



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/306,897	11/29/2011	Keith James Hensel	BRE1139U	7942
33372	7590	11/22/2016	EXAMINER	
MICHAEL MOLINS MOLINS & CO. PTY. LTD. SUITE 6, LEVEL 1 88 MOUNTAIN STREET ULTIMO NSW, 2007 AUSTRALIA			HOANG, TU BA	
			ART UNIT	PAPER NUMBER
			3742	
			MAIL DATE	DELIVERY MODE
			11/22/2016	PAPER

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEITH JAMES HENSEL

Appeal 2013-010777
Application 13/306,897
Technology Center 3700

Before MICHAEL L. HOELTER, LYNNE H. BROWNE, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Keith James Hensel (Appellant) appeals under 35 U.S.C. § 134 from the rejection of claims 1–8. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A motorised citrus press having two switches for safety purposes comprising:
 - a housing containing a motor for driving a rotating reamer;
 - the housing having attached to it an actuating arm;
 - the arm being hinged to the housing at one end and having a handle at a free end;
 - the arm supporting for movement toward the reamer, a fruit dome, having a path toward the reamer;
 - the movement of the arm causing an activation of a first switch that is associated with the motor;
 - the reamer being mechanically associated with a second switch such that pressure on the reamer activates the second switch;
 - the motor receiving electrical power for the reamer only when both the first and second switches cooperate.

REFERENCES

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

Hurst	US 1,838,626	Dec. 29, 1931
Elliott	US 1,933,621	Nov. 7, 1933
De Zarate	US 4,706,559	Nov. 17, 1987
Capdevila	US 4,716,823	Jan. 5, 1988
Seul	US 2003/0179645 A1	Sept. 25, 2003

REJECTIONS

- I. Claims 1–3 and 5 stand rejected under 35 U.S.C § 103(a) as unpatentable over De Zarate and Seul.
- II. Claim 4 stands rejected under 35 U.S.C § 103(a) as unpatentable over De Zarate, Seul, and Capdevila.

- III. Claim 6 stands rejected under 35 U.S.C § 103(a) as unpatentable over De Zarate, Seul, and Elliott.
- IV. Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over De Zarate, Seul, and Hurst.

DISCUSSION

Rejection I

Claims 1 and 2

Claim 2 depends from independent claim 1. Appellant does not present separate arguments for the patentability of claim 2. *See* Appeal Br. 16. Accordingly, claim 2 stands or falls with claim 1.

The Examiner finds that De Zarate discloses all of the limitations of claim 1 except for “the motor receiving electrical power for the reamer only when both the first and second switches cooperate.” Final Act. 3. In particular, the Examiner finds that De Zarate discloses “a first switch that is associated with the motor (micro-switch 34); the first switch is only activated when the fruit dome has traveled at least to an intermediate waypoint along the path toward the reamer.” *Id.* at 2, Ans. 3–4 (citation omitted). The Examiner finds that “De Zarate teaches the reamer being mechanically associated with a second switch (micro-switch 39) such that pressure on the reamer activates the second switch.” Final Act. 2–3, Ans. 4 (citing col. 3, ll. 1–5). The Examiner notes that De Zarate’s second switch is an alternative to its first switch. In addition, the Examiner finds that “Seul teaches an electric mixer that describes two switches cooperating to rotate the motor, i.e. provide electrical power.” Final Act. 3, Ans. 4 (citing ¶ 5). Based on these findings, the Examiner determines that it would have been obvious “to include the feature of multiple, cooperating switches as taught

Appeal 2013-010777
Application 13/306,897

by Seul, in order to provide for increased user safety during operation.”
Final Act. 3, Ans. 4.

Appellant contends that “[t]he Examiner has merely dissected a claimed invention into discrete features for consideration, without considering the claims as a whole — including limitations imposed on the switches by the language of Claim 1 when read as a whole.” Appeal Br. 7; *see also* Reply Br. 2. In support of this contention, Appellant argues that “[t]he scope and content of *De Zarate* is limited to two distinct juice extractor embodiments that each use a single mechanically-activated switch.” *Id.* However, this fact is not in contention. Rather, the Examiner finds that *De Zarate* discloses alternative switches as discussed *supra*. Moreover, “in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle” and, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). Thus, Appellant’s argument is unconvincing.

Appellant further contends that “[t]he scope and content of *Seul* is limited, contrary to the examiners conclusion, to an electric mixer using only a single mechanically-activated switch.” Appeal Br. 8. In support of this contention, Appellant argues that “it would be understood that the scope and content of this teaching would be limited to a single mechanically-activated switch (5) used with a conventional power ‘on’ switch (10).” *Id.* However, claim 1 does not preclude the second switch from being a “power ‘on’” switch. Thus, Appellant does not apprise us of error.

Next, Appellant contends that *Seul* is nonanalogous art. *See* Appeal Br. 9. In support of this contention, Appellant argues that:

Seul is not from the field of endeavor pertaining to citrus presses or motorised citrus presses, and teaches an electric mixer that operates very differently to [] motorised citrus presses, *Seul* would not have commended itself to an inventor's attention in considering [] a safely problem that is particular to motorised citrus presses. Accordingly, *Seul* does not address the same or similar problem and is therefore not "reasonably pertinent."

Id.

Responding to this argument, the Examiner notes that "*Seul explicitly* states that the application is for fruit [which] further undermines applicant's argument." Ans. 9 (citing *Seul*, Abstract). Based on this fact, the Examiner determines that *Seul* is in the same field of endeavor as the instant invention.

See id.

The Specification states that "[t]he invention pertains to juicers and more particularly to a citrus juicer with improvements that contribute to ease of use and juicing efficiency." Spec. 1. However, we are not persuaded that simply because the Specification states that the invention pertains to juicers, juicers and only juicers is the field of endeavor. Rather, those who are knowledgeable about juicers likely have knowledge of other appliances for processing fruit, such as blenders and mixers. Accordingly, we agree with the Examiner that the field of endeavor is "kitchen appliances used to create juice." Ans. 9. Thus, Appellant's argument that *Seul* is not in the same field of endeavor as the instant invention is unconvincing. Accordingly, *Seul* qualifies as analogous art under the first test defining the scope of analogous prior art.

Further, as noted by Appellant:

Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is

Appeal 2013-010777
Application 13/306,897

reasonably pertinent to the particular problem with which the inventor is involved.[]

Appeal Br. 8 (citing *In re Klein*, 647 F.3d 1343 (Fed. Cir. 2011); *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)). As quoted *supra*, based on the fact that *Seul* is not a juicer, Appellant argues that *Seul* is not reasonably pertinent to a problem with which the inventor was involved. *See id.* at 9. However, Appellant does not explain why *Seul* is not pertinent to a problem with which the inventor was involved.

Seul provides a safety switch in addition to a power switch. *See, e.g., Seul* ¶ 26. Thus, *Seul* is pertinent to safety-related problems. The instant invention is also concerned with problems related to safety. Thus, *Seul* is pertinent to a problem with which Appellant is involved and, as such, qualifies as analogous art under the second test defining the scope of analogous prior art.

Appellant also argues that “the substantial differences in structure, function and problem solved between *Seul* and the claims at issue clearly establish that this reference is non-analogous art.” Appeal Br. 10. However, as discussed *supra*, “substantial differences” is not one of the tests for determining the scope of analogous art. Accordingly, Appellant’s argument is unconvincing.

Next, Appellant argues that “[t]he Examiner has not provided evidence of any such teaching, suggestion or motivation — other than based on hindsight derived from the present application — to motivate a person of ordinary skill in the art at the time of the invention to increase user safety during operation.” Appeal Br. 10. This argument is foreclosed by *KSR*, in which the Court rejected the rigid requirement of a teaching or suggestion or motivation to combine known elements in order to show obviousness. *KSR*,

550 U.S. at 415. The Court noted that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.¹ Further, to the extent that Appellant is arguing that the Examiner fails to articulate reasons for the proposed modification, Appellant’s argument is unconvincing, because the Examiner reasons that it would have been obvious “to include the feature of multiple, cooperating switches as taught by Seul, in order to provide for increased user safety during operation.” Final Act. 3.

In addition, Appellant argues that “Seul does not include any one of the claimed features: actuating arm supporting a fruit dome and hinged to a housing; a motorised rotating reamer; first switch mechanically actuated by movement of the arm, second switch mechanically actuated by pressure applied to the reamer.” Appeal Br. 10. Although Appellant is correct, this is not indicative of error as the rejection lies on De Zarate, not Seul, to meet these limitations of claim 1.

Appellant further argues that the rejection is improper because “(a) a person of ordinary skill in the art would not have a reasonable expectation of success in making the claimed device; and (b) the Examiner applied impermissible hindsight reasoning to make the combination.”² Appeal Br.

¹ Appellant cites several cases that predate *KSR* (*e.g.*, *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)) (Appeal Br. 10). In the interest of brevity, we do not address each of the obviousness arguments based on these cases, as such arguments are foreclosed by *KSR*.

² Appellant repeatedly argues that the rejection relies upon impermissible hindsight. *See e.g.*, Appeal Br 13–15; Reply Br. 1. In the interest of brevity, we respond to all instances of this argument *infra*.

12. However, with respect to argument (a), switches are electronic devices whose performance characteristics can be determined by those skilled in the art. Appellant provides no evidence or persuasive argument that this is not the case or that the results of the proposed combination are not reasonably predictable. Absolute predictability that the modification will be successful is not required, all that is required is a reasonable expectation of success. *See In re O'Farrell*, 853 F.2d 894, 903–04 (Fed. Cir. 1988). Furthermore, with respect to argument (b), Appellant does not identify any knowledge relied upon by the Examiner that was gleaned only from Appellant's disclosure and that was not otherwise within the level of ordinary skill at the time of the invention. Thus, Appellant's assertion of hindsight is not persuasive. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Next, Appellant argues that “*De Zarate* teaches away from the claimed invention by showing only alternative embodiments (one teaching a preferred citrus press and the other a ‘simplified’ citrus press), each comprising only a single mechanically activated safety switches.” Appeal Br. 13. Appellant's argument is unconvincing because “teaching away” requires that the reference “criticize, discredit, or otherwise discourage” the use of other alternatives. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Appellant identifies no such teaching. Thus, Appellant does not apprise us of error.

Appellant further contends that:

De Zarate and *Seul*, even if combined, would only teach use of a single mechanically operated safety switch in combination with a conventional user activated power on switch — ***not*** a first switch activated by movement of the arm; and second switch activated by pressure on the reamer; wherein the motor is powered only when both the first and second switches cooperate according to the invention defined by Claim 1.

Appeal 2013-010777
Application 13/306,897
Appeal Br. 13, 15.

Appellant's argument is not responsive to the rejection as articulated by the Examiner. The rejection does not propose replacing De Zarate's second switch with Seul's second switch. *See* Final Act. 2–3. Rather, the rejection proposes using both of De Zarate's switches at the same time based on Seul's teachings of a switch (Seul's safety switch 5, which will not operate except in cooperation with Seul's off switch 11). *See id.*; *see also* Seul ¶ 26. Thus, Appellant does not apprise us of error.

In addition, Appellant argues that:

The present inventor discovered ergonomic and safety issues for citrus presses (Spec, page 10 line 32 – page 11 line 3). Therefore, the knowledge that the problem even existed, let alone the solution to it, was not “within the level of ordinary skill in the art at the time the claimed invention was made.”

Appeal Br. 14; *see also* Reply Br. 2. However, it is not necessary for the prior art to serve the same purpose as that disclosed in Appellant's Specification in order to support the conclusion that the claimed subject matter would have been obvious. *See KSR*, 550 U.S. at 419 (“In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the [Appellant] controls.”); *see also In re Linter*, 458 F.2d 1013, 1016 (CCPA 1972).

Appellant also argues that “[t]he Examiner, by relying on mere conclusory statements that *De Zarate* and *Seul* would be combined without out any evidence on how such a modification could even be implemented, has not established a prima facie case of obviousness against Claim 1.” Appeal Br. 15 (emphasis omitted). However, “it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.” *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983)

Appeal 2013-010777
Application 13/306,897

(citation omitted). The relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the combined teachings of those references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). Thus, Appellant does not apprise us of error.

In the Reply Brief, Appellant for the first time and not in response to an argument raised in the Answer, argues that “[t]he Examiner has made no meaningful findings regarding the level of ordinary skill in the art” and that “‘built-in’ two stage or two step protection that does not require any user input other than using the device is nowhere seen in any of the art of record.” Reply Br. 1, 2. In accordance with 37 C.F.R. § 41.41 (b)(2), lacking a showing of good cause, we do not consider arguments raised in the Reply Brief which are not responsive to an argument raised in the Answer.

For these reasons, we sustain the Examiner’s decision rejecting claim 1, and claim 2, which falls therewith. As some of our reasoning differs from the Examiner’s, we designate our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b).

Claim 3

The Examiner finds that in De Zarate “the first switch is only activated when the fruit dome has traveled at least to an intermediate waypoint along the path toward the reamer (as shown in Fig. 1, activation occurs as cap 33 moves towards extractor head 25).” Final Act. 2.

Appellant argues that De Zarate does not support the Examiner’s finding. *See* Appeal Br. 16. We agree. With regard to the activation of

Appeal 2013-010777
Application 13/306,897

microswitch 34, De Zarate merely states “[t]here is a micro-switch 34 on the fixed arm 29 designed to activate the motor and provided with a push button worked by the cam 35 of the lever arm 30.” De Zarate 4:43–46 (emphasis and dashes omitted). De Zarate does not describe when micro-switch 34 is activated nor is it readily apparent from Figure 1 when activation occurs. Accordingly, the Examiner’s finding is speculative and not supported by a preponderance of the evidence.

For this reason, we do not sustain the Examiner’s decision rejecting claim 3.

Claim 5

Claim 5 is subject to a new ground of rejection under 35 U.S.C. § 112, second paragraph, discussed *infra*. Having determined that claim 5 is indefinite, we cannot sustain the rejection of this claim under 35 U.S.C. § 103(a) because to do so would require speculation as to the scope of the claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (Holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a)).

Rejection II

The Examiner determines that De Zarate and Seul “fail to teach: a portion of the arm contacts a cam surface on a switch actuator link, the switch actuator link acting to activate or deactivate the first switch.” Final Act. 3. The Examiner finds that “Capdevila teaches a juice extractor for industrial use that comprises a switch actuator link that activates a switch (circular cam 21 with an angular notch that, by means of a connecting device 22 closes or opens the circuit with a button 23 on microswitch 24; col. 3, ln. 10–20).” *Id.* Based on this finding, the Examiner reasons that it would have been obvious “to include the features of Capdevila, in order to provide for

Appeal 2013-010777
Application 13/306,897

more precise control of the reamer/extractor, thereby insuring a more responsive fruit and/or citrus press.” *Id.*

Appellant argues that “[t]he cam 35 of De Zarate (see Fig. 1) is not a cam according to Claim 4. In consideration of the claim as a whole, the location of the cam surface is defined as being on a switch actuator link. The cam 35 of De Zarate is on the actuating arm - not a switch actuator link.” Appeal Br. 17 (emphasis omitted).

Appellant’s argument is not responsive to the rejection as articulated by the Examiner, which relies on Capdevila, not De Zarate, to meet the limitations at issue. Accordingly, Appellant does not apprise us of error.

We sustain the Examiner’s decision rejecting claim 4. As claim 4 depends from claim 1, which we have designated as a new ground of rejection, we also designate our affirmance of the rejection of claim 4 as a new ground of rejection.

Rejection III

The Examiner determines that De Zarate and Seul “fail to teach: a collapsible quadrilateral hinge.” Final Act. 4. The Examiner finds that “Elliott teaches a fruit juice extractor with a collapsible quadrilateral hinge (arm members 22, 23 connected via hinge 28 form quadrilateral shape).” *Id.* Based on this finding, the Examiner reasons that it would have been obvious “to modify De Zarate and Seul to include the features of Elliott, in order to provide for greater flexibility of the arm/handle during use.” *Id.*

Appellant contends that Elliott does not teach a quadrilateral hinge. *See* Appeal Br. 18. In support of this contention, Appellant argues that “‘quadrilateral hinge’ is a term of art. A quadrilateral shape is a closed shape defined by four sides or edges — **not** a pair of hinged arm members.” *Id.* Responding to this argument, the Examiner repeats the finding that

Appeal 2013-010777
Application 13/306,897

“Elliott teaches a fruit juice extractor with a collapsible quadrilateral hinge (arm members 22, 23 connected via hinge 28 form quadrilateral shape).”

Ans. 12.

It is unclear how Elliott’s arms 22 and 23, together with hinge 28, form a collapsible quadrilateral shape. Thus, Appellant’s argument is convincing.

We do not sustain the Examiner’s decision rejecting claim 6.

Rejection IV

Appellant does not contest the rejection of claims 7 and 8. *See, generally*, Appeal Br. Accordingly, we summarily sustain the Examiner’s decision rejecting claims 7 and 8.

New Ground of Rejection

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 5 requires a “first switch [that] only cooperates with the first switch to cause rotation of the reamer when the path of the dome is generally linear.” Appeal Br. 22. It is unclear how the first switch can cooperate with itself.

DECISION

We enter a NEW GROUND OF REJECTION for claim 5 under 35 U.S.C. § 112, second paragraph.

The Examiner's rejections of claims 1, 2, 4, 7, and 8 are AFFIRMED and designated a NEW GROUND OF REJECTION.

The Examiner's rejections of claims 3, 5, and 6 are REVERSED.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides:

When the Board enters such a non-final decision, the [A]ppellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, [A]ppellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Appeal 2013-010777
Application 13/306,897

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)