

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL BELOKIN, MARTIN P. BELOKIN and NORMAN P. BELOKIN

Appeal No. 2001-0533
Application No. 09/322,043

HEARD: JUNE 12, 2001

Before ABRAMS, FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 4-9. The examiner has withdrawn the rejections of claims 2 and 10, indicating claim 10 to be allowable and objecting to claim 2 as being dependent upon a rejected base claim (answer, p. 4). The examiner and

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appellants disagree as to whether claim 3 has been canceled or is still pending.¹ No other claim remains in the application.

¹ The instruction to "[a]dd the following Claim [new claim 10] (replacing original claim 3)" on page 2 of the amendment filed March 24, 2000 (Paper No. 3) appears to us to be an instruction to add a new claim 10 and to cancel claim 3. Moreover, it is apparent from the examiner's comments on page 2 of the answer that the examiner has so treated that instruction. In any event, in that the examiner has not rejected claim 3, we leave its status to be addressed by the primary examiner.

BACKGROUND

The appellants' invention relates to a combination comprising first and second containers and a coupling. An understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows.

1. A combination comprising:

(a) first and second containers, each having a body, an externally threaded neck which defines an open mouth, and a collar extending radially from said neck intermediate the threaded portion of the neck and the body of said container which defines a diameter greater than the diameter of the neck portions adjacent thereto; and

(b) a coupling comprising an axially elongated body with a central divider forming diametrically opposed cavities in the ends thereof, each cavity supporting internal threads mating with the externally threaded neck on one of said first and second containers and an end face which abuts the radially extending collar.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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| Taylor 1940 | 2,196,345 | Apr. 9, |
| Leopold Jr. et al. (Leopold) 12, 1966 | 3,245,701 | Apr. |
| Conti 1982 | 4,322,012 | Mar. 30, |
| Smith 1982 | 4,336,891 | Jun. 29, |

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| Matsubara 7, 1990 | 4,946,034 | Aug. |
| Roark 1995 | 5,379,909 | Jan. 10, |

The following rejections stand before us for review.²

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Smith.

Claims 1, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roark in view of Smith.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Conti.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Roark in view of Smith and Taylor.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Matsubara.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Leopold.

Reference is made to the brief and reply brief (Paper Nos. 11 and 13) and the answer (Paper No. 12) for the

² All other rejections set forth in the final rejection have been withdrawn (answer, p. 4).

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respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

Smith discloses an adapter closure for use with a pair of containers for pouring contents of one of the containers into the other container. As shown in Figures 1 and 2, the adapter closure 11 is used with two bottles 12, 13 and includes a body portion 15 with an axial passage 16 extending therethrough, first and second threaded sections 19, 20 and a shoulder portion 17 extending inwardly from the body portion 15, preferably at substantially the midpoint thereof. The threaded portions 19, 20 terminate closely adjacent the shoulder portion 17. The shoulder portion extends radially inward from the body portion only part of the way toward the

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central longitudinal axis thereof, leaving an opening for passage of contents from one bottle to the other. According to the examiner, the shoulder portion 17 responds structurally to the "central divider" recited in claim 1.

Appellants argue that the shoulder portion 17, by virtue of its central opening therein, is not a "divider forming diametrically opposed cavities in the ends thereof" (brief, pp. 8-9). For the reasons set forth below, we agree with appellants.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

As explained on page 4 of appellants' specification, appellants' invention comprises a connector 10 having "a solid rigid substantially cylindrical body with diametrically opposed open cavities 30 in the ends thereof." When viewed in light of this disclosure on page 4 of the specification, it is

apparent that the central body structure shown traversing the diameter of the connector 10 in Figure 2 is a solid wall structure across the entire cross-section of the connector which separates the opposed cavities 30. Further, in discussing the "central divider" limitation in claim 1, appellants urge that "[i]t is therefore essential to the invention that the coupler connects the necks of the containers but isolates the interiors of the containers from each other" (Paper No. 8, p. 3).

In light of the above, we interpret the phrase "divider forming diametrically opposed cavities" as a thing that divides, in the sense of separating or disuniting, the cavities such that they are not joined to one another.³ Clearly, Smith does not provide any such structure and, indeed, requires connection or communication between the two threaded cavities for passage of contents through the adapter closure from one bottle to the other.

³ Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988) defines the verb "divide" as "to separate into parts; split; sever," the verb "separate" as "to keep apart by being between; divide; disunite" and the adjective "separate" as "set apart or divided from the rest or others; not joined, united or connected; severed."

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Accordingly, in that Smith does not disclose each and every element recited in claim 1, we conclude that the subject matter of claim 1 is not anticipated⁴ by Smith. Thus, we shall not sustain the examiner's rejection of claim 1 as being anticipated by Smith.

The obviousness rejections

Having reviewed the additional teachings of Conti, Matsubara and Leopold, we find nothing therein which cures the above-noted deficiency of Smith with regard to the limitations of claim 1. Therefore, we shall also not sustain the examiner's rejections of claims 4, 8 and 9, which depend from claim 1, as being unpatentable over Smith in view of Conti, Smith in view of Matsubara and Smith in view of Leopold, respectively.

⁴ Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

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For the reasons which follow, we shall also not sustain the examiner's rejections of claims 1, 5 and 6 as unpatentable over Roark in view of Smith and claim 7 as unpatentable over Roark in view of Smith and Taylor.

Roark discloses an exercise device comprising a closure including a cylindrical connector sleeve having a divider wall 14 separating the interior of the sleeve into two threaded substantially identical bore portions 10, 12, the sleeve being threadedly attached to two containers 40, 42. The specially adapted containers comprise substantially cylindrical first neck portions 28, 30 having substantially uniform lengths and outer surfaces and second neck portions 24, 26 extending from the first neck portions 28, 30 and further comprising externally threaded annular sleeves. The first neck portions have diameters which are substantially identical to that of the external surface 16, 18 of the closure. When fully assembled, the containers and closure form a dumbbell. Roark teaches that the characteristic of the substantially equal diameters of the closure and container first neck portions is important because it "assures that the dual-sided closure and container neck, that are intended to comprise the grip area of

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the fillable dumbbell when fully assembled, are of substantially equal outer surface diameter, similar again to a standard dumbbell, in order to be gripped comfortably in ones [sic, one's] hand" (col. 2, lines 9-14).

The examiner recognizes that the Roark containers lack "a collar extending radially from said neck intermediate the threaded portion of the neck and the body of said container which defines a diameter greater than the diameter of the neck portions adjacent thereto" as recited in claim 1. The examiner's position, as we understand it, is that it would have been obvious to use the containers of Smith with the closure of Roark to provide a stop for the closure or, in the alternative, that it would have been obvious to use the closure of Roark with the containers of Smith. It is our opinion that neither of these positions is well taken.

To use containers of the type taught by Smith having a "collar extending radially from said neck intermediate the threaded portion of the neck and the body of said container which defines a diameter greater than the diameter of the neck portions adjacent thereto" as recited in claim 1 in combination with the Roark closure to form a dumbbell would be

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contrary to the teachings of Roark, in that this would not result in the smooth, continuous cylindrical gripping surface achieved by the specially adapted containers of Roark. The use of a bottle having a collar extending radially from the neck and being of a diameter greater than the neck portions adjacent thereto would inherently result in a step-down from the greater diameter to the smaller neck diameter over the gripping portion of the dumbbell and, thus, would not have been obvious to one having skill in the art.

As for the examiner's alternative position, the Smith assembly requires a passage through the adapter closure to permit passage of contents therethrough from one container to the other. In that the closure of Roark comprises a divider wall 14 which blocks communication between the bore portions 10, 12 of the closure, the teachings of Smith and Roark provide no suggestion to use the closure of Roark with the containers of Smith in the assembly of Smith.

In light of the above, we conclude that the teachings of Roark and Smith are insufficient to establish a prima facie case of obviousness of the subject matter of claim 1 or of claims 5 and 6 which depend therefrom. Having reviewed the

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additional teachings of Taylor, we find nothing therein which overcomes the above-noted deficiencies of the combination of Roark and Smith so as to establish a prima facie case of obviousness of the subject matter of claim 7.

CONCLUSION

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To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102 and claims 1 and 4-9 under 35 U.S.C. § 103 is reversed.

REVERSED

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| NEAL E. ABRAMS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS |
| Administrative Patent Judge |) | AND |
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| JENNIFER D. BAHR |) | |
| Administrative Patent Judge |) | |

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JACK A. KANZ
502 SO COTTONWOOD DRIVE
RICHARDSON, TX 75080