

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

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. KESSLER

Appeal No. 1998-2418
Application No. 08/686,883

HEARD: September 12, 2000

Before ABRAMS, McQUADE, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11 and 21 through 38, which are all of the claims pending in this application.

We affirm-in-part and reverse-in-part.

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BACKGROUND

The appellant's invention relates to label roll packages and ink roller packages (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Burtis	1,214,750	Feb. 6, 1917
Jones	3,770,118	Nov. 6, 1973
Lane	4,875,620	Oct. 24, 1989

Prior Art as described by appellant on pages 1 and 2 of the specification and in figures 8 and 9 of the drawing.

Claims 21 through 26 and 36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and for failing to particularly point out and distinctly claim the invention.¹

Claims 11, 21 through 30, 37 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellant's disclosed prior art in view of Jones.

¹ Rejection of claim 25 under 35 U.S.C. § 112, second paragraph, as being indefinite in that there is no antecedent basis for "the tubular openings" was overcome by an amendment after final rejection (see Papers No. 7 and 8).

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Claims 31 through 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellant's disclosed prior art in view of Jones and further in view of Lane and Burtis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed February 28, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 10, filed January 12, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection of claims 21 through 26 and 36 under 35 U.S.C. § 112 should not be sustained and the examiner's rejection of claims 11 and 21 through 38 under 35 U.S.C. § 103 should be affirmed-in-

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part and reversed-in-part. Our reasons for this determination follow.

The 35 U.S.C. § 112, second paragraph, rejection of claims 21 through 26 and 36 as indefinite.

Claims 21 through 26 and 36 stand rejected under 35 U.S.C. ' 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. The examiner rejects claims 21 and 24 through 26 for the reason that "[t]he phrase 'the other end being free of any handle' is indefinite because such a negative limitation would appear to have no clear meaning when used with open language such as 'comprising'" (answer, pages 4 and 5). Regarding claim 36, the examiner states "the phrase 'the tubular portion being frictionally releasably held in the central opening' is inaccurate and indefinite" *id.*

Claims are considered to satisfy the requirements in the

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second paragraph of ' 112 if they define the metes and bounds of the claimed subject matter with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) and In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In the present case, the metes and bounds of claims 21 through 26 and 36 are sufficiently clear to enable one to evaluate the possibility of infringement and dominance as set forth in In re Hammack, *supra*. We conclude that the scope of claims 21 through 26 and 36 is clear, the limitation that one end is free of any handle does not conflict with the term "comprising" because it is permissible to describe at least some element(s) in terms of what it is not. The recitation that the tubular portion is frictionally releasably held is consistent with appellant's clear description of this feature in the specification at page 5, lines 16-20.

Accordingly, the decision of the examiner to reject claims 21 through 26 and 36 under 35 U.S.C. ' 112, second paragraph, is reversed.

The 35 U.S.C. § 103 rejection of claims 11, 21 through

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30, 37 and 38 as being unpatentable over appellant's disclosed prior art in view of Jones.

An understanding of the invention can be derived from a reading of exemplary claim 11 which appears in the appendix to the appellant's brief.

Appellant's disclosure of the prior art (at pages 1 and 2 of the specification) provides, in effect, that side by side label rolls may be shrink wrapped with an ink roller in a package disposed in the central tubular opening of the rolls.

A prior art ink roller with one type of prior art package is shown in appellant's figures 8 and 9.

Directing our attention to claim 11, appellant stresses the shrink wrap has a "dual function of holding the rolls 11 and the ink roller container in tact . . . and of closing or sealing off the container 19 and the roller which it houses" (brief, page 11). The examiner counters that "[i]t would have been obvious to one having ordinary skill in the art to eliminate the removable cover from the ink roller container" (answer, page 7). The examiner is suggesting that cover 32 in Jones may be eliminated. However, even assuming that the examiner is correct, this would not have provided the dual

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function of the shrink wrap, that the shrink wrap both envelopes the rolls and is "sealed to the flange" as recited in claim 11. Appellant discloses "[t]he shrink wrap 14 is adhesively adhered or heat sealed directly to the flange 24 of the container 19" (specification, page 7). Omission of the cover 32 of Jones would provide the shrink wrap in contact with the flange but would not provide the claimed type of seal between the shrink wrap and the flange. Accordingly, we will not sustain the examiner's rejection of claim 11.

The examiner further states that "[a]s to claims 21-26, it would have been obvious to one having ordinary skill in the art to assemble the ink roller with the handle oriented at the open end of the ink roller container of the Related Prior Art as modified to facilitate grasping" (answer, page 7). Appellant urges "[w]ith the claimed package, the handle is always accessible when the cover is removed, thereby avoiding the problem of the user getting ink on his/her hands" (brief, page 11). We find that claims 21 through 26 require "a handle at one end of the ink roller and the other end being free of any handle" which is not disclosed by either appellant's disclosed prior art or Jones. The disclosed prior art ink

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rollers do not have a handle, or, if the axel and/or flange is considered as a handle, both ends have a handle. Accordingly, we will not sustain the examiner's rejection of claims 21-26.

Regarding claims 27 through 30, 37 and 38 it is the examiner's position that, "[i]t would have been obvious to one having ordinary skill in the art in view of Jones to modify the package of the Related Prior Art so the ink roller container comprises an elongated portion with a closed first end and an open second end, a flange and a removable cover for closing off the open end wherein (*sic*) the elongated portion of the container extending in the axial direction in the tubular opening of at least one label roll to prevent the whole container from slipping into the central opening and also to facilitate removing container (*sic*)" (answer, page 6).

Appellant's argument repeats the claimed elements, including the "removable" (claims 27 and 28) or "peelable" cover (claims 29, 30, 37 and 38) for closing off the end of the container, and urges "[n]o such combination is taught in the references" (brief pages 15 and 16). We agree.

Although the examiner urges "[i]t would have been obvious to . . . modify the package of the Related Prior Art so the

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ink roller container comprises . . . a removable cover for closing off the open end" (answer, page 6) and that "Jones teaches the removable cover (32) adhered to the flange (24) of the container (10) by heat seals (38) or other sealing means . . ." (answer, page 7), we note the cover 32 provided for the container 10 in Jones is stated to be "secured by any suitable means" (col. 4, line 12) which, in the preferred embodiment is adhered "by spaced heat seals 38, although other sealing means such as glue, adhesive and the like can be utilized" (col. 4, lines 26-27). Providing a removable cover is not disclosed by Jones or appellant's disclosed prior art. The item may subsequently removed from Jones' package by slitting the cover or package, but without removal of the cover. Accordingly, in our view the removable cover in combination with the other features of appellant's claims 27 through 30, 37 and 38, is not taught by, or obvious from, the applied prior art and we will not sustain the examiner's rejection of claims 27 through 30, 37 and 38.

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The 35 U.S.C. § 103 rejection of claims 31 through 36 as being unpatentable over appellant's disclosed prior art in view of Jones and further in view of Lane and Burtis.

Directing our attention to claims 31, 32 and 34, we note the examiner's rejection relies on appellant's disclosed prior art in view of Jones, Lane and Burtis. Appellant's disclosed prior art and Jones are applied by the examiner as in the above discussed rejection of claims 11, 21 through 30, 37 and 38. Burtis is relied on for teaching "a container (1,2) having at least one enlarged portion frictionally releasably held in the central opening (12) of the roll (9)" (answer, page 8).

We shall sustain this rejection.

Appellant's disclosed prior art as shown by the blister package in figures 8 and 9 is described as "[t]he blister package can be sized to be inserted into and frictionally held inside the tubular opening" (specification, page 1). As shown in appellant's figures 8 and 9 the blister package is tubular and has an enlarged portion (spanned by label 35) which at its extremities has ridge portions which frictionally contact the interior of the tubular opening of the label roll(s). With

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regard to claim 34 the additional ink roller features are clearly shown in figures 8 and 9. Accordingly, we find appellant's disclosed prior art describes the claimed features and we will sustain the examiner's rejection of claims 31 and 32 even though reliance on Jones and Burtis (and Lane) is not necessary. See In re Kronig 539 F.2d 1300, 1303, 190 USPQ 425, 427 (CCPA 1976).

Turning now to claim 33, appellant argues "it defines that the enlarged portion is substantially less than the elongate portion. Again, there is no teaching of such a combination of structure" (brief, page 19). We do not find this feature to be described in appellant's disclosed prior art nor do we find a suggestion of this modification in Lane or Burtis. While both Lane and Burtis disclose enlarged container portions, in our view the combination of this feature with appellant's disclosed prior art would appear to be improper hindsight. Accordingly, we will not sustain the examiner's rejection of claims 33.

Appellant's claim 35 includes, inter-alia, "an ink roller container . . . having an enlarged portion frictionally releasably held in the central opening, the container having

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an open end at the enlarged portion, a peelable cover closing off the open end" Although Jones discusses frictional engagement with respect to the disadvantageous prior art packages, the article containing package 10 of Jones' preferred embodiment is not disclosed as being in frictional engagement with the central opening, rather "the article containing chamber 20 has a maximum transverse dimension which is slightly less than the transverse dimension of the opening 14" (col.3, lines 38-41), i.e. it is not in frictional engagement. Lane and Burtis are applied by the examiner for an enlarged container portion and an enlargement on the container for frictional engagement, respectively, the suggestion being that such modification is obvious as stated in the answer at page 8. However, no acceptable reasoning for combining this feature with appellant's disclosed prior art is given by the examiner. Accordingly, we will not sustain the examiner's rejection of claim 35 on this ground.

Appellant's arguments with regard to claim 36 assert "the ink roller contacts the closed end and the other end of the ink roller contacts the cover. This results in the ink roller being held captive in the ink roller container . . . {n]one of

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the assembled references teaches the claimed combination"
(brief, pages 21 and 22). In response, the examiner notes
"Jones clearly

teaches the article (36) contacts the top and bottom of the
container (Figure 4)" (answer, page 12).

In our view the examiner has not taken into account that
the claim recites a specific article, an ink roller with
flanges and a porous sleeve, which when combined with the
other claimed features provides the ink roller oriented with
respect to the remaining elements. As urged by appellant
"[a]ccording to the invention the claimed combination in
certain claims relates to an oriented ink roller. No
reference teaches this feature The point is that in
the prior art there was no teaching of orienting anything . .
. The orienting of the ink roller is not only for the purpose
of making the ink roller easy to remove, but moreover for
making the ink roller easy to remove without getting ink on
the user's hands" (brief, page 24). We agree.

In our view the proposed modification of the disclosed
prior art does not provide appellant's oriented ink roller in

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combination with the other features as recited in claim 36. Accordingly, we will not sustain the examiner's rejection of claims 36.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21 through 26 and 36 under 35 U.S.C. § 112, second paragraph, is reversed. The decision of the examiner to reject claims 11 and 21 through 38 under 35 U.S.C. § 103 is reversed with respect to claims 11, 21-30, 33 and 35-38. The decision of the examiner to reject claims 31, 32 and 35 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART and REVERSED-IN-PART

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Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
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