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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/008,029	09/27/2013	Olivier Hoffmann	2011P00372WOUS	1047
46726	7590	01/22/2019	EXAMINER	
BSH Home Appliances Corporation 100 Bosch Boulevard NEW BERN, NC 28562			DODSON, JUSTIN C	
			ART UNIT	PAPER NUMBER
			3761	
			NOTIFICATION DATE	DELIVERY MODE
			01/22/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OLIVIER HOFFMANN, RADWANE OUMGHARI,
and MATTHIEU SCHNEIDER

Appeal 2017-006405
Application 14/008,029¹
Technology Center 3700

Before JILL D. HILL, GEORGE R. HOSKINS, and ERIC C. JESCHKE,
Administrative Patent Judges.

JESCHKE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Olivier Hoffman et al. (“Appellants”) seek review under 35 U.S.C. § 134(a) of the Examiner’s decision, as set forth in the Non-Final Office Action dated July, 7, 2016 (“Non-Final Act.”), rejecting claims 9–28. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify BSH Hausgeräte GmbH as the real party in interest. Appeal Br. 3.

BACKGROUND

The disclosed subject matter “relates to a steam cooking appliance, in particular a steam oven.” Spec. ¶ 1. Claim 9, the sole independent claim on appeal, is reproduced below:

9. A steam cooking appliance, comprising:
 - side walls defining a cooking space in which a food item is cooked by steam inside the steam cooking appliance, at least one of the side walls having an overflow opening;
 - an overflow line directly connected to the overflow opening and branching into an overflow drain and a steam exhaust tube, the steam exhaust tube being configured to channel steam from the cooking space; and
 - a steam valve provided on the steam exhaust tube and configured to reversibly change a cross section of the steam exhaust tube such that the change in cross section of the steam exhaust tube regulates a pressure of the steam inside the cooking space.

REJECTIONS

1. Claims 25 and 28 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention.^{2,3}

2. Claims 9–15, 19, 22, and 25–28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Segato (US 2008/0105138 A1, published May 8, 2008) and Eckenhausen (US 7,021,206 B2, issued Apr. 4, 2006).

3. Claims 16, 18, 23, and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Segato, Eckenhausen, and Frock (US 2009/0107477 A1, published Apr. 30, 2009).

4. Claim 17 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Segato, Eckenhausen, and Yamasaki (US 7,199,340 B2, issued Apr. 3, 2007).

5. Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Segato, Eckenhausen, and Nishtala (US 2009/0221933 A1, published Sept. 3, 2009).

² The Examiner states that “[t]he present application is being examined under the pre-AIA first to invent provisions” (Non-Final Act. 2), but then the Examiner appears to apply the AIA version of the relevant statute—i.e., 35 U.S.C. § 112(b) (*id.* at 2–3). We understand the Examiner to have intended to apply pre-AIA 35 U.S.C. § 112, second paragraph. The minor differences between the two versions of the statute, however, would not change the rejection or the analysis here.

³ The Examiner also rejected claims 19, 20, 22, and 27 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention, based on the phrase “elastically deformable.” *See* Non-Final Act. 3. In the Answer, the Examiner withdraws this part of the rejection. *See* Ans. 2 (§ 2).

DISCUSSION

Rejection 1 – The rejection of claims 25 and 28 under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 25 and 28, stating that “the recitation of ‘all valve actuating elements’ renders the claims indefinite as it is unclear what elements the applicant is intending to be encompassed.” Non-Final Act. 3.⁴

In the briefing, Appellants do not address the *current* indefiniteness rejection (based on the phrase “all valve actuating elements”), but rather, Appellants address a *now-withdrawn part* of the original rejection (based on the phrase “elastically deformable” (*see supra* note 3)). *See* Appeal Br. 6–7.

In the Answer, the Examiner states: “The rejection of claims 19–25, 27, and 28 under 35 U.S.C § 112[, second paragraph] regarding the indefiniteness of the phrase ‘elastically deformable’ is withdrawn.” Ans. 2. The Examiner does not otherwise address in the Answer the rejection under § 112, second paragraph.

Considering the record as a whole, we understand the Examiner to have withdrawn *both parts* of the original rejection under § 112, second paragraph—i.e., both (1) the rejection of claims 19, 20, 22, and 27 based on the phrase “elastically deformable” and (2) the rejection of claims 25 and 28 based on the phrase “all valve actuating elements.” *See* Non-Final Act. 2–3. As an initial matter, we note that the statement in the Answer quoted in the

⁴ Claim 25 recites: “The steam cooking appliance of claim 9, wherein all valve actuating elements of the steam valve are located outside the hose.” Appeal Br. 18 (Claims App.). Claim 28 recites: “The steam cooking appliance of claim 27, wherein all valve actuating elements of the steam valve are located outside the hose.” *Id.* at 19.

prior paragraph is internally contradictory. On the one hand, the narrowing language “regarding the indefiniteness of the phrase ‘elastically deformable’” would appear to indicate that the Examiner withdrew only the *first* part of the original rejection. *See* Ans. 2. On the other hand, the Examiner includes claims 25 and 28—only at issue in the *second* part of the original rejection—in the list of claims in which the rejection under § 112, second paragraph, was withdrawn. *Id.* In addition to the claim listing, also supporting that the Examiner withdrew *both parts* of the original rejection is that, in the Answer, the Examiner did not address Appellants’ failure to substantively argue the *second* part of the original rejection. *See id.*

To the extent the Examiner did not withdraw the second part of the original rejection under § 112, second paragraph, we determine that the Examiner has not made a prima facie case of indefiniteness in the rejection of claims 25 and 28 based on the phrase “all valve actuating elements.”

“Applying the broadest reasonable interpretation of a claim . . . , the Office establishes a prima facie case of indefiniteness with a rejection explaining how the metes and bounds of a pending claim are not clear because the claim contains words or phrases whose meaning is unclear.” *Ex parte McAward*, Appeal 2015-006416, 2017 WL 3669566, at *2 (PTAB Aug. 25, 2017) (precedential) (citing *In re Packard*, 751 F.3d 1307, 1310 (Fed. Cir. 2014) (per curiam)); *see also* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2173.02(III)(B) (9th ed., Rev. 08.2017, Jan. 2018) (“The Office action must set forth the specific term or phrase that is indefinite and why the metes and bounds are unclear. Since a rejection requires the applicant to respond by explaining why claim language would be recognized by a person of ordinary skill in the art as definite or by

amending the claim, the Office action should provide enough information for the applicant to prepare a meaningful response.”).

Here, the Examiner has not adequately explained why the phrase “all valve actuating elements” is unclear. The phrase would include “all” features that actuate the “steam valve” recited in the last clause of claim 9. *See, e.g.*, Spec. ¶ 35 (discussing Figures 4 and 5). For these reasons, to the extent this rejection was not previously withdrawn, we do not sustain the rejection of claims 25 and 28 under 35 U.S.C. § 112, second paragraph.

*Rejection 2 – The rejection of claims 9–15, 19, 22,
and 25–28 under 35 U.S.C. § 103(a)*

For this rejection, Appellants argue the patentability of independent claim 9, and do not provide separate arguments for claims 10–15, 19, 22, and 25–28, which depend from claim 9. Appeal Br. 7–10; Reply Br. 3–4. Thus, we address claim 9, with claims 10–15, 19, 22, and 25–28 standing or falling with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2016).

For claim 9, the Examiner relied on Segato for certain limitations, including aspects of the “steam valve” recited in the last clause, but stated that “Segato is silent on the steam valve being configured to reversibly change a cross section of the steam exhaust tube.” Non-Final Act. 5; *see also id.* at 4–7 (addressing claim 9). The Examiner found, however, that:

Eckenhausen teaches that it is known in the art of fluid dispensing that a valve (*Figure 3, Element 25*) can be configured to change a cross section of an exhaust tube (*Figure 3, Element 26-shown as a hose; element 38 acts on the outer diameter of element 26 narrowing the cross section from the outside; Col. 8, Lines 26-45 disclose that hose 26 is held in a normally closed condition to create a shut state, whereby no fluid is allowed to flow; In order to allow flow, the valve deactivates allowing hose*

26 to relax, thereby creating a two state condition-open and closed-thus implying a reversible change).

Id. at 6. According to the Examiner, it would have been obvious for one of ordinary skill in the art at the time of the invention

to modify the valve of Segato, already configured to regulate the pressure of the cooking space, to use the valve taught by Eckenhausen in order to employ a valve that avoids direct contact between the fluid being dispensed and the valve components, thereby increasing the operational longevity of said valve.

Id. at 7.

First, Appellants argue that “neither Segato nor Eckenhausen teach[es] or suggest[s] a steam valve” as recited in the last clause of claim 9. Appeal Br. 7.

Nonobviousness cannot be established by attacking prior art references individually when the rejection is based on the teachings of a combination of references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). By arguing that neither Segato nor Eckenhausen *alone* teaches *all* aspects of the clause at issue, Appellants do not address the rejection as articulated, in which the Examiner relies on certain *combined* teachings of the prior art. *See Non-Final Act. 4–7; Ans. 6–7; see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

Second, Appellants argue that “Eckenhausen is not available to the Examiner for use in a rejection because Eckenhausen is clearly non-analogous art” in that “Eckenhausen is neither within the field of Appellants’ endeavor nor reasonably pertinent to the particular problem with which Appellants were concerned.” Appeal Br. 8; *see also In re Bigio*, 381 F.3d

1320, 1325 (Fed. Cir. 2004) (“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 reasonably pertinent to the particular problem with which the inventor is involved.”).

A prior art reference that satisfies either test is considered analogous art. *See In re Kahn*, 441 F.3d 977, 987–88 (Fed. Cir. 2006). For the reasons below, we determine that Eckenhausen satisfies the “reasonably pertinent” test; thus, we do not address the “field of endeavor” test.

Appellants contend that they (as the inventors) “were concerned with the problem of controlling or regulating the setting of a desired pressure in a cooking space” (Appeal Br. 8 (citing Spec. ¶ 5)) whereas, “[i]n stark contrast, Eckenhausen is concerned with the completely different and unrelated problem of providing a dairy-based beverage dispensing system that employs a self-contained unit in which a refrigerated milk supply is located above the emulsification unit” (*id.* (citing Eckenhausen, 2:47–55)). According to Appellants, “Eckenhausen has absolutely nothing to do with the problem of controlling or regulating the setting of a desired pressure in a cooking space,” and “[t]hus, Eckenhausen is not reasonably pertinent to the particular problem” at issue. *Id.* at 8–9.

The Examiner states that “a ‘steam valve’ encompasses any valve that may be used for steam” and that “steam valves are structurally similar to valves for beverages, and a beverage valve could be used to regulate the flow of steam.” Ans. 8.

“If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports

use of that reference in an obviousness rejection.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). Here, consistent with the Examiner’s findings on this issue (Ans. 8), we consider the relied-upon aspects of Eckenhausen to have the same purpose as the “steam valve” in the claimed invention: regulating flow. *See* Ans. 8; *see also* Non-Final Act. 6 (discussing how the relied-upon aspects of Eckenhausen can be configured to allow flow and not allow flow); Spec. ¶ 13 (“A steam valve is provided in the steam exhaust tube to regulate the steam exhaust, in other words to regulate the flow of steam in the steam exhaust tube.”); Eckenhausen, 8:26–44, 10:64–11:17, 12:26–29, 14:39–42 (discussing the purposes of pinch valve 25 and valve gate 38).

Appellants focus not on the purpose or problem at issue, but on the specific application or use in Eckenhausen—i.e., “a dairy-based beverage dispensing system.” Appeal Br. 8. The scope of analogous art is not so limited. *See Graham v. John Deere Co.*, 383 U.S. 1, 35 (1966) (rejecting the argument that the cited references were not “pertinent prior art” and stating that “[t]he problems confronting [the patentee] and the insecticide industry were not insecticide problems; they were mechanical closure problems”).

Third, Appellants contend that, “without the teachings of the present Application, there would have been no reason to combine the valve of Eckenhausen with the appliance of Segato.” Appeal Br. 10. Appellants argue that paragraph 18 of the Specification “teaches the use of a valve that pinches a steam exhaust line for the purpose of controlling the pressure inside a cooking chamber.” *Id.* Appellants also argue that “[o]ne of the stated purposes of the valve of Eckenhausen is that no part of the pinch valve contacts the milk” (citing Eckenhausen, 14:3–4) and that, “[b]ecause the invention does not contact a food item or anything that will contact a

food item after passing through the valve, this is not a feature that would suggest the use of such a valve on a steam exhaust line.” *Id.*

The Examiner responds:

Eckenhause offers motivation for using such a valve in that in doing so would mean that no part of the valve comes in direct contact with the fluid, where such contact could decrease the performance of the valve (*See [Eckenhause] Col. 14, Lines 21-42*). Therefore, the examiner asserts that it would have been obvious to one of ordinary skill in the art to use the valve of Eckenhause, as it pertains to fluid dispensing and one of ordinary skill in the art would recognize the benefit of using the valve of Eckenhause in lieu of the valve of Segato, in that in doing so, the valve (and components thereof) would avoid direct contact with the fluid being dispensed, which would increase the operational longevity of the valve components.

Ans. 8–9.

Appellants’ argument does not apprise us of error. We understand the Examiner to take the position that one of ordinary skill in the art at the time of the invention would have used the valve of Eckenhause in place of the valve of Segato in order to “avoid direct contact with the fluid flowing through the tube[, i.e., the steam from Segato], which would increase the operational longevity of the valve components ” and because *allowing* such direct contact “could decrease the performance of the valve.” Ans. 7–8 (citing Eckenhause, 14:21–42)); *see also* Non-Final Act. 7 (stating that it would have been obvious for one of ordinary skill in the art at the time of the invention “to modify the valve of Segato . . . to use the valve taught by Eckenhause in order to employ a valve that avoids direct contact between the fluid being dispensed and the valve components, thereby increasing the operational longevity of said valve”).

Contrary to Appellants' argument, the Examiner does not rely on the alleged benefits provided in paragraph 18 of the Specification—the ability of “controlling the pressure inside a cooking chamber” (Appeal Br. 10)—in the context of the rejection here. Instead, the Examiner relies on the reasoning summarized in the prior paragraph. That the Examiner relies on reasoning that does not align with the stated purpose of the applicants does not show error in the rejection. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007) (“In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls.”); *see also Alcon Res., Ltd. v. Apotex, Inc.*, 687 F.3d 1362, 1368 (Fed. Cir. 2012) (“We have repeatedly held that the motivation to modify a prior art reference to arrive at the claimed invention need not be the same motivation that the patentee had.”).

Moreover, although the valve in the modified device would avoid contact with *steam* rather than avoiding contact with *food* (as in Eckenhausen), we agree with the Examiner's implicit position that, by avoiding direct contact with *either* steam or food, the valve (and related components) would benefit as identified in the reasoning statements above.

Further, we disagree with Appellants' contention, in the Reply Brief, “that there is nothing in column 14, lines 21–42 [of Eckenhausen], that refers to performance” and that “[t]his passage . . . refers only to the pinch valve providing more simple cleaning.” Reply Br. 4. In the relevant passage, Eckenhausen discloses that “conventional, mechanical valves” “require a rigorous daily flushing procedure, with special chemicals” and that, “[i]f such valves are not cleaned properly, they suffer from bacteria buildup and *unreliable performance*.” Eckenhausen, 14:34–39 (emphasis

added). Eckenhausen continues: “However, the use of the pinch valve 25 that avoids direct contact of any operating component of the flow control mechanism with the milk 20 eliminates the requirement for such cleaning.” *Id.* at 14:39–42 (emphasis omitted).

For these reasons, we determine that the reasoning relied on by the Examiner provides a “rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

Fourth, Appellants argue that “the citation of Eckenhausen is a clear case of the use of impermissible hindsight reconstruction.” Appeal Br. 9 (discussing MPEP §§ 2141.02(I), 2142). According to Appellants, “the claim appears to have been dissected to focus only upon the use of a valve that pinches a flexible hose and the Examiner resorted to the use of hindsight in an attempt to locate anything that was related to a valve that pinches a flexible hose,” “likely through a keyword search.” *Id.* at 10.

The Examiner responds:

[I]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.

Ans. 8 (citing *In re McLaughlin*, 443 F.2d 1392 (CCPA 1971)).

Appellants’ argument does not apprise us of error. Although Appellants contend that the Examiner has engaged in hindsight reconstruction, for the reasons discussed above, Appellants have not shown error in the reasoning provided by the Examiner. *See In re Cree, Inc.*, 818

F.3d 694, 702 n.3 (Fed. Cir. 2016) (viewing an “impermissible hindsight” argument as “essentially a repackaging of the argument that there was insufficient evidence of a motivation to combine the references”).

For the reasons above, we sustain the rejection of independent claim 9. Claims 10–15, 19, 22, and 25–28 fall with claim 9.

Rejections 3 through 5 – The rejections of claims 16–18, 20, 21, 23, and 24 under 35 U.S.C. § 103(a)

For these rejections, Appellants argue that claims 16–18, 20, 21, 23, and 24 are allowable based on their dependence from claim 9. *See* Appeal Br. 11–13. Appellants do not provide additional arguments for claims 16–18, 20, 21, 23, and 24. For the reasons discussed above, we are not apprised of error in the rejection of claim 9. *See supra* Rejection 2. As such, we sustain the rejections of claims 16–18, 20, 21, 23, and 24.

DECISION

We *reverse* the decision to reject claims 25 and 28 under 35 U.S.C. § 112, second paragraph (to the extent not previously withdrawn), and we *affirm* the decision to reject claims 9–28 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv); 37 C.F.R. § 41.50(f).

AFFIRMED