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RANKIN, HILL & CLARK LLP 38210 GLENN AVENUE WILLOUGHBY, OH 44094-7808			LACHICA, ERICSON M	
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40854@rankinhill.com  
spaw@rankinhill.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LOUIS DEUBER

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Appeal 2019-001312  
Application 15/104,426  
Technology Center 1700

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Before BEVERLY A. FRANKLIN, MONTÉ T. SQUIRE, and  
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> requests our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1–11. We have jurisdiction over the appeal 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 QBO COFFEE GMBH. Appeal Br. 3.

### STATEMENT OF THE CASE

Claim 1 is illustrative of Appellant's subject matter on appeal and is set forth below:

1. A portion capsule that is filled with an extraction material, for creating a brewed product, comprising:

- a main body with a bottom region, a peripheral side wall, and a peripheral collar, the peripheral side wall converging into the collar; and
- a cover, which is fastened on the collar;
- wherein the main body and the cover enclose the extraction material;
- wherein the main body in a region of the collar has an essentially rectangular cross section;
- wherein the cover forms an outward arch, so that a capsule volume is greater than if a flat cover was attached to the main body;
- wherein a peripheral surface facing the cover side is formed, said surface extending from an outer edge of the collar up to a base of the arch;
- and wherein the base of the arch is offset inwards in comparison to a transition between the side wall and the collar.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Deuber

US2012/0090475 A1

Apr. 19, 2012

### THE REJECTION

1. Claims 1–11 are rejected under 35 U.S.C. §103 as being unpatentable over Deuber.

### ANALYSIS

Upon consideration of the evidence and each of the respective positions set forth in the record, we find that the preponderance of evidence supports the Examiner’s fact-finding and reasoning set forth in the record. We thus affirm the Examiner’s decision to reject claims 1–11 for the reasons provided by the Examiner in the record, and add the following primarily for emphasis.

At issue is whether Deuber suggests the claimed subject matter, particularly with respect to the element of “the base of the arch is offset inwards in comparison to a transition between the side wall and the collar.” Appellant’s Figure 3 (reproduced below) shows this offset as “v”, and also shows base 12, collar 4, and transition region 13.

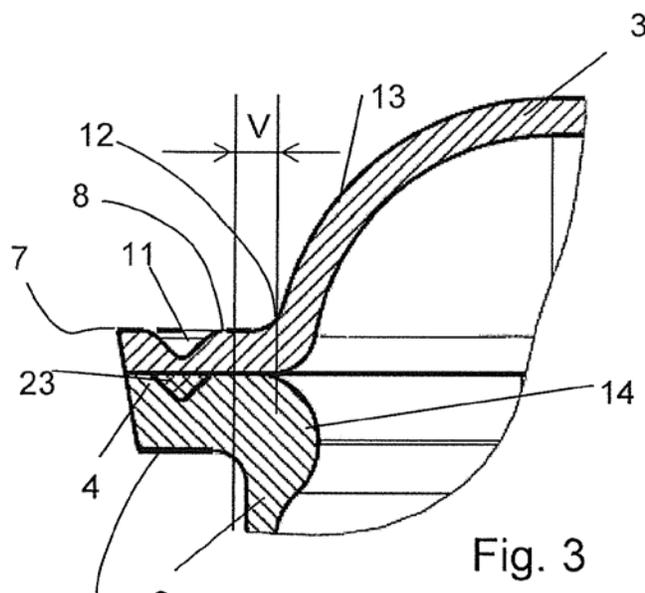
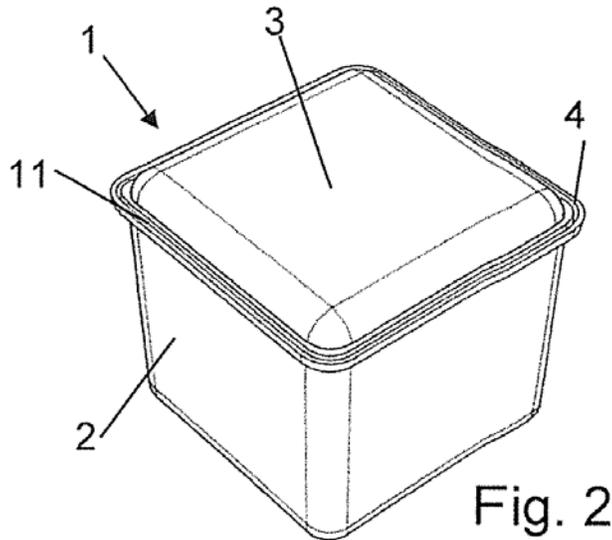
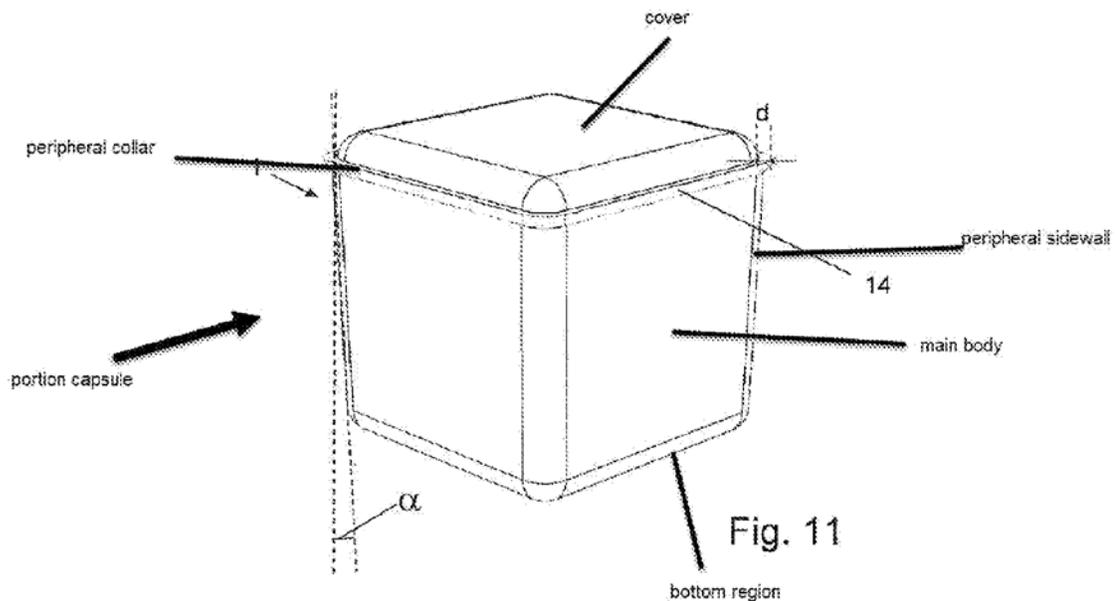


Fig. 3

Appellant's Figure 2 also shows collar 4 (below), as well as main body 2 and cover 3, and groove 11.



Appellant submits that Deuber does not teach or suggest the claim feature of “the base of the arch is offset inwards in comparison to a transition between the side wall and the collar.” Appellant contends that although Deuber’s Figure 11 shows an inclined angle “ $\alpha$ ” of a peripheral side wall of the main body and discusses an offset “d” of the welding bead, there is nothing in Deuber that suggests the above noted claim feature. Appeal Br. 9. Figure 11 (as annotated by the Examiner on page 5 of the Answer) of Deuber is reproduced below:



We refer to the Examiner's findings made on pages 4–5 of the Answer. Therein, the Examiner recognizes that Deuber is silent regarding the base of the arch being offset inwards in comparison to a transition between the side wall and the collar. Ans. 5. The Examiner finds that the configuration of the claimed arch is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed arch was significant (MPEP § 2144.04.IV.B.). *Id.* The Examiner further finds that the disposition of the arch provides no functionality to the claimed capsule and does not show a patentably distinguishing feature over the prior art of record. *Id.*

Appellant argues on pages 10–11 of the Appeal Brief that the claimed feature of the base of the arch being offset inwards in comparison to a transition between the sidewall and the collar has a technical significance and is advantageous in terms of attaching the cover to the main body. Appellant refers to parts of the Specification which discloses that a tool which, during an ultrasound welding procedure, is applied during a thermal connection process, can engage along a

greater area without the collar having to be extended, and that the tool also engages where no counterpart in a further tool supporting the collar is present. Appeal Br 11; Spec. ¶ [0034]. Appellant further states that the first tool 21 cannot apply a counterforce in the inner region because it is applied further outwardly than second tool 22 coupling in the energy, wherein an advantage results from the intrinsic stiffness of the main body and the cover, due to the shape, wherein the intrinsic stiffness is increased by thickening 14. Appeal Br. 11; Spec. ¶ [0035]. Appellant explains that energy director 23 (*see* Figures 3 and 4), which is an important and necessary feature during ultrasonic welding of the cover on the main body, can be further inwards with reference to the sidewall, and that the configuration with an outwardly arched cover adds to the fastening strength. Appeal Br. 11; Spec. ¶ [0036].

On page 12 of the Appeal Brief, Appellant submits that the claim feature of “the base of the arch is offset inwards in comparison to a transition between the side wall and the collar” is a structural part of the claimed capsule that is provided to increase the strength of the connection between the cover and the main body. Hence, Appellant argues that even if some of the advantages are related to the production of the capsule, this does not alter the fact that the claim feature is not disclosed in Deuber. Appeal Br. 12. Appellant also argues that the Examiner provided no persuasive evidence that the claim feature of “the base of the arch is offset inwards in comparison to a transition between the side wall and the collar” was a known design alternative for the prior art capsules. Appeal Br. 12. Appellant contends that to support a conclusion that a feature is an obvious matter of design choice, the Examiner must present a ‘convincing line of reasoning’ as to why one of ordinary

skill in the art would have found the claimed feature to have been obvious.<sup>2</sup> Appeal Br. 12.

The Examiner's response is set forth on pages 10–11 of the Answer, which we adopt as our own. We refer to pages 2–3 of the Reply Brief regarding Appellant's stated reply.

We agree with the Examiner that Appellant's arguments pertaining to the improvements in the production of the capsule are unpersuasive for the reasons discussed by the Examiner in the record (discussed, *supra*).

With regard to Appellant's position that even if some of the advantages of the claim feature are related to improving the production of the inventive capsule, the claim feature is a structural feature of the capsule itself which has a clear mechanical significance not disclosed in Deuber, we are also unpersuaded by such argument for the following reasons.

As discussed above, it is the Examiner's finding that the modification of Deuber to arrive at the claim feature is an obvious variation of shape. Appellant argues it results in a change of function in the form of advantages associated with strength of the connection and refers to the Specification in this regard (Spec. ¶ [0035]). However, as pointed out by the Examiner, there is no comparison of connection strength in the record. Ans. 10–11. There is no comparison of the connection strength of Deuber's capsule with the connection strength of Appellant's claimed capsule. As such, it is simply unknown whether the function of the Deuber's capsule is different from the function of the claimed capsule in this regard.

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<sup>2</sup> As discussed in MPEP § 2144.04, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Changes in shape is an example directed to common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients. MPEP § 2144.04 IV. B. This is the line of reasoning used by the Examiner.

Furthermore, “[t]he fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.).

In view of the above, we affirm the rejection.

#### DECISION

The rejection is affirmed.

#### TIME PERIOD

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).

#### ORDER

AFFIRMED