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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN STEINER

Appeal 2017-011226
Application 14/666,222
Technology Center 3600

Before KEVIN F. TURNER, NATHAN A. ENGELS, and
SEAN P. O’HANLON, *Administrative Patent Judges*.

O’HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Martin Steiner (“Appellant”)¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 12, 14, 16, 17, 20, 23–25, and 27–34.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

¹ The Appeal Brief identifies the Appellant as the real party-in-interest. Appeal Br. 2.

² Claims 1–11 are canceled, and claims 13, 15, 18, 19, 21, 22, and 26 are withdrawn. Amendment 2 (filed December 20, 2015); Final Act. 1.

SUMMARY OF THE DECISION

We AFFIRM.

SUMMARY OF THE INVENTION

Appellant's claimed invention is relates to an urn and planter assembly. Spec. ¶ 1.³ Claims 12 and 23 are independent. Claim 12, reproduced below from page 7 (Claims Appendix) of the Appeal Brief, is illustrative of the claimed subject matter:

12. An urn and planter assembly, comprising:
 - a first chamber configured to receive cremation ashes;
 - a second chamber configured to receive a planting matrix; and
 - at least one nutrient transmission element arranged between the first chamber and the second chamber such that it prevents the cremation ashes from coming in contact with the planting matrix,
 - wherein nutrients can pass through the at least one nutrient transmission element from the first chamber into the second chamber.

REFERENCES

The Examiner relies on the following prior art references in rejecting the claims on appeal:

Farrell	US 5,167,672	Dec. 1, 1992
Lucas	FR 2 701 808 A1	Sept. 2, 1994

REJECTIONS

- I. Claims 12, 14, 16, 17, 20, 23–25, 27, 29–31, 33, and 34 stand rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Lucas.

³ Citations to the Specification refer to the substitute specification submitted on May 10, 2015.

II. Claims 28 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lucas and Farrell.

ANALYSIS

Rejection I

The Examiner finds that Lucas discloses all of the elements of independent claims 12 and 23. Final Act. 2–4. Of particular note, the Examiner relies on the combination of Lucas’s plate 1, cartridge 6, sponge 7, and tube 9 as corresponding to the recited nutrient transmission element. *Id.* at 2, 3.

Appellant traverses the rejection, first arguing that “claim 12 requires not just an ability to separate cremation ashes from a planting matrix[.] The nutrient transmission element must actually separate the two, which Lucas does not disclose.” Appeal Br. 4.

We disagree with Appellant’s interpretation of the claim language. Both of claims 12 and 23 are directed to an “urn and planter assembly”—that is, an apparatus. *Id.* at 7, 9 (Claims App.). It is well established that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, and in order to satisfy the functional limitations in an apparatus claim the prior art apparatus must be capable of performing the claimed function. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997). Lucas discloses that plate 1 “support[s] the culture medium [above] a reserve of [water]” and that the plate is positioned “against the inner wall of a tank *so as to prevent the passage* of any fragment of the culture medium to the water supply.” Lucas 1 (emphasis

added).⁴ This is what claims 12 and 23 require. Thus, Lucas supports the Examiner’s finding that the Examiner-defined nutrient transmission element is capable of separating cremation ashes from planting matrix. *See* Ans. 2–3. Appellant’s argument, therefore, is unpersuasive.

Each of claims 12 and 23 also recite a first chamber “configured to receive cremation ashes.” Appeal Br. 7, 9 (Claims App.). The Federal Circuit has held that, when phrases such as “configured to” are used to describe the construction of an apparatus, rather than simply a functional characteristic, such phrases may require more than simply an identification of structure that is *capable of* being used in the claimed manner. *In re Giannelli*, 739 F.3d 1375, 1379–80 (Fed. Cir. 2014) (explaining that structural details in the written description may support a narrow interpretation of the phrase “adapted to”). Here, however, the Specification describes the first chamber in terms of its functionality. *See, e.g.*, Spec. ¶ 60 (“The first chamber 7 serves as a receptacle for ashes, in particular cremation ashes.”). Thus, “configured to receive cremation ashes,” as used in the claims, merely requires an identification of structure that is capable of receiving cremation ashes therein. Thus, we are not persuaded by Appellant’s argument that because “Lucas does not disclose any cremation ashes,” it “does not disclose the functional limitation of preventing cremation ashes from coming in contact with a planting matrix.” Appeal Br. 4. As noted above, such functional limitations in an apparatus claim merely require corresponding structure that is capable of performing the recited

⁴ Citations to Lucas refer to the translation accompanying the April 15, 2016, Final Office Action.

function, which the Examiner has established by a preponderance of the evidence.

Appellant next argues that “[t]he nutrient transmission element disclosed by Lucas would not be able to prevent cremation ashes in the first chamber from coming in contact with a planting matrix in the second chamber.” *Id.* Appellant relies on Lucas’s Figure 4 to support this contention, citing the uppermost instance of cartridge 6 (identified with label “A” in an annotated reproduction of Lucas’s Figure 4). *Id.* at 4–5.

Appellant states that “none of Lucas’[s] drawings show what the Examiner describes as ‘all openings being blocked,’” and argues, therefore, the Examiner’s finding that such openings would be blocked requires a modification to the reference, which is inappropriate for an anticipation rejection. *Id.* Appellant also argues that Figure 4 shows an opening in the end of sponge 7 (identified with label “B” in the annotated reproduction of Lucas’s Figure 4) that “would not function to prevent cremation ashes from coming in contact with the planting matrix.” *Id.* at 5.

As noted above, Lucas’s plate 1 separates pot 2 into two chambers—an upper chamber in which culture medium is placed, and a lower reservoir in which water is placed. Lucas 1, Fig. 2. Lucas further discloses cartridges 6, each of which includes sponge 7, that transfer water from the reservoir to the upper chamber. *Id.* at 1. A number of holes 8 are provided in plate 1, and “the plate ha[s] as many holes as cartridges which are arranged in alignment with the holes.” *Id.* The sponges are rolled about a longitudinal axis to take the shape as depicted in Figure 7 and then “forcibly pushed into the tube 9.” *Id.* at 3. Lucas, therefore, supports the Examiner’s finding that a sponge is positioned in each plate opening. *See* Final Act. 8. Additionally,

Lucas states, “In the embodiment of Figure 4, three cartridges 6 equidistant [angularly] of [120°] are distributed around the center of the circular plate 1. One cartridge was depicted without his [sponge].” Lucas 3. Thus, as correctly noted by the Examiner (*see* Ans. 3), Lucas discloses all openings in the plate being filled with cartridges and sponges. Therefore, we are not persuaded by Appellant’s arguments regarding any alleged unfilled opening in Lucas’s plate. Additionally, as also noted above, Lucas expresses an intention to “prevent the passage of any fragment of the culture medium to the water supply.” Lucas 1.

Nor are we persuaded by Appellant’s attempt to identify a cross-sectional view along line F–F in the enlarged and annotated partial reproduction of Lucas’s Figure 4 presented on page 5 of the Appeal Brief. As correctly noted by the Examiner (*see* Final Act. 8; Ans. 4–5), Lucas’s Figure 1 shows a full cross-sectional view of cartridge 6, sponge 7, hole 8, and the tube 9. Notably, Figure 1 shows the sponge “opening” alleged by Appellant. However, Figure 1 shows that over the vast majority of sponge length—and over the full length of tube 9 and plate 1—there is no such opening. As noted above, the written description discloses sponge 7 being “forcibly pushed into tube 9.” Lucas 3. Thus, we are not persuaded of the presence of any hole as suggested by Appellant.

In the Reply Brief, Appellant takes exception to the Examiner’s reference to portions of Lucas’s written description (in addition to the drawing figures) in the Answer, characterizing the translation as “inadmissible,” arguing that “the Examiner changed his position and relies on the full text document,” and arguing that “the Board should hold the

Examiner to his previous statement that the final rejection is based only on the drawings and the abstract.” Reply Br. 2–3.

We are not persuaded by Appellant’s arguments. Initially, we are unaware of, and Appellant provides no citation to, any authority prohibiting the Examiner to clarify (or even “change his position”) in the Examiner’s Answer; 37 C.F.R. § 41.39 requires that an examiner must indicate any rejection that relies on new evidence as being a new ground, and appellants can file a petition challenging an undesignated new ground. *See* 37 C.F.R. §§ 1.181, 41.40; MPEP § 1207.03(b). Here, the Examiner did not identify a new ground in the Answer, and Appellant did not file a petition alleging the rejection over Lucas as being such. Additionally, considering the merits of Appellant’s arguments, we are unpersuaded of error because the Examiner did not “change his position” in the Answer. Rather, the written description of Lucas is used to rebut Appellant’s arguments and support the rejection as set forth in the Final Office Action. In other words, Lucas’s written description is used to confirm the Examiner’s findings of how a person having ordinary skill in the art would interpret Lucas’s figures. For the reasons set forth above, we agree with the Examiner’s findings.

Nor are we persuaded that we should disregard the machine translation of Lucas relied upon by the Examiner. Appellant does not assert any error in the translation, instead reproducing the boilerplate caveat preceding the translation and suggesting that machine translations, as a whole, should not be relied upon for rejecting claims. Such conclusory arguments fail to apprise us of error in the machine translation or the Examiner’s reliance thereupon.

Accordingly, for the foregoing reasons, we sustain the Examiner's rejection of independent claims 12 and 23 as being anticipated by Lucas. We further sustain the rejection of dependent claims 14, 16, 17, 20, 24, 25, 27, 29–31, 33, and 34, which Appellant does not argue separately.

Rejection II

Appellant does not address the obviousness rejection of claims 28 and 32 over Lucas and Farrell. *See* Appeal Br. 3–5. Accordingly, Appellant has waived any argument of error, and we summarily sustain the rejection of these claims. *See Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (explaining that summary affirmance without consideration of the substantive merits is appropriate where an appellant fails to contest a ground of rejection).

DECISION

The Examiner's decision to reject claims 12, 14, 16, 17, 20, 23–25, and 27–34 is 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)(1)(iv).

AFFIRMED