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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY HALE SUNTUP

Appeal 2018-001289
Application 13/561,041
Technology Center 3700

Before JEREMY M. PLENZLER, GEORGE R. HOSKINS, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's Final Decision rejecting claims 1, 2, 4–6, and 12–22 under 35 U.S.C. § 103 as unpatentable over Henry (US 4,187,962, issued Feb. 12, 1980), Weempe (US 2,784,747, issued July 11, 1955), Stephens (US 4,313,168, issued Jan. 26, 1982), and Givens (US 7,861,537 B2, issued Jan. 4, 2011). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claims 1, 6, 13, and 16 are independent, with claims 2, 4, 5, 12, 14, 15, and 17–22 depending from claim 1, 6, 13, or 16. Claims 1 and 2 are representative of the claims on appeal, and are reproduced below:

1. A home heating oil delivery apparatus comprising:
 - (a) a tank having a capacity of about 119 gallons, for containing heating oil;
 - (b) a pump having a flow rate of about 2–29 gallons per minute, in fluid communication with the tank, for drawing heating oil from the tank and flowing it to and through a meter subsystem;
 - (c) a meter subsystem meeting NTEP certification requirements in fluid communication with the pump, for measuring the quantity of heating oil pumped at a rate of 2 to 29 gallons per minute from the tank and through a dispensing conduit by the pump;
 - (d) an air and vapor eliminator, interconnected between the pump and the meter subsystem;
 - (e) a dispensing conduit in fluid communication with the meter subsystem, for flowing oil received from the meter subsystem to a container adapted for receiving an oil delivery;
 - (f) a power supply for powering the pump; and,
 - (g) a skid;wherein the elements (a) through (f) are mounted on said skid.

2. The apparatus of claim 1 in combination with a truck motor vehicle having a bed for transporting things and having a gross vehicle weight of 1,500 pounds or less, wherein said skid is removably mounted on said bed, further comprising up to 119 gallons of home heating oil contained within the tank; and, wherein said combination weighs no more than 10,000 pounds.

OPINION

Claims 1 and 6 are apparatus claims, and claims 13 and 16 are methods of using the apparatus recited in those claims. With respect to claims 1, 2, 6, and 12, the Examiner finds that “Henry . . . discloses a fuel service tank 14 on the back of a conventional pickup truck 12 with an electric pump 18 and a delivery ‘body’ and reel system 16, 22.” Final Act. 2. Appellant does not dispute this finding.

Addressing the features of both claim 1 and claim 2, the Examiner acknowledges that Henry does not teach the specific type of fuel (heating oil), the specific tank capacity (119 gallons), the specific pump rate (2–29 gallons per minute), that the meter is NTEP certified, an air and vapor eliminator, a power supply for the pump, or the particular weight of the apparatus (1,500 pounds) or truck/apparatus combination (10,000 pounds) recited in the claims. *Id.*

The Examiner finds that Stephens teaches a heating oil delivery truck and a computerized record keeping system that tracks heating oil deliveries. Final Act. 3. The Examiner reasons that it would have been obvious to modify Henry’s truck to deliver heating oil with Stephens’ metering, in order to “widen its utility.” *Id.* Appellant does not dispute these findings, or the Examiner’s rationale for modifying Henry to deliver heating oil. Indeed, Appellant “agrees that capturing data (metering) in general during heating oil delivery is known and obvious to use on a Henry apparatus.” Appeal Br. 9. Appellant contends, however, that “there is no suggestion from Stephens or elsewhere that the metering system shall meet NTEP certification requirements.” *Id.* That contention is not persuasive because the Examiner explains that “NTEP certification is a well[-]known and well understood

requirement of fuel deliveries (by regulation)” and reasons that “it would be obvious . . . to modify the Stephens device to be NTEP certified (if it wasn’t already) because . . . it allows the device to be used lawfully within United States.” Final Act. 3. Appellant does not dispute this finding or rationale.

With respect to the recited pump rate of “2–29 gallons per minute,” the Examiner finds that pumps having the capacity recited were well-known in the art and determines that “it would be obvious to one of ordinary skill in the art to select a pump with that flow rate for [H]enry’s pump 18 because first 2 to 29 gpm is a wide range, and pumps in that range are well known and well understood in the art to pump sufficient quantities of fluid while not being too big themselves.” Final Act. 4. Appellant does not dispute this finding or rationale.

The Examiner also determines that “the selection of 119 gallons of capacity, that weighs less than 1,500 pounds for a grand total of less than 10,000 pounds are all examples of obvious design choice.” Final Act. 5 (citing MPEP § 2144.04 (discussing *In re Rose*, 220 F.2d 459 (CCPA 1955) and *In re Rinehart*, 531 F.2d 1048 (CCPA 1976))). Appellant does not address the tank capacity being 119 gallons, recited in claim 1, other than indicating that “[t]he references also do not teach . . . a 119 gallon tank” (Appeal Br. 10), which is unpersuasive of error because it does not address the Examiner’s rejection.

Appellant responds that “there is a criticality of specific limitation[s]” recited in claim 2, including the “truck . . . having a gross vehicle weight of 1,500 pounds or less,” “up to 119 gallons of home heating oil contained within the tank,” and the “combination weigh[ing] no more than 10,000 pounds.” Appeal Br. 16. Appellant contends that “MPEP 2144 . . . say[s]

that “[i]f the applicant has demonstrated the criticality of a specific limitation, it *would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.*” *Id.* Based on this contention, Appellant concludes that “[t]he rejection is insufficient as a matter of law.” *Id.*

Appellant’s contentions are not persuasive. The “criticality” noted by Appellant is that it is critical to follow the law. *See id.* at 12–13 (“If not done ‘in weights and measures approved fashion’ the use of the claimed invention would be illegal.”). We agree with the Examiner that it would have been obvious to follow applicable laws prescribing the various weights and tank capacities.

With respect to the “skid” recited in claim 1, the Examiner finds that “Givens . . . teaches a portable powered 92 pump system 42a, that fits on a skid that fits on the back of a conventional pickup truck 103 . . . and can be moved from truck to truck via the fork tines 43a on the skid.” Final Act. 3. The Examiner reasons that “[i]t would be obvious . . . to borrow the teaching of a fork[-]tined skid with its own battery power from Givens and modify the Henry device to have these features because then the Henry delivery device could be transferred from one pickup truck to another when the pickup truck has downtime for maintenance or other issues.” *Id.* at 3–4.

Appellant responds that Givens is non-analogous art. Appeal Br. 10–12. Appellant contends that “[t]he problem being solved by applicant is delivery of heating oil to domestic and commercial buildings with storage tanks.” Appeal Br. 11 (citing Spec. ¶¶ 12–14).

“A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention.” *In re*

Klein, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (citing *Innovention Toys, LLC v. MGA Entm't., Inc.*, 637 F.3d 1314, 1321 (Fed. Cir. 2011), and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)).

Two separate tests define the scope of analogous 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.

Id. (quoting *In re Bigio*, 381 F.3d at 1325).

We are persuaded that Givens is reasonably pertinent to the problem addressed by Appellant, even under Appellant's characterization of the problem, because that problem also involves how to mount the necessary equipment to a vehicle, such as a pickup truck, that does not require a commercial driver's license for delivery and is able to navigate areas otherwise unreachable by large commercial tankers. *See, e.g.*, Spec. ¶ 9 ("using a typical large truck can present a problem when a driveway, roadway, or bridge has a load limit below that of the weight of even a partially loaded local-delivery heating oil tank truck"), ¶ 12 ("Sending a large heating oil tank truck and qualified professional driver to a customer's site is costly in terms of labor and operating costs; and the dollar mark up on a small quantity of heating oil can easily be insufficient to cover the costs."). Givens is relevant to this problem. For example, Givens describes a "portable tool power system 17 with control panel 54, engine 47, fuel tank 49, generator 53, hydraulic oil reservoir 20 and hydraulic pumps 42a and 42b mounted to frame 40." Givens 3:65–4:1. Givens explains that "[f]rame 40 is also equipped with hoist flange 41 which may be used for lifting and moving portable tool power system 17" (*id.* at 4:39–40) such that a "pick up

truck 103 [can have] portable power tool system 17 installed in its bed” (*id.* at 8:8–9). Indeed, Appellant acknowledges “[y]es, Givens Fig. 11 shows his apparatus mounted on a pick-up truck and it has a lifting point 41— so it is removably mounted.” Appeal Br. 12.

Although Appellant acknowledges that Givens “teaches a portable apparatus,” Appellant contends that “Givens does not describe a skid, only frame 40.” Appeal Br. 10. Appellant also contends that “there is no reason to pick the frame-mounting of Givens over permanent mounting taught by Stephens and Weempe patents,” noting that “there is no basis to assume that a truck would significantly be taken out of service for maintenance; and even if so, that the additional cost of providing portability to the apparatus would be worth the supposed benefit.” *Id.*

Appellant does not identify error in the Examiner’s findings or rationale related to Givens. Although Appellant alleges that Givens does not teach a “skid,” Appellant offers no explanation as to what structure required to be a “skid” is missing from Givens. *See* Appeal Br. 10 (“Givens does not describe a skid, only frame 40.”). Appellant’s Specification makes clear that there is no particular structure associated with a skid. *See* Spec. ¶ 42 (“The term ‘skid’ shall not be limiting and shall be construed as embracing any structure which functions as a base sufficient to carry the apparatus components and enable them to be moved as an integral unit while functionally interconnected.”). We are apprised of no reason why Givens’ frame 40 with lifting point 41 cannot be considered a “skid.”

Appellant’s contentions related to “the additional cost of providing portability to the apparatus” are also unpersuasive. Obviousness, as a determination of unpatentability, is not a question of commercial viability as

a practical business determination. *See Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983) (“[T]he fact that the two [prior art disclosures] would not be combined by businessmen for economic reasons is not the same as saying that it could not be done because skilled persons in the art felt that there was some technological incompatibility that prevented their combination. Only the latter fact is telling on the issue of nonobviousness.”).

With respect to the “air and vapor eliminator” recited in claim 1, the Examiner finds Weempe teaches a fuel delivery tank truck with an air and vapor eliminator in the fuel dispensing line. Final Act. 2. The Examiner concludes it would have been obvious to borrow this teaching from Weempe and add it to the Henry device, so “it could dispense more volatile products more efficiently.” *Id.* at 2–3.

Appellant responds that it is logical for Weempe to include a vapor eliminator because it employs “a LPG tank contain[ing] pressurized vapor.” Appeal Br. 9; *see also id.* at 8 (LPG is liquefied petroleum gas). Appellant contends “there is no reason” for using a vapor eliminator when storing and dispensing heating oil, because heating oil is much less volatile than LPG. *Id.*

Appellant’s response consists solely of attorney argument; it is unsupported by any citation to evidence in the record concerning the relative volatility of the substances at issue. Moreover, we credit the Examiner’s answer that “Weempe is proper because whether heating oil is more or less volatile than [LPG], a vapor eliminator is a good idea when dispensing heating oil, because heating oil also emits volatile (smelly) odors which could become flammable.” Ans. 8. That is, even if heating oil is less

volatile than LPG, heating oil still emits smelly vapor which could become flammable, and therefore would benefit from employing a vapor eliminator.

Appellant provides Declarations under 37 C.F.R. § 1.132 in support of its contentions related to non-obviousness of the pending claims (the “Pelloni Declaration” and the “Sutnup Declaration”), and contends that the Examiner has failed to consider sufficiently those Declarations. Appeal Br. 12–16. Appellant acknowledges that the Final Action addresses those Declarations, but notes that “[t]he final rejection asserts that the Sutnup and Pelloni declaration (simply) show that the invention works as intended.” *Id.* at 13 (citing Final Act. 5–6). Indeed, the Final Action explains that “[t]wo Affidavits were furnished to present evidence that the 103 rejection was not obvious due to ‘secondary considerations[,]’ namely ‘unexpected results,’” but “the first affidavit does not address the actual claims, and both the first and second affidavits fail to successfully prove ‘unexpected results.’” Final Act. 6. We have considered those Declarations and determine that Appellant has not identified reversible error in the Examiner’s treatment of those Declarations.

Appellant asserts, generally, that “unexpected/surprising results are supported by the declarations.” Appeal Br. 13. Appellant also contends, for example, that “there is documented commercial interest in the claimed invention in the heating oil dealer trade” (*id.* at 14 (citing Sutnup Declaration ¶ 14)) and “the claimed invention provides an innovative solution to a long-standing problem in the heating oil delivery trade” (*id.* (citing Pelloni Declaration ¶ 9)). Appellant also directs us to “[s]ee also the public documents in Appendix IV here (page 45+). They comprise news articles in trade publications that show the uniqueness of the present invention to the

heating oil delivery trade.” *Id.* As best we can ascertain, Appellant appears to assert that the Declarations and trade publications provide evidence of secondary considerations of obviousness that weigh in favor of patentability.

To be relevant, secondary evidence of non-obviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). There must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining non-obviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988).

The discussion of secondary indicia of non-obviousness in Appellant’s Brief fails to address any relation of the claim elements, or even any particular claim, to that evidence. Indeed, Appellant offers no meaningful argument, in its Brief, with respect to these secondary consideration contentions and, instead, simply alleges these secondary considerations exist and render the claims non-obvious. Appellant does not identify Examiner error because Appellant does not rebut (or even dispute), in its Brief, the Examiner’s determination that nexus has not been established.¹

¹ While there may be a presumption of nexus in certain circumstances, Appellant does not even allege such a presumption is appropriate here. *See WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016) (“[T]here is a presumption of nexus for objective considerations when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’”).

Concerning claims 16 and 17, Appellant additionally contends the Examiner has failed to articulate a sufficient reason why it would have been obvious to make a first delivery of more than 119 gallons of heating oil to a customer using a first (larger) truck, and to make a second delivery of less than 119 gallons of heating oil to the same customer using a second (smaller) truck. Appeal Br. 22–23. We disagree. The Examiner finds “a user can select to dispense as many or as few gallons of fuel in each delivery” as might be needed, so it would be obvious to utilize a larger truck for bigger deliveries and a smaller truck for smaller deliveries. Final Act. 4–5.

Appellant’s additional argument concerning other claims on appeal largely repeats the arguments set forth and considered above. *See* Appeal Br. 17–24. For at least the reasons provided above, we are not apprised of Examiner error in the rejection of claims 1, 2, 4–6, and 12–22.

DECISION

We AFFIRM the Examiner’s decision to reject claims 1, 2, 4–6, and 12–22 under 35 U.S.C. § 103.

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