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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CURTIS D. KNIGHT, JOSHUA ZIEBERT,
JUSTIN D. KESKE, DAWN VERTZ, AARON KUHLLOW,
and KEN HALL

Appeal 2015-006424
Application 13/659,958
Technology Center 2800

Before GEORGE C. BEST, AVELYN M. ROSS, and BRIAN D. RANGE,
Administrative Patent Judges.

RANGE, *Administrative Patent Judge.*

DECISION ON APPEAL

SUMMARY

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–3, 5–12, 15, and 16. We have jurisdiction. 35 U.S.C. § 6(b). We AFFIRM.

¹ According to the Appellants, the real party in interest is KOHLER CO. Appeal Br. 2.

STATEMENT OF THE CASE

Appellants describe the present invention as pertaining to a towable generator with a removable enclosure. Spec. ¶ 1. Claims 1 and 5, reproduced below with emphasis added to certain key recitations, is illustrative of the claimed subject matter:

1. A towable power generation system comprising:
 - an internal combustion engine;
 - an alternator driven by the internal combustion engine to generate electrical power;
 - a trailer configured to be attached to a vehicle that is adapted to tow the trailer;
 - a base attached to the trailer such that the internal combustion engine and the alternator are mounted on the base; and
 - an enclosure that houses the internal combustion engine and the alternator, wherein **the enclosure is detachably connected to the base using fasteners such that when the fasteners are removed only the enclosure is removed from the base and every other part of the towable generator remains in place, wherein the enclosure is removed from the base as one piece**, wherein the base has a perimeter such that a user has access to each part of the towable generator from around the entire perimeter of the base when the enclosure is removed from the entire perimeter of the base.

5. A towable power generation system comprising:
 - an internal combustion engine;
 - an alternator driven by the internal combustion engine to generate electrical power;
 - a trailer configured to be attached to a vehicle that is adapted to tow the trailer;
 - a base attached to the trailer such that the internal combustion engine and the alternator are mounted on the base; and
 - an enclosure that houses the internal combustion engine and the alternator, wherein the enclosure is detachably connected to the base using fasteners such that when the fasteners are removed only the

enclosure is removed from the base and every other part of the towable generator remains in place, wherein the towable generator further **includes a control panel that is attached to the base**, wherein the control panel includes wires that provide signals and power to other parts of the towable generator, wherein the control panel remains in place when the enclosure is removed from the base.

Appeal Br.² 25–26 (Claims Appendix).

REFERENCES

The Examiner relies upon the prior art below in rejecting the claims on appeal:

Frank	US 5,965,999	Oct. 12, 1999
Konop et al. (hereinafter “Konop”)	US 7,642,665	Jan. 5, 2010

ASI Specification 8565 – Weather Resistant Sound Attenuated Drop-Over Enclosure to Base OR UL-142/2085 Base/Tank with Sound Attenuated Fixed Intake Louvers (Aug. 27, 2008), <http://www.acousticalsheetmetal.com/Spec8565> (as obtained from web.archive.org on January 13, 2014) (hereinafter “ASI”).

REJECTIONS

The Examiner maintains the following rejections on appeal:

Rejection 1. Claims 1–3, 5–12, 15, and 16 under 35 U.S.C. § 103 as unpatentable over Konop in view of ASI. Ans. 2.

Rejection 2. Claim 10 under 35 U.S.C. § 103 as unpatentable over Konop and ASI in view of Frank. *Id.*

² In this decision, we refer to the Non-Final Office Action mailed September 30, 2014 (“Non-Final Act.”), the Appeal Brief filed February 9, 2015 (“Appeal Br.”), the Examiner’s Answer mailed April 23, 2015 (“Ans.”), and the Reply Brief filed June 18, 2015 (“Reply Br.”).

ANALYSIS

After having considered the evidence presented in this Appeal and each of Appellants' contentions, we are not persuaded that Appellants identify reversible error, and we affirm the Examiner's rejections for the reasons expressed in the Non-Final Office Action and the Answer. We add the following primarily for emphasis.

Rejections 1 and 2, claims 1–3, 7, 10–12, 15, 16. Appellants argue all claims on appeal (claims 1–3, 7, 5–12, 15, and 16) as a group and make no separate argument with respect to rejection 2. *See* Appeal Br. 8, 10, 20. Therefore, consistent with the provisions of 37 C.F.R. § 41.37(c)(1)(iv) (2013), we limit our discussion immediately below to claim 1. Appellants make additional arguments with respect to claims 5, 6, 8, and 9 (Appeal Br. 10–14), and we address those additional arguments after addressing claim 1. All other claims rise or fall with claim 1.

The Examiner rejects claim 1 as obvious over Konop in view of the ASI publication. The Examiner finds that Konop teaches the recited generator set recitations of claim 1 (for example, the internal combustion engine and alternator) as well as a trailer. Non-Final Act. 3–4 (providing numerous citations to Konop). The Examiner finds that “Konop fails to disclose the enclosure is removed from the base as one piece and the base has a perimeter such that a user has access to each part of the towable generator” Non-Final Act. 3–4. The Examiner, however, finds that ASI teaches “a drop over enclosure” for housing “each engine/generator and all accessories.” Non-Final Act. 4; *see also* ASI 1–2. The Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to design an enclosure that is

removable from the base as one piece . . . because that would make the generator more accessible to perform any maintenance or repairs.” Non-Final Act. 4. A preponderance of the evidence supports the Examiner’s findings and conclusion.

Before directly addressing Appellants’ arguments, we first assess the scope of claim 1. Claim 1 recites “an enclosure that houses the internal combustion engine and the alternator, wherein the enclosure is detachably connected to the base using fasteners such that when the fasteners are removed only the enclosure is removed from the base and every other part of the towable generator remains in place . . .” Appeal Br. 25 (Claims Appendix) (emphasis added). The emphasized portion of the recitation is functional because it describes how the apparatus behaves when the fasteners and enclosure are removed.

While a patent applicant may recite features structurally or functionally, “choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). In particular, where there is reason to believe that prior art structure is inherently capable of performing the claimed function, the burden shifts to the applicant to show that the claimed function patentably distinguishes the claimed structure from the prior art structure. *See id.*; *In re Hallman*, 655 F.2d 212, 215 (CCPA 1981) (affirming rejections where applicant failed to show that prior art structures were not inherently capable of functioning as claimed invention). Below, we address each of Appellants’ arguments with this legal framework in mind.

Appellants argue that the Examiner’s analysis is in error because ASI provides no description “relating to removing the enclosure . . .” Appeal

Br. 9. Appellants further argue that ASI does not discuss removing ASI in one piece. *Id.* The Examiner, however, finds that if the two-piece enclosure of Konop were substituted with the one-piece enclosure of ASI, the enclosure would be capable of being removed in one piece. Non-Final Act. 3–4. This finding is well-supported by the evidence. ASI describes a “drop over enclosure.” ASI Title, 1. ASI explains that the enclosure consists “of a roof, underframe, side walls, and walls” *Id.* at 1(e). The structure includes “[l]ifting provisions . . . at or near the enclosure base, with capacity and number suitable for rigging the entire assembly.” *Id.* at 1(j). Thus, ASI is best understood as teaching that the entire enclosure is lifted as one piece and set over the “engine/generator and all accessories” (*id.* at 1). If the enclosure can be placed as one piece over the engine/generator, it is also capable of being removed as one piece after it is set down. Appellants, meanwhile, have not made a convincing showing that the claimed structure is patentably distinct from the prior art structure or that ASI’s enclosure is incapable of being removed. *See In re Schreiber*, 128 F.3d 1473 at 1478.

Appellants argue that ASI’s teaching of attaching components such as drains and exhaust teach away from removing the enclosure. Appeal Br. 20 Reply Br. 1–2. This argument, however, fails to establish that the ASI enclosure is incapable of being removed especially if one considers the point in time prior to such components being attached or mounted. We further note that claim 1 does not require attachment of these components.

Appellants also argue that the Examiner improperly combined the teachings of Konop and ASI (Appeal Br. 14–20) because, for example, combining the ASI drop down enclosure with Konop would render Konop unsatisfactory for its intended purpose because it “would not permit lifting

of the base and the genset components mounted on the base. . . .” Appeal Br. 17. We find, however, that such lifting would have still been possible by removing the ASI enclosure. *See also* Ans. 4–5.

Appellants also argue that the references teach away from the combination because Konop describes a multi-component enclosure with rotatable pieces whereas ASI presents a one-piece drop-over enclosure. Appeal Br. 17–18. The prior art’s presentation of alternatives, however, without criticizing, discrediting, or discouraging the applied combination of references is not a teaching away. *See, e.g., In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (“The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the ’198 application.”). Konop and ASI both address covering a genset, and the fact that the Konop enclosure and ASI enclosure each present different advantages and disadvantages does not obviate motivation to combine in this instance. *Cf. Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine”).

Finally, Appellants argue that the proposed combination would require substantial reconstruction and change the principal of operation of Konop. Appeal Br. 19. The evidence, however, supports the Examiner’s position, that “the multiple enclosures of Konop are already capable of being removed and one having ordinary skill in the art would have come to the conclusion to use one enclosure as opposed to two separate enclosures to permit access to either of the engine of [sic, or] the generator.” Ans. 5.

Appellants have not identified reversible error with respect to the Examiner's rejection of claim 1. We therefore sustain the Examiner's rejection of claims 1–3, 7, 10–12, 15, and 16.

Rejection 1, claims 5 and 6. Claim 5 recites that the generator “includes a control panel that is attached to the base” Appeal Br. 25–26 (Claims Appendix). Claim 6 recites “the towable power generation of claim 5, wherein no wires need to be disconnected when the enclosure is removed from the base.” *Id.* at 26. The Examiner finds that Konop discloses a control panel attached to the base in Figures 21 and 22. Ans. 3; Non-Final Act. 6. Appellants argue that Konop does not state that the control panel is attached to the base and, at most, Konop teaches attaching a control panel to the enclosure's rear hood 206. Appeal Br. 10–11.

We begin with claim construction with respect to the recitation “a control panel that is attached to the base.” Appellants' Specification states, “[t]he towable power generation system 10 may further include a control panel 17 that is attached to the base 14.” Spec. ¶ 19. Figure 3 of the

Specification, reproduced below, depicts control panel 17 as being a large box that houses controls that abuts the trailer's base 14.

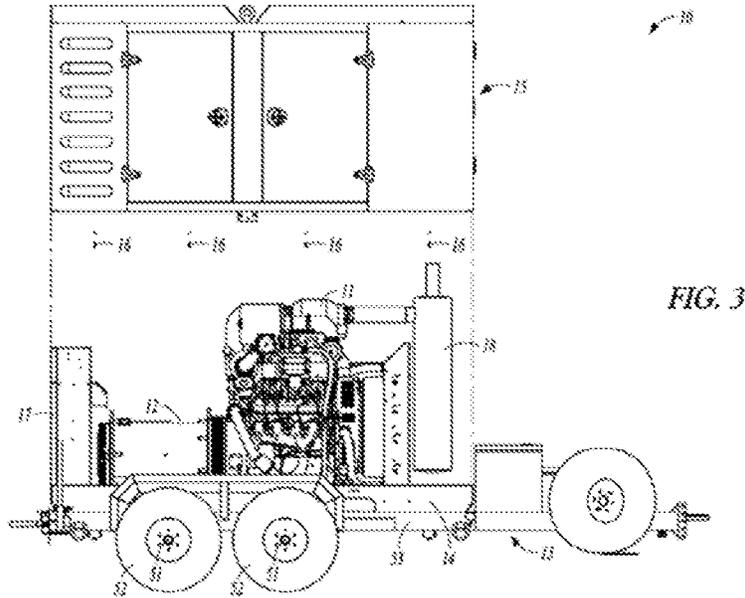


Figure 3 of the specification is an exploded side view of an example towable power generation system. Spec. ¶ 9. The Specification provides little other guidance as to what claim 5 means by “control panel” or what it means for the control panel to be “attached to the base.” Based on the Specification and the context of claim 5, the recitation “a control panel that is attached to the base” must at least be broad enough to encompass, for example, what Figure 3 depicts. We assess Appellants’ arguments with this construction in mind.

Contrary to Appellants’ argument, we do not agree that Konop teaches that the control panel is attached to the rear hood. Rather, Konop at col. 7, lines 41–53, indicates that the control panel may have connections to the rear hood, and Figure 26 of Konop, reproduced below, depicts “wiring

and operating controls area 238” being attached to the genset’s “rear panel 220.” Konop 7:38–39.

FIG. 26

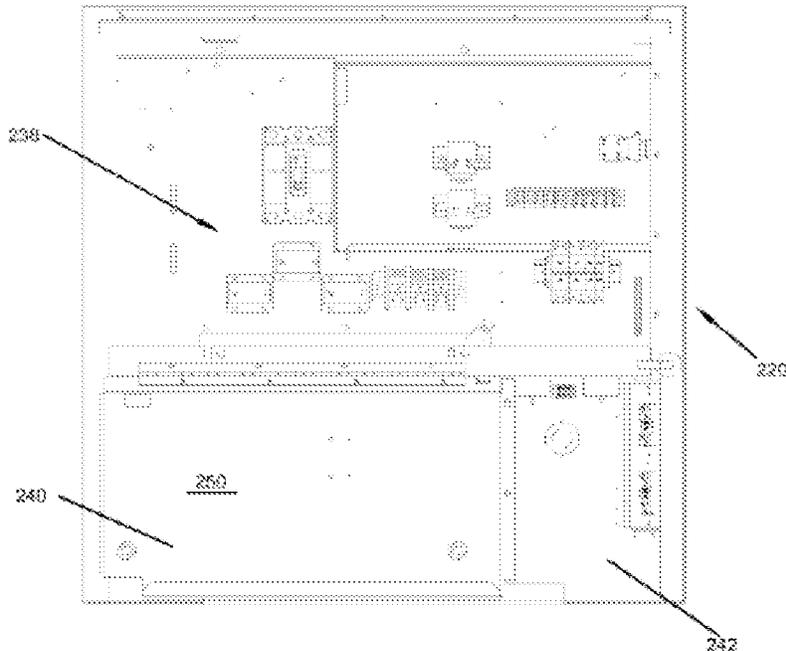


Figure 26 is an end view of a rear panel of a genset according to Konop’s disclosure, with a wiring enclosure exposed. *Id.* at 3:17–18.

A preponderance of the evidence supports the Examiner’s finding that the control panel of Konop is attached to the base. Ans. 3; Non-Final Act. 6. Figure 21 of Konop, for example, depicts an end view of the genset including the control panel (wiring and operational controls area 238). Konop 3:4–6; 6:51–64. The control panel is attached to base frame 202. *Id.* at Fig. 21; *see also id.* 5:62–66; Fig. 16A. Thus, the evidence supports that the control panel is attached to the base in essentially the same manner as depicted in Figure 3 of the Specification. Moreover, the Examiner has adequately explained that the ASI enclosure (when combined with Konop) is

capable of being removed without disturbing the control panel (Final Act. 6–7; Ans. 3).

Appellants argue, for example, that the references do not teach that “no wires need to be disconnected when the enclosure is removed from the base” (Appeal Br. 11–12), but, similar to claim 1, the ASI enclosure reasonably appears capable of being removed without disconnecting wires at least at the point in time after it is dropped over the genset (i.e., before additional wires are connected). Appellants have not identified convincing evidence of a structural distinction between the ASI/Konop combination and claims 5 or 6 in this regard. Because Appellants have not identified reversible error with respect to the Examiner’s rejection of claims 5 and 6, we sustain the rejection of these claims.

Rejection 1, claims 8 and 9. Claim 7 recites “[t]he towable power generation system of claim 1, wherein the towable generator further includes an exhaust system that is attached to the internal combustion engine to expel gases from the enclosure when the enclosure is attached to the frame.” Appeal Br. 26 (Claims Appendix). Claim 8 recites “[t]he towable power generation system of claim 7, wherein the exhaust system is not attached to the enclosure.” *Id.* Claim 9 recites “[t]he towable power generation system of claim 7, wherein the exhaust system remains in place when the enclosure is removed from the base.” *Id.*

Appellants argue that the ASI and Konop combination do not teach the recitations of claims 8 and 9 because ASI does not describe removing the enclosure. Appeal Br. 13. A preponderance of the evidence, however, supports the Examiner’s finding that the exhaust system would not have been attached to the ASI enclosure because it is a “drop over enclosure.”

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Non-Final Act. 10; *see also* Ans. 3–4. Because the ASI enclosure is dropped over, it would have been capable of being removed without disturbing the exhaust system at, for example, the point in time after it is dropped over the system. The exhaust system would not be attached to the enclosure at that point in time. Appellants therefore have not identified reversible error in the Examiner’s rejection of claims 8 and 9, and we sustain the Examiner’s rejection of these claims.

DECISION

For the above reasons, we affirm the Examiner’s rejection of claims 1–3, 5–12, 15, and 16.

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

AFFIRMED