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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte W. PERRY DOWST and DWIGHT C. ASPINWALL

Appeal 2010-006993
Application 10/603,947
Technology Center 3700

Before: JENNIFER D. BAHR, GAY ANN SPAHN, and
CHARLES N. GREENHUT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 106-160. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to a heating vessel. Claim 106, reproduced below, with emphasis added, is illustrative of the claimed subject matter:

106. A portable heating system comprising:

a vessel having enclosed sides, *a thermally conductive bottom end* and a top end forming an opening for the introduction and extraction of contents to be heated, the bottom end having an external bottom side for receiving heat;

a top housing having a top rim coupled circumferentially to the external bottom end of said vessel, a side structure extending downwardly from said top rim and having a plurality of exhaust vents formed therein, and a bottom rim;

a single thermally conductive member comprising a continuous piece of material fixedly attached to and positioned adjacent to and extending continuously along the entire extent of a peripheral edge of the external bottom side and having an inner peripheral edge defining an inner diameter and an outer peripheral edge defining an outer diameter, the conductive member having a plurality of undulating protrusions extending downwardly from the external bottom side;

a burner having a heat outlet head disposed below and in a central position with respect to said external bottom side and having a fuel intake port configured to couple to a fuel source, the heat outlet head having a diameter less than said thermally conductive member inner diameter and being configured to deliver heat to a central area of the external bottom side;

a bottom housing configured to couple to the bottom rim and substantially encasing the heat source, the bottom housing having a plurality of air inlet vents formed therein.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Goerl	US 2,154,305	Apr. 11, 1939
Robbins	US 4,374,489	Feb. 22, 1983
Horner	GB 882,881 A	Nov. 22, 1961
Barrard	FR 2446097 A1	Aug. 8, 1980
Nusser	DE 3339848 A1	May 15, 1985
Chen	FR 2816395 A3	May 10, 2002

REJECTIONS

Claims 151-160 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Ans. 3.

Claims 151 and 152 are rejected under 35 U.S.C. § 102(b) as being anticipated by Goerl. Ans. 4.

Claims 106-116 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goerl and Horner. Ans. 5.

Claims 117-149 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goerl, Horner, and Nusser. Ans. 8.

Claims 153-160 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goerl and Barrard. Ans. 11.

OPINION

The Examiner rejected claim 151 under 35 U.S.C. § 112, second paragraph because, due to the lack of antecedent basis, it is unclear whether “the external bottom end” imposes an additional limitation on the previously recited “bottom end” or if Appellants intended to refer to either the

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previously recited “bottom end” or “external bottom side.”¹ The thrust of Appellants’ arguments regarding the Examiner’s rejections of claims 151 and 153 under 35 U.S.C. § 112, second paragraph, is that, though the Examiner is technically correct, one skilled in the art would recognize what Appellants intended to recite.

As compared to cases arising in the litigation context (*see* App. Br. 8), claims can be amended during prosecution before the PTO. “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). An exploration of the meaning of the words recited in a claim is not an exploration into what words Appellants intended to recite. Since “[i]t is the applicants’ burden to precisely define the invention, not the PTO’s,” we sustain the Examiner’s rejection of claims 151 and 153 under 35 U.S.C. § 112, second paragraph. *See In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Regarding the Examiner’s rejection of claim 152 under 35 U.S.C. § 112, second paragraph, since “its” is in the clause defining the bottom housing, we agree with Appellants that one skilled in the art would understand “its top rim” to refer to that of the bottom housing. App. Br. 7. Further, one skilled in the art would understand that the top rim *is* the “shape or form” (*see* Ans. 4) of the bottom housing that must face, i.e., be oriented toward², the vessel top. Thus, we do not sustain the Examiner’s rejection of

¹ Claim 106 appears to suffer from a similar flaw and should be corrected in any further prosecution.

² face. (2000, 2007). In *The American Heritage® Dictionary of the English Language*. Retrieved from <http://www.credoreference.com/entry/hmdictenglang/face>.

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claim 152 under 35 U.S.C. § 112, second paragraph, for the reasons set forth by the Examiner. However, we do sustain this rejection based upon dependency.

Turning to the prior-art rejections, the Examiner found that Goerl discloses each and every element of independent claim 151, and the basic structure of independent claims 106, 117, 129, and 140. However, with regard to the independent claims, the sole issue raised by Appellants concerning Goerl is that the Examiner incorrectly interpreted the “bottom end” of the vessel as including the combination of the circular bottom 31, annular portion 32, and lower wall portion 33 of Goerl’s pan 13. App. Br. 9-10, 13. Appellants contend that only the circular bottom 31 of Goerl’s pan can be reasonably interpreted as the recited “bottom end.” For purposes of claims 106, 117 and 151, as Appellants point out (App. Br. 9, 12), if Appellants’ proposed construction is correct, Goerl would lack a top housing having a top rim coupled circumferentially to the external bottom end of said vessel, since Goerl’s bead 53, interpreted by the Examiner as the recited “top rim [of the top housing],” only couples to annular portion 32 and lower wall portion 33 of Goerl’s pan.³

Appellants contend that, while Goerl’s elements 31, 32, and 33 may be on a bottom side of the vessel, they are not on a bottom end.⁴ App. Br. 9.

³ Even if Appellants were correct in their proposed construction of “bottom end,” since the circumferential coupling limitation is absent from claims 129 and 140, it would be inconsequential since there is no dispute that the bottom 31 of Goerl’s pan is reasonably construed as such.

⁴ In light of this argument, if the ambiguity described with regard to the rejections under 35 U.S.C. § 112, second paragraph, were resolved such that “the external bottom end” referred to “the external bottom side,” apparently, there would be no dispute regarding this issue. For the sake of completeness,

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While Appellants quote various definitions of the term “end,” Appellants make no assertion of which definition or definitions are the most appropriate. App. Br. 10; *See Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300 (Fed. Cir. 2003); *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1299 (Fed. Cir. 2007). Appellants simply conclude, without further explanation, that there is no reasonable basis for the Examiner’s interpretation. App. Br. 10.

The third and sixth definition proffered by Appellants are “a part . . . adjacent to an extremity” and “the concluding part,” respectively. Goerl’s pan has an upper cylindrical part defined by wall 34 and a lower frustoconical part defined by lower wall 33 and bottom 31. If Goerl’s pan 13 has an upper and lower extremity, as viewed in Figure 8, we see no reason why the part of Goerl below the cylindrical upper part should not be considered a part adjacent to the lower extremity, or a concluding part of the bottom of the pan. Thus, the structure cited by the Examiner meets at least the third and sixth definitions of “end” proffered by Appellants. The functional differences between Goerl and Appellants’ preferred embodiment (App. Br. 10) are noted. However, “the name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998).

Regarding claim 152, the Examiner correctly concluded that Goerl’s burner member 17, even if inverted from the orientation shown in Figure 8, could be at least partially contained within Goerl’s pan 13. Ans. 15. The crux of Appellants’ argument concerning claim 152 is that “contained within” should be construed to require that the entire bottom housing can be placed and or confined, in its upright position, entirely within the vessel.

we will resolve this issue as if “the external bottom end” read “the bottom end” as Appellants suggest it should. App. Br. 7.

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Reply Br. 3. Appellants do not apprise us of any reason why the express words of the claim should be afforded such a narrow construction.

Appellants chose not to recite language in the claims limiting the claimed subject matter to that having the particular features of the preferred embodiment. *See e.g.*, fig. 4. We will not import limitations from the Specification to that effect. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

Appellants' remaining arguments are clearly unpersuasive. Since Horner expressly indicates that the invention disclosed therein is "applicable to heating appliances generally" (col. 2, ll. 59-60), Appellants' argument that one skilled in the art would only regard Horner's disclosure as relevant to tea kettles (App. Br. 13-14; Reply Br. 3-4) is clearly without merit. Appellants' argument concerning the insulating material 12 (App. Br. 15) of Nusser's cooking vessel 1 fails to address the Examiner's rejection based upon the teachings of Nusser regarding the ribs 3 or conducting surfaces 15. *See Ans. 17*. With regard to the Examiner's rejection based on the combination of Goerl and Barrard, Appellants, apparently citing figure 8 of Goerl, merely point out that Goerl lacks the feature that the Examiner relied upon Barrard to teach. *See App. Br. 15-16*. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Further, Appellants do not appear to contest the Examiner's taking of official notice that it is known to place an igniter in the fuel stream. *See Ans. 12*. Appellants appear to contest only the Examiner's explanation of how such an igniter would be structurally incorporated into Goerl. App. Br. 16. That some structure of Goerl might have to be modified or repurposed to incorporate an igniter does not demonstrate that it would

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have been nonobvious to do so. The fact that judgment and mechanical skill may be required to arrive at a particular combination does not necessarily mean that particular combination constitutes a nonobvious invention.

Graham v. John Deere Co., 383 US 1, 10-12 (1966) (discussing *Hotchkiss v. Greenwood*, 11 How. 248 (1851)).

DECISION

The Examiner's rejections are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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