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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 11/08/2019
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EXAMINER
BECKER, DREW E

ART UNIT	PAPER NUMBER
1792	

NOTIFICATION DATE	DELIVERY MODE
11/08/2019	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 DREW E BECKER	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 8/12/19.

☐ 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) 9-28 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) 9-28 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 8/12/19 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)

2) ☑ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date 8/12/19.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

4) ☐ Other: _____.

DETAILED ACTION

Notice of Pre-AIA or AIA Status

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

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 26-27 been renumbered as 27-28. For examination purposes, it will also be assumed that both claims 27-28 should depend from claim 26.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Germany on 2/7/11, 7/22/10, and 9/2/10. It is noted, however, that applicant has not filed a certified translation of these applications as required by 37 CFR 1.55. A translation of said applications has not been made of record in accordance with 37 CFR 1.55. See MPEP §§ 215 and 216.

Specification

3. The disclosure is objected to because of the following informalities: the first sentence of the specification should include the status of the parent applications.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. 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.

5. Claims 10, 19 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 enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10 and 19 recite “the portion capsule is free of a filter”. It is not clear how an infusion capsule would function without some sort of filter device to retain the coffee material.

6. Claims 10, 19 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.

Claims 10 and 19 recite “the portion capsule is free of a filter”. The application does not appear to disclose this concept.

7. 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.

8. Claims 9-28 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.

9. Claim 9, lines 6-7 both recite “a base element” and “a cavity”. It is not clear if there are two base elements and cavities, or just one.

10. Claim 19, lines 5 and 7 both recite “a cavity”. It is not clear if there are two cavities, or just one.

11. Claim 19 recites the limitation "the barcode reader". There is insufficient antecedent basis for this limitation in the claim. It is not clear if this is the same element as the “detector”, or not.

12. Claim 20 recites “an amount of water”. It is not clear if this is the same as the “heated water’ of parent claim 19, or not.

13. Claim 26, lines 5 and 6 both recite “a cavity”. It is not clear if there are two cavities, or just one.

14. Claim 26 recites the limitation "the barcode reader". There is insufficient antecedent basis for this limitation in the claim. It is not clear if this is the same element as the “detector”, or not.

15. Claim 26 does not include an unloading step for the first capsule. It is not clear if the apparatus must be capable of holding two capsules simultaneously, or not.

16. Claims 27-28 were misnumbered as claims 26-27, and claim 27 depends from claim 25. It is not clear if claim 27 should depend from claim 26 or not.

Claim Rejections - 35 USC § 103

17. 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 negatived by the manner in which the invention was made.

18. Claims 9-11, 13-15, 17, 19-23, 26-28 rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Schifferle [US 2005/0150391A1] in view of Jarisch et al [US 2013/0064937A1], Sweeney et al [US 2002/0020659A1], Boyd et al [US 2002/0048621A1], and WO 2010/099806A1.

Schifferle teaches a method for making coffee by providing an apparatus a bar code reader and supply of heated water (Figure 1, #28, 3; paragraph 0019), loading a capsule into the apparatus (Figure 1-2, #20), the capsule including a lid sealed to a base element having a cavity

holding coffee powder (Figure 1, #21; paragraph 0016), the capsule having a circumferential flange (Figure 1, #20-21), the barcode located just below the flange on the side of the base element (Figure 1, #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, #13), introducing heated water into the capsule (paragraph 0021-0023), 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 (Figure 1, #13), and a water pump connected to the controller (Figure 1, #2, 7).

Schifferle does not explicitly recite a foil lid, vertical ribs, the barcode located on the flange bottom (claim 9, 19), comparing the barcode with a stored reference (claim 13), activating the machine or water pump if there is a match (claim 14-15, 17), the capsule being filter free (claim 10, 19), and use of a second capsule (claim 26).

It would have been obvious to one of ordinary skill in the art to use the system of Schifferle for a second capsule since the apparatus of Schifferle was not a disposable system 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.

Sweeney et al teach a method for making coffee by use of a capsule with vertical ribs which extend inwardly (Figure 1 & 5, #20; paragraph 0014), and the capsule closed by a foil lid sealed to a flange top surface (Figure 1-2, #16, 22; paragraph 0055).

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 et al, since both are directed to methods of making coffee, since Schifferle already included a capsule and lid, since coffee capsules commonly included vertical ribs and a foil lid as sown by Sweeney et al (Figure 1, #20; paragraph 0055), since Schefferle already taught using elevated pressure during brewing (paragraph 0026), since the vertical ribs were used to reinforce and strengthen the capsule as taught by Sweeney et al (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.

Jarisch et al teach a method for making coffee by reading a code located on the flange bottom (Figure 4, #62, 72) and the capsule sealed by a foil lid (paragraph 0036).

Boyd et al teach a method for making coffee by use of a capsule with a barcode on its flange (Figure 2, #10, 30).

WO 2010/099806A1 teach a method for making coffee by providing a capsule with barcodes on its bottom surface (Figure 1, #2, 4-5), an absence of a filter (Figure 1), a barcode reader below the capsule (Figure 1, #7), the control unit comparing the barcode with pre-stored data (page 9, lines 19-26), and only activating the machine if the barcode is recognized (page 11, lines 1-6; Figure 1, #8-10).

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 et al, Boyd et al, and WO 2010/099806A1, 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 (Figure

1, #27), since coffee capsules commonly included a barcode located on the flange surface as shown by Boyd et al (Figure 2, #30), since coffee capsules commonly included a code on the flange bottom as shown by Jarisch et al (Figure 4, #72), since coffee capsules commonly included barcodes on the bottom surface as shown by WO 2010/099806A1 (Figure 1, #4-5), 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 WO 2010/099806A1 (Figure 1, #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.

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 et al, Boyd et al, and WO 2010/099806A1, since all are directed to methods of making coffee, since Schifferle already included a water pump connected to the controller and barcode reader (Figure 1, #2, 7, 28) and controlling a production condition such as water amount (paragraph 0019), since coffee capsules often did not include a filter as shown by WO 2010/099806A1, since Schifferle taught using capsules for making espresso, since hot beverages such as instant coffee and hot chocolate commonly did not require a filter, since coffee systems commonly included a controller comparing a barcode with pre-stored data

(page 9, lines 19-26) as shown by WO 2010/099806A1, and since these modifications of Schifferle would have further ensured that the coffee was brewed under acceptable conditions.

19. Claims 12, 24-25 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Schifferle, in view of Jarisch et al, Sweeney et al, Boyd et al, and WO 2010/099806A1, as applied above, and further in view of EP 1849718A1.

Schifferle, Jarisch et al, Sweeney et al, Boyd et al, and WO 2010/099806A1 teach the abovementioned concepts. Schifferle, Jarisch et al, Sweeney et al, Boyd et al, and WO 2010/099806A1 do not explicitly recite the ribs inducing turbulent flow (claim 12, 24). EP 1849718A1 teaches a method for making coffee by use of a capsule with vertical ribs (Figure 8, #50) which provide optimal conveyance of the water through the capsule (paragraph 0019, 0004). It would have been obvious to one of ordinary skill in the art to incorporate the claimed turbulent flow into the invention of Schifferle, in view of Jarisch et al, Sweeney et al, Boyd et al, EP 1849718A1, and WO 2010/099806A1, since all are directed to methods of making coffee, since Schifferle already included a capsule with sidewalls (Figure 1, #20) as well as controlling the water flow velocity and flow rate with the pump and controller (Figure 1, #2, 7), since coffee capsules commonly included vertical ribs which extend inwardly and reinforce the sidewalls (Figure 1 & 5, #20; paragraph 0014), since coffee capsules commonly included vertical ribs to optimize flow conditions within the capsule as shown by EP 1849718A1 (paragraph 0019, 0004; Figure 8, #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.

20. Claims 16, 18 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Schifferle, in view of Jarisch et al, Sweeney et al, Boyd et al, and WO 2010/099806A1, as applied above, and further in view of Mahlich.

Schifferle, Jarisch et al, Sweeney et al, Boyd et al, and WO 2010/099806A1 teach the abovementioned concepts. Schifferle, Jarisch et al, Sweeney et al, Boyd et al, and WO 2010/099806A1 do not explicitly recite the barcode reader placed in a media chute (claim 16, 18). Mahlich teaches a method for making coffee by use of a barcode reader below a media chute holding the capsules (Figure 3, #27, 1, 12). It would have been obvious to one of ordinary skill in the art to incorporate the claimed media chute reader into the invention of Schifferle, in view of Jarisch et al, Sweeney et al, Boyd et al, WO 2010/099806A1, and Mahlich, since all are directed to methods of making coffee, since Schifferle already included a barcode reader, since coffee systems commonly included a barcode reader located below a media chute as shown by Mahlich (Figure 3, #27, 1, 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.

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(l)(1) - 706.02(l)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

22. Claims 9-28 (particularly claim 9) are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-9 (particularly claim 9) of copending Application No. 16/438,818 in view of Schifferle and Sweeney et al. The '818 application does not claim a bar code reader, vertical ribs, piercing the lid, and controlling the process. Schifferle teaches a method for making coffee by providing an apparatus a bar code reader and supply of heated water (Figure 1, #28, 3; paragraph 0019), loading a capsule into the apparatus (Figure 1-2, #20), the capsule including a lid sealed to a base element having a cavity holding coffee powder (Figure 1, #21; paragraph 0016), the capsule having a circumferential flange (Figure 1, #20-21), the barcode located just below the flange on the side of the base element (Figure 1, #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, #13), introducing heated water into the capsule (paragraph 0021-0023), 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 (Figure 1, #13), and a water pump connected to the controller (Figure 1, #2, 7). Sweeney et al teach a method for making coffee by use of a capsule with vertical ribs which extend inwardly (Figure 1 & 5, #20; paragraph 0014) and closed by a foil lid sealed to a flange top surface (Figure 1-2, #16, 22; paragraph 0055).

It would have been obvious to one of ordinary skill in the art to incorporate the claimed process steps, reader, and vertical ribs into the invention of '818, in view of Sweeney et al and Schifferle, since all are directed to methods of making coffee, since '818 already claimed sidewall channels (claim 4, 7-8), a flange (claim 2), and a barcode identifier (claim 1), since Schifferle already included a capsule with a barcode identifier and extracting a hot beverage using the above mentioned steps, since coffee capsules commonly included vertical ribs and a foil lid as sown by Sweeney et al (Figure 1, #20; paragraph 0055), since Schefferle already taught using elevated pressure during brewing (paragraph 0026), since the vertical ribs were used to reinforce and strengthen the capsule as taught by Sweeney et al (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.

This is a provisional nonstatutory double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DREW E BECKER whose telephone number is (571)272-1396. The examiner can normally be reached on 8am-5pm Monday-Friday.

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 use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

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.

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 http://pair-direct.uspto.gov. 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.

/DREW E BECKER/
Primary Examiner, Art Unit 1792