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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VANESSA VALLES, DANIEL PEIRSMAN, and
SARAH VAHOVE¹

Appeal 2019-001807
Application 12/812,874
Technology Center 3700

Before JILL D. HILL, LEE L. STEPINA, and ARTHUR M. PESLAK,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Vanessa Valles et al. (“Appellants”) appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 16–24.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants identify the real party in interest as Anheuser Busch INBEV S.A. Appeal Br. 1.

² Claims 25 and 26 are withdrawn from consideration. Final Act. 1; *see also* Appeal Br. 3.

BACKGROUND

Appellants' invention relates to a closure having a pierceable part that is used for sealing a container. Claim 16, reproduced below, illustrates the claimed invention, with certain limitations italicized:

16. A container containing a carbonated beverage to be dispensed using a home appliance, said container comprising an opening and being provided with a closure for sealing said opening, said closure having a base comprising a pierceable part, the pierceable part being pierceable by insertion therethrough of a dispensing tube, said pierceable part being defined by a sidewall extending transversally with respect to the base and a bottom, at least one of said sidewall and bottom comprising several lines of weakened material strength dividing the at least one of said sidewall and bottom in several wedge formed parts, *wherein a side of said pierceable part facing outside the container when the closure is correctly applied thereon is provided with an overmold having an elastic material that at least partially covers the side to form a seal with respect to the dispensing tube inserted in the container through the pierceable part* for preventing leakage from inside the container to outside the container during dispensing of liquid through said dispensing tube.

REJECTIONS

I. Claims 16–22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Stenger (US 4,784,299, iss. Nov. 15, 1998), Anderson (US 7,435,389 B2, iss. Oct. 14, 2008), and Parsons (US 5,370,252, iss. Dec. 6, 1994). Final Act. 3.

II. Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Stenger, Anderson, Parsons, and Reichel (US 2,085,392, iss. June 29, 1937). Final Act. 5.

ANALYSIS

Rejection I – Stenger, Anderson, and Parsons

The Examiner finds that the combined teachings of Stenger and Anderson disclose most of the limitations of the container of claim 16, but do not disclose that a pierceable part of the container is provided with an overmold having an elastic material that forms a seal with respect to the dispensing tube inserted in the container through the pierceable part. Final Act. 4. The Examiner relies on Parsons to teach an overmold, and concludes that it would have been obvious to modify Anderson to apply “an additional layer of elastic material at least partially over the pierceable part to ensure re-sealing of the closure after initial piercing to prevent leakage.” *Id.* at 5.

Appellants argue that the references do not teach the claimed overmold because “overmolding has a very clear meaning to a person of ordinary skill in the art - molding one material onto another material during a molding process.” Appeal Br. 4. According to Appellants, the upper portion 3 and lower portion 4 of Parsons are not overmolded because they are connected by a ring or seal 8, which “allows for ‘separating’ and ‘remov[al]’ of the upper portion 3 from the lower portion 4 with operator intervention.” *Id.* (alteration in original) (emphasis omitted) (citing Parsons, 3:30–32 and 48–50). Appellants contend that separability in Parsons “is exemplified by the clear gap between the upper portion 3 and the lower portion 4 in Figure 1,” and by air cushion 6 between upper and lower portions. *Id.* at 4–5. Appellants assert that Parsons’ disclosure of separable elements with a gap therebetween, “is in clear contrast to an ‘overmold’ in which one material is molded onto another material, which would inhibit or constrain any ability for an operator to separate or remove the two

materials.” *Id.* at 5. Appellants provide Exhibit A (Tony Rogers, *Everything You Need To Know About Overmolding Prototypes*, Creative Mechanisms Blog (2015) (“Rogers”), in support of their definition of “overmold.” *Id.* at 4.

The Examiner responds that an overmold is “an elastic material or part applied on a side of another part which can function to protect weakening lines, aid against permeation prior or during piercing, and to provide a sealing function.” Ans. 4. According to the Examiner, even if an overmolding process is implied, it would be a product-by-process limitation that is limited to the resultant product, which is the same product taught by Parsons. Ans. 5–6 (citing *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (“A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.”)).

Appellants reply that “[t]he plain and ordinary meaning of ‘overmold’ cannot be interpreted merely to mean ‘a material or part applied on the side of another part,’” because “[s]uch a claim construction is unreasonably broad. The term ‘overmold’ clearly has a more narrow meaning.” Reply Br. 2.

Appellants have the better position. Where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product, the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art. *In re Garnero*, 412 F.2d 276, 279 (CCPA 1979) (holding “interbonded . . . by interfusion” to limit structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and

“etched” are capable of construction as structural limitations). Here, Appellants’ Specification discloses that “the pierceable part 4 can be entirely or partially over-moulded with an elastic material.” Spec. 6:1–2; *see also* Fig. 1A. The term “overmold” requires more than just placing one portion, namely, layer 12 of Parsons over another portion, namely, pierceable part 5 of Parsons. Specifically, Appellants provide evidence that one part being molded over another part requires that the two parts form a chemical bond as part of the molding process. *See* Rogers 2–3. This is consistent with Appellants’ assertion that “an ‘overmold’ in which one material is molded onto another material, . . . would inhibit or constrain any ability for an operator to separate or remove the two materials.” Appeal Br. 5.

Parsons discloses a “cap . . . comprising an upper portion and lower portion, the upper portion being detachable from the lower portion and allowing access to the interior of the container in such a detached position.” Parsons 2:36–41. In the embodiment of Figures 1, 2, and 4B, Parsons discloses that “upper portion 3 is provided with a ring or seal 8 around the elongate member which mates with a corresponding depression in the lower portion 4 to provide additional sealing to the cap in its closed position.” *Id.* at 3:26–30. “[A]n air space or cushion 6 is also provided between the barrier 5 [of lower portion 5] and the upper portion 3 when the cap is in a closed or fitted position.” *Id.* at 3:58–60.

We agree with Appellants that additional layer 12 of upper portion 3 of Parsons is not an overmold because Parsons’ connection does not include a chemical bond or otherwise infer such bond by inhibiting or constraining any ability for an operator to separate or remove the two materials. Absent evidence that Parsons includes a chemical bond or otherwise inhibits or

constrains any ability for an operator to separate or remove upper portion 3 from lower portion 4, the Examiner has not established that Parsons imparts the distinctive structural characteristic of a chemical bond that is obtained by overmolding. Accordingly, the Examiner has not established that Parsons discloses an overmold as claimed in claim 16.

We do not sustain the Examiner's rejection under 35 U.S.C. § 103 of claims 16–22 as unpatentable over Stenger, Anderson, and Parsons.

Rejection II – Stenger, Anderson, Parsons, and Reichel

Rejection II additionally pertains to claims that depend from independent claim 16. The Examiner does not rely on Reichel in any manner that would cure the deficiencies of Stenger, Anderson, and Parsons, and we, therefore, do not sustain Rejection II for the reasons set forth above regarding Rejection I.

DECISION

We REVERSE the Examiner's rejection of claims 16–22 as unpatentable over Stenger, Anderson, and Parsons.

We REVERSE the Examiner's rejection of claims 23 and 24 as unpatentable over Stenger, Anderson, Parsons, and Reichel.

REVERSED