

claim drafting question, 16 points were deducted. Accordingly, petitioner initially achieved a combined score of 64 points for the afternoon section of the examination.

On February 3, 1994, the petitioner requested a regrade of the claim drafting question and of Multiple Choice Question No. 2. In a decision of an OED staff attorney, dated March 14, 1994, the petitioner was allowed 2 additional points for the claim drafting question and no additional points for Multiple Choice Question No. 2. Petitioner's revised score of 66 is still short of the 70 points needed to pass the afternoon section of the examination.

On May 31, the petitioner requested reconsideration of the staff attorney's regrade decision, urging that the petitioner's answer for Multiple Choice Question No. 2 was correct. The Multiple Choice Question was worth 5 points.

On April 4, 1994, the Director of OED rendered a decision stating that Model Answer C for Multiple Choice Question No. 2 is correct and petitioner's Choice E was incorrect, and denied petitioner's request for 5 additional points on his score.

On April 26, 1994, the petitioner filed a petition under 37 CFR § 10.2(c) for review by the Commissioner of the Director's decision of April 4, 1994. The petition was received in OED on May 10, 1994.

On May 12, 1994, the Director issued a supplemental decision correcting several referencing errors in his decision

of April 4, 1994, and gave the petitioner additional time to seek review in response to the supplemental decision.

On May 23, 1994, the petitioner filed a supplemental petition under 37 CFR § 10.2(C) for review by the Commissioner of the Director's decisions, focusing on the Director's supplemental decision of May 12, 1994.

Multiple Choice Question Nos. 1-8 shared these instructions:

On March 1, 1989, Jones invented a bottle stopper for champagne bottles. You prepared a patent application for Jones on his invention and filed it in the PTO on June 20, 1989. The application issued as Patent No. 9,999,999 on July 10, 1990. On April 7, 1991, Jones invented a threaded bottle stopper which was an improvement over his original and patented bottle stopper. The improvement is directed to a means which functions to control the release of pressurized gas from the bottle to preclude both ejection of the stopper at a dangerous velocity and undesirable premature spillage of the bottle contents. On August 8, 1991, you filed an application in the PTO on behalf of Jones disclosing and claiming the improved bottle stopper.

The application for the improvement was prosecuted through final rejection. The examiner's grounds for the final rejection were stated as follows:

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (U.S. Patent No. 7,777,777, issued October 17, 1972).

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. Patent No. 9,999,999).

Claim 1-4 and 6 are rejected under 35 U.S.C. 103 as being unpatentable over Miller (U.S. Patent No. 7,777,777). The Miller patent discloses the bottle stopper substantially as claimed by applicant except that Miller uses two V shaped ribs or seals instead of three. The number of ribs is not critical and would have been an obvious matter of choice to one of ordinary skill in the art.

You prosecuted both applicants on behalf of Jones. You have appealed the examiner's final rejection of claims 1-4 and 6. Claim 5 has been indicated by the examiner as being allowable. The relevant portions of the Jones application on appeal (i.e. the specification and a clean copy of the appealed claim 1-4 and 6 and allowable claim 5) are reproduced in the YELLOW Supplement. The application included an abstract which has not been produced. The references

relied upon by the examiner in his final rejection are also set forth in the YELLOW Supplement. You have timely filed a Notice of Appeal and an Appeal Brief with the appropriate fees. In your Brief, you requested that "the rejection of claims 1-3 and 6 under 35 U.S.C. 102(b) as being anticipated by Miller, the rejection of claims 1-4 and 6 under 35 U.S.C. 102(b) as being anticipated by Jones and the rejection of claims 1-4 and 6 under 35 U.S.C. 103 as unpatentable over Miller be reversed." You did not request an oral hearing. The examiner filled his Examiner's Answer and the case is presently awaiting decision by the Board of Patent Appeals and Inferences (the Board). Answer the following 8 questions in SECTION 1 on your Answer Sheet, and unless otherwise directed, answer each question independently of all other questions. See the directions on page 1 of this test booklet for instructions for recording your answers on the Answer Sheet. Each numbered question below corresponds to the numbered answer in SECTION 1 of your Answer Sheet. For each question, mark in SECTION 1 the letter you choose as your answer. If choice (E) is "None of the above", your selection of choice (E) denotes your intent not to select any of the previous choices.

Multiple Choice Question No. 2 reads:

2. Claim 5 has been indicated by the examiner as being allowable. The claim is not an original claim, but was added by amendment in response to the examiner's first Office action. The claim specifies that the "tubular body portion is flexible". In accordance with established PTO practice and procedure, the Board would _____

(A) introduce in its decision a statement setting forth a new rejection of claim 5 under U.S.C. 112, first paragraph, as having no descriptive basis in the specification as filed.

(B) introduce in its decision a statement setting forth a new rejection of claim 5 under 35 U.S.C. 103 as being obvious over the Miller patent.

(C) recommend in its decision a new rejection of claim 5 under 35 U.S.C. 102(b) as being anticipated by the disclosure of the Miller patent.

(D) recommend in its decision rejections of claim 5 under 35 U.S.C. 112, first paragraph, as having no descriptive basis in the original specification and under 35 U.S.C. 102(b), as being anticipated by

Miller, and remand the application to the examiner.

(E) take no action relative to allowed claim 5 because the claim is fully supported in the specification.

Decision

Petitioner argues that for Question No. 2, Model Answer C is incorrect. According to petitioner, answer choice E is the correct answer. Petitioner's argument is not persuasive.

Answer choice E states that the Board would:

(E) take no action relative to allowed claim 5 because the claim is fully supported in the specification.

With regard to answer choice E, petitioner is correct that amended claim 5 is supported by the original Jones specification. In his decision of April 4, 1994, the Director even stated (decision at 2): "Your showing that claim 5 is supported by the Jones application is not questioned. As noted earlier, the question was designed so that claim 5 would be fully supported by the disclosure." But sufficient support in the original specification is not enough to make answer choice E correct, because answer choice E also states that the Board should take no action.

The Board should take action, because claim 5 is anticipated by the Miller patent under 35 U.S.C. § 102(b). Model Answer C correctly states that the Board would recommend

that claim 5 be rejected under 35 U.S.C. § 102(b) as being anticipated by the Miller patent.

Anticipation requires that all elements of the claimed invention be described in a single reference. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Claim 5 recites a bottle stopper and is dependent on claim 1. Per 37 CFR § 1.75(c), a dependent claim shall be construed to include all the limitations of the claim from which it depends. Accordingly, claim 5 includes the following features:

[1.] A bottle stopper for containing pressurized product within a bottle comprising:

a cap, said cap including a disc portion having an inner surface and an outer periphery;

an annular skirt depending from said inner surface at said outer periphery;

a tubular body portion depending from said inner surface of said disc portion radially inward of said annular skirt so as to define an annular space therebetween;

said annular space being defined in part by an annular base section of said inner surface of said disc portion

said annular base section including a plurality of V shaped seals for engaging a rim of a neck of said bottle when said neck is positioned within said annular space;

said annular skirt including an inside surface having threads thereon intended to engage

threads on an external surface of
said neck of said bottle

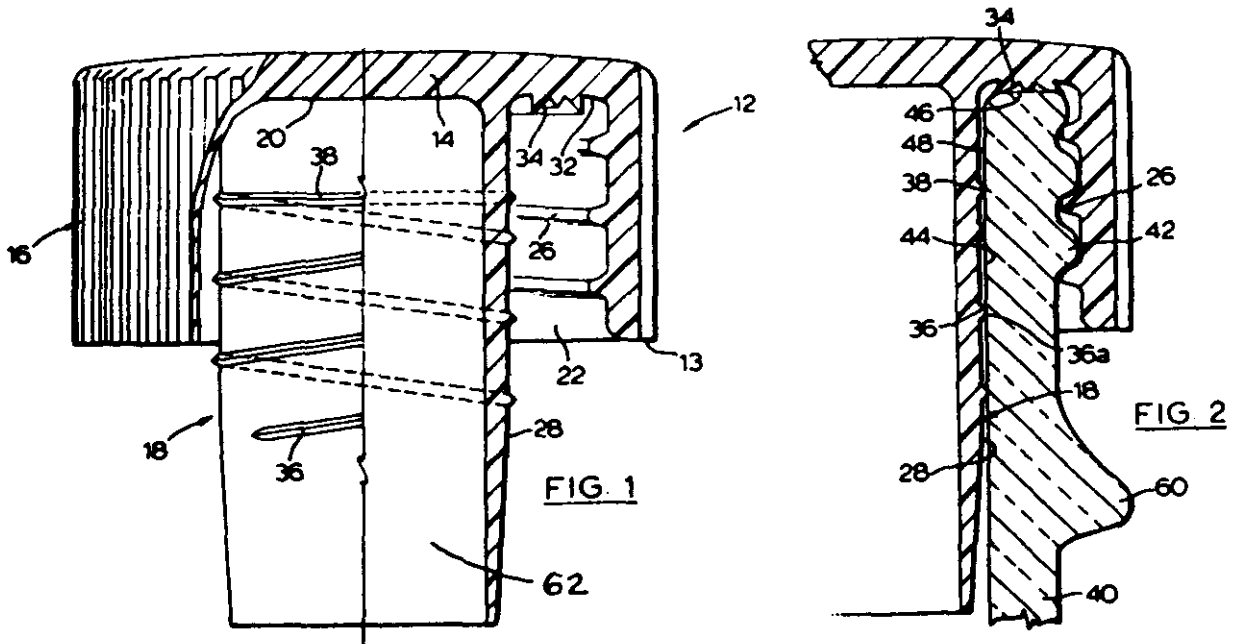
and said tubular body portion
including an outside surface
intended to engage an inner
annular surface of said neck
bottle when said neck is received
within said annular space;

[5. The bottle stopper of claim
1] wherein said tubular body
portion is flexible.

[Emphasis added.]

The only limitation of claim 5 which the petitioner argues is
not met by the Miller patent is that the tubular body portion
must depend from the inner surface of the disc. That
limitation is underlined in the reproduction of claim 5 on the
preceding page.

Figures 1 and 2 of the Jones application are reproduced
below.



The specification of the Jones application states, in part:

Figure 1 illustrates a one piece bottle stopper 12 made of plastic. The stopper includes a cap that comprises a disc portion 14 with an annular skirt 16 depending from an inner surface 20 of the disc portion at its outer periphery. A continuous mechanical thread 26 is provided on the inside surface of the skirt 16 which engages a mating thread 42 on the external surface of bottle neck 40, as shown in Figure 2. A flexible tubular body portion 18, generally concentric with the skirt, also extends from the inner surface 20 of the disc portion. The outer diameter of the tubular body portion 18 is less than the inner diameter of the skirt 16 so that annular space 22 is defined therebetween. . . .

Numeral 28 designates the outside surface of the tubular body portion 18. With regard to the limitation at issue, tubular body portion 18 with exterior surface 28 depends from the inner surface of the disc portion 14 radially inward of the annular skirt 16 such that annular space 22 exists between the annular skirt and the tubular body portion 18.

Figures 1 and 2 of the Miller patent are reproduced below.

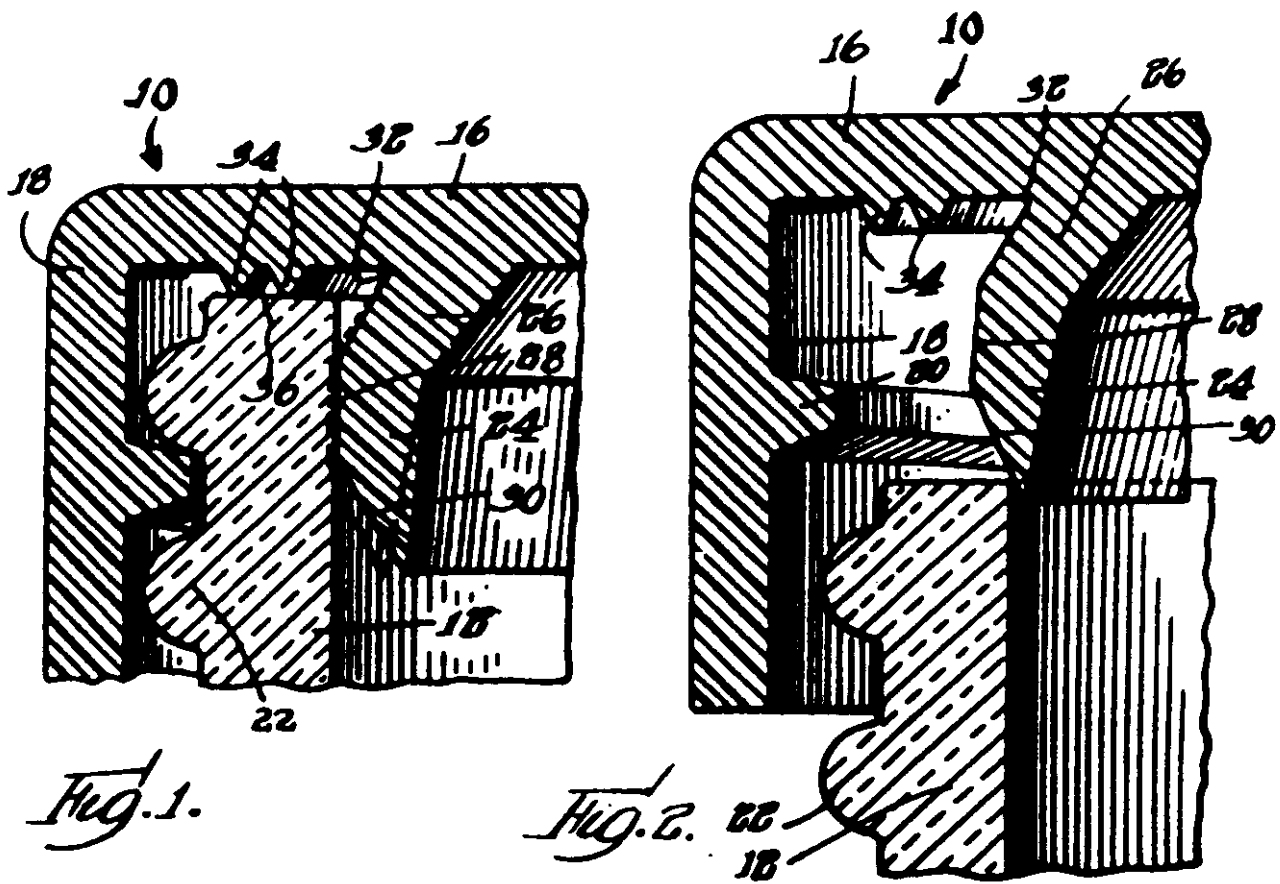


Fig. 1.

Fig. 2.

The specification of the Miller patent states, in part: Figure 1 shows a flexible closure cap 10 of polyethylene closing off the neck 12 of a glass bottle. The cap 10 includes a disc 16 and a cylindrical wall 18 fixed to the edge of the disc. The interior surface of the wall 18 is provided with threads 20 for engaging cooperating threads 22 on the annular exterior surface of the neck 12 of the bottle.

The cap also includes a flexible skirt 24 connected to the disc 16 by the frusto-conical collar 26.

Skirt 24 is concentric with and spaced apart from the cylindrical wall 18 so that a cylindrical sealing portion 28 of the skirt can engage the interior surface of the neck 12. The diameter of the sealing portion 28 exceeds the internal diameter of the neck 12. The skirt 24 is radially compressed when the bevel 30 of the skirt enters the neck 12. . . . In assembled position, the sealing portion 28 of the skirt engages the interior surface of the neck 12. The flexure of the collar 26 permits the skirt to engage the neck resiliently thereby effectively sealing bottles whose inside neck diameter varies slightly from standard dimensions.

According to the petitioner, the flexible skirt 24, insofar as it is a tubular body portion, does not depend from disc 16. The petitioner asserts that the skirt 24 is connected to the frusto-conical collar 26, which in turn depends on disc 16. The supplemental petition states:

Applicant points out that:

"in no way does the flexible skirt (24) depend or extend from disc (16), as required by claim 5 of the Jones' application. In fact, the frusto-conical collar (26) disposed between the inner surface of the disc (16) and the flexible skirt (24) results in an added structural

limitation which destroys the physical possibility of flexible skirt (24) depending or extending from the inner surface of the disc (16), as required by claim 5."

Petitioner's argument is rejected. The limitation at issue is this:

a tubular body portion depending from said inner surface of said disc portion . . .

Claim 5 nowhere requires that the tubular body portion be "directly" dependent on the inner surface of the disc portion. Thus, despite the fact that the skirt 24 connects to the disc portion 16 through a frusto-conical collar 26, the arrangement is still squarely within the meaning of a tubular body portion depending from the inner surface of the disc portion.

Even if claim 5 were construed so as to require a direct connection between the tubular body portion and the disc portion, the flexible skirt 24 and the frusto-conical collar 26 together constitute a tubular body portion depending directly from the inner surface of the disc portion. The limitation at issue would still be met by the Miller patent.

During patent examination, claim terms are properly construed according to their broadest reasonable interpretation not inconsistent with the specification. E.g., In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir.

1990); In re Pearson, 494 F.2d 1399, 1404, 181 USPQ 641, 645 (CCPA 1974); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). The Jones disclosure does not preclude recognizing a tubular body portion connected through a frusto-conical collar to a disc portion as depending from the disc portion. Nor does it preclude a tubular body portion from itself including a frusto-conical collar.

The Director also stated:

[T]he portion of the Jones' tubular body portion 18 near his disc 14 could also be characterized as including a frusto-conical collar and the same language as used in Miller could be used to describe Jones' tubular body portion.

The petitioner argues that the Jones' application says nothing of a frusto-conical collar and the drawings do not depict any frusto-conical collar.

Whether the tubular body portion of Jones includes a frusto-conical collar is not the issue. The important point is that the claim language does not preclude the tubular body portion from itself having a frusto-conical collar.

In any event, the Director correctly held that even the tubular body portion 18 of the Jones' disclosure includes a frusto-conical collar. It is not necessary that the Jones' specification expressly refer to a frusto-conical collar. The frusto-conical is shown in Figures 1 and 2 of the Jones application. Any longitudinal segment of the tubular body

portion beginning at the disc portion 14 is a frusto-conical collar. As is defined in Webster's Third New International Dictionary (1961), "frustoconical" means "of the shape of a frustum of a cone," and "frustum" means (pertinent pages enclosed):

1: the part of a cone-shaped solid next to the base and formed by cutting off the top by a plane parallel to the base; also: the part of a solid (as a cone or pyramid) intersected between two planes that are either parallel or sometimes inclined to each other.

Additionally, the flexible skirt 24 is nonetheless is still directly dependent from the inner surface of disc portion 16, even if the frusto-conical collar 26 of the Miller patent is not regarded as part and parcel to the tubular body portion. Here, the frusto-conical collar acts merely as a connecting means; it is integral to both the disc portion 16 and the skirt 24. Like glue, the frusto-conical collar 26 bonds the disc portion 16 and the flexible skirt 24. Like two elements bonded together by glue, the disc portion 16 and the flexible skirt 24 are "directly" connected to each other.

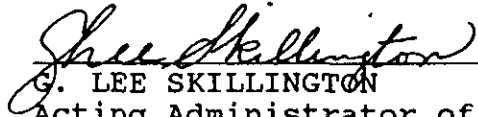
Accordingly, the claim limitation at issue is met by the Miller patent, and claim 5 is anticipated by the Miller patent under 35 U.S.C. § 102(b). Model Answer C to Question No. 2, that the Board would "recommend in its decision a new rejection of claim 5 under 35 U.S.C. 102(b) as being anticipated by the disclosure of the Miller patent," is correct.

Conclusion

For the foregoing reasons, the Director's decisions are affirmed, insofar as they decline to award any points for petitioner's answer (E) to Multiple Choice Question No. 2 in Part II of the afternoon section of the examination.

And it is herein ORDERED that:

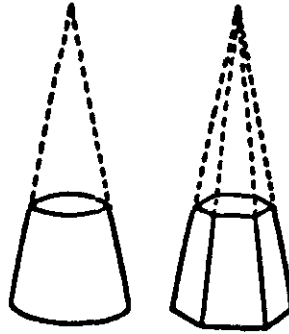
The petition is denied.


G. LEE SKILLINGTON
Acting Administrator of Legislation
and International Affairs

cc:

frus-tu-lum \ˈfrɒschələm\ *n*, *pl frustu-la* \-lə\ [NL, fr. L, small piece] : a light breakfast allowed on fast days in the Roman Catholic Church

frus-tum \ˈfrɒstəm\ *also frus-trum* \-trəm\ *n*, *pl frustums* \-təmz\ *or frus-ta* \-tə\ *also frustrums* \-trəmz\ *or frus-tra* \-trə\ [NL, fr. ML & L; ML *frustum* piece, bit, alter. of L *frustum* — more at BRUISE] **1** : the part of a cone-shaped solid next to the base and formed by cutting off the top by a plane parallel to the base; *also* : the part of a solid (as a cone or pyramid) intersected between two planes that are either parallel or sometimes inclined to each other **2** : one of the drums of the shaft of a column



frustums 1

fru-tes-cence \frūˈtesⁿn(t)s\ *n* -s : the quality or state of being frutescent

fru-tes-cent \(')frūˈtesⁿnt\ *adj* [L *frutex* shrub, bush + E -escent] : having or approaching the appearance or habit of a shrub : SHRUBBY

fruti- *comb form* [L *frutic-*, *frutex*] : shrub (<fruticolous>)

fru-ti-ce-tum \frūd-əˈsēd-əm\ *n*, *pl frutice-ta* \-ēd-ə\ [NL, fr. L, place full of shrubs, fr. *frutic-*, *frutex* + -etum] : a collection of shrubs grown for ornament or study (as in a botanical garden) — compare ARBORETUM

fru-ti-cose \frūd-əˈkōs\ *adj* [L *fruticosus*, fr. *frutic-*, *frutex* shrub + -osus -ose; akin to MHG *briezen* to bud, swell, OHG *broz* bud, sprout, OIr *broth* whisker, hair] : occurring in the form of or resembling a shrub : SHRUBBY (<a ~ chrysanthemum> (herbaceous or sometimes ~ perennials); *esp*, of a lichen : having a shrubby bushy thallus with flattened or cylindrical branches

fru-ti-cu-lose \frūˈtikyə,lōs\ *adj* [L *frutic-*, *frutex* + -ulus (dim. suffix) + E -ose] : resembling a small shrub

fru-ti-lla \frūˈtē(y)ə\ *n* -s [Sp, dim. of *fruta* edible fruit, fr. ML *fructa*, pl. of *fructum*, alter. of L *fructus* — more at FRUIT] : CHILEAN STRAWBERRY

frwy *abbr* freeway

1 fry \ˈfri\ *vb* *fried*; *fried*; *frying*; *fries* [ME *frien*, fr. OF *frire*, fr. L *frigere* to roast, fry; akin to Gk *phrygein* to roast, fry, Skt *bhr̥jati* he roasts] *vt* : to cook in a pan or on a griddle by heating over a fire *esp*. with the use of fat : cook in hot fat (<~ fish> — compare BROIL ~ *vi* **1** : to undergo the process of frying : become subject to the action of heat in a frying pan or on a griddle **2 slang** : to suffer execution in the electric chair (if I burn, you'll ~ along with me — Barton Black)

2 fry \ˈ\ *n* -ES **1** & (1) : a dish of something fried (a mixed ~ of . . . tiny crayfish and squid — P.E.Deutschman) (2) : FRENCH

fuchsia red *n* : a moderate to magenta

fuchsia rose *n* : a variable color red that is bluer and deeper than violine pink, red magenta rose, and bluer and s

fuch-sine *or fuch-sin* \ˈfyūˈfuk(,)s\ *n* -s [F *fuchsine*, pr + -ine; fr. its color] **1** *ofte* that is made usu. in the form mixture of aniline and toluid: red solution and dyes wool cotton, but is used chiefly in c stain — called also magenta, r Basic Violet 14 and Solvent F

NEW FUCHSINE, PARA FUCHSIN

fuch-sin-o-phil \f(y)ükˈsina,f *or fuch-si-no-phil-ic* \(')f(y) *fuchsinophile* fr. ISV *fuchsine* - fr. *fuchsinophil*, *fuchsinophile*

the acid dye fuchsine (<~ cyt on such an affinity (the ~ m

fuchs-ite \f(y)ükˈsīt\ *n* -s *Fuchs* †1856 Ger. mineralog

consisting of a common mica **1 fu-coid** \ˈfyūˈkoid\ *or fu-co* prob. fr. (assumed) NL *fuco*

-oid; *fucoidal* fr. *fucoïd* + -al. bling algae of the order Fuca nature of seaweeds **2** : of, rela of fossil fucoids or markings

2 fucoïd \ˈ\ *n* -s [prob. fr.] *fucoïdes*, *adj*.] **1** : a seawee fossil of an alga or a plant res

fu-co-ïd-in \fyūˈkoidⁿn\ *n* -s | ester of fucosan obtained from of the genus *Fucus*)

fu-co-san \ˈfyūkəˌsan\ *n* -s polysaccharide occurring in v the genus *Fucus*) and yielding

fu-cose \ˈfyūkōs\ *n* -s [ISV CH₃(CHOH)₄CHO occurrin. D-form in various glycoside

rotatory L-form in fucosan. typical of some blood groups: GLUCOSE

fu-cos-ter-ol \fyūˈkəstəˌrōl, - line sterol C₂₅H₄₇OH occur *vesiculosus*)

fu-co-wan-thin \ˈfukōwān\ *n*

frumpishly

aged spinster —Carol Field) (<~ in a lacy old-fashioned way —Edmund Wilson) (a ~ old maid —Louis Bromfield)
 — **frump-ish-ly** *adv* — **frump-ish-ness** *n* -ES
frum-ple \ˈfrʌmpəl, ˈfrəm-\ *vt* -ED/-ING/-S [ME *fromplen*, fr. MD *verrompelen*, fr. *ver-* for- (akin to OHG *fir-*) + *rompelen* to wrinkle — more at RUMPLE] *dial Brit* : WRINKLE, CRUMPLE
frumpy \ˈfrʌmpē, -pi\ *adj* -ER/-EST : DULL, FRUMPISH, DOWDY, DRAB (a dull ~ Victorian society —Anita Leslie) (enraged all the ~ bluestockings by the smartness of her toilet —V.L. Parrington)
frush \ˈfrʌʃ\ *n* -ES [perh. alter. of *frosh*] **1** : the frog of a horse's foot **2** : a discharge from the frog of a horse's foot; *also* : THRUSH
frush \ˈfrʌʃ, ˈfrəʃ\ *adj* [perh. alter. of *frough*] **1 dial Brit**, of timber or cloth : decayed to the point of brittleness : lacking tensile strength **2 dial Brit**, of soil : friable and mellow
frusta *pl* of FRUSTUM
frus-to-conical \ˈfrə(,)stō+\ *adj* [*frustum* + -o- + *conical*] : of the shape of a frustum of a cone
frustra *pl* of FRUSTRUM
frus-tra-ne-ous \ˈfrəˌstrānēəs, ˈfrə's-\ *adj* [L *frustra* + E -aneous (as in *extraneous*)] : leading to frustration : VAIN, UNPROFITABLE
frus-trate \ˈfrəˌstrāt, chiefly Brit (,)zˈz; usu -ād.+V\ *vt* -ED/-ING/-S [ME *frustraten*, fr. L *frustratus*, past part. of *frustrare*, *frustrari* to deceive, disappoint, frustrate, fr. *frustra* in error, in vain; akin to L *fraud-*, *fraus* deception, fraud — more at FRAUD] **1 a** : to check, balk, or defeat in an endeavor or purpose : prevent from attaining (<*frustrated* by army routine —Darrell Berrigan) (<*frustrated* by a blank wall of suspicion . . . and bureaucratic inertia —H.W.Carter) **b** : to induce feelings of frustration or discouragement in (<brought the short story to a harsh perfection that ~s contemporary short-story writers —Alfred Kazin) (<the story of a personality *frustrated* by the practical temper of America —J.D.Hart) **2 a** : to make ineffectual : bring to nothing : DEFEAT, BAFFLE, FOIL (<nature . . . supports as well as ~s our lofty aspirations —H.J. Muller) (<illness *frustrated* his plans for college) (<did all they could to ~ . . . the inquiry —William McFee) **b** : to make null or ineffectual : make invalid or of no effect : NULLIFY
syn THWART, BALK, FOIL, BAFFLE, OUTWIT, CIRCUMVENT:
 . . . indicates a check, repelling, defeating of a sort that

frus-tu-lur
 small piece
 Roman C
frus-tum \-təmz\ or
 \-trəmz\
 ML & L; M
 L *frustum*
 part of a
 base and f
 a plane p
 part of a
 intersected
 either par
 each other
 shaft of a
fru-tes-ces
 quality or
fru-tes-ce
frutex shr
 appearance
fruti- *com*
fru-ti-ce-l
 fr. L, plac
 lection o
 botanical
fru-ti-cos
 shrub +
 OHG *br*
 in the for
 themum)
 lichen :
 cylindrical
fru-ti-cu-
 (dim. suf
fru-ti-lla
 ML *fruct*
 : CHILEA
frwy *abbr*
fr \ˈfri
frire, fr.
 fr. Sht