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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN BONGIOVANNI

Appeal 2019-006389¹
Application 15/610,932²
Technology Center 3700

Before PHILLIP J. KAUFFMAN, TARA L. HUTCHINGS, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 11 and 12. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Our Decision references Appellant’s Specification (“Spec.,” filed June 1, 2017) and Appeal Brief (“Appeal Br.,” filed Mar. 26, 2019), and the Examiner’s Answer (“Ans.,” mailed May 24, 2019) and Final Office Action (“Final Act.,” mailed Oct. 29, 2018).

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies John Bongiovanni as the real party in interest. Appeal Br. 2.

CLAIMED INVENTION

Claim 11, reproduced below with added bracketed notations, is the sole independent claim on appeal and is representative of the claimed subject matter:

11. A device for acting as both a container and a funnel which comprises:
- a) a body;
 - b) a neck;
 - c) a spout; and
 - d) a base;
- [1] wherein said neck has a proximal end and a distal end;
- [2] wherein said proximal end of said neck is connected to said body;
- [3] wherein said spout is disposed at said distal end of said neck;
- [4] wherein said body and said base are for holding a fluid to be dispensed through said spout via said neck; and
- [5] wherein said base is for being at least partially detached from said body after said dispensing of said fluid through said spout via said neck, so that said body, said neck, and said spout may act as a funnel;
- [6] wherein said neck comprises a flexible portion;
- [7] wherein said flexible portion of said neck is flexible by virtue of having an accordion construction;
- [8] wherein said device further comprises a cap; wherein said cap is threadably attachable to said spout;
- [9] wherein said spout is rigid;
- [10] wherein said base comprises an indented portion and a flush portion;
- [11] wherein said body has a circumference;
- [12] wherein said indented portion has a circumference which is recessed from said circumference of said body by a distance;

[13] wherein said flush portion has a circumference substantially identical to said circumference of said body;

[14] wherein said base further comprises at least two guides;

[15] wherein said at least two guides comprise an upper guide and a lower guide;

[16] wherein said guides are for guiding a user in cutting of said device;

[17] wherein said upper guide is on said indented portion of said base;

[18] wherein said lower guide is on said flush portion of said base;

[19] wherein when a user cuts said upper guide of said base and said lower guide of said base, a bottom portion and a central portion are separated from said base;

[20] wherein said bottom portion of said base has a sidewall portion;

[21] wherein said sidewall portion has an interior size;

[22] wherein said interior size of said sidewall portion of said bottom portion of said base corresponds to said circumference of said indented portion of said base;

[23] wherein said sidewall portion of said bottom portion of said base has a cross-sectional thickness; and

[24] wherein said cross-sectional thickness of said sidewall portion of said bottom portion of said base is substantially identical in measure to said distance by which said circumference of said indented portion of said base is recessed from said circumference of said body.

REJECTIONS

Claim 11 is rejected under 35 U.S.C. § 103 as unpatentable over Ha (US 4,602,728, iss. July 29, 1986) and Genius Asian, *4 Ways to Make an*

Engine Oil Funnel & 2 Ways to Pour Oil, (May 26, 2014),
<https://www.youtube.com/watch?v=ICcqwXPSxmk> (“Digital Video”).

Claim 12 is rejected under 35 U.S.C. § 103 as unpatentable over Ha, Digital Video, and Rogers Martijena (US 2010/0044339 A1, pub. Feb. 25, 2010).

ANALYSIS

Claim 11

We are persuaded at least by Appellant’s argument that the Examiner erred in determining that it would have been an obvious design choice to modify Ha to have a “cross-sectional thickness of said sidewall portion of said bottom portion of said base [be] substantially identical in measure to said distance by which said circumference of said indented portion of said base is recessed from said circumference of said body,” as recited in claim 11, limitation (d)(24). Appeal Br. 4–9.

As a brief overview of the prior art, Ha discloses a container adapted to pour its contents into a hard-to-reach opening. Ha 1:5–7. Ha’s container 10’ includes reservoir 12 with bottom 14, top 16’, bottom rim 18, and top rim 20. *Id.* at 3:28–32, Fig. 2. Top 16’ includes neck 24’ adapted to be extendible from a collapsed position. *Id.* at 3:33–39. Digital Video teaches how to make an engine oil funnel by removing a bottom portion of an empty plastic container, such as a soda bottle, milk jug, or motor oil container. *See* Digital Video; *see also* Final Office Action 6–7 (providing screen shots of Digital Video).

In rejecting claim 11, the Examiner primarily relies on Ha for disclosing the limitations recited in claim 11. *See* Ans. 11; *see also* Final

Act. 2–4. The Examiner acknowledges that Ha does not teach “cutting the container along the upper and the lower guide to form a funnel and a funnel cap out of the container as suggested by the claim” (i.e., limitations (d)(14)–(d)(19)). Ans. 11. However, the Examiner relies on Digital Video for teaching that it “would have been obvious . . . to cut the container of Ha along the upper and lower guides *or any other location as deemed fit* by a consumer or a user to form a make-shift funnel[.]” Ans. 11–12 (emphasis added); *see also* Final Act. 5.

The Examiner also recognizes that Ha’s container does not disclose the claimed cross-sectional thickness of the sidewall portion of the base, as recited in limitation (d)(24) of claim 11. Ans. 11; Final Act. 4. However, the Examiner determines that modifying the base of Ha’s container to meet limitation (d)(24) would have been an obvious matter of design choice. *Id.* at 4–6. Specifically, the Examiner reasons that the modification involves “a mere change in the size of a component” that could be performed for various reasons, “such as providing a stronger and thicker wall for increasing the circumferential strength of the container” or “changing the thickness of the [] base portion of a container to increase its vertical stability when the container as a whole is placed on a horizontal surface.” *Id.* at 5–6 (citing MPEP § 2144.04(IV)).

Yet, Appellant’s Specification provides that when a user cuts along upper guide 44 of base 18 and lower guide 46 of base 18, bottom portion 48 and central portion 50 are separated from base 18. Spec. 11:28–30, Figs. 2, 4. Bottom portion 48 of base 18 has sidewall portion 52 having interior size 54 that corresponds to circumference 38 of indented portion 32 of base 18 (i.e., limitation (d)(24)). *Id.* at 11:31–12:4, Fig. 4. “This

construction allows the bottom portion 48 to act as a cap for the device 10 after it has been used as a funnel, as illustrated in Figures 4, 6, and 7.” *Id.* at 12:4–6. The correspondence of size of the interior of the sidewall portion of the circumference of the indented portion allows the cap to fit snugly on device 10 after it is used as a funnel. *Id.* at 12:6–9. In addition, this construction “allows the bottom portion 48 to fit sleekly with the body for both aesthetic and storage reasons.” *Id.* at 12:17–19. Put simply, limitation (d)(24), as recited in claim 11, allows the bottom portion of the base to be an effective cap after the device is used as a funnel. Appeal Br. 5 (arguing that the bottom portion once removed would “fit snugly onto the indented portion without sliding or being precariously balanced,” and would “keep debris out of the container”).

Given this difference in structure and function from Ha and Digital Video, we are persuaded that the Examiner erred in relying on design choice for the proposed modification of Ha. *See In re Gal*, 980 F.2d 717, 719–20 (Fed. Cir. 1992) (finding of obvious design choice precluded when claimed structure and the function it performs are different from the prior art).

Therefore, we do not sustain the rejection of claim 11 under 35 U.S.C. § 103 as unpatentable over Ha and Digital Video.

Claim 12

The Examiner’s rejection of dependent claim 12 under 25 U.S.C. § 103 does not cure the deficiencies in the rejection of the independent claim, as set forth above. Therefore, we do not sustain the rejection of claim 12 under 35 U.S.C. § 103 for the same reasons.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
11	103	Ha, Digital Video		11
12	103	Ha, Digital Video, Rogers Martijena		12
Overall Outcome				11, 12

REVERSED