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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
16/538,752	08/12/2019	Marc Krüger	1859.029USD3	8143
25215	7590	04/28/2020	EXAMINER	
The Dobrusin Law Firm P.C.			SMITH, CHAIM A	
29 W. Lawrence Street, Ste. 210			ART UNIT	
SUITE 210			PAPER NUMBER	
PONTIAC, MI 48342			1792	
			NOTIFICATION DATE	
			DELIVERY MODE	
			04/28/2020	
			ELECTRONIC	

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

16/538,752

Applicant(s)

Krüger, Marc

Examiner

CHAIM A SMITH

Art Unit

1792

AIA (FITF) Status

No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 23 January 2020.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☒ Claim(s) 9-18 and 26-29 is/are pending in the application.

5a) Of the above claim(s) ____ is/are withdrawn from consideration.

6) ☐ Claim(s) ____ is/are allowed.

7) ☒ Claim(s) 26-29 is/are rejected.

8) ☐ Claim(s) ____ is/are objected to.

9) ☐ Claim(s) ____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) ☒ The specification is objected to by the Examiner.

11) ☒ The drawing(s) filed on 12 August 2019 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some** c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

3) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date ____.

2) ☒ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)

4) ☐ Other: ____.

Paper No(s)/Mail Date ____.

IPR2023-00502

DETAILED ACTION

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on applications DE 10 2010 031 988.0, DE 10 2010 044 251.8, and DE 10 2011 010 534.4 filed in Germany on 22 July 2010, 02 September 2010, and 07 February 2011 respectively, the official translations of which were received 23 January 2020.

3. Under 35 U.S.C. 119(a) or (e), the claims in a U.S. application are entitled to the benefit of a foreign priority date or the filing date of a provisional application if the corresponding foreign application or provisional application supports the claims in the manner required by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph.

4. This is to say that current application must be an application for a patent for an invention which is also disclosed in the prior application(s), foreign or domestic. The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of 35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112, except for the best mode requirement. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994)

5. The disclosure of the prior-filed applications, Applications No. DE 10 2010 031 988.0, DE 10 2010 044 251.8, and DE 10 2011 010 534.4, as well as US Applications 15/646980, 15/211823, and 13/744623 fail to provide adequate support or enablement

in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph for one or more claims of this application. Claims 9 – 18 and 26 – 29 are directed to a method of using a “system” for making a coffee beverage. There is no disclosure of a method of using a “system” for making a coffee beverage found in any of applicant’s prior filed applications. Regarding claims 9 and 26 particularly, there is no disclosure of loading a first portion capsule into an apparatus, sealing the top side of the flange and/or the first foil lid against a seal of the apparatus, followed by the loading of a second portion capsule into said apparatus, reading a second barcode therefrom, controlling a second production process based on reading of said second barcode, piercing the second foil lid with the mandrel of the apparatus, sealing the top side of the flange and/or the second foil lid against a seal of the apparatus therefore for claims in the current application are not entitled to the benefit of the claimed priority dates, foreign or domestic and the priority date is the filing date of the application, that is 12 August 2019.

6. This application has been filed as a divisional application. The application repeats a substantial portion of prior Applications No. 15/646980, 15/211823, and 13/744623, filed 11 July 2017, 15 July 2016, and 18 January 2013 respectively but, by way of the claims adds *significant* disclosure not presented in the prior applications. Because this application names the inventor or at least one joint inventor named in the prior application, it should constitute a continuation-in-part of the prior application and not a divisional application. Appropriate correction is required.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following feature must be shown or said features cancelled from the claims:

an apparatus adapted to supply heated water;

the introduction of heated water into first and second portion capsules through a water inlet of the apparatus along the central axis of said portions capsules;

sealing the top side of the flange and/or the first foil lid and second foil lid against a seal of the apparatus.

8. Specifically with respect to the claimed placement of a barcode as being located on the “bottom” side of a circumferential flange, applicant’s figure 2 clearly shows the position of the barcode reader (13) when it would read the barcode and where the barcode would be located on the circumferential flange. Applicant’s figure 14 further purports to show the location of the barcode and appears to be a view from the membrane side as also shown in figure 2. Therefore it has been determined that these views show what would be the bottom side of the flange and the location of the barcode thereon. In the event that applicant differs in this interpretation of the claimed barcode location then applicant must show the barcode’s location in the figures or the feature cancelled from the claims.

9. Applicant is cautioned against the addition of new matter when making changes to the drawings.

10. Figures 1, 2, 3, 16, and 17 contain partial views.

11. The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear (MPEP § 608.02 V.(u)).

12. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "15" has been used to designate both an arrow in figure 2 and grooves in at least figures 19 and 22. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

13. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

14. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

There is no antecedent basis in the specification for the following limitations recited in claims 9 and 26:

- loading a first portion capsule into an apparatus;
- reading a first barcode with a barcode reader;
- sealing the top side of the flange and/or the first foil lid against a seal of the apparatus;
- forming a first coffee beverage;
- unloading a first or second portion capsule from the apparatus;
- loading a second portion capsule into the apparatus;
- reading a second barcode with a barcode reader;

controlling a second production process of a second coffee beverage;
piercing a second foil lid;
sealing the top side of the flange and/or the second foil lid of the second portion capsule against a seal of the apparatus;
forming a second coffee beverage;

Claim Objections

15. Claims 9 and 26 are objected to because of the following informalities:
16. Claim 9 contains roman numerals enclosed within parentheses. These roman numerals are not seen to be reference characters. Similarly for claim 26 where the claims contains roman numerals, Arabic numerals, and lower case letters in parentheses which are not reference characters. Only reference characters should be enclosed by parentheses so as to avoid confusion in the claims.
17. Appropriate correction is required.

Claim Rejections - 35 USC § 112

18. **The following is a quotation of the first paragraph of 35 U.S.C. 112(a):**

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19. Claims 9 – 18 and 26 – 29 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

20. First it is noted that whilst applicant's disclosure infers a portion capsule would be used for making a coffee beverage, no actual method steps for making a coffee beverage are positively recited in the specification.

21. Regarding claims 9 and 26, with respect to sealing the top side of the flange and/or foil lid of a portion capsule applicant discloses only the edge region has a sealing surface. There is no disclosure of sealing the (entire) top side of a flange and/or a first foil lid or a second foil lid against the seal of the apparatus.

22. Regarding claim 9 and 26, there is no disclosure of piercing a second foil lid with the mandrel in a region that is offset from a central axis of a second portion capsule.

23. Regarding claim 26, there is no disclosure of unloading a first portion capsule from the apparatus.

24. These new recitations are therefore seen to constitute an issue of new matter and as such must be deleted from the claims.

25. Claims 9 – 18 are rejected under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 9 fails to unload the first portion capsule from the apparatus, which is/are critical or essential to the practice of the invention but not included in the claim(s). See *In re Mayhew*, 527 F.2d 1229, 188

USPQ 356 (CCPA 1976). Unless the first portion capsule is unloaded from the apparatus a second capsule would not be able to be inserted into the apparatus to make a second coffee beverage.

26. Claims 10 – 18 and 27 – 29 are rejected by virtue of their dependence on a rejected base claim.

27. **The following is a quotation of 35 U.S.C. 112(b):**

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

28. Claims 9 – 18 and 26 – 29 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

29. Regarding claim 9, it is unclear how many coffee beverages are to be made. In line 18 heated water is introduced into a first portion capsule but no completed coffee beverage is recited as being formed. A second portion capsule is then loaded into the apparatus and a coffee beverage is recited as being formed. As recited this would mean that a single coffee beverage is formed by introducing heated water first into a first portion capsule and then introducing heated water into a second portion capsule however the claim recites the second portion capsule is “to form the second coffee beverage”.

30. Regarding claim 9, it is not clear how a second coffee beverage could be formed without first forming a first coffee beverage which is to say there is no basis for the formation of a second coffee beverage since a first coffee beverage is not recited as having been formed.

31. Regarding claim 9, it is unknown how a second portion capsule could be loaded into the apparatus since the first portion capsule is not recited as being unloaded from the apparatus.

32. Regarding claim 26, there is no antecedent basis in line 13 for the term “the first foil lid”.

33. Regarding claim 26, there is no antecedent basis in line 31 for the term “the second foil lid”.

34. With respect to the recitation of the term “a system” in claims 9 and 26, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph (MPEP 2173.05(p) II).

35. Such claims may also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

36. Claims 9 and 26 are indefinite because the meaning of system is not clear. It is not clear what additional structural limitations the term “system” adds to the product. This rejection can be overcome by deleting the term “system”. For example, the claims could be amended to read “A method of using a portion capsule and an apparatus for making a coffee beverage”.

37. Claims 10 – 18 and 27 – 29 are rejected by virtue of their dependence on a rejected base claim.

38. **The following is a quotation of 35 U.S.C. 112(d):**

(d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The following is a quotation of pre-AIA 35 U.S.C. 112, fourth paragraph:

Subject to the following paragraph [i.e., the fifth paragraph of pre-AIA 35 U.S.C. 112], a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

39. Claims 11 and 12 are rejected under 35 U.S.C. 112(d) or pre-AIA 35 U.S.C. 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends.

40. Claim 9 recites that the first foil lid and second foil lid would be pierced with a mandrel which is to say that the first foil lid and the second foil lid are to be provided with holes as recited in claim 11, therefore it is not seen that claim 11 further limits claim 9 from which it depends.

41. Claim 12 is rejected by virtue of its dependence on a rejected base claim.

42. Applicant may cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, rewrite the claim(s) in independent form, or present a sufficient showing that the dependent claim(s) complies with the statutory requirements.

Claim Rejections - 35 USC § 103

43. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

44. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under pre-AIA 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

45. Claims 9 – 18 and 26 – 29 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Krüger US 2013/0129872.

46. Regarding claims 9 and 26 Krüger discloses a method of using an apparatus and a portion capsule for making a coffee beverage which method comprises providing an apparatus (coffee machine) including a barcode reader (detector 13) and which apparatus is capable of supplying heated (hot) water (paragraph [0061] and [0063]). A first portion capsule would be loaded (inserted) into the apparatus, which first portion capsule includes a first foil lid (membrane, cover foil) sealed to a base element (2) having a cavity within which a powdered coffee material is located (paragraph [0023]). The cavity includes a central portion, and a plurality of ribs (grooves 15) that are (i) radially spaced, (ii) vertically oriented, and (iii) configured to extend toward the central portion of the cavity (paragraph [0083] and fig. 19 and 22). The base element includes a circumferential flange (17) having a top side and a bottom side with a first barcode located on the bottom side (attached to the base element's edge region) (fig. 2).

47. In order to make the coffee beverage the first barcode (identifier) would have to be read with the barcode reader (13) (paragraph [0063]) which would then control a production process of a first coffee beverage based upon the reading of the first barcode (paragraph [0015]). The first foil lid would be pierced with a mandrel (29) of the apparatus in a region that is offset from a central axis of the first portion capsule (fig. 16) which would seal the top side of the flange and/or the first foil lid against a seal (21) of the apparatus and heated water would be introduced into the first portion capsule through a water inlet (28) of the apparatus that is arranged along the central axis of the portion capsule (paragraph [0077]) after which the first portion capsule would have to be unloaded from the apparatus or the apparatus could not be used to make other coffee beverages.

48. With respect to the loading of a second portion capsule into the apparatus and the repetition of the same steps that were performed to make said first beverage to make a second coffee beverage, once it was known to perform the claimed steps to make the first coffee beverage it is not seen that patentability would be predicated on the repetition of the same steps to make a second, third, fourth, or an even an infinite number of said beverages absent strong and compelling evidence that a new and unexpected result would be produced. Stated somewhat differently it would have been obvious to not just the ordinarily skilled artisan but to anyone who knows how to use the apparatus and capsule to make a coffee beverage to use said capsule and apparatus taught by Krüger to make as many of said beverages as they would like. Regarding the second barcode being different from the first barcode to control a second, i.e. different process, obviously different coffee beverages such as espresso, filter coffee, and Café

Americano would require different production processes and different barcodes to control those production processes and the particular coffee beverage one would choose to make would have also been a matter of personal taste.

49. Regarding claim 10, Krüger discloses the base element of the portion capsule would be provided with a beverage raw material and then the base element would be sealed by a membrane. Whilst Krüger discloses that “additionally the cavity could contain one or several built-in elements such as, for example a filter” the phrase “additionally the cavity could contain” makes it obvious that such built-in elements would be optional and the basic design is for the portion capsules, first and/or second to be free of a filter (paragraph [0006]).

50. Claim 11 is rejected for the same reasons given above in the rejection of claim 9.

51. Regarding claim 12, Krüger discloses the introducing steps include inducing turbulent flow (turbulence) of the heated water by the ribs (paragraph [0022]).

52. Regarding claims 13, 14, 15, and 17, Krüger discloses the read barcode (detected identifier) would be compared to a stored reference and the apparatus would be activated, in particular the water- providing pressure pump, if the read barcode matches the stored reference (paragraph [0007]).

53. Regarding claims 16 and 18, Krüger discloses the barcode reader (detection system) would be placed in a media chute of the apparatus (paragraph [0007]).

54. Regarding claim 27, Krüger discloses the production conditions would include pressure, temperature, and/or an amount of the heated water (paragraph [0015]). With respect to the production conditions associated with the first barcode being different from the production conditions associated with the second barcode, the particular coffee

beverage one would choose to make and enjoy would have been a matter of personal taste, which is to say that obviously different coffee beverages such as espresso, filter coffee, and Café Americano would require different production processes and different barcodes to control those production processes.

55. Regarding claim 28, Krüger discloses the mandrel would have a chamfered distal tip (fig. 16).

56. Regarding claim 29, Krüger discloses one or both of the introducing steps would include inducing laminar flow of the heated water by the ribs (paragraph [0022]).

57. Claims 9-11, 13-15, 17, 26 – 29 rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Schifferle US 2005/0150391 in view of Jarisch et al. US 2013/0064937, Sweeney et al. US 2002/0020659, Boyd et al. US 2002/0048621, and Rossi WO 2010/099806.

58. Schifferle discloses a method for making coffee by providing an apparatus a bar code reader and supply of heated water (fig. 1, reference sign 28 and 3 paragraph [0019]), loading a capsule into the apparatus (fig. 1 and 2, reference sign 20), the capsule including a lid sealed to a base element having a cavity holding coffee powder (fig. 1, reference sign 21, paragraph [0016]), the capsule having a circumferential flange (fig. 1, reference signs 20 and 21), the barcode located just below the flange on the side of the base element (fig. 1, reference sign 27), reading the barcode with the reader (paragraph [0019]), controlling the coffee process according to the read barcode (paragraph [0019], [0021]), piercing the lid (Figure 2, reference sign 13), introducing heated water into the capsule along the central axis (paragraph [0021] – [0023], fig. 2), putting holes in the lid (paragraph [0023]), controlling a production condition such as

water amount (paragraph [0019]), a longitudinally extending mandrel with a chamfered or angled distal tip (fig. 1, reference sign 13), and a water pump connected to the controller (fig. 1, reference signs 2 and 7). Schifferle further shows the lid would be sealed against a seal of the apparatus (fig. 2).

59. Schifferle does not explicitly recite a foil lid, vertical ribs, the barcode located on the flange bottom (claim 9), comparing the barcode with a stored reference (claim 13), activating the machine or water pump if there is a match (claims 14, 15 and 17), the capsule being free of a filter (claim 10), and use of a second capsule (claims 9 and 26).

60. Nevertheless it would have been obvious to one of ordinary skill in the art to use the capsule and apparatus of Schifferle for a second capsule since the apparatus of Schifferle was not a disposable apparatus to be discarded after a single use, since Schifferle taught using different types of capsules and beverages, since coffee capsules were commonly only used once before being discarded, and since brewing a second serving coffee with a second capsule would have enabled more people to enjoy the coffee of Schifferle.

61. Sweeney discloses a method for making coffee by use of a capsule with vertical ribs which extend inwardly ('659, fig. 1 and 5, reference sign 20, paragraph [0014]), and the capsule closed by a foil lid sealed to a flange top surface ('659, fig. 1 and 2, reference sign 16 and 22, paragraph [0055]).

62. It would have been obvious to one of ordinary skill in the art to incorporate the claimed foil lid and vertical ribs into the invention of Schifferle, in view of Sweeney, since both are directed to methods of making coffee, since Schifferle has already included a capsule and lid, since coffee capsules commonly included vertical ribs and a foil lid as

shown by Sweeney ('659, fig. 1, reference sign 20; paragraph [0055]), since Schifferle already taught using elevated pressure during brewing ('391, paragraph [0026]), since the vertical ribs were used to reinforce and strengthen the capsule as taught by Sweeney ('659, paragraph [0014]), and since these changes would have been made during the course of normal experimentation and optimization due to factors such as the type of coffee brewing, the expected pressure, and the materials used for the capsule and lid.

63. Jarisch discloses that it was well established to place barcodes (small rectangles 65) on the bottom side of the flange of a portion capsule (fig. 2 and 3), that the location of the barcode would be relevant to the location of the barcode reader and the arrangement of said barcode on the portion capsule provides an improved way to identify the capsule within an apparatus (beverage production machine) to ensure reliable and convenient retrieval of information so as to adjust the working parameters of the apparatus (paragraph [0014]) and therefore one would be motivated to modify Schifferle in view of Sweeney and place the barcode on the flange as taught by Jarisch.

64. With respect to the claimed placement of a barcode as being located on the "bottom" side of a circumferential flange, it is The Office's position that applicant's figure 2 clearly shows the position of the barcode reader (13) when it would read the barcode and where the barcode would be located on the circumferential flange and figure 14 further shows the location of the barcode in a view from the membrane side which is also as also shown in figure 2. Therefore it is seem that these views show what would be the bottom side of the flange and the location of the barcode thereon as determined from applicant's figures and specification.

65. In the event that applicant differs in this interpretation of the claimed barcode location then Jarisch discloses a method for making coffee by reading a code (70) located on the flange bottom ('937, fig. 4, reference signs 62 and 72) and the capsule sealed by a foil lid ('937, paragraph [0036]).

66. Boyd discloses a method for making coffee by use of a capsule with a barcode on its flange ('621, fig. 2, reference signs 10 and 30).

67. Rossi discloses a method for making coffee by providing a capsule with barcodes on its bottom surface ('806, fig. 1, reference signs 2, 4, and 5), an absence of a filter ('806, fig. 1), a barcode reader below the capsule ('806, fig. 1, reference sign 7), the control unit comparing the barcode with pre-stored data ('806, page 9, lines 19-26), and only activating the machine if the barcode is recognized ('806, page 11, lines 1 – 6, fig. 1, reference signs 8 – 10).

68. It further would have been obvious to one of ordinary skill in the art to incorporate the claimed barcode on the flange bottom into the invention of Schifferle, in view of Jarisch, Boyd, and Rossi, since all are directed to methods of making coffee, since Schifferle already included a barcode below the flange in a sheltered area of the capsule ('391, fig. 1, reference sign 27), since coffee capsules commonly included a barcode located on the flange surface as shown by Boyd ('621, fig. 2, reference sign 30), since coffee capsules commonly included a code on the flange bottom as shown by Jarisch ('937, fig. 4, reference sign 72), since coffee capsules commonly included barcodes on the bottom surface as shown by Rossi ('806, fig. 1, reference signs 4 and 5), since the flange bottom area of Schifferle was also a sheltered area of the capsule where the barcode would be less likely to be smudged or damaged as compared to the

capsule bottom or sidewall, since coffee machines commonly included barcode readers positioned below the capsules as shown by Rossi ('806, fig. 1, reference sign 7), since barcode readers placed below the capsules were also capable of reading the flange bottom areas, and since placing plural barcodes in different locations on the capsule would have further ensured that the capsule of Schifferle could be easily recognized and used for brewing even if one or more of the barcodes became smudged or damaged.

69. It further would have been obvious to one of ordinary skill in the art to incorporate the claimed activation and comparing steps, and absence of a filter, into the invention of Schifferle, in view of Jarisch, Boyd, and Rossi, since all are directed to methods of making coffee, since Schifferle already included a water pump connected to the controller and barcode reader ('391, fig. 1, reference signs 2, 7, and 28) and controlling a production condition such as water amount ('391, paragraph [0019]), since coffee capsules often did not include a filter as shown by Rossi, since Schifferle discloses using capsules for making espresso, since hot beverages such as instant coffee and hot chocolate commonly did not require a filter, since coffee apparatuses commonly included a controller comparing a barcode with pre-stored data ('806, page 9, lines 19-26) as shown by Rossi, and since these modifications of Schifferle would have further ensured that the coffee was brewed under acceptable conditions.

70. As set forth above it is seen that Schifferle, in view of Jarisch, Boyd, and Rossi disclose the lid would be pierced by a mandrel. It is further seen that Schifferle, in view of Jarisch, Boyd, and Rossi disclose the lid would be pierced in a region that is offset

from a central axis of the capsule by disclosing that small openings would be need to be provided in the lid in order for the lid to be pervious to liquid ('937, paragraph [0037]).

71. Regarding claim 29, since Schifferle, in view of Jarisch, Boyd, and Rossi have taught the portion capsule as claimed it would be expected that the introducing steps would induce laminar flow of the heated water by the ribs.

72. Claim 12 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Schifferle US 2005/0150391 in view of Jarisch et al. US 2013/0064937 in view of Sweeney et al. US 2002/0020659 in view of Boyd et al. US 2002/0048621 in view of Rossi WO 2010/099806 in view of Rubino EP 1 849 718.

73. Schifferle, Jarisch, Sweeney, Boyd, and Rossi disclose the abovementioned concepts. Schifferle, Jarisch, Sweeney, Boyd, and Rossi do not explicitly recite the ribs inducing turbulent flow (claim 12). Rubino discloses a method for making coffee by use of a capsule with vertical ribs ('718, fig. 8, reference sign 50) which provide optimal conveyance of the water through the capsule ('718, paragraph [0019] and [0004]). It would have been obvious to the ordinarily skilled artisan to incorporate the claimed turbulent flow into the invention of Schifferle, in view of Jarisch, Sweeney, Boyd, Rubino, and Rossi, since all are directed to methods of making coffee, since Schifferle already included a capsule with sidewalls ('391, fig. 1, reference sign 20) as well as controlling the water flow velocity and flow rate with the pump and controller ('391, fig. 1, reference signs 2 and 7), since coffee capsules commonly included vertical ribs which extend inwardly and reinforce the sidewalls ('659, fig. 1 and 5, reference sign 20; paragraph [0014]), since coffee capsules commonly included vertical ribs to optimize flow conditions within the capsule as shown by Rubino ('718, paragraph [0019] and

[0004], fig. 8, reference sign 50), and since turbulent flow within the capsule would better ensure that the water was able to contact all of the coffee material within the capsule of Schifferle and thus provide more effective brewing.

74. Claims 16 and 18 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Schifferle US 2005/0150391 in view of Jarisch et al. US 2013/0064937 in view of Sweeney et al. US 2002/0020659 in view of Boyd et al. US 2002/0048621 in view of Rossi WO 2010/099806, and further in view of Mahlich US 2004/0089158.

75. Regarding claims 16 and 18 it is seen that Schifferle, Jarisch, Sweeney, Boyd, and Rossi disclose the barcode reader would be placed within the media chute of the apparatus ('937, fig. 2 and 3). In the event that claims 16 and 18 can be construed as differing from Schifferle, Jarisch, Sweeney, Boyd, and Rossi in reciting the barcode reader would be placed in a media chute Mahlich discloses a method for making coffee by use of a barcode reader below a media chute holding the capsules (fig. '158, 3, reference signs 27, 1, and 12). It would have been obvious to the ordinarily skilled artisan to incorporate the claimed media chute reader into the invention of Schifferle, in view of Jarisch, Sweeney, Boyd, Rossi, and Mahlich, since all are directed to methods of making coffee, since Schifferle already included a barcode reader, since coffee apparatuses commonly included a barcode reader located below a media chute as shown by Mahlich ('158, fig. 3, reference signs 27, 1, and 12), since this would have enabled the capsule to be automatically scanned and read before placement in the brew chamber of Schifferle and thus provided faster and more accurate brewing without the need for manual reading of the barcode.

Response to Arguments

76. Applicant's arguments filed 23 January 2020 have been fully and carefully considered but they are not found persuasive.

77. Applicant urges that Jarisch is not prior art asserting that applicant is entitled to a priority date of 22 July 2010. This urging is not deemed persuasive.

78. The current application must be an application for a patent for an invention which is also disclosed in the prior applications, foreign or domestic. The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of 35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112

79. As set forth above after a careful review of applicant's recently submitted foreign priority document translations applications No. DE 10 2010 031 988.0, DE 10 2010 044 251.8, and DE 10 2011 010 534.4, as well as US Applications 15/646980, 15/211823, and 13/744623 it is seen that the priority documents fail to provide adequate support or enablement in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph for one or more claims of this application due to the significant amount of disclosure presented in the claims but not found in the previous applications to which applicant claims benefit therefore applicant's priority claim is denied.

80. Further, whilst the application repeats a substantial portion of applicant's prior applications No. 15/646980, 15/211823, and 13/744623, by way of the claims the application adds significant disclosure not presented in the prior applications to the extent that this application cannot be seen to constitute a divisional application as filed but should constitute a continuation-in-part of the prior application and not a divisional

application. This is to say that any limitations in the claims not found in the priority documents would only receive benefit of the filing date of the instant application.

Conclusion

81. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAIM A SMITH whose telephone number is (571)270-7369. The examiner can normally be reached on Monday-Thursday 09:00-18:00.

82. Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to telephone the Examiner.

83. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erik Kashnikow can be reached on (571) 270-3475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

84. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <https://ppair-my.uspto.gov/pair/PrivatePair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C.S./
Chaim Smith
Examiner, Art Unit 1792
12 April 2020

/ERIK KASHNIKOW/
Supervisory Patent Examiner, Art Unit 1792