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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KURT KOPTIS

Appeal No. 95-5130
Application 08/022,077¹

ON BRIEF

MAILED

MAR 18 1995

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before LYDDANE, McQUADE, Administrative Patent Judges and
CRAWFORD, Acting Administrative Patent Judge.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 and 3 through 8, which are all of the claims pending in the application.

The subject matter on appeal is directed to a tube dispenser, sponge applicator and cover assembly. Claim 1 is exemplary of the invention and a copy thereof, as it appears in the appendix to the appellant's brief, has been appended to this decision.

¹ Application for patent filed February 24, 1993.

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The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103 are:

Sharpe	3,214,780	Nov. 2, 1965
Christine et al. (Christine)	3,922,099	Nov. 25, 1975
Niksich et al. (Niksich)	4,271,982	June 9, 1981
Goncalves	4,848,946	July 18, 1989
Hulsh ² (German OLS Patent Application)	1,411,630	Apr. 3, 1969

The following reference, which is of record, has been relied upon in a new rejection under 35 U.S.C. § 103 pursuant to the provisions of 37 CFR 1.196(b):

Ruch	1,007,492	Oct.31, 1911
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Claims 1, 3, 5 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sharpe.

Claims 1, 3 and 5 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goncalves in view of Hulsh. The examiner takes the position that it would have been obvious for one having ordinary skill in the art to modify the tube dispenser, brush applicator and cover structure of Goncalves by replacing the brush applicator thereof with a sponge type applicator as taught by Hulsh.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Goncalves in view of Hulsh and either Niksich

² A copy of the translation is attached to this decision.

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or Christine. The examiner is of the view that it would have been obvious to further modify the assembly of Goncalves to include a breakable seal for the container in view of the teachings of either Niksich or Christine.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 3 through 6 of the examiner's answer, to pages 3 through 6 of the appellant's brief and to the appellant's reply brief for the full exposition thereof.

OPINION

Our evaluation of the patentability issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art, and the respective positions advanced by the appellant and the examiner. With respect to the applied references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Additionally, we have taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968). On the basis of the knowledge and level of skill in the art at the time of appellant's invention, as reflected by the applied references, it

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is our conclusion that the examiner's rejections of claims 1 and 3 through 7 under 35 U.S.C. § 103 are well founded but that the rejections of claims 1, 3, 5 and 8 under 35 U.S.C. § 102(b) and of claim 8 under 35 U.S.C. § 103 are not. Our reasoning for this determination follows.

With respect to the rejection of claims 1, 3, 5 and 8 under 35 U.S.C. § 102(b), we initially observe that an anticipation under § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984), cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp., 468 U.S. 1228 (1984). Additionally, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983) cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985).

On this basis, we have carefully considered the disclosure of the dispenser assembly of the patent to Sharpe. It is apparent that Sharpe does disclose a squeezable dispensing container 2, a sponge applicator 16 and a cover member 3, and it is thus

reasonable to conclude that the dispensing container is "formed of a relatively pliable material." However, we find nothing in the disclosure of Sharpe to indicate that the cover member is "formed of a relatively stiff material" as required by appealed claim 1. Sharpe states in column 1, lines 41 through 43, that his invention includes "a hollow flexible container 2 with an elongated cover 3 detachably mounted in a force-fit arrangement," and in column 2, lines 56 through 64, that

[t]he container will preferably be made as a unitary molded assembly of sufficient flexibility to allow squeezing action to discharge the cleaning fluid...A single material can be used for the entire assembly with the exception of the swab. A durable plastic or the like would be preferred.

We appreciate the examiner's position that the cover 3 must be sufficiently stiff to "protect the applicator and withstand the forces applied when closing the container," (answer, page 3). However, it is our view that the recitation in claim 1 that the

cover member is formed of a relatively stiff material and the tube dispenser is formed of a relatively pliable material

connotes that the cover member and tube dispenser be formed from two materials, each having the different respective property described in the claim, i.e., one "relatively stiff" and the other "relatively pliable." The only teaching in Sharpe regarding the material from which the cover and container can be formed is that of a "single material" as noted above. At best, the disclosure

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of the material for the cover and the container of Sharpe would be regarded as ambiguous, and an anticipation rejection cannot be predicated on an ambiguous reference. See In re Turlay, 304 F.2d 893, 134 USPQ 355 (CCPA 1962). Since the patent to Sharpe does not disclose every element of the claimed invention recited in appealed claim 1, it cannot anticipate claim 1, nor claims 3, 5 and 8 dependent thereon. Thus, we cannot sustain the examiner's rejection of these claims under 35 U.S.C.

§ 102(b).

Turning to the rejection of claims 1, 3 and 5 through 8 under 35 U.S.C. § 103 based on the combined teachings of Goncalves and Hulsh, we agree with the examiner's position that the dispenser assembly depicted in Figure 5 of Goncalves provides structure as claimed except for the applicator thereof being a brush 121 having bristles 123 rather than a sponge applicator as claimed. We also agree that the Hulsh reference discloses a similar squeezable tube type dispenser utilizing a sponge applicator for the material to be dispensed (Figures 2 and 4). Moreover, Hulsh discloses that the sponge applicator of his invention is an improvement over brush-type applicators that tend to cause intense soiling when used (note page 2 of the translation).

Applying the test for obviousness set forth in In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), which is what the com-

bined teachings of the references would have suggested to those of ordinary skill in the art, it is our conclusion that one having ordinary skill in the art would have found it obvious to replace the brush type applicator of the dispenser of Goncalves with a sponge type applicator as taught by Hulsh in order to reduce soiling caused by the use of a brush type applicator. The dispensing assembly resulting from these combined teachings would have rendered obvious the dispensing assembly recited in appealed claims 1, 3 and 5 through 7, but not that recited in appealed claim 8.

Appellant has not disputed the propriety of combining the teachings of Goncalves and Hulsh as set forth above, but urges on page 5 of the brief that "Goncalves does not have a cover which meets with and seals to a relatively pliable upper circumferential portion of the tube dispenser," that the cover member of Goncalves "is shown to be cross hatched as a metallic material and therefore could not be the plastic material specified in claim 3" and that the

attachment of the sponge applicator around the neck portion is clearly not the same in Goncalves and the Examiner is attempting to use the Hulsh patent to rectify this deficiency.

In our view, the shouldered portion 127 of the flexible dispensing tube 101 that is engaged by the lower end of the cover 126 as depicted in Figure 5 of Goncalves corresponds to the

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"upper circumferential portion of the main body of the tube dispenser" as recited in appealed claim 1. It is also apparent that the lower end of the cover has a friction fit, to at least some degree, in order to maintain the cover in its intended covering position. We note that the law presumes skill on the part of the artisan rather than the converse. See In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Thus, contrary to appellant's argument, the patent to Hulsh has not been, and need not be, relied upon to suggest the interengagement of the cover member with the tube dispenser.

With respect to claim 3, we recognize that the patent to Goncalves does not specifically disclose the cover 126 as being formed of a plastic material. However, the question of obviousness cannot be approached on the basis that an artisan having ordinary skill would have known only what was read in the references, because such artisan must be presumed to know something about the art apart from what the references disclose. See In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). Further, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Moreover, where, as here, a change solves no stated problem, we consider it

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to be a mere matter of choice and therefore obvious. See In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Appellant has also argued that claims 6 and 7 "relate to the particular type of material used in the tube" (brief, page 6) which is not taught by either Goncalves or Hulsh. However, the patentability of the dispenser assembly is not predicated on the particular material dispensed thereby. Whether the dispenser is actually used in such a manner is dependent upon the performance or nonperformance of a future act of use and not upon a particular structural relationship set forth in the claims. Note In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Yanush, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); and In re Casey, 405 F.2d 567, 160 USPQ 189 (CCPA 1969).

Appellant does argue on page 6 of the brief that appealed claim 8 "relates to the specific step configuration" of the cover member which is not taught by either Goncalves or Hulsh. We agree. Thus, we cannot sustain the examiner's rejection of claim 8 under 35 U.S.C. § 103 based on the combined teachings of Goncalves and Hulsh.

With respect to the rejection of claim 4 under 35 U.S.C. § 103 based on the combined teachings of Goncalves, Hulsh, Niksich and Christine, appellant merely argues that the "patents to Niksich and Christine do not supply any additional features other than as suggested by the Examiner" (brief, page 6). Since

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we agree that Niksich and Christine are suggestive of modifying the dispenser tube of Goncalves to include a closed end that must be cut off or punctured to release the substance in the tube to be dispensed, we shall also sustain the examiner's rejection of claim 4 on this ground.

We make the following new rejection pursuant to the provisions of 37 CFR 1.196(b).

Claim 8 is rejected under 35 U.S.C. § 103 as being unpatentable over Goncalves in view of Hulsh and either Sharpe or Ruch. Sharpe (Figure 1) and Ruch (Figure 2) both teach cover members for a dispenser assembly, the cover members having an inner step to engage a circumferential portion of the dispenser container to provide a stop to limit insertion of the cover member on the dispenser. We conclude that one having ordinary skill in the art would have found it obvious to have further modified the dispenser assembly of Goncalves to provide the cover member thereof with an inner step for the self evident purpose of providing a stop to limit insertion of the cover.

Accordingly, the decision of the examiner rejecting claims 1, 3, 5 and 8 under 35 U.S.C. § 102(b) and rejecting claim 8 under 35 U.S.C. § 103 is reversed, the decision rejecting claims 1 and 3 through 7 under 35 U.S.C. § 103 is affirmed, and a new rejection of claim 8 under 35 U.S.C. § 103 has been made pursuant to the provisions of 37 CFR 1.196(b).

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Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR § 1.197.

With respect to the new rejection under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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APPENDIX

1. A tube dispenser, sponge applicator and cover assembly wherein the tube dispenser is designed to contain a substance for application to an exterior surface including,

a tube dispenser having a main body portion, an upper neck portion extending from the main body at an upper end for dispensing any substance within the main body portion and a non-threaded upper circumferential portion at the upper end of the main body portion and adjacent to the neck portion,

a sponge applicator for attachment around the neck portion of the tube dispenser for applying to the exterior surface the substance contained in the tube dispenser which has been dispensed through the upper neck portion and through the sponge applicator,

a cover member having an upper portion for covering the sponge applicator and the neck portion of the tube dispenser and a non-threaded lower circumferential portion to provide a friction fit to mate with and seal to the upper circumferential portion of the main body of the tube dispenser, and

wherein the cover member is formed of a relatively stiff material and the tube dispenser is formed of a relatively pliable material so that the lower circumferential portion of the cover member forms a substantially rigid ring to provide the friction fit to mate with and seal to the relatively pliable upper circumferential portion of the tube dispenser.