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Edward Stemberger Manelli Selter PLLC 10560 Main Street, Suite PH6 Fairfax, VA 22030			LACHICA, ERICSON M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LIBERATORE A. TROMBETTA, YUCHENG FU,  
DENNIS DWIGHT PAYNTER, and STEPHEN LEUNG

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Appeal 2019-000770  
Application 14/463,770  
Technology Center 1700

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Before JAMES C. HOUSEL, CHRISTOPHER C. KENNEDY, and  
MICHAEL G. McMANUS, *Administrative Patent Judges*.

HOUSEL, *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 finally reject claims 1–6, 8, 9, 11–13, 15–18, 21–26, 28, and 29. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as 2266170 Ontario Inc. Appeal Brief (“Appeal Br.”) filed August 10, 2018, p. 1.

We REVERSE.<sup>2</sup>

### CLAIMED SUBJECT MATTER

The claims are directed to a capsule for preparing a consumable product. Claim 1, reproduced below from the Claims Appendix to the Appeal Brief, is illustrative of the claimed subject matter. The limitation at issue is italicized.

1. A capsule, for use in a machine that is adapted for injecting a fluid into a capsule for preparing a consumable product, said capsule comprising:
  - a body defining an interior space with an opening;
  - a filter disposed in said interior space to define an ingredients chamber;
  - an axis defined through said opening and said ingredients chamber in said body for receiving an injection of fluid from the machine;
  - insoluble ingredients disposed in said ingredients chamber for preparing a desired consumable product by extraction or infusion from the injection of fluid from the machine, *a portion of said insoluble ingredients being non-permanently bound into a cluster that is disposed on the line of said axis*; and
  - a cover disposed over said opening.

Remaining independent claim 13 similarly recites a capsule including insoluble ingredients, wherein a portion of the insoluble ingredients forms a control member disposed on the line of the axis, the control member comprising a non-permanent structure adapted to at least partially dissolve or break apart when exposed to the fluid injection over a period of time.

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<sup>2</sup> Our Decision refers to the Specification (“Spec.”) filed August 20, 2014, the Examiner’s Answer (“Ans.”) dated September 26, 2018, and Appellant’s Reply Brief (“Reply Br.”) filed November 6, 2018.

## REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Camera et al.	US 2012/0070542 A1	Mar. 22, 2012
Winkler et al.	US 2012/0058226 A1	Mar. 8, 2012
Hall	US 1,951,357	Mar. 20, 1934

## REJECTIONS

The Examiner maintains, and Appellant requests our review of, the following grounds of rejection under 35 U.S.C. § 103:

1. Claims 1, 2, 5, 6, 8, 9, 11–13, 15, 18, 21–26, 28, and 29 as unpatentable over Camera et al. (“Camera”) in view of Winkler et al. (“Winkler”); and
2. Claims 3, 4, 16, and 17 as unpatentable over Camera in view of Winkler, and further in view of Hall.

## OPINION

### *Rejection 1: Obviousness over Camera and Winkler*

The issue before us in this appeal is whether Appellant has shown reversible error in the Examiner’s finding that Camera teaches embodiments including a filter and insoluble ingredients disposed in the ingredients chamber, a portion of which being non-permanently bound into a cluster (claim 1) or forming a control member comprising a non-permanent structure adapted to at least partially dissolve or break apart when exposed to the injected fluid (claim 13). After review of the Examiner’s and Appellant’s opposing positions and the appeal record before us, we determine that Appellant’s arguments are sufficient to identify reversible error in the Examiner’s obviousness rejections. *In re Jung*, 637 F.3d 1356, 1365 (Fed.

Cir. 2011). Accordingly, we reverse the stated obviousness rejections for substantially the reasons set forth in the Appeal and Reply Briefs. We offer the following for emphasis only.

During examination, the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Meeting that burden requires establishing that the prior art describes or suggests each and every limitation of the claim or would have provided one of ordinary skill in the art with an apparent reason to modify the prior art to arrive at the claimed invention. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In addition, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) *quoted with approval in KSR*, 550 U.S. at 418.

The Examiner finds, in relevant part, that Camera discloses a capsule for use in a machine that injects a fluid in the capsule for preparing a consumable product, wherein the capsule comprises a body defining an interior space with an opening having a cover, and an axis defined through the opening and the interior space for receiving an injection of fluid from the machine. Ans. 4. The Examiner further finds that Camera discloses that ingredients are disposed in the interior space for producing the consumable product, wherein a portion of the ingredients are non-permanently bound into a cluster/control member 850 which is disposed on the line of the axis to control flow of fluid injected into the capsule. *Id.*

The Examiner finds Camera teaches that cluster/control member 850 may include a flavor enhancer such as sugar, but may also include particulate materials and other instant beverage components such as coffee, which the Examiner finds “reads on the claimed insoluble ingredients being non-permanently bound into a cluster/control member.” Ans. 5. The Examiner finds that Camera teaches that some embodiments include particulate materials or components such as hot cocoa, tea, and juice, and that “[t]ea is well known in the art to encompass insoluble tea leaves.” *Id.* at 17. Therefore, the Examiner concludes that it would have been obvious to incorporate an insoluble instant beverage component into Camera’s cluster/control member 850 in order to provide an instant beverage component in a compressed form so as to reduce the volume of space occupied by the beverage component. *Id.* at 5.

Appellant argues, *inter alia*, that Camera fails to teach insoluble ingredients disposed in the ingredients chamber of the filter for preparing the consumable product. Appeal Br. 5–7. In particular, Appellant contends that Camera teaches the use of substantially soluble instant beverages, such as instant coffee, microground coffee, and dry coffee extract. *Id.* at 5. With regard to Camera’s teaching that insert 850 may be made of insoluble material, Appellant asserts that such an insoluble insert is configured to facilitate mixing of the soluble beverage ingredients and is not part of the ingredients of the beverage. *Id.* at 6–7. Further, Appellant urges that only when Camera’s insert is soluble is it part of the ingredients of the beverage. *Id.* at 7. As such, Appellant contends that Camera fails to disclose insoluble ingredients being non-permanently bound into a cluster or insoluble ingredients forming a control member comprising a non-permanent structure

adapted to at least partially dissolve or break apart as fluid is injected into the capsule. *Id.*

Initially, we note that both claims 1 and 13 require insoluble ingredients, a portion of which being non-permanently bound into a cluster or control member. *See Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003) (explaining that anticipation and obviousness require comparison of the properly construed claims to the available prior art); *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“Only when a claim is properly understood can a determination be made . . . whether the prior art anticipates and/or renders obvious the claimed invention.”).

An ingredient, as used in the claims before us, is “something that enters into a compound or is a component part of any combination or mixture.”<sup>3</sup> This definition is consistent with Appellant’s Specification which refers to “ingredients for producing beverages such as coffee, tea, hot chocolate or soup broth.” Spec. ¶ 3. In addition, a portion is “an often limited part of a whole.”<sup>4</sup> Again, this definition is consistent with Appellant’s Specification which teaches that ingredients in one region may be loosely disposed in the capsule while ingredients in another region are contained within a cluster. *Id.* ¶ 28; *see also* Figs. 1 and 3. In light of these definitions, we interpret claims 1 and 13 as requiring some, but not all, of the

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<sup>3</sup> <https://www.merriam-webster.com/dictionary/ingredient>, last visited November 19, 2019.

<sup>4</sup> <https://www.merriam-webster.com/dictionary/portion>, last visited November 19, 2019.

insoluble ingredients for making the beverage are non-permanently bound into the cluster or the control member.

Although the Examiner correctly finds that Camera teaches that an insoluble insert may be used, we note that Camera fails to teach that the insert is made from a portion of the insoluble ingredients for making the beverage or that these ingredients are non-permanently bound into a cluster. Instead, Camera's insert is either insoluble (and a non-ingredient) or soluble (and an ingredient). Indeed, regardless of the merits of the Examiner's finding that Camera teaches that the beverage ingredients may include insoluble ingredients, Camera fails to teach that a portion of these insoluble ingredients are non-permanently bound into a cluster or control member as required by claims 1 and 13. We note that the Examiner does not rely on either Winkler or Hall to remedy this deficiency. Absent such a teaching, we are persuaded that the Examiner's obviousness conclusion lacks sufficient rational underpinning. *Kahn*, 441 F.3d at 988.

Accordingly, we do not sustain the Examiner's decision to reject independent claims 1 and 13, and claims 2–6, 8, 9, 11, 12, 15–18, 21–26, 28, and 29 which depend therefrom.

## CONCLUSION

Upon consideration of the record, and for the reasons given above and in the Appeal and Reply Briefs, the decision of the Examiner rejecting claims 1–6, 8, 9, 11–13, 15–18, 21–26, 28, and 29 under 35 U.S.C. § 103 as unpatentable over Camera and Winkler, alone or further in view of Hall, is *reversed*.

DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 5, 6, 8, 9, 11-13, 15, 18, 21-26, 28, 29	103	Camera, Winkler		1, 2, 5, 6, 8, 9, 11-13, 15, 18, 21-26, 28, 29
3, 4, 16, 17	103	Camera, Winkler, Hall		3, 4, 16, 17
<b>Overall Outcome</b>				1-6, 8, 9, 11-13, 15-18, 21-26, 28, 29

REVERSED