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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SCOTT H. PRYNE  
(Applicant: American Felt & Filter Company)

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Appeal 2018-000404  
Application 14/340,958  
Technology Center 3700

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Before LINDA E. HORNER, STEVEN D.A. McCARTHY and  
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

McCARTHY, Administrative Patent Judge.

DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 The Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's  
3 decision finally rejecting claims 1–10. We have jurisdiction under 35 U.S.C.  
4 § 6(b).

5 We sustain the rejection of claims 1–5, but not that of 6–10, under 35  
6 U.S.C. § 102(a)(1) as being anticipated by Harris (US 3,104,174, issued  
7 Sept. 17, 1963).

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<sup>1</sup> The Appellant identifies American Felt and Filter Company of New Windsor, New York, the applicant under 37 C.F.R. § 1.46, as the real party in interest. (*See* Appeal Brief, dated July 11, 2017, at 3).

1 We do not sustain the rejection of claims 1–10 under 35 U.S.C. § 103  
2 as being unpatentable over Foster (US 2,413,964, issued Jan. 7, 1947).

3  
4 THE CLAIMED SUBJECT MATTER

5 Claims 1 and 6 are independent and self-explanatory:

6 1. A device for removing hot molten wax from a  
7 receptacle, comprising:

8 a wafer with a heat resistant body formed of a material that  
9 is of sufficient porosity to absorb or soak up the hot molten wax  
10 in the receptacle when the wafer is moved to the receptacle and  
11 positioned therein and to retain the structural integrity of the  
12 wafer so that the wafer can be removed from the receptacle and  
13 disposed of after the wafer has absorbed or soaked up the hot  
14 wax.

15 6. A method of removing hot molten wax from a  
16 receptacle for a wax tart or fuel holder, comprising:

17 positioning in the receptacle having the hot molten wax  
18 therein a heat resistant cleanout wafer that is formed of a material  
19 that absorbs or soaks up the hot molten wax in the receptacle, and

20 removing the clean out wafer from the receptacle after the  
21 clean out wafer has absorbed or soaked up all of the hot molten  
22 wax in the receptacle.

23  
24 ISSUES

25 The Appellant argues the patentability of the dependent claims on the  
26 basis of the asserted patentability of the independent claims. This appeal  
27 turns on three issues:

28 *First*, does Harris anticipate device claim 1?

29 *Second*, does Harris anticipate method claim 6?

1           *Third*, would the subject matter of claims 1 and 6 have been obvious  
2 from the teachings of Foster?

3

4

#### FINDINGS OF FACT

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The record supports the following findings of fact (“FF”) by a  
preponderance of the evidence.

7

8

*Harris*

9

1. Harris describes a friction facing made from a fibrous material  
for use in a wet automotive clutch. (*See Harris*, col. 1, ll. 13–17).

10

11

2. Harris teaches fabricating the fibrous material by suspending  
cellulose fibers, linen fibers, cotton linters, asbestos fibers or the like in a  
fluid vehicle and then depositing the fibers on a screen to form a mat. (*See*  
Harris, col. 1, l. 68 – col. 2, l. 13). Harris additionally teaches punching the  
mat to form annuli, that is, wafers, of the fibrous material. (*See Harris*, col.  
2, ll. 14–19 & Fig. 2). Harris’s wafers of fibrous material anticipate the  
device of claim 1.

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17

18

3. The Examiner has a sound basis for belief that Harris’s annuli  
of fibrous material are heat resistant bodies. (*See Final Office Action*,  
mailed Apr. 13, 2017 (“Final Act.”), at 2). Even though Harris teaches that  
the use of the friction facings described in Harris reduce the operating  
temperatures of transmissions including the facings (*see Harris*, col. 1, ll.  
58–65), transmissions are high temperature environments. The capacity of  
Harris’s friction facings to maintain sufficient dimensional stability in that  
high temperature environment indicates that the annuli of fibrous material  
from which the facings are made are heat resistant. The Appellant does not

26

1 appear to challenge the Examiner's finding that Harris's annuli of fibrous  
2 material are inherently heat resistant bodies.

3         4.       The Examiner has a sound basis for belief that Harris's annuli  
4 of fibrous material are formed of a material that is of sufficient porosity to  
5 absorb or soak up the hot molten wax in a receptacle when the wafer is  
6 moved to the receptacle and positioned therein. (*See* Final Act. 5). Harris  
7 teaches dipping the annuli of fibrous material in a wax emulsion, such as an  
8 aqueous emulsion of carnauba wax, beeswax or microcrystalline waxes of  
9 the hydrocarbon series, as a preparatory step before impregnating the annuli  
10 with polymeric resins. (*See* Harris, col. 2, ll. 53 – col. 3, l. 2). Harris also  
11 teaches heating the annuli after dipping the annuli in the wax emulsions, so  
12 as to drive off the water and coat the fibers of the annuli with the wax. (*See*  
13 Harris, col. 3, ll. 6–14). Harris therefore teaches that the annuli absorb the  
14 hot wax emulsions.

15         5.       Finally, Fig. 2 of Harris teaches the steps of dipping the annuli  
16 of fibrous material in a wax emulsion and then removing the annuli from the  
17 wax emulsion. Harris therefore teaches that Harris's annuli of fibrous  
18 material would retain sufficient structural integrity after absorbing hot  
19 molten wax to remove the annuli from receptacles containing hot wax, and  
20 to dispose of the annuli, after absorbing or soaking up the hot wax.  
21 Likewise, the fact that the annuli retain sufficient structural integrity for later  
22 use as friction facings indicates that the annuli would retain sufficient  
23 structural integrity after absorbing hot molten wax to remove the annuli from  
24 receptacles containing hot wax, and to dispose of the annuli, after absorbing  
25 or soaking up the hot wax. (*See* Final Act. 2, citing Harris, col. 1, ll. 58–65).

1           6.       Thus, the Examiner has a sound basis for belief that Harris’s  
2 annuli of fibrous material satisfy each limitation of claim 1.

3           7.       We take Official Notice that beeswax is a wax that might be  
4 used to fabricate a candle tart.

5  
6 *Foster*

7           8.       Foster describes a dish towel made from yarn comprising a  
8 fabric woven from yarn comprising a mixture of cotton and asbestos fibers.  
9 (*See Foster*, col. 1, ll. 41–46). Foster teaches that the addition of the  
10 asbestos fibers improves the wicking properties of the towels as compared  
11 with towels made from yarns comprising cotton fibers alone. Foster also  
12 teaches that the addition of the asbestos fibers provides mild abrasive  
13 properties. (*See Foster*, col. 1, ll. 19–28; col. 2, ll. 27–41). According to  
14 Foster, the improved dish towel “is superior to an all cotton towel or a linen  
15 towel in its ability to dry and polish glassware, dishes and silverware.”  
16 (*Foster*, col. 1, ll. 14–18). Foster does not describe using the improved dish  
17 towel to absorb hot molten wax.

18  
19 ANALYSIS

20 *First Issue*

21           The Appellant argues that Harris describes a friction facing that is  
22 completely unrelated to the subject matter of claims 1–5. (*See Appeal Brief*,  
23 dated July 11, 2017 (“App. Br.”), at 6 & 7; Reply Brief, dated Oct. 12, 2017,  
24 at 2). The argument is not persuasive. The Examiner has a sound basis for  
25 belief that Harris describes an annulus of fibrous material that satisfies each  
26 and every limitation of claim 1. (*See FF 2–6*). The Appellant does not rebut

1 this belief. The fact that the device Harris discloses is used for different  
2 purposes does not support a finding of no anticipation if all of the limitations  
3 are disclosed by Harris. Therefore, we sustain the rejection of claims 1–5  
4 under § 102(a)(1) as being anticipated by Harris.

5

6 *Second Issue*

7 Claim 6 recites the step of “removing the clean out wafer from the  
8 receptacle after the clean out wafer has absorbed or soaked up all of the hot  
9 molten wax in the receptacle.” Although Figure 2 of Harris describes  
10 dipping an annulus of fibrous material in an emulsion having hot molten  
11 wax therein and then removing the annulus from the emulsion (*see* FF 5),  
12 Harris does not describe absorbing all of the wax in the emulsion. Indeed, it  
13 is unlikely that Harris would describe absorbing all of the wax in the  
14 emulsion, since this might result in the absorption of insufficient wax to  
15 facilitate a subsequent resin impregnation step. Thus, Harris fails to describe  
16 removing the annulus from the wax emulsion after the annulus has absorbed  
17 or soaked up all of the hot molten wax in a receptacle containing the wax  
18 emulsion. Because Harris does not recite a method including all of the steps  
19 recited in claim 6, we do not sustain the rejection of claims 6–10 under  
20 § 102(a)(1) as being anticipated by Harris.

21

22 *Third Issue*

23 Claim 1 recites a device including a wafer. Claim 6 recites a method  
24 including the step of “positioning in [a] receptacle having . . . hot molten  
25 wax therein a heat resistant cleanout wafer.” The Examiner defines a  
26 “wafer” as “any small, thin disk.” (Final Act. 5). Foster describes a dish

1 towel (*see* FF 8) but does not describe a small, thin disk. The Examiner  
2 seeks to remedy this deficiency by concluding that the distinction between a  
3 dish towel and a wafer is one of size or shape; and that it would be a matter  
4 of obvious design choice to reduce Foster’s dish towel to a small, thin disk  
5 or wafer. (*See* Final Act. 6; Examiner’s Answer, mailed Sept. 13, 2017, at 4  
6 & 5).

7 A finding of “obvious design choice” is precluded where the claimed  
8 structure and the function it performs are different from the prior art. *In re*  
9 *Chu*, 66 F.3d 292, 299 (Fed. Cir. 1995), citing *In re Gal*, 980 F.2d 717, 719  
10 (Fed. Cir. 1992). As noted earlier, Foster’s dish towel is a different structure  
11 than a wafer as recited in claim 1, and as used in the method of claim 6.

12 Likewise, Foster does not describe the use of its dish towel to absorb or soak  
13 up hot molten wax. Reducing Foster’s dish towel to a wafer, that is, to a  
14 small, thin disk, likely would reduce its absorbent capacity and its ability to  
15 be manipulated by hand, thereby affecting its ability to dry and polish  
16 glassware, dishes and silverware. Because the structure and function of the  
17 claimed subject matter differs from that of Foster’s dish towel, the  
18 Examiner’s reliance on obvious design choice is not persuasive. We do not  
19 sustain the rejection of claims 1–10 under § 103 as being unpatentable over  
20 Foster.

21

22

DECISION

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We AFFIRM the Examiner’s decision rejecting claims 1–5 under  
§ 102(a)(1) as being anticipated by Harris. We do not sustain the rejection  
of claims 1–5 under § 103 as being unpatentable over Foster.

1           We REVERSE the Examiner’s decision rejecting claims 6–10, either  
2 under § 102(a)(1) as being anticipated by Harris; or under § 103 as being  
3 unpatentable over Foster.

4           No time period for taking any subsequent action in connection with  
5 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
6 § 1.136(a).

AFFIRMED-IN-PART