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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,388	08/06/2008	7325994	599928-015002	2326

61650 7590 12/30/2010

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EXAMINER	
KAUFMAN, JOSEPH A	
ART UNIT	**PAPER NUMBER**
3993	
MAIL DATE	**DELIVERY MODE**
12/30/2010	PAPER

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

The time period for reply, if any, is set in the attached communication.

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90/010,208	06/23/2008	7325994	LIBE 59RE	1889

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

THE J.M. SMUCKER COMPANY
Requester and Appellant

v.

Patent of MACK-RAY, INC.
Patent Owner

Appeal 2010-011463
Reexamination Control 95/000,388 and 90/010,208[1]
Patent US 7,325,994 B2[2]
Technology Center 3900

Before RICHARD M. LEBOVITZ, JEFFEY B. ROBERTSON and DANIEL S. SONG, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL[3]

---

[1] The *inter partes* reexamination requested by the Appellant and *ex parte* reexamination requested by the Patent Owner were merged by Decision, *Sua Sponte*, to Merge Reexamination Proceedings, mailed July 10, 2009.
[2] Issued February 5, 2008 to Liberatore (hereinafter '"944 patent").
[3] The one-month time period for filing a request for rehearing, as recited in 37 C.F.R. § 41.79, and the two-month time period for filing an appeal, as recited in 37 C.F.R. § 1.304 (*see* 37 C.F.R. § 1.983(b)(1)), both begin to run from the "MAIL DATE" shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The patentability of claims 1-13 of the '994 patent stands confirmed by the Examiner. The Third Party Requester (hereinafter "Appellant") appeals, under 35 U.S.C. §§ 134, 306 and 315 (2002), the Examiner's refusal to adopt a proposed rejection of claims 1-13. We have jurisdiction under 35 U.S.C. §§ 134 and 315 (2002). An oral hearing with the Appellant's representative was held before the Board of Patent Appeals and Interferences on November 2, 2010.

The '994 patent was involved in an infringement litigation between the Requester and the Patent Owner styled *MACK-RAY, INC. v. THE J.M. SMUCKER COMPANY*, E.D. Tex., May 16, 2008, No. 2:08CV00213. This litigation has been DISMISSED without prejudice. The Examiner's decision in a related merged *inter partes* and *ex parte* reexamination of Patent U.S. 7,314,328, also owned by MACK-RAY, INC., is also being appealed to the Board by the Appellant (Appeal 2010-011461; Reexamination Control 95/000,387 and 90/010,207).

THE '994 PATENT

The '994 patent describes a spreader apparatus for use with a dispenser such as a squeeze bottle for dispensing flowable material such as food items like jelly on to a food surface like bread (Abst.; col. 5, ll. 56-58; col. 6, ll. 6-8). Figure 4 of the '944 patent pertinent to the present appeal is reproduced below:

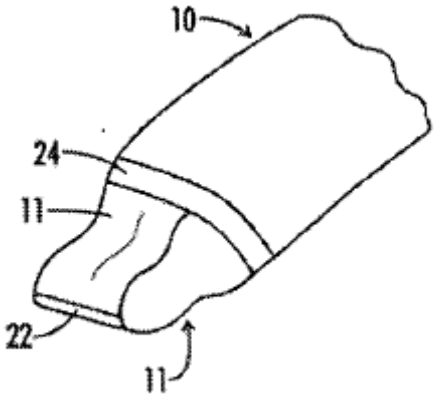

FIG. 4

Figure 4 of the '994 patent reproduced above shows a perspective top plan view of a spreader 10 with a dispensing nozzle 11 connected thereto by a fitting 24, the dispensing nozzle 11 having a nozzle outlet 22 (Fig. 4; col. 4, ll. 22-23; col. 5, l. 53 - col. 6, l. 12).

Independent claim 1, which is the only independent claim at issue, reads as follows (App. Br., Claims App'x, emphasis added):

> 1. A nozzle for attachment to a dispenser for dispensing material, the nozzle comprising:
>
> a) a fitting at a first end to facilitate attachment to the dispenser;
>
> b) an opening at a second end opposite the first end through which material is dispensed, the fitting being wider than the opening, the opening defining a periphery having a lateral width dimension and a height dimension, the opening further comprising arcuate and concave surfaces at widthwise opposite ends that remain of fixed dimension to define an oval periphery, the lateral width dimension substantially exceeding twice the height dimension of the opening; and

> c) a forwardly-projecting side wall extending from the first end to the opening, *the side wall having a peripheral outer surface defined by a concave surface that transitions into a convex surface that terminates at the opening*;
>
> d) wherein the side wall further comprises an upper wall and a lower wall, each of the upper and lower walls comprising a portion of the peripheral outer surface such that *each of the upper and lower walls comprises a concave surface that transitions into a convex surface terminating at the opening*,
>
> e) whereby a substantially constant layer of material is dispensed through the opening and having a width of the opening.

THE PROPOSED REJECTION NOT ADOPTED

The Appellant contends that the Examiner erred in confirming claims 1-13 rather than rejecting them under 35 U.S.C. § 102(b) as anticipated by WO 01/96198 A1 to Seaquist (hereinafter "WO Seaquist"), as proposed.

We AFFIRM the Examiner's decision not to adopt the proposed rejection.

ISSUES

The following issues have been raised in the present appeal:

1. Whether the Examiner sufficiently articulated the reason for refusing to adopt the proposed rejection; and

2. Whether the Examiner erred in refusing to adopt the proposed rejection that claims of the '994 patent are anticipated by WO Seaquist in view of the evidence that the Patent Owner filed a District Court action

alleging that the '994 patent claims were infringed by the Appellant's commercialized dispenser.

PROCEDURAL HISTORY and FACTS ("F")

1. In the merged reexamination proceeding, the Examiner stated:

> A. Claims 1-13 are confirmed over the prior art patents and printed publications cited for proposed rejections within this reexamination proceeding. (RAN 2).
>
> B. The rejections over WO 01/96198 to Seaquist in light of Patent Owner's alleged admission as proposed for claims 1-13 [were] **not adopted**. . . .
>
> Seaquist does not show a sidewall with a concave surface that transitions to a convex surface that terminates in an opening. Both Patent Owner and Requester fail to point to any feature in Seaquist that meets this limitation. As this feature is present in all of the claims, the Seaquist application does not anticipate the claims of the Liberatore '994 patent. (ACP 2-3; RAN 2-3; Ans. 4-5; emphasis in original).

2. In the *Ex Parte* Reexamination Request, the Patent Owner specifically identifies limitations "c)" and "d)" of claim 1 as being "not shown" in WO Seaquist (Req. 3), and further stated:

> Specifically, Seaquist fails to teach or reasonably suggest a side wall having a peripheral outer surface defined by a concave surface that transitions into a convex surface that terminates at the opening. Instead, Seaquist teaches a peripheral outer surface that is cumulative of peripheral outer surfaces of the prior art of record. Thus, Seaquist does not teach or render obvious

> every element of Claim 1, and therefore Claim 1 is believed to be patentable over Seaquist.
> (Req. 3).

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). Claim construction is a question of law. *See In re Donaldson Co., Inc.*, 16 F.3d 1189, 1192 (en banc) (Fed. Cir. 1994).

35 U.S.C. § 301 states, *inter alia*:

> Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. . . .

35 U.S.C. § 311 states, *inter alia*:

> (a) IN GENERAL. - Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
> (b) REQUIREMENTS. - The request shall -
> (2) set forth the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.

37 C.F.R. § 1.949 states:

> Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the inter partes reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor.

37 C.F.R. § 1.953(c) states:

> The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection.

37 C.F.R. § 41.69(a) states:

> The primary examiner may, within such time as directed by the Director, furnish a written answer to the owner's and/or requester's appellant brief or respondent brief including, as may be necessary, such explanation of the invention claimed and of the references relied upon, the grounds of rejection, and the reasons for patentability, including grounds for not adopting any proposed rejection.

ANALYSIS

Issue 1

The Appellant states that "[t]he key limitation at issue in this appeal is the 'concave-to-convex' limitation[.]" (App. Br. 4). The Appellant argues

that the Examiner has not sufficiently articulated the reason for refusing to adopt the proposed rejection (Rebuttal Br. 2). We disagree.

The Examiner has clearly set forth his determination to not adopt the proposed anticipation rejection, and has also clearly explained the reasons for his determination. Specifically, the Examiner explained that WO Seaquist does not show a sidewall with a concave surface that transitions to a convex surface that terminates in an opening (F 1B). As further explained by the Examiner, because all of the reexamined claims require a sidewall with a concave surface that transitions to a convex surface, the Examiner refused to adopt the proposed rejection (F 1B). The Examiner further extensively addressed the Appellant's arguments based on the alleged "admission" of the Patent Owner (Ans. 7-8), these arguments being addressed in further detail *infra*. Hence, the Examiner has fully satisfied his required duties. 37 C.F.R. §§ 1.949, 1.953(c) and 41.69(a).

The Appellant argues that the Examiner's articulated reason is a conclusion, which needs to be further explained (Rebuttal Br. 2). While the Examiner's response is concise, it is nonetheless complete because it states specifically what is lacking in the cited prior art reference and fully meets the requirements of the Rules. 37 C.F.R. § 41.69(a). The Appellant's desire for further elaboration beyond that which is required does not make the Examiner's response deficient.

In the above regard, we also observe that while the Appellant alleges inadequacy of the Examiner's reason for not adopting the rejection, the Appellant does not specifically explain how the WO Seaquist reference discloses the pertinent limitation (F 1B). Indeed, the Appellant points to

features illustrated in various figures of the WO Seaquist reference corresponding to various recited limitations of claim 1 (App. Br. 16-21, 25), but with respect to the "key limitation" at issue, as recited in paragraphs "c)" and "d)" of claim 1, the Appellant does not explain how the disclosure in the WO Seaquist reference describes the claimed limitation. Instead, the Appellant relies on the alleged "admission" of the Patent Owner based on the fact that the '994 patent has been asserted against the Appellant's commercialized dispenser (App. Br. 21-25), arguments for which are discussed *infra*. Whereas various passages of WO Seaquist are cited by the Appellant as disclosing, and being relevant to, the pertinent limitation (App. Br. 22-24), the Examiner is correct that none of the cited portions of WO Seaquist describes "a concave surface that transitions into a convex surface." (*See* Ans. 8-9).

We observe that reexaminations are conducted by the PTO based on "patents or printed publications." *See* 35 U.S.C. §§ 301, 311. The deficiency of the WO Seaquist reference has been made clear by the Examiner. Thus, we are not persuaded by the Appellant's arguments.

Issue 2

The Appellant contends that the Examiner erred in refusing to adopt the proposed rejection that the claims of the '994 patent are anticipated by WO Seaquist in view of the evidence that the Patent Owner filed a District Court action alleging infringement of the patent claims by the Appellant's commercialized dispenser. According to the Appellant, because the Patent Owner has instituted a patent infringement action asserting infringement of

the '994 patent by the Appellant's dispenser, which commercializes WO Seaquist, the claims of the '994 patent must necessarily be anticipated (App. Br. 4-7, 12-13; Rebuttal Br. 6-7).

The Appellant's reasoning is as follows:

1. The Patent Owner filed a lawsuit in Federal Court asserting infringement of the claims of the '994 patent by dispensers present in the Appellant's commercially sold products.

2. By filing an infringement lawsuit, the Patent Owner necessarily construed the claims of the '994 patent, including the "key limitation" reciting "a concave surface that transitions into a convex surface that terminates at the opening" because Fed. R. Civ. P. 11 requires the Patent Owner to analyze the patent and the accused dispensers before filing a suit (App. Br. 4-7, 12-13; Rebuttal Br. 6).

3. The commercialized dispensers sold by the Appellant is manufactured by Seaquist (the assignee of WO Seaquist), and is "virtually identical" to an embodiment disclosed in the WO Seaquist reference (App. Br. 6; Rebuttal Br. 3-5).

4. Hence, the Patent Owner has made an "admission" that the claims of the '994 patent read on the dispenser disclosed in the WO Seaquist reference (App. Br. 11, 13; Rebuttal Br. 5-7).

5. Therefore, in view of the Patent Owner's "admission" and alleged infringement of the commercialized dispenser that is "virtually identical" to an embodiment of WO Seaquist, the claims of the '994 patent must be anticipated by WO Seaquist (App. Br. 7).

We disagree with the Appellant. We are not directed by the Appellant to any persuasive precedent that mere filing of a lawsuit is an "admission," as asserted. As explained by the Appellant during the Oral Hearing, the Patent Owner instituted the infringement action by filing a simple notice pleading which merely stated that the Patent Owner "owns this patent and Smucker's [Appellant] nozzles infringe." (Transcript pg. 13, ll. 1-3, 12-14). We decline to find such filings to be an admission as characterized by the Appellant.

While the Patent Owner may have necessarily construed the asserted claims of the '994 patent in concluding that a particular commercialized dispenser infringes, claim construction is a matter of law. The fact that the Patent Owner may have construed the claims one way does not establish what the claims actually mean or that the advocated construction is correct as a matter of law. In this regard, we also disagree with the Appellant's fundamental contention that whatever the implicit claim construction by the Patent Owner is, such construction must be encompassed by the broadest reasonable interpretation used by the PTO (Rebuttal Br. 10). Not only are we not provided with any persuasive authority on point in support of this contention, but the Board's experience in routinely finding unreasonable claim constructions, whether that of appellants or examiners, does not support the Appellant's contention.

In addition, as to the present appeal, the Appellant's argument is premised on an evidentiary finding that is not established by the record. In this regard, the record is lacking, with respect to establishing that the features of the opening in the commercialized dispenser and that disclosed in

WO Seaquist are identical. For example, there is insufficient evidence to establish that the commercialized dispenser only includes a "taper," and no other feature, such as a curvature in addition to the taper or a curvature within the taper.

The Appellant essentially requests us to make a factual finding that the commercialized dispenser is identical to that disclosed in WO Seaquist with respect to the limitations at issue, based on general similarities of the dispenser and the drawings of WO Seaquist, and without the Appellant specifying to the PTO and establishing through evidence, what the WO Seaquist shows with respect to the "key limitation." We decline this request.

Reexaminations are to be based on prior art patents or publications, not on devices such as the commercialized dispenser by Appellant. *See* §§ 301, 311. The Appellant's request requires the PTO to examine the commercialized dispenser and conclude that the commercialized dispenser is the same as that shown in WO Seaquist, that there are no additional features such as a convex curvature, and that the taper does not include some ancillary feature such as a curvature therein. It is not the PTO's responsibility, nor does the PTO have the resources, to evaluate such factual matters

The Appellant also contends that the Examiner ignored the Patent Owner's infringement allegations (Rebuttal Br. 9-10). However, this contention is not supported by the record, which includes detailed discussions by the Examiner regarding the alleged "admission" (Ans. 4-7). The Examiner disagreeing with the Appellant as to what filing of an infringement suit means and weighing the evidence differently from that

desired by the Appellant, does not mean that the Examiner ignored the Appellant's contention or the evidence. The Appellant's objection that the Examiner failed to articulate the broadest reasonable interpretation standard, as applied to the convex to concave limitation (Rebuttal Br. 14), is also unpersuasive. We do not subscribe to the view that such plain and unambiguous terms need further construction.

The Appellant also appeals to policy considerations by pointing out the Patent Owner's "extraordinary decision to remain silent throughout these proceedings[,]" which is alleged to be made with future litigation in mind (Rebuttal Br. 8). While the Patent Owner's silence is atypical, we observe that it was the Appellant that initiated this *inter partes* reexamination proceeding and the Patent Owner is on record as to what the WO Seaquist reference (on which this reexamination is based), does, and does not disclose (F 2). To the contrary, after hundreds of pages of arguments and exhibits as well as an oral hearing, it is the Appellant's silence with respect to where the WO Seaquist reference discloses the "key limitation" that is deafening. In instances where the Appellant asserts that this showing has been made, the Appellant relies on the Patent Owner's alleged "admission" and the contention that implicit claim construction of the Patent Owner is within the broadest reasonable interpretation standard. However, as discussed above, we disagree with the Appellant as to those propositions.

Finally, we observe that the Appellant's fundamental argument appears to be based on estoppel principles. The nature of the Appellant's arguments, and foundational reliance on the commercialized spreader device, as well as evidentiary findings that would be required (i.e., whether

the commercialized dispenser is the same as that disclosed in WO Seaquist, and whether the commercialized dispenser includes a concave-to-convex transition, etc.), all are a poor fit for the limited evidentiary nature of a reexamination proceeding.

CONCLUSIONS

1. The Examiner sufficiently articulated the reason for refusing to adopt the proposed rejection.

2. We disagree with the Appellant that the mere filing of a patent infringement lawsuit using a notice pleading is an "admission."

3. We disagree with the Appellant that any claim construction implicit in filing of a patent infringement lawsuit falls within the broadest reasonable interpretation standard.

4. We find the evidence in the record does not show that the commercially implemented spreader is the same as that disclosed in WO Seaquist.

5. The Examiner did not err in refusing to adopt the proposed rejection that claims of the '994 patent are not anticipated by WO Seaquist.

DECISION

The Examiner's refusal to adopt the Requester's proposed rejection of claims 1-13 as anticipated by WO Seaquist is AFFIRMED.

AFFIRMED

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