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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DONALD W. LUSARETA

Appeal 2019-002811
Application 11/811,041
Technology Center 3700

Before JENNIFER D. BAHR, CHARLES N. GREENHUT, and
BRETT C. MARTIN, *Administrative Patent Judges*.

BAHR, *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 17–20, 23, 25, and 27–44. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ 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 TRS Lid Technology, LLC. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Appellant's invention is directed to "a disposable lid with filter for a drink container to overcome the problem of loose tea leaves or any other insoluble matter not desir[able] to consume from reaching the mouth of the drink consumer." Spec. ¶ 15. Claim 17, reproduced below, is illustrative of the claimed subject matter.

17. A lid for closing a cup, the cup having a rim and being adapted and sized to hold a beverage including consumable fluid within an interior, the lid comprising:

 a cup attachment portion for removable association with the rim of the drink cup in a snug, liquid-tight relation,
 an annular cover portion,

 a spout extending from said annular cover portion and unitarily formed with said annular cover portion, the spout having a lower end, an upper end, and opposed side walls between the lower end and the upper end defining an elongated interior space, the spout further having an opening disposed adjacent the upper end to provide passage of the beverage from the interior of the cup through the elongated interior space and the opening when the cup attachment portion is associated with the cup, and

 only a single filter, the filter being coupled to the lid, the filter being seated within and secured within and across said elongated interior space of the spout to filter the beverage as the beverage passes from the interior of the cup into and through the interior space and opening of the spout, the filter being a foam filter block extending from a lower portion of the spout towards the upper end of the spout and abutting at least a portion of the opposed side walls;

 wherein, as the lid is repositioned into a vertical position, fluid within the spout adjacent the opening flows back through the filter to at least partially clean the filter, and

 wherein all fluid entering and leaving the spout flows through the filter.

EVIDENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
DeMars	US 4,899,902	Feb. 13, 1990
Thompson	US 5,846,418	Dec. 8, 1998
Cai	US 7,032,507 B2	Apr. 25, 2006
Kelstrom	US 2006/0163251 A1	July 27, 2006

REJECTION

- I. Claims 17–20, 23, 25, and 27–44 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
- II. Claims 23, 28, 32–35, 38–40, and 42–44 stand rejected under 35 U.S.C. § 103(a) as unpatentable over DeMars and Thompson.
- III. Claims 17, 18, 20, 27, 29–31, 37, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over DeMars, Thompson, and Cai.
- IV. Claims 25 and 36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over DeMars, Thompson, and Kelstrom.
- V. Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over DeMars, Thompson, Cai, and Kelstrom.

OPINION

Rejection I—Written Description

The Examiner finds that the limitation “only a single filter” recited in each of independent claims 17, 23, 33, and 40 lacks written description support in the present application. *See* Final Act. 2.

The fundamental factual inquiry for ascertaining compliance with the written description requirement is whether the disclosure of the application

relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “This inquiry . . . is a question of fact,” and “the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* “[T]he specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Id.*

Appellant argues that “[e]ach embodiment depicted in the drawings as well as the related descriptions thereof refers to a single filter.” Appeal Br. 4 (discussing three embodiments, namely, the embodiment of Figures 1–3, the embodiment of Figures 4–7, and the embodiment of Figures 8–12). According to Appellant, “the written description includes no discussion whatsoever of the inclusion of more than one filter within a lid.” *Id.*

The Examiner finds that Figure 12 of the present application “is a sectional view and therefore it cannot be known how many filters are present or being shown” and that “[t]he [S]pecification is open for the inclusion of unspecified number of filters.” Ans. 3.

Appellant’s Specification describes Figure 12 as “showing *the* filter inserted within the spout portion of the lid and the holding area for filtered liquid positioned above the filter and below the spout void.” Spec. ¶ 41 (emphasis added). The Specification also refers repeatedly to “*the* filter 18” and “*the* filter 64.” *Id.* ¶¶ 32, 48 (emphasis added, boldface omitted). Further, the Specification describes the passage of liquid beverage through filter 64 in the direction of arrow “A” to become filtered beverage as the cup

is tilted to allow the user to take a sip, the retention of an amount of the filtered beverage within spout holding area 66, and the reverse flow of residual filtered beverage held in spout holding area 66 back through filter 64 in the direction of Arrow “B” as the cup is returned to its vertical or upright position, thereby helping “to clean or partially clean filter 64 between sips from cup 70” to “[maintain] generally unobstructed flow of beverage from the cup during use.” *Id.* ¶¶ 47–49 (boldface omitted); *see* Fig. 12. The Specification describes “*the* filter” as “*a* filter of approximate 1/4 inch thickness composed of a generally open foam-like or open-cellular structure composed of plastic or paper or cellulose-based fibers.” Spec. ¶ 50 (emphasis added). This description of *the* filter being *a* filter reasonably conveys to those skilled in the art that there may be only one filter in the disclosed embodiments. Thus, Appellant’s Specification describes at least one embodiment of the invention including the claimed subject matter, including only one filter. The fact that Appellant does not expressly exclude other possible embodiments comprising more than one filter does not negate the fact that the Specification describes at least one embodiment having only a single filter.

For the above reasons, we agree with Appellant that the disclosure of the present application reasonably conveys to those skilled in the art that Appellant had possession of the claimed subject matter as of the filing date. Accordingly, we do not sustain the rejection of claims 17–20, 23, 25, and 27–44 as failing to comply with the written description requirement.

Rejection II—Obviousness: DeMars and Thompson

Principles of Law Pertaining to Obviousness:

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “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), *cited with approval in KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Analysis:

Claims 23, 28, 32, and 42:

In rejecting independent claim 23, the Examiner finds that DeMars lacks a “filter being subjacent the shoulder in and across the interior space” and “spaced from the opening to define a cavity between the filter, the opening, and a portion of the opposed walls,” as required in claim 23. Final Act. 4. The Examiner determines it would have been obvious, in view of the teachings of Thompson, to provide the spout of DeMars with a filter, but does not articulate in the rejection any findings or reasoning to explain why it would have been obvious to dispose the filter subjacent the shoulder and

spaced from the opening to define a cavity as called for in claim 23. *See id.* at 4–5.

Appellant argues that the Examiner ignores the limitations in claim 23 setting forth the particular relationship of the filter to the shoulder. Appeal Br. 8. Claim 23 recites a specific spatial relationship between the shoulder and the filter—namely, “the filter being subjacent the shoulder” and “spaced from the opening to define a cavity between the filter, the opening, and a portion of the opposed walls.” Claims App. 2. The Examiner does not explain why it would have been obvious to dispose a filter in this particular location in the lid of DeMars.² All words in a claim must be considered in judging the obviousness of the claimed subject matter. *See In re Wilson*, 424 F.2d 1382, 1385.

For the above reasons, the Examiner fails to set forth sufficient factual findings and reasoning to establish that the subject matter of independent claim 23 would have been obvious. Accordingly, we do not sustain the rejection of claim 23, or claims 28, 32, and 42, which depend from claim 23, under 35 U.S.C. § 103(a).

² Appellant alludes to the Examiner’s treatment of the recitation of the relationship between the filter and the shoulder in addressing claim 35. Appeal Br. 8; *see* Final Act. 6. However, the Examiner’s statement that “[t]he modified DeMars further discloses the filter being disposed adjacent the shoulder and between the shoulder and the opening” (Final Act. 6), although pertinent to claim 35, is not pertinent to claim 23, which recites a different location of the filter—namely, “subjacent the shoulder” and “spaced from the opening to define a cavity between the filter, the opening, and a portion of the opposed walls.” *Compare* Claims App. 2 (claim 23), *with id.* at 4 (claim 35).

Claims 33–35, 38–40, 43, and 44:

Independent claims 33 and 40 require, in pertinent part, that “as the lid is repositioned into a vertical position, fluid within the spout adjacent the opening flows back through the filter to at least partially clean the filter.” Claims App. 3, 4–5. In addressing this limitation, the Examiner states that “the modified device of DeMars is capable of being used as claimed” without setting forth any factual findings or providing any technical explanation to support this statement. *See* Final Act. 6.

Appellant argues that “there would be no reason to provide a back flow through the Thompson exit filter 34,” and that “any incidental flow back through the exit filter 34 of Thompson is not a necessary aspect required for the operation or even necessarily a desirable feature of the exit filter 34 of Thompson.” Appeal Br. 9. Indeed, the Examiner must provide sufficient evidence or scientific reasoning to establish there is a sound basis for the examiner’s belief that the functional limitation is an inherent characteristic of the prior art. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). However, the Examiner does not respond to this argument.

In light of the above, the Examiner fails to provide the requisite factual findings and reasoning to support the conclusion that the subject matter of claims 33 and 40 would have been obvious. Accordingly, we do not sustain the rejection of claims 33 and 40, or their dependent claims 34, 35, 38, 39, 43, and 44, under 35 U.S.C. § 103(a).

Rejection III—Obviousness: DeMars, Thompson, and Cai

Independent claim 17, like independent claims 33 and 40, recites that “as the lid is repositioned into a vertical position, fluid within the spout

adjacent the opening flows back through the filter to at least partially clean the filter.” Claims App. 1. Claim 17 also recites that the filter is “a foam filter block.” *Id.*

The Examiner’s application of Cai for its teaching of providing a filter made of open-cell foam material (Final Act. 10) in rejecting independent claim 17, as well as claims 18, 20, 29–31, and 41, which depend from claim 17, and claims 27 and 37, which depend from claims 23, and 33, respectively, does not make up for the deficiencies in the rejection of claims 23 and 33 discussed above. Accordingly, for the same reasons, we do not sustain the rejection of claims 17, 18, 20, 27, 29–31, 37, and 41 under 35 U.S.C. § 103(a).

Rejection IV—Obviousness: DeMars, Thompson, and Kelstrom

The Examiner’s application of Kelstrom for its teaching to secure a filter element to a lid with an adhesive (Final Act. 13) in rejecting claims 25 and 36 does not cure the deficiencies in the rejections of claims 23 and 33, from which claims 25 and 36 depend. Accordingly, we do not sustain the rejection of claims 25 and 36 under 35 U.S.C. § 103(a).

Rejection V—Obviousness: DeMars, Thompson, Cai, and Kelstrom

The Examiner’s application of Cai (Final Act. 10) and Kelstrom (Final Act. 13) in rejecting claim 19, which depends, via claim 18, from claim 17, does not overcome the aforementioned deficiency in the rejection of claim 17. Accordingly, we also do not sustain the rejection of claim 19 under 35 U.S.C. § 103(a).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
17–20, 23, 25, 27–44	112, first paragraph	Written Description		17–20, 23, 25, 27–44
23, 28, 32–35, 38–40, 42–44	103(a)	DeMars, Thompson		23, 28, 32–35, 38–40, 42–44
17, 18, 20, 27, 29–31, 37, 41	103(a)	DeMars, Thompson, Cai		17, 18, 20, 27, 29–31, 37, 41
25, 36	103(a)	DeMars, Thompson, Kelstrom		25, 36
19	103(a)	DeMars, Thompson, Cai, Kelstrom		19
Overall Outcome				17–20, 23, 25, 27–44

REVERSED