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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD C. DARR and EDWARD V. MORGAN

Appeal 2011-011436
Application 11/749,501
Technology Center 3700

Before MICHAEL W. KIM, MICHAEL C. ASTORINO, and
HYUN J. JUNG, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 36-70. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claimed Subject Matter

Claims 36 and 65 are independent. Claim 36, reproduced below with added emphasis, is illustrative of the subject matter on appeal.

36. A plastic preform for making a blow molded container, comprising:

a closed bottom portion;

a lower portion extending upwardly from the bottom portion;

a neck portion extending upwardly from the lower portion; the neck portion including a support flange having an upper and lower surface;

a tamper-evident formation, and a dispensing opening at the top of the neck portion, a neck portion extending upwardly from the lower portion, the neck portion including a support flange having an upper and lower surface;

a tamper-evident formation; and

a dispensing opening at the top of the neck portion, the dispensing opening having an inner diameter that is at least 22 mm;

wherein the vertical distance from the dispensing opening to the lower surface of the support flange is 0.580 inches or less.

Claim 65 is directed to “[a] method for making a container” and, similar to claim 36 recites, “wherein the vertical distance from the dispensing opening to the lower surface of the support flange being 0.580 inches or less.” App. Br., Clms. App’x.

*Rejections*¹

Claims 36-40 and 42-70 are rejected under 35 U.S.C. § 103(a) as unpatentable over Brewster (US 5,888,598, iss. Mar. 30, 1999).

Claim 41 is rejected under 35 U.S.C. § 103(a) as unpatentable over Brewster and Ryder (US 4,756,438, iss. Jul. 12, 1988).

OPINION

Claims 36 and 65 call for a plastic preform having a distance of *0.580 inches or less* between the dispensing opening at the top of the neck portion and the lower surface of the support flange. *See* App. Br., Clms. App'x.; *see also* Spec. fig. 5, para. [00023] (stating “the vertical distance **X** from the top of the dispensing opening/ neck portion (e.g., point 30) to the lower surface 22 of the support flange 18 (e.g., point 32) is 0.580 inches or less.”).

The Examiner finds that Brewster discloses that “[t]he vertical distance from the dispensing opening to the lower surface of the support flange is 0.580 inches or less (the vertical distance is $e = 0.827\text{mm}$ or 0.033 inches, which is less than 0.580 inches).” Ans. 5. Indeed, Brewster states that distance “e” in Figures 1 and 2 is 0.827 mm. Brewster, Tables 3 and 4, col. 5, ll. 30-35, 38, 46-50, 55 and col. 6, ll. 18-21.

The Appellants contend that one of ordinary skill in the art would immediately recognize that the unit of length for distance “e” in Brewster’s Tables 3 and 4, among others, are incorrect. *See* App. Br. 5. Specifically,

¹ Although the Examiner includes *In re Aller*, 220 F.2d 454 (CCPA 1955), as part of both grounds of rejection (Ans. 5, 18), case law is used to support a ground of rejection and is not considered as part of the ground of rejection. Accordingly, we have removed the Examiner’s citation to *Aller* in the ground of rejection.

that the unit of length must be in inches rather than millimeters, and as such, the unit of length listed in Tables 3 and 4 of Brewster is clearly a typographical error. *See id.* The Appellants rely on Brewster's disclosure and a Declaration of Richard C. Darr, filed March 1, 2010² as evidence to explain why the unit of length listed in Brewster's disclosure as millimeters for distance "e" is a clear typographical error. *See* App. Br. 5-8, Reply Br. 1-2. Most notably, the Appellants assert that Brewster's disclosure provides contradictory lengths for the length of the preform. App. Br. 7.

The Appellants' contention is persuasive. Brewster refers to the length of the preform between 40-110 mm. *See, e.g.,* Brewster, col. 2, ll. 55-63 and col. 7, ll. 31-50; *see also* App. Br. 7, Reply Br. 1-2. However, the length of the preform, i.e., distance "a," in Figures 1 and 2 is 3.125 mm and 2.864 mm, respectively. Brewster, col. 5, ll. 29-35, 46-52, 64-66 and col. 6, ll. 37-38. Assuming the identification of millimeters in Tables 3 and 4 is a typographical error and should be inches instead, it is notable that 3.125 inches converts to approximately 79 mm and 2.864 in converts to approximately 72 mm. Since 79 mm and 72 mm is between the range of 40 – 110 mm and 3.125 mm and 2.864 mm is well outside of the aforementioned range, the Appellants' contention that one of ordinary skill in the art would immediately recognize 0.827 as inches rather than millimeters as the unit of length for distance "e" is persuasive. Further, this contention is supported by the Appellants' remaining arguments at pages 5-7 of the Appeal Brief and pages 1-2 of the Reply Brief explaining why one of

² The Appellants present the Declaration of Richard C. Darr in the Evidence Appendix of the Appeal Brief, at pages 19-21.

ordinary skill in the art would immediately recognize the units of length for distance “e” as inches and not millimeters.

In response, the Examiner correctly notes that there is a presumption that a patent is valid (Ans. 3, 19), and within that presumption is a presumption of operability. *See* 35 U.S.C. § 282, MPEP § 716.07; *see also Metropolitan Eng. Co. v. Coe*, 78 F.2d 199 (D.C. Cir. 1935). However, the presumption of operability is rebuttable by a preponderance of the evidence. *See In re Sasse*, 629 F.2d 675, 681 (CCPA 1980); *see also In re Jacobs*, 318 F.2d 743 (CCPA 1963). In this case, the Appellants are correct that “as recognized by the Court in *Yale*, one of ordinary skill in the art would recognize the obvious error and simply substitute the correct value.” App. Br. 7; *see* MPEP § 716.07, *In re Yale*, 434 F.2d 666, 668-669 (CCPA 1970). As discussed above, Brewster’s identification of millimeters as the length of distance “e” in Tables 3 and 4 is a clear typographical error, and as such, a person of ordinary skill in the art would mentally disregard or substitute millimeters in Brewster’s Tables 3 and 4 for inches. *See id.* *But see* Ans. 4 (Examiner explains that even if the unit of length in Tables 1-5 is in error, one of ordinary skill in the art would recognize the error and convert to the appropriate units.). Accordingly, Brewster has not placed the length of the vertical distance from the dispensing opening to the lower surface of the support flange to be 0.580 inches or less in the possession of the public.

For the foregoing reasons, we find that the Appellants have rebutted the presumption of operability by a preponderance of the evidence. *See Sasse*, 629 F.2d at 681. Further, the Examiner has not substantively refuted the Appellants’ rebuttal. Thus, the Examiner’s finding that Brewster

discloses “the vertical distance is $e = 0.827\text{mm}$ or 0.033 inches, which is less than 0.580 inches” (Ans. 5) is inadequately supported.

Further, the Examiner cites to *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830 (1984), to conclude, “*actual dimensions* are given little patentable weight.” Ans. 4 (emphasis added). The Examiner does not offer any further analysis of facts of *Gardner* to the claims on appeal. Specifically, the Examiner does not explain how the facts of *Gardner* are similar to the present case. *See also* MPEP § 2144.04. Additionally, *Gardner* is a case directed to “relative dimensions”, i.e., changes in size or proportion, which is conceptually distinct from “actual dimensions,” since changes in dimensions may not be proportional changes. *See* MPEP § 2144.04(IV)(A) (stating “[i]n *Gardner* . . . , the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.”). Accordingly, the Examiner’s proffered holding of *Gardner* is inaccurate.

For the foregoing reasons, the Examiner has not established a prima facie case of obviousness. Thus, the rejection of independent claims 36 and 65, and their dependent claims 37-40, 42-64, and 66-70, as unpatentable over Brewster is not sustained.

The remaining rejection based on Brewster in combination with Ryder relies on the same erroneous finding discussed above with regard to the rejection of claim 36. *See* Ans. 18. As such, we cannot sustain the rejection

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under 35 U.S.C. § 103(a) of claim 41 as unpatentable over Brewster and
Ryder.

DECISION

We REVERSE the rejections of claims 36-70.

REVERSED

Klh