by Appellant is proven correct, then the claims would not be indefinite. However, despite the submission of numerous publications, Appellant has not demonstrated the truth of this assertion. Appellant refers to Exhibit A, the best available copy of which is generally illegible, without any citation to a specific part of that publication or mention of specific language therefrom. App. Br. 23. Appellant also cites Exhibits B–D in support of this assertion. App. Br. 23. However, at most, the cited portions of Exhibits B–D define the brewing temperature range associated with “certified” (Exhibit B), “World Barista Championship compliant” (Exhibit C), or “good quality” (Exhibit D), *Italian espresso*. There is no indication of record that these temperature ranges associated with brewing Italian espresso are generally recognized as well-defined industry standards for brewing what results in “good quality of the coffee” as Appellant asserts.

Accordingly, considering the evidence and argument presently before us, we agree with the Examiner’s decision to reject claim 1 as indefinite. We are able to decide the merits of the prior-art rejection despite this

uncertainty surrounding the temperature range necessary to satisfy the claim language.

*Obviousness*

Regarding the Obviousness rejection, the Examiner proposes to modify Yoakim with the teachings of Ozasa related to softening to arrive at the claimed subject matter which requires “the lip softening when placed in contact with hot water. . . flowing during the preparation of the coffee beverage to improve the seal between the lip and the lower portion of the capsule cage.” The Examiner determined:

Ozasa discloses a biodegradable container (bowl-shaped container 10a, Fig. 4a-4b) having a biodegradable plastic coating film (12, Fig. 4a-4b) that is not soft at room temperature, but softens when placed in contact with a hot water whose temperature is above room temperature. Ozasa also discloses that the temperature at which the biodegradable plastic coating film begins to soften can be controlled by controlling the additives in the coating film that affect the temperature at which the coating film softens. See para. 0218, 0223, and 0237.

Final Act. 6. In particular the Examiner relies on Ozasa’s teaching:

additives may be added to the coating film 12 ... additives are not particularly limited to specific types ... additives improving qualities in relation to softening when the coating film 12 is attached, etc.

Ans. 13 (citing Ozasa para. 223).

However, we agree with Appellant (App. Br. 14–16) that Ozasa’s mention of “improving qualities,” read in context, particularly in context of paragraph 218, means *avoiding* softening at elevated temperatures. Without resorting to hindsight we see no reason of record one would look to

teachings of Ozasa that discourage softening of a food container as a basis to provide a material that is specifically designed to soften as the Examiner proposes. As hindsight cannot form the basis for an obviousness rejection, we do not sustain the Examiner’s rejections under 35 U.S.C. § 103(a).

**CONCLUSION**

The Examiner’s indefiniteness rejection is affirmed.

The Examiner’s prior art rejections are reversed.

**DECISION SUMMARY**

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3–5, and 20–25	112, second paragraph	indefiniteness	1, 3–5, and 20–25	
1, 3, 5, 8, 10, 13, 15, 18, 20-30, 32-34, and 36	103(a)	Yoakim, Ozasa, and Rapparini		1, 3, 5, 8, 10, 13, 15, 18, 20–30, 32–34, and 36
4, 11, and 38	103(a)	Yoakim, Ozasa, Rapparini, Bardazzi, and Pierce		4, 11, and 38
<b>Overall Outcome</b>			1, 3–5, and 20–25	8, 10, 11, 13, 15, 18, 26–30, 32–34, 36, and 38

**TIME PERIOD FOR RESPONSE**

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2019-000131  
Application 12/937,868

AFFIRMED-IN-PART