



# 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.
12/792,482	06/02/2010	Lawrence Epstein	PPT 0102 PUSP	4832
22045	7590	06/12/2020	EXAMINER	
Brooks Kushman 1000 Town Center 22nd Floor Southfield, MI 48075			ACKUN, JACOB K	
			ART UNIT	PAPER NUMBER
			3736	
			NOTIFICATION DATE	DELIVERY MODE
			06/12/2020	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):

docketing@brookskushman.com  
kdilucia@brookskushman.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* LAWRENCE EPSTEIN, AL FOTHERINGHAM, and  
MARK POE

---

Appeal 2019-003117  
Application 12/792,482  
Technology Center 3700

---

Before ANNETTE R. REIMERS, JILL D. HILL, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>2</sup> appeals from the Examiner's rejection of claims 1 and 3–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

---

<sup>1</sup> The subject application was previously before the Patent Trial and Appeal Board in Appeal No. 2015-000693. *See* Decision dated November 8, 2016.

<sup>2</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 Pressed Paperboard Technologies LLC. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

The claims are directed to a multi-compartment food tray. Claims 1, 8, and 17 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A multi-compartment food tray, comprising:

a first compartment and a second compartment formed of a paperboard material, each compartment including a compartment lip; and

a carrier formed of a paperboard material and including one or two pairs of openings receiving the first and second compartments, respectively, and a divider area between the one or two pairs of openings, the carrier uninterruptedly extending from edge to edge except for only the one or two pairs of openings,

wherein each of the first and second compartment lips is coupled to the carrier to form an inseparably coupled interface between the carrier and the first compartment and between the carrier and the second compartment during exposure to extremely high heat during baking or cooking.

### REJECTIONS

Claims 1 and 3–20 are rejected under 35 U.S.C. §:

- I. 112, first paragraph, as failing to comply with written description requirement;
- II. 112, second paragraph, as being indefinite;
- III. 102(b) as being anticipated by or 103(a) as being unpatentable over Galluch (US 2007/0108089 A1, pub. May 17, 2007); and
- IV. 102(b) as being anticipated by or 103(a) as being unpatentable over Anghileri (US 4,986,432, iss. Jan. 22, 1991).

OPINION

*I. New Matter - 35 U.S.C. § 112, ¶¶ 1, 2; Objections to Specification and Drawings*

It is the examiner’s “initial burden [to] present[ ] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” (*In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976)). However, just as when analyzing the question of obviousness, when reviewing the question of written description support it must be remembered that one of skill in the art is not an automaton. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is . . . not an automaton.”).

35 U.S.C. § 112, ¶ 1

The Examiner finds that the following claim limitations lack written description support: “**one or two pairs** of openings;” “**a divider area between the one or two pairs of openings;**” “**uninterruptedly extending from edge to edge** except for only the one or two pairs of openings;” and “each of the first and second compartment lips is coupled to the carrier to form **an inseparably coupled interface.**” Final Act. 5–7. For the reasons expressed below, we reverse.

*“one or two pairs of openings”*

The claimed “one or two pairs of openings” is included in three of the noted phrases above. The Examiner finds that “[c]onceptually a pair or two pairs of openings is simply not taught anywhere in the original disclosure.” *Id.* at 5. The Examiner acknowledges that two openings are disclosed in Figure 3 and discussed in the Specification. *Id.* at 15. The Examiner also acknowledges that Figure 6 teaches a number of openings. *Id.* at 16; *see* Spec., Figure 6 (showing 4 openings). However, the Examiner determines

Appeal 2019-003117  
Application 12/792,482

that because the word “pair” is not used, the concept of a pair is not disclosed. *Id.* at 15–16.

The Examiner construes “pair” as requiring “a relationship between the two entities that goes beyond the fact that there are two of them in number.” Ans. 8 (citing Webster’s II New Riverside University Dictionary, “pair” (1984)). The Examiner’s statement is consistent with the cited dictionary, where a pair is “two corresponding . . . items, similar in form and function, and matched or associated.” Ans. 7–8 (quoting Webster’s II New Riverside University Dictionary, “pair” (1984)). However, the Examiner does not establish that the written description lacks support for “one or two pairs of openings” based on this construction of “pair.” Further, the Examiner does not contend that the proposed definition is consistent with Appellant’s disclosure.

The Examiner is correct that the term “pair” is not used in Appellant’s Specification. At the same time, there is no requirement that the Specification include a claim term word for word to provide written description support. *See Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.”). Nonetheless, the disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *See id.*

As noted above, the Examiner acknowledges that two openings are disclosed in Figure 3 and discussed in the Specification. Final Act. 15. The Examiner further admits that “they are arranged with respect to each other in a particular manner.” Ans. 4. However, the Examiner determines that this is not a pair because the openings do not have identical shapes. *Id.* at 5.

Identity of form or shape is not required by the Examiner's construction or the cited definition. We determine that one of skill in the art would understand the openings in Figure 3 have similar form and identical functions. We further determine that one of skill in the art would understand the openings to be matched and associated because, as stated by the Examiner, "they are arranged with respect to each other in a particular manner." Ans. 4. This is at least because there are only two openings in the carrier.

As also noted above, the Examiner acknowledges that Figure 6 teaches a number of openings. Final Act. 16; *see* Spec., Figure 6 (showing 4 openings). The Examiner determines that "[t]here is no specific relationship between [any of these] apertures." Ans. 8. We determine that one of skill in the art would understand the openings in Figure 6 to have identical form and function. We further determine that one of skill in the art would understand Figure 6 to disclose two pairs of openings at least because the two on the right are positioned closer together and the two on the left are positioned closer together. Appellant's Specification does not discuss a particular level of matching or association required, and we therefore determine that the requirement for two similar items to be matched or associated is a low bar.

Thus, we do not sustain the Examiner's 35 U.S.C. § 112, ¶ 1 rejection on these grounds.

*"a divider area between the one or two pairs of openings"*

The Examiner admits that the Specification teaches divider area 41 between two openings in Figure 3. Ans. 4-5; *see also* Spec 6, ln. 25. As discussed above, we determine that the Specification provides written description support for a pair of openings in Figure 3. Thus, the

Appeal 2019-003117  
Application 12/792,482

Specification provides support for a divider area between one pair of openings.

Appellant argues that

As with “divider area 41 between the openings 37 and 39[”]  
. . . , a divider area exists between the four circular openings  
and each pair of circular openings of Figs. 6 and 8. The  
“placement” of reference numeral 68 on Fig. 6 is supported by  
the original written description regarding this embodiment and  
the drawings for the other embodiments relating to divider area  
41.

Appeal Br. 6.

We agree that one of skill in the art, reviewing the disclosure of the divider area 41 in Figure 3, would understand that Figure 6 includes a similar divider area. As we previously found that the Specification provides written description support for one or two pairs of openings, we therefore determine that the phrase “a divider area between the one or two pairs of openings” also has written description support.

*“uninterruptedly extending from edge to edge except for only the one or two pairs of openings”*

The Examiner determines that the phrase “**uninterruptedly** extending **from edge to edge** except for only the one or two pairs of openings” does not have written description support because “this issue has already been decided by the Board in the decision rendered on 11/8/16.” Final Act. 7 (citing Decision 5).

However, this statement is inaccurate. Our previous decision addressed the phrase “uninterruptedly extending from edge to edge except for the first and second openings.” Decision 3. We determined that this phrase was indefinite because Appellant was arguing for a meaning based at

Appeal 2019-003117  
Application 12/792,482

least in part on Figure 6 (showing four openings), which is inconsistent with the prior phrase from the claims. *Id.* at 4.

Appellant has now amended the claims such that they are no longer inconsistent with what is shown in Figure 6, or Figure 3. Thus, we do not sustain the Examiner’s 35 U.S.C. § 112, ¶ 1 rejection on these grounds.

*“each of the first and second compartment lips is coupled to the carrier to form an inseparably coupled interface”*

The Examiner determines that “the original disclosure did not refer to a feature that corresponds to the claimed ‘inseparably coupled interface.’” Final Act. 7. The Examiner again appears to be requiring that the exact phrase be included in the original disclosure to provide written description support. This is not required. The Examiner admits the Specification teaches “that the carrier does not separate from the compartments”; thus, it is unclear why the Examiner concludes that this “is not disclosure of a structural feature that is an inseparably coupled interface.” Final Act. 7.

We agree with Appellant where it is argued:

The original specification discloses that “once coupled, carrier 36 does not separate from the compartments 32 and 34 when exposed to extreme temperatures.” . . . The original specification also discloses that once coupled, carrier 36 may not separate from each compartment 32 and 34 during exposure to extremely high heat during baking or cooking.” The phrase “inseparably coupled interface” describes the originally disclosed phrase “does not separate” and “may not separate.”

Appeal Br. 11; *see* Spec 6, lines 9–23.

Thus, we do not sustain the Examiner’s 35 U.S.C. § 112, ¶ 1 rejection on these grounds.

35 U.S.C. § 112, ¶ 2

Having determined that certain phrases lack written description support, the Examiner also determines that these same phrases “are

Appeal 2019-003117  
Application 12/792,482

indefinite because they cannot be properly interpreted” because of the lack of written description support. Final Act. 8.

We first note that just because a phrase lacks written description support does not necessarily render a phrase indefinite. Further, as we reverse herein the Examiner’s rejections for lack of written description, we reverse the Examiner’s related rejections for indefiniteness.

#### Objections to Specification and Drawings

Typically, we do not address the merits of objections to the Specification or Drawings because an Examiner’s objection is a petitionable matter—not an appealable matter. 37 C.F.R. §§ 1.113(a), 1.181; *see also* MPEP § 2163.06(II) and MPEP § 706.01 (“[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board.”). However, there are times where objections are properly before the Board. For example, MPEP § 2163.06(II) states that where “both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.” *See also* Appeal Br. 5. Such is the case here.

The Examiner objected to certain amendments to the Specification and Drawings for containing new matter. *Id.* at 2–3. As noted above, we determine that the Specification-as-originally-filed, including the drawings, provides written description support for all of the features of the claims addressed by the Examiner’s rejection under 35 U.S.C. § 112. Presumably, Appellant proposed the amendments to the Specification and Drawings as a way to address the Examiner’s concerns. We determine that these new matter objections are properly before us, and reverse based on the prior showing of written description support. *See In re Hengehold*, 440 F.2d

Appeal 2019-003117  
Application 12/792,482

1395, 1404 (CCPA 1971) (holding that Board had no jurisdiction to review restriction requirement but stating “the kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims”).

For example, based on our determination of written description support for these claim elements, we agree with Appellant that one of skill in the art would understand the area newly marked “68” in Figure 6 to be a divider area based on the original disclosure. *See* Appeal Br. 6–7. Thus, we also agree with Appellant that adding reference numeral “68” to the Specification does not amount to new matter. We further determine that the inclusion of the claimed phrases addressed by the Examiner’s rejection under 35 U.S.C. § 112 and the related reference numerals in the amendments to the Specification do not amount to new matter.

Because the Examiner determined that “**one or two pairs of openings**” lacked written description support, the Examiner objected to the drawings for not showing this feature under 37 C.F.R. § 1.83(a). Final Act. 3. However, as noted above, the drawings do in fact provide written description support for “one or two pairs of openings.” Thus, we do not sustain the Examiner’s objection to the drawings on this basis.

At the same time, we agree with the Examiner that newly added Figures 7 and 8 include new matter. As discussed above, the Specification provides written description support for openings and pairs of openings; however, we agree with the Examiner that the original disclosure does not provide clear disclosure of the *exact shapes* of the openings in new Figures 7 and 8. *See* Final Act. 2–3. Contrary to Appellant’s argument, though the shapes shown by Appellant seem likely, it is possible that the openings could be shaped differently or even have a different size in relation to the carrier.

Appeal 2019-003117  
Application 12/792,482

*See* Appeal Br. 7. Thus, we agree with the Examiner that new Figures 7 and 8 introduce new matter. At the same time, we find that original Figures 3 and 4 indicate the location of openings 37, 39, and we determine that one of skill in the art would understand original Figure 6 to include openings in the same manner. Thus, the exact shape of the openings shown in new Figures 7 and 8 is not supported, and the reference to Figures 7 and 8 in the amended Specification amounts to new matter.

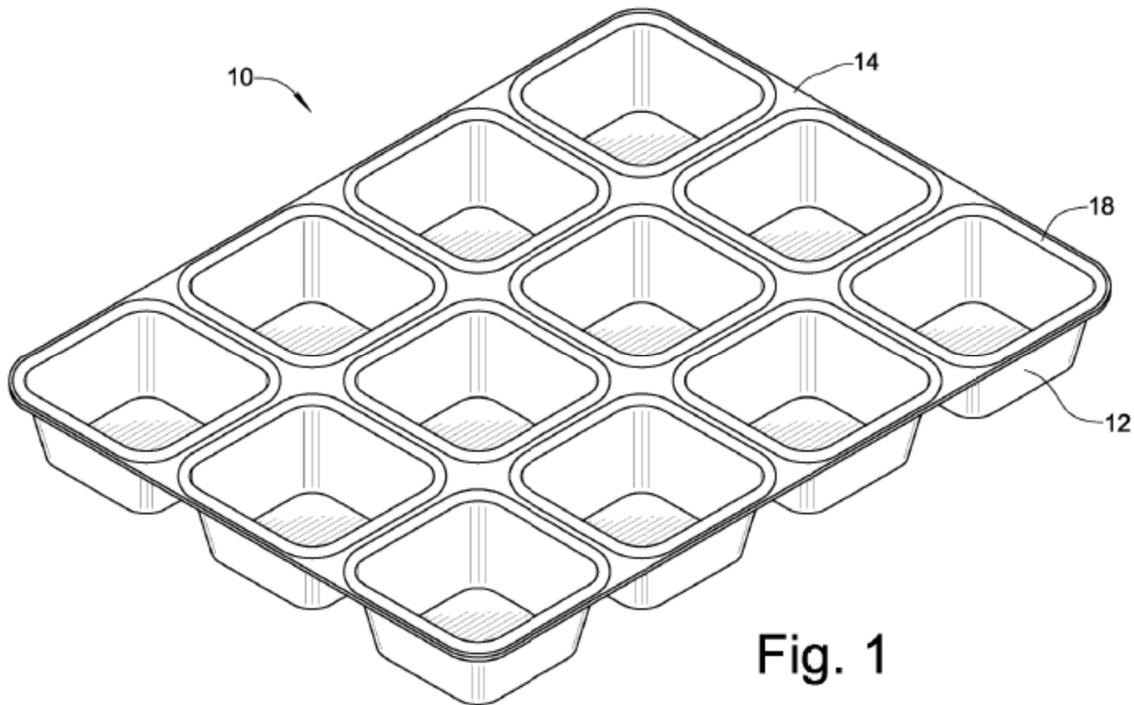
## *II. 35 U.S.C. § 102 / 103 - Galluch*

Galluch is directed to “an ovenable tray including a plurality of serving containers connected by a detachable support matrix.” Galluch, Abstract. The serving containers can detach from the support matrix in one of many ways, such as melting hot melt glue during baking, and breaking along perforations in the support matrix. *Id.* at Abstract, ¶¶ 21, 24.

The Examiner rejects the claims separately over three different groups of embodiments (Fig. 1, Figs. 5–6, Fig. 7). Final Act. 9–12. We address Figure 1 and then Figures 5–7 in turn.

### *Figure 1*

In rejecting the claims, the Examiner first points to Galluch Figure 1, reproduced below, stating: “[a]ny two openings can be one pair and any two others the second pair” and “[ ] the divider area’ is the appropriate surface (or surfaces) between the openings.” Final Act. 9.



Galluch Figure 1 shows a baking tray.

The Examiner also finds that “during baking or cooking to up to between 250–275 degrees the carrier does not separate from the compartments therefore it appears that there is some inseparably coupled interface between the carrier and the compartments at up to these temperatures.” Final Act. 10. The Examiner determines that the use of other adhesives separable at other temperatures would have been “a matter of obvious choice of design . . . in order to provide optimal baking or cooking for particular food items.” *Id.* at 12. The Examiner further explains that Galluch “suggests that other adhesives could be used to facilitate separation at other temperature ranges depending on the baking or cooking requirements (which in turn would depend on factors such as exactly what was being baked or cooked or how ‘well-done’ one wanted to cook a particular dish).” *Id.* (citing Galluch ¶ 21).

Appellant highlights two different claim elements as not shown by Galluch:

Independent claim 1 recites “the carrier uninterruptedly extending from edge to edge except for only the one or two pairs of openings,” independent claim 8 recites “the carrier having an uninterrupted upper surface except for only the one or two pairs of openings,” and independent claim 17 recites “the exposed top surface of the carrier uninterruptedly extending from edge to edge except for only the one or two pairs of openings.”

and

Pending claims 1, 8 and 17 also each recite that “each of the first and second compartment lips is coupled to the carrier to form an inseparably coupled interface between the carrier and the first compartment and between the carrier and the second compartment during exposure to extremely high heat during baking or cooking.”

Appeal Br. 14. We agree that these are not taught or suggested by Galluch.

For example, as can be seen in Figure 1, Galluch’s carrier includes twelve openings, which are more than the only “one or two pairs of openings” required by the claims. The Examiner states that the claims are not “limited to four openings” because of the use of the term “comprising.” Ans. 10. However, the claim term “comprising” is later limited by the term “only.” The claims require that the carrier extend uninterruptedly “from edge to edge except for only the one or two pairs of openings.” Any additional openings are prohibited interruptions in the carrier. *See* Appeal Br. 16–17.

The second issue is that Galluch teaches “the support matrix is attached to the serving containers by hot melt glue which melts during baking or heating to automatically release the support matrix from the serving containers.” Galluch, Abstract. This is the opposite of the claim

requirement that the compartments and carriers have “an inseparably coupled interface” “during exposure to extremely high heat during baking or cooking.” Galluch teaches separation “at a temperature preferably within a range of 250° F.–275° F.” Galluch ¶ 21. This is not “extremely high heat during baking or cooking.”

The Examiner’s determination that it would be a matter of design choice for other, presumably much higher, temperatures is also not supported by the record. *See* Final Act. 12. In particular, the Examiner’s reasoning hinges on the determination that there is an established relationship between separating the compartments from the carrier on the one hand and the cooking temperature “to provide optimal baking or cooking” on the other. *Id.* Galluch does not provide any such rationale or relationship.

*Figures 5-7*

The Examiner also points to the embodiments in Galluch Figures 5–7 in rejecting the claims. Final Act. 10–11. Similar to Figure 1, these embodiments also show twelve openings, which are more than the only “one or two pairs of openings” required by the claims. As previously noted, the claims require that the carrier extend uninterruptedly “from edge to edge except for only the one or two pairs of openings.” Any additional openings are prohibited interruptions in the carrier. *See* Appeal Br. 16–17.

The Examiner also determines that perforations shown in Galluch Figures 5 and 6 and the slots in Figure 7 are not interruptions. Final Act. 10–11. This finding is erroneous. The Examiner’s reasoning is that “there is no indication anywhere in the application that perforation lines [or slots] are to be considered interruptions and since in any event the spaces between the actual perforations would appear to be uninterrupted.” *Id.* at 11. It is

unclear why the Examiner is stating that the application needs to provide a definition of every feature that is to be considered an interruption. This is well within the skill of one of the art.

### *Conclusion*

For all of the above reasons, we do not sustain the Examiner's rejection of claims 1 and 3–20 as anticipated by or obvious over Galluch.

### *III. 35 U.S.C. § 102 / 103 - Anghileri*

Anghileri suffers from many of the same issues as Galluch discussed above. For example, Anghileri shows six openings where the claims are limited to only “one or two pairs of openings.” Further, the Examiner commits reversible error in determining that in Anghileri the “tear lines 5 are not . . . interruptions,” “[n]or are the shaped holes 7.” Final Act. 12–13. These are clearly interruptions in the carrier, which are prohibited by the claims. Thus, the Examiner has not established that Anghileri anticipates claims 1 and 3–20.

Concerning the obviousness of the claims, the Examiner states: “baking apparatus of the kind disclosed in Anghileri but not having tear lines or shaped holes is conventional.” *Id.* at 13 (citing Galluch). The Examiner then determines that “it would have been obvious to construct the Anghileri apparatus without these elements as a matter of obvious choice of design or to facilitate a more economical construction (such as when separation between the compartments was not required).” *Id.* The Examiner's analysis is incomplete.

For example, the Examiner cites Galluch, which is focused on separation, as the only supporting reference for evidence to support “when separation between the compartments was not required.” *Id.* The Examiner

provides no analysis of the reason to modify Anghileri in the context of the claim limitations. Further, even as modified, Anghileri is still not limited to only “one or two pairs of openings.” Thus, the Examiner has not established that Anghileri renders obvious claims 1 and 3–20.

#### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3–20	112, ¶ 1	Written Description		1, 3–20
1, 3–20	112, ¶ 2	Definiteness		1, 3–20
1, 3–20	102(b) or 103(a)	Galluch		1, 3–20
1, 3–20	102(b) or 103(a)	Anghileri		1, 3–20
<b>Overall Outcome:</b>				1, 3–20

We also *affirm* the Examiner’s objection under 35 U.S.C. § 132(a) to new Figures 7–8 and the related amendments to the Specification.<sup>3</sup> *See* Final Act. 2–3. We *reverse* the Examiner objections under 35 U.S.C. § 132(a) to the amendments to the Figures and amendments to the Specification on all other grounds. *See id.* We also *reverse* the Examiner’s objection to the Drawings under 37 C.F.R. § 1.83(a). *See id.* at 3.

#### REVERSED

---

<sup>3</sup> Though we affirm an objection, this does not impact the status of the claims. As all of the rejections of the claims are reversed herein, the decision is deemed a reversal, as opposed to an affirmance in part.