EXPEDITED PROCEDURE
EXAMINING GROUP 3728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty.'s Docket: CIPRIANI=1B

In re Application of:	)	Group Art Unit: 3728
	)	
Giancarlo CIPRIANI	)	Examiner: S.T.N. LUONG
	)	
Appln. No.: 10/278,818	)	Confirmation No. 9186
	)	
Filed: October 24, 2002	)	Washington, D.C.
	)	
For: CARDBOARD BOX FOR CONTAINING AND DISPENSING LARGE QUANTITIES OF WIRE	)	January 26, 2005

REPLY: AMENDMENT AND REMARKS

NO Translation

Customer Service Window
Randolph Building, Mail Stop **AF**
401 Dulany Street
Alexandria, VA 22314

Sir:

Replying to the Office Action mailed October 26, please amend as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 12 of this paper.

Amendments To The Claims

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Claims 1-8 (Canceled).

9. (Currently Amended) A welding wire package ~~for~~ containing ~~and dispensing~~ a welding wire packaged as a coil of wire, the wire coil having an axis, axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top having an upper opening ~~for removing~~through which the welding wire is removed, one of the axially opposite ends of the wire coil supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil being maintained by said inwardly facing container

surfaces such that the coil axis is a vertical axis when said outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, said brake element descending within said internal container during the unwinding of the wire coil.

Claim 10. (Canceled)

11. Previously Presented) The welding wire package of claim 9, further including four triangular corner-pieces made of folded cardboard, said corner pieces having about the same height as said outer box and which are interposed between said inner container and said outer box at the vertically extending corners of said outer box when said internal container is fitted into said outer box.

Claim 12. (Canceled)

13. (Currently Amended) ~~The welding wire package of claim 9,~~ A welding wire package for containing a welding wire packaged as a coil of wire, the wire coil having an axis, axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top having an upper opening for removing the welding wire, one of the axially opposite ends of the wire coil supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil being maintained by said inwardly facing container surfaces such that the coil axis is a vertical axis when said outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, said brake element descending within said internal container during the unwinding of the wire coil;

further including a retainer element positioned over said brake element that exerts a downward force on said brake element to maintain said brake element and said wire coil while said package is being transported.

14. (Previously Presented) The welding wire package of claim 13, wherein said downward force is produced by an elastic element extending between said retainer element and said outer box bottom.

Claims 15-17. (Canceled)

18. (Previously Presented) The welding wire package of claim 9, wherein said package is recyclable.

Claim 19 (Canceled)

20. (Previously Presented) The welding wire package of claim 9, wherein said brake element is annular and substantially corresponds in area to that of said other of the axially opposite ends of the wire coil.

21. (Canceled)

22. (Currently Amended) A welding wire package containing a welding wire packaged as a coil of wire as the welding wire is unwound when being dispensed, the wire coil having an axis, axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top

having an upper opening ~~for removing~~ from which the welding wire is removed, one of the axially opposite ends of the wire coil adapted to be supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil adapted to be maintained by said inwardly facing container surfaces such that the coil axis is a vertical axis when said outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, while the welding wire is unwound and dispensed.

Claims 23-25 (Canceled)

26. (Currently Amended) ~~The welding wire package of claim 25,~~ A welding wire package for containing a welding wire packaged as a coil of wire, the wire coil having an axis,

axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top having an upper opening for removing the wire, one of the axially opposite ends of the wire coil supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil being maintained by said inwardly facing container surfaces such that the coil axis is a vertical axis when said outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, said brake element descending within said internal container during the unwinding of the wire coil;

further including a flat octagonal element within said internal container, the wire coil resting on said flat element; and

wherein said flat octagonal element fits snugly into said internal container.

27. (Currently Amended) A welding wire package ~~for~~ containing ~~and dispensing~~ a welding wire packaged as a coil of wire, the wire coil having an axis, axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top having an upper opening ~~for removing~~ through which the welding wire is removed, one of the axially opposite ends of the wire coil supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil being maintained by said inwardly facing container surfaces such that the coil axis is a vertical axis when said

outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a flat octagonal element within said internal container that is positioned between the wire coil and said bottom of said outer box; ~~and~~

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, said brake element descending within said internal container during the unwinding of the wire coil.

28. (Currently Amended) A welding wire package for containing and dispensing a welding wire packaged as a coil of wire, the wire coil having an axis, axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top having an upper opening for removing the wire, one of the axially opposite ends of the wire coil supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base

area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil being maintained by said inwardly facing container surfaces such that the coil axis is a vertical axis when said outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a flat octagonal element within said internal container that is positioned between the wire coil and said bottom of said outer box;

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, said brake element descending within said internal container during the unwinding of the wire coil; and

wherein said flat octagonal element fits snugly into said internal container;

29. (Currently Amended) A welding wire package ~~for~~ containing and dispensing a welding wire packaged as a coil of wire, the wire coil having an axis, axially opposite ends and an axially extending outer periphery about the axis, said package comprising:

a cubic square-base outer box having inwardly facing and outwardly facing box side surfaces, a bottom and a top

having only an upper opening ~~for removing~~ from which the welding wire is removed, the outer box having no other opening for removing the wire elsewhere, one of the axially opposite ends of the wire coil supported by said outer box bottom;

an octagonal-base internal container having inwardly facing and outwardly facing container surfaces and being of such dimensions as to be fully containable within said square-base area of said outer box such that portions of said outwardly facing container surfaces are supported by portions of said inwardly facing box side surfaces, the outer periphery of the packaged coil being maintained by said inwardly facing container surfaces such that the coil axis is a vertical axis when said outer box is resting on said bottom, said internal container having about the same height as said outer box and having a top opening;

a bottom side of a brake element engaged on the other of the axially opposite ends of the wire coil and within said internal container, said brake element descending within said internal container during the unwinding of the wire coil.

REMARKS

Applicant has carefully reviewed the Examiner's October 26, 2004, Official Action and respectfully requests reconsideration based on the above amendments and the following comments.

Claims 10, 12, 15-17, 19, 21, and 23-25 have been canceled. Claims 9, 11, 13, 14, 18, 20, 22 and 26-29 remain in the application for consideration.

Applicant respectfully requests that the finality of the Examiner's October 26, 2004 office Action be withdrawn.

While the Examiner is correct that Applicant provided the English abstract of FR '255, this was done on the basis that FR '255 was cited as prior art in the form of the submitted abstract by a foreign patent office, and its submission was required as prior art by the U.S. Patent and Trademark Office. Accordingly, the Examiner's suggestion that Applicant has a translation of FR '255 is not correct and FR '255 remains subject to Section 706.02 of the MPEP. As such, the following language from that section applies to FR '255 whether ornot Applicant provided the abstract of FR '255:

> If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying

> upon the abstract or the full text document to support a rejection.

While Applicant has provided an English abstract, the Examiner has neither indicated whether she is relying upon this abstract nor provided a full text translation to support the rejections based on FR'255 as required by MPEP §706.02. Clearly, the full text of FR '255 may not support the Examiner's description of the FR '255 container and ay be inconsistent with the abstract description. Accordingly, Applicant is unable to determine the precise facts the Examiner is relying upon to support her rejection, and therefore the record is not clear.

Applicant submits that the finality of the Examiner's office action should be withdrawn and a new non-final action be provided, accompanied by an indication she is relying on the English abstract or is providing a translation of the FR'255 reference to enable Applicant to determine the facts upon which the Examiner is relying to support her rejection.

In the meantime, Applicant has chosen to respond to the Examiner's rejection as best able on the basis of the English abstract in order to expedite prosecution. However, Applicant does not believe that this response in any way justifies the final office action by the Examiner based on the FR'255 reference, as that would be inappropriate in view of the above cited MPEP section.

Applicant further respectively traverses the Examiner's objection under 35 U.S.C. §132 that Applicant's August 6, 2004 amendments introduced new matter into the disclosure, objection to the disclosure under 35 U.S.C. §112, first paragraph, and rejection of claims 9-29 under 35 U.S.C. §112, first paragraph and second paragraph.

In this regard, Applicant incorporates by reference, its remarks on page 15, line 10 through line 10 on page 16 of its August 6, 2004 response, wherein Applicant maintains that the specification clearly provides the basis for its position that brake element 12 is clearly engaged to the top end of coil 3.

In addition, Applicant notes that elastic band 9 produces a downward force which forces the ring into the wire coil and there is nothing in the specification or drawing that states the ring is supported by anything except for its engagement with the coil. Further, the Examiner should note the fact that the drawings consistently use spacing between the components of the packaging to better show the individual components of the invention. Eliminating this spacing would make the figures more difficult to read. Nothing in the specification or drawings indicates anything other than the ring being supported by the wire coil.

Accordingly, Applicant respectfully submits that the Examiner's objection under 35 U.S.C. §132, objection to the disclosure and rejection of claims 9-29 under 35 U.S.C. §112, first and second paragraph have now been overcome.

Applicant thanks the Examiner for her indication that claims 13, 14, 26 and 28 are allowable subject to overcoming her 35 U.S.C. §112, second paragraph rejection. In response, Applicant has rewritten claims 13, 14, 26 and 28 in independent form. Accordingly, Applicant respectfully submits that claims 13, 14, 26 and 28 are now allowable.

The Examiner has further rejected claims 9, 11, 18, 20, 22, 27 and 29 under 35 U.S.C. §103(a) as being unpatentable over FR '255 in view of Cirpriani '862 or Whearley '565. Applicant respectfully traverses this rejection especially as applied to independent claims 9, 22, 27, and 29 as amended.

Applicant notes that claims 9, 22, 27 and 29 have been amended to clarify that the welding wire package and welding wire formed as a coil are claimed in the combination and that the welding wire is removed through the top opening of the package.

These amendments are based on the Examiner's comment on page 4 of her October 26, 2004 Office Action that, "As long as the container can hold a welding wire that Applicant has not claimed in combination, then it is combinable with the secondary

references." As the welding wire is now claimed in combination with the package, Applicant submits that FR '255 is now not combinable with the secondary references.

This is further supported by the fact that the abstract of FR'255 indicates that it is limited to a case for bulk liquid or powdered products which are emptied by opening a pair of flaps located at the bottom edge of the case. There is no indication whatever that the case could be used for wire coils which could be removed from an upper opening in the case. Indeed, Applicant submits that once liquid or powder is introduced into the case, flaps 2 would be sealed, eliminating any upper opening and precluding the removal of any product enclosed in the case through an upper opening as claimed. As such, Applicant submits that there is no motive, incentive or teaching to first include a wire coil in the case and thereafter engage the brake element of either Cipriani or Whearley over the coil especially since FR'255 teaches that the liquid or powder product in the case is emptied by opening the pair of flaps located at the bottom edge of the case without opening the sealed flaps 2 on the top of the case.

Applicant respectfully submits that the combination of FR'255 and Cipriani or Whearley can only be based on the teaching of Applicant's disclosure as there is no teaching

whatever in the cited references of assembling the elements disclosed therein in the manner proposed by the Examiner.

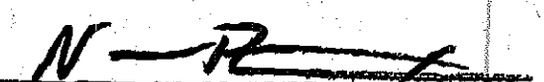
Finally, if the Examiner maintains that FR'255 has "an upper opening for removing the wire", Applicant would note that the FR'255 flaps at the bottom edge of the case create an additional opening for removing the wire. As such, claim 29 as amended is patentable over the cited combination, as it is limited to include only the upper opening.

Applicant submits that the invention is new and unobvious and not disclosed by the cited art. Accordingly, Applicant respectfully solicits the Examiner's early review and issuance of this application.

Applicant submits that the invention is new and unobvious and not disclosed by the cited art. Accordingly, Applicant respectfully solicits the Examiner's early review and issuance of this application.

Respectfully submitted,

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