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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT G. ZURCHER

Appeal 2009-010195
Application 10/337,092
Technology Center 1700

Before CATHERINE Q. TIMM, MARK NAGUMO, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing under 37 C.F.R. § 41.52 of the Decision on Appeal mailed January 25, 2011. In that Decision, the panel affirmed the Examiner's decision to reject claims 1, 2, 4, 6-8, 10, 11, 13, and 15-17 as anticipated under 35 U.S.C. §102(b) by Niermann; claims 19, 21, 23-25, and 27 as unpatentable under 35 U.S.C § 103(a) over Niermann; and claims 3, 5, 9, 12, 14, 18, 20, 22, and 26 as unpatentable under 35 U.S.C. § 103(a) over Niermann in view of one or more of Zurcher, King, and Levy.

On rehearing, Appellant contends that we failed to properly consider the language of representative claim 1, overemphasized the cited *In re Schreiber* decision, and overlooked the significance of previously presented evidence showing that the Niermann ball and socket closure does not anticipate, inherently or otherwise, the closure assembly defined in the claims (Request 2).

Representative claim 1 is directed to a closure assembly. The claim requires "a top ring assembly removably attachable to said bottom ring when said bottom ring is attached to said container."

In the Brief, Appellant focused on the "removably attached" language (Br. 5-8) and we, therefore, focused on that language when fashioning the issue to be reviewed. Appellant now contends that we ignored the language "when said bottom ring is attached to said container." (Request 2-3.) Appellant states that when the issue on appeal is properly framed by taking into account the additional "when" clause, it is evident that the rejection is unsupported "because there is insufficient evidence that the ball 20 in Niermann is removably attachable from the socket 40 when the socket 40 is attached to the container." (Request 3.)

To support the contention, Appellant argues that "[o]nce the closure is attached to the container, the engagement between the socket and the container compresses the socket, therefore rendering it less flexible than when it is not attached to the container, and preventing the ball from being removable from the socket in the same manner as it is forcibly inserted." (Request 3-4.) Appellant does not cite, and we do not find, any credible evidence supporting the assertion. Figure 5 of Niermann shows that the

socket is above the level of the container 100 (Fig. 5). It is the protrusion 47 below the socket 40 that is inserted into the container (Fig. 5; Niermann, col. 4, ll. 27-32). The socket is made of elastomeric-like material and is not constrained (Decision, FF 4-5). The evidence as a whole supports the Examiner's finding that the ball 20 would inherently be capable of being removed from the socket whether or not the protrusion 47 below the socket 40 is fitted within the container (*see* Decision, FF 1-5).

We neither improperly disregarded the "when" clause of the claim, nor does evidence indicate that the Examiner's inherency conclusion is unreasonable. As properly found by the Examiner, "[s]ince the socket is flexible enough to allow for the forceful insertion of a ball having a greater diameter than the first open end (43), then the socket (40) is inherently flexible enough to allow for removal of the ball through the same first opening." (Ans. 8.)

Appellant contends we failed to recognize distinctions between the present facts and those of *In re Schreiber*. Appellant asserts that "the conclusion of inherency set forth in *Schreiber*, as articulated by the Federal Circuit, was based on the fact that the *disclosed embodiment* of the claimed design had the same general shape, *i.e.*, structure, as the prior art." (Request 5 (emphasis added).)

Appellant has overlooked a key discussion in *Schreiber* relating to functional limitations. As pointed out in *Schreiber*, "[a] patent applicant is free to recite features of an apparatus either structurally or functionally." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). "Yet, choosing to

define an element functionally, *i.e.*, but what it does, carries with it a risk." *Id*.

> where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Id., (quoting *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971) and further citing *In re Hallman*, 655 F.2d 212, 215 (CCPA 1981); *In re Ludtke*, 441 F.2d 660, 663-64 (CCPA 1971).)

In the present case, Appellant has used functional language in an attempt to distinguish the claimed structure from the prior art structure. The Examiner has established a reason to believe that the function recited in the claim may be an inherent characteristic of the ball and socket structure of the prior art. The fact that the structure of the prior art is structurally different from the structure of the "disclosed embodiment" Appellant describes in the Specification and depicts in the Figures is of little moment. The name of the game is the claim. *In re Hiniker Co*., 150 F.3d 1362, 1369 (Fed.Cir.1998).

Appellant further would require that one of ordinary skill in the art recognize that the ball would be capable of being removed from the socket of Niermann citing to *Continental Can Co. v. Monsanto Co*., 948 F.2d 1264, 1268 (Fed. Cir. 1991) (Request 5-6). There is no such requirement. *See Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) ("*Continental Can* does not stand for the proposition that an inherent feature of a prior art reference must be perceived as such by a person of ordinary skill in the art before the critical date."); *In re Omeprazole Patent*

Litig., v. Andrx Pharms, Inc., 483 F.3d 1364, 1373 (Fed. Cir. 2007) (recognition in the prior art is not necessary when the claimed characteristic or function is inherently present in the prior art).

The subject Request has been granted to the extent that the Decision has been reconsidered, but is denied with respect to making any changes therein.

REHEARING DENIED

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