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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/479,583	04/05/2017	Joel Dean GENAW JR.	15269-US-NP	5263
74475	7590	01/02/2020	EXAMINER	
Societe des Produits Nestlé S.A. Attn: Patent Department One Checkerboard Square St. Louis, MO 63164			HICKS, ROBERT J	
			ART UNIT	PAPER NUMBER
			3736	
			NOTIFICATION DATE	DELIVERY MODE
			01/02/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOEL DEAN GENAW JR.,
SARAH ELIZABETH SMITH-SIMPSON,
CHRISTOPHER ROBERT SMITH, SARA LYNN MOSSER, and
MATTHEW BLAKE RODGERS

Appeal 2019-003449
Application 15/479,583
Technology Center 3700

Before JENNIFER D. BAHR, MICHELLE R. OSINSKI, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–16. We have jurisdiction over this appeal under 35 U.S.C. § 6(b). We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Nestec S.A. Appeal Br. 1.

In explaining our Decision, we refer to the Specification filed April 5, 2017 (“Spec.”), the Final Office Action mailed July 3, 2018 (“Final Act.”), the Appeal Brief filed December 7, 2018 (“Appeal Br.”), the Examiner’s Answer mailed January 23, 2019 (“Ans.”), and the Reply Brief filed March 22, 2019 (“Reply Br.”).

SUMMARY OF THE INVENTION

Appellant’s claimed invention relates to a spout for use with a food package. Spec. ¶ 1. Claims 1 and 9 are independent. Claim 1, reproduced below from page 25 (Claims Appendix) of the Appeal Brief, is illustrative of the claimed subject matter:

1. A feeding spout for use with a food package, the feeding spout comprising:
 - a hollow tubular portion having a tube wall, an open end, and a closed end, the tube wall having two or more slits therethrough offset from the closed end; and
 - a collar portion integrally connected with the open end of the hollow tubular portion, the collar portion sealingly securable to the food package, wherein the slits are aligned circumferentially and offset at a distance of from about 2 mm to about 20 mm from the closed end; and
 - wherein at least a portion of the hollow tubular portion is designed for insertion into a user’s mouth, whereby food is discharged from the food package and directly into a user’s mouth through the slits.

REFERENCES

The Examiner relies on the following prior art references in rejecting the claims on appeal:

Campbell	US 2,435,033	Jan. 27, 1948
Herbst	US 8,602,236 B2	Dec. 10, 2013

REJECTION²

Claims 1–16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Herbst and Campbell.

ANALYSIS

Appellant presents arguments for patentability of claims 1–16 collectively. Appeal Br. 14–23. We select claim 1 as representative and treat claims 2–16 as standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Herbst discloses a feeding spout including, in relevant part, “a hollow tubular portion having a tube wall, a closed end [Fig. 2b], and two or more slits [162] through the tube wall offset from the closed end [Fig. 3], whereby food is discharged from the food package and directly into a user’s mouth through the slits.” Final Act. 5 (citing Herbst, Fig. 3, 3:48–51, 3:58–63). The Examiner finds that “Herbst does not expressly disclose that at least a portion of the hollow tubular portion is designed for insertion into a user’s mouth.” *Id.* at 7. However, the Examiner finds that “Campbell – a spout for transferring liquids – discloses the device [Campbell, 10 or 50] can be inserted in the user’s mouth for the liquids to directly transfer to a person’s mouth.” *Id.* (citing Campbell, Figs. 3, 11). The Examiner determines:

One of ordinary skill would be able to modify the spout in Herbst to be dimensioned for insertion into a person’s mouth for consumption, before the effective filing date of the claimed invention, having predictable and obvious results, in order to

² Rejections of claims 1–16 under 35 U.S.C. §§ 112(a) and 112(b) were withdrawn by the Examiner. Ans. 3; *see also* Final Act. 3–4.

drink from the container in a sanitary way [Campbell, Col. 1 Lines 13–19], and since the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Id. at 7–8 (citing MPEP § 2144.04(IV)).

Appellant argues that Herbst does not disclose several features:

(1) a package in which a flowable product may be contained and that contains a feeding spout for discharging food/flowable product from a package directly into a user’s mouth; (2) said feeding spout comprising a hollow tubular portion, at least a portion of which is designed for insertion into a user’s mouth; and (3) the flowable product is discharged from the main package and directly into a user’s mouth through the slits.

Appeal Br. 17–18; *see also id.* at 20 (asserting that “the structure of Herbst is not ‘designed for insertion into a user’s mouth’ as claimed”). We are not persuaded by Appellant’s argument because, as discussed above, the Examiner does not rely on Herbst for teaching that the hollow tubular portion is designed for insertion into a user’s mouth. *See* Final Act. 7. Rather, the Examiner relies on Campbell as providing evidence that feeding spouts designed to be inserted in a user’s mouth were known in the art at the time of the invention, and concludes that, based on the teachings of Campbell, it would have been obvious to modify Herbst to include this feature. *See id.* at 7–8. Thus, Appellant’s arguments against Herbst individually are unpersuasive of error because the rejection is based on the combined teachings of Herbst and Campbell. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking

references individually where, as here, the rejections are based on combinations of references.”).

Appellant argues that “the novelty liquor bottle of Herbst is completely unrelated to the problem solved by the presently claimed spout (i.e., discharging food/flowable product directly into a specific portion of a user’s mouth).” Appeal Br. 18. To the extent Appellant argues that Herbst is non-analogous art, such an argument is unpersuasive. The established precedent of our reviewing court sets up a two-fold test for determining whether art is analogous: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (quoting *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)). Here, the Examiner takes the position that Herbst is from the same field of endeavor as Appellant’s disclosure. *See* Ans. 5 (explaining that “Herbst and Campbell, as well as the appellant’s invention, are all from the art of containers with removable closures performing as spouts”). Appellant does not contest the Examiner’s position and, instead, argues only the second part of the two-fold test. Consequently, Appellant does not identify error in the Examiner’s determination that Herbst is analogous art.

Appellant argues that “a person having ordinary skill in the art would not find any motivation or reasonable expectation of success in modifying the novelty-shaped liquor bottle with [the] hollow removable closure of Herbst to arrive at a feeding spout for direct insertion into the mouth of a user.” Appeal Br. 18. Appellant asserts that the “rejection contains a lack of

reasoning for discharging liquid in the manner suggested by the Examiner – nothing in Herbst discloses or suggests discharging liquid directly into a user’s mouth.” *Id.* at 19. According to Appellant, “[g]iven the size and shape of the structure taught by Herbst, as well as the clear choking hazard posed by the stoppers utilized therewith, . . . the required motivation and/or reasonable expectation of success clearly cannot be found in the combination of Herbst and Campbell.” *Id.* at 20. We are not persuaded by these arguments.

To the extent Appellant appears to insist on an explicit teaching, suggestion, or motivation in the prior art to establish obviousness, such an argument has been foreclosed by the Supreme Court. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415, 419 (2007) (stating that a rigid insistence on teaching, suggestion, or motivation is incompatible with its precedent concerning obviousness). The Court noted that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for [an examiner] can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. Instead, the relevant inquiry is whether the Examiner has set forth “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*, 550 U.S. at 418.

Here, as discussed above, the Examiner articulates adequate reasoning based on rational underpinnings as to why it would have been obvious to modify Herbst’s spout to be designed for insertion into a person’s mouth.³

³ The Examiner appears to interpret “designed for insertion,” as recited in claim 1, as requiring that the hollow tubular portion is *dimensioned* such that

See Final Act. 7 (explaining that such a modification would yield predictable results and allow a user to drink from the container in a sanitary manner); *id.* at 7–8 (explaining that Herbst and the claimed spout merely differ in relative dimensions and do not perform differently (citing MPEP § 2144.04 (IV))). In this regard, Appellant does not specifically address the Examiner’s articulated reasoning or explain why the reasoning is in error. Moreover, even if Herbst’s secondary stoppers 164 are small enough such that they could be a choking hazard (*see* Appeal Br. 20), claim 1 does not recite any limitations that preclude the use of small parts. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“Many of appellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”).

Appellant argues that the Examiner’s rejection is based on impermissible hindsight reconstruction. *See* Appeal Br. 22–23. However, Appellant does not identify, nor do we discern, any knowledge relied upon by the Examiner that was gleaned only from Appellant’s disclosure and that was not otherwise within the level of ordinary skill at the time of the invention. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971) (“Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from [Appellant’s] disclosure, such a reconstruction is proper.”). As such,

it can be inserted into a person’s mouth. *See* Final Act. 7; Ans. 5. Appellant does not point to, nor do we find, any disclosure in the Specification that would necessitate a narrower interpretation of this claim language.

we disagree with Appellant's contention that the Examiner relied on impermissible hindsight in reaching the determination of obviousness of the claimed subject matter.

In the Reply Brief, Appellant presents a new argument that was not raised in the Appeal Brief. *See* Reply Br. 6–7. Appellant argues that Herbst does not disclose “slits” as claimed. *Id.* at 6. Appellant asserts that “[t]he term ‘slit’ is well known in the art to refer to ‘a long narrow cut or opening’ (see, for example, Merriam Webster Dictionary). As can be clearly seen, Herbst teaches that the secondary openings 162 formed therein are round.” *Id.* at 6. This argument is not responsive to an argument raised in the Answer, and Appellant has not shown good cause why this argument could not have been raised earlier and should be considered now.⁴ Accordingly, this argument is not timely, and we do not consider it. *See* 37 C.F.R. § 41.41(b)(2); *see also Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (designated informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.”).

Accordingly, for the foregoing reasons, we sustain the rejection of claim 1, and of claims 2–16 falling therewith, as being unpatentable over Herbst and Campbell.

⁴ The Examiner’s interpretation that Herbst’s secondary openings 162 read on the claimed “slits” was presented in the Final Action. *See* Final Act. 5 (finding that Herbst teaches “two or more slits [162] through the tube wall offset from the closed end [Fig. 3]”).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed
1-16	103	Herbst, Campbell	1-16	

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).

AFFIRMED