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Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DOROTHEA McGEE

Appeal No. 2004-0046
Application No. 10/001,313¹

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 20, which are all of the claims pending in this application.

We AFFIRM.

¹ In any further prosecution of the claimed subject matter, the examiner should ascertain if any of the claims are anticipated by or made obvious from the appellant's Design Patent No. 423,732. This patent is referred to on page 1 of the application and was cited in the Information Disclosure Statement (Paper No. 2) filed by the appellant and considered by the examiner. This patent appears to qualify as prior art under 35 U.S.C. § 102(b) and may anticipate claims 1 and 10.

BACKGROUND

The appellant's invention relates to improved methods and apparatus concerning preventing pets or small children from spilling liquid or food provided to them (specification, p. 1). A copy of claims 2 to 20 under appeal is set forth in the appendix to the appellant's brief. Claim 1 under appeal reads as follows:

A bowl comprising:
an inner wall;
a rim connected to the inner wall;
an outer wall connected to the rim;
an inner base connected to the inner wall;
an outer base connected to the outer wall, the outer base having a portion nearest the outer wall which is connected to the outer wall, and the outer base having a portion farthest away from the outer wall, the portion farthest away from the outer wall including an edge;
wherein the inner wall and the inner base form a receptacle which can receive and hold nourishment; and
wherein when the outer base is placed on a flat surface the edge of the outer base and the portion of the outer base nearest the outer wall both come in contact with the flat surface.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Emery	2,053,949	Sept. 8, 1936
Sinaiko	2,587,237	Feb. 26, 1952

Claims 1 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Emery in view of Sinaiko.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 5, mailed August 13, 2002) and the answer (Paper No. 8, mailed January 30, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 7, filed November 22, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Emery's invention relates to single use containers and receptacles made entirely of some lightweight, inexpensive material, as molded pulp, paper, or the like. Emery states (column 1, lines 14-26) that:

One problem with such a receptacle or container made of such light-weight material is that the article is easily tilted or tipped over when placed on a flat supporting surface, as a table in the case of a plate or dish, or the floor in the case of a cuspidor.

Considering the cuspidor as characteristic of the general line of light-weight single service receptacles and containers made of molded pulp or the like, it is to be noted that the problem involved is to stabilize the article in the region of its base so as to prevent it from being tipped over or tilted.

Emery's invention contemplates a single service receptacle or container which embodies as an inherent feature of its construction an element of two-fold function, viz. a stabilizer to steady the receptacle against tilting or tipping over and a mechanical reinforcement or truss to stiffen and strengthen the receptacle against collapse or distortion. According to Emery's concept, the base of the receptacle or container is provided with an annular rim extension adapted to rest flatly upon the table, floor or other supporting surface and by such flat contact with such supporting surface to impart stability to the article, as well as generally to stiffen and reinforce the same in the region where it is normally weakest and most susceptible to distortion.

Figures 1 and 2 of Emery illustrate a cuspidor 10 made of molded pulp or other light weight inexpensive fibrous material, and embodying the features of his invention.

As shown, the cuspidor 10 has an internal cavity 11 defined by an inverted V-shaped enclosing rim or wall 12-13 and a connecting portion 14 constituting the cavity bottom. The outer portion 13 of the rim or wall 12-13 terminates in a generally horizontally extending rim extension 15. This preferably although not necessarily is of channel cross-section as indicated at 16 and terminates in an outwardly extending horizontal edge 17, the whole providing a combination stabilizing and reinforcing annulus. Preferably, the cavity bottom is flat as best shown in Figure 2, so as to rest squarely on the floor or other supporting surface S on which the receptacle is placed.

Emery's rim extension 15-16-17 is disposed in a plane generally parallel to that of the supporting surface S so as to enable the cuspidor 10 when accidentally struck, kicked, or otherwise contacted, to slide in an upright condition along the surface S rather than to tilt or tip over. To this extent such extension acts as a runner or extended slide bearing which stabilizes the cuspidor 10 as a whole by its steady, flat bearing on the surface S. Apart from its function as a stabilizer, such rim extension acts as an annular truss or reinforcement at the base of the rim portion 13 where the article is ordinarily weakest. It also affords an annular gutter or trap about the base of the receptacle effective to catch and retain any overflow from the central cavity. Emery teaches (column 3, lines 14-19) that: "The rim extension may be of any practical width and cross-section. In effect, it constitutes a continuation of the cavity bottom 14, being

spaced therefrom by the distance separating the inverted V-shaped wall portions 12 and 13 at their lower edges."

Sinaiko's invention relates generally to vessels or containers and, more specifically, to drinking vessels such as cups, glasses, tumblers, mugs and the like.

Sinaiko teaches (column 1, lines 17-35) that

the ordinary mug used by children upsets quite readily when struck or pushed sidewise, as it frequently is by its user.

My present invention is designed to prevent the usually frequent accidental spilling of their beverages by children or the upsetting of any similar vessel or container. With this end in view, it contemplates the provision of a drinking mug or other vessel or container which will not readily upset when struck or pushed sidewise and which, when deposited on a tray or other supporting surface, will automatically, under ordinary conditions, assume an upright position.

In carrying out the conception of my invention I propose to provide a drinking vessel or container, preferably in the form of a mug or other vessel having a low center of gravity, with a base which extends radially a substantial distance or distances in all directions from the bottom of the mug.

A preferred embodiment of Sinaiko's invention is illustrated in Figures 1-3 wherein a drinking mug is constructed in accordance with his invention. The mug comprises a body 5, a handle 6 and a base 7 which surrounds and extends radially outwardly in all directions from the lower end the body 5. This base may be formed integrally with the body of the mug, as, for instance, by a molding process if the mug be

made of plastic or ceramic material or glass or other suitable material, or, if preferred, the mug body and the base may be formed structurally independent of each other and rigidly secured together by a fusion process, or by the employment of a suitable adhesive. The shape of the base 7 may vary in accordance with the manufacturer's views but, preferably, it is polygonal in contour, and for illustrative purposes has been shown as being substantially square. In any event, the base extends outwardly from the mug bottom a sufficient distance to impart great stability to the mug so that it cannot be readily upset by striking it or pushing it laterally, obliquely or in any other plane. Furthermore, when the user lowers the mug in an inclined position onto a tray or other surface, an edge or a corner of the base will be first to contact the surface and will act as a fulcrum about which the mug will tilt to assume an upright position.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Emery and claims 1 and 10, the independent claims on appeal, it is our opinion that the only difference is the limitation that when the outer base is placed on a flat surface the edge of the outer base and the

portion of the outer base nearest the outer wall both come in contact with the flat surface. As shown in Figure 2 of Emery, edge 17 of the rim extension 15 (i.e., the outer base) does not contact the flat surface S.

With regard to this difference, in applying the above-noted test for obviousness, we conclude that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have replaced Emery's rim extension 15 having a channel 16 (i.e., gutter or trap) with a flat rim extension as suggested and taught by Sinaiko's base 7 and thus when the flat rim extension (i.e., the outer base) is placed on a flat surface the edge of the flat rim extension and the portion of the flat rim extension nearest the outer wall both come in contact with the flat surface. The motivation for this modification to Emery comes from (1) the applied prior art teaching two known alternatives for achieving the same function² (i.e., prevention of tipping), and (2) Emery's teaching that his rim extension 15 preferably, although not necessarily, is of channel cross-section as indicated at 16 thus suggesting to an artisan that other configurations are feasible.

² In this regard, it must be borne in mind that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

The appellant argues (brief, pp. 5-6) that (1) there is no suggestion in the applied prior art for a person of ordinary skill in the art to have modified Emery to arrive at the claimed subject matter of independent claims 1 and 10; and (2) that Emery teaches away from the claimed subject matter of independent claims 1 and 10. We find argument (1) unpersuasive since we believe that the applied prior art does provide sufficient suggestion/motivation for a person of ordinary skill in the art to have modified Emery to arrive at the claimed subject matter of independent claims 1 and 10 for the reasons set forth above. As to argument (2), Emery's teaching of a preferred embodiment does not constitute a teaching away. See In re Susi, 440 F.2d 442, 446 n. 3, 169 USPQ 423, 426 n.3 (CCPA 1971) and In re Dunn, 349 F.2d 433, 438, 146 USPQ 479, 482-83 (CCPA 1965). As to the specific question of "teaching away," our reviewing court in In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated "a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In this case, Emery does not teach or suggest that a flat rim extension would not work. Instead, Emery teaches that a rim extension with a channel to act as a gutter or trap would be preferred.

For the reasons set forth above, the decision of the examiner to reject claims 1 and 10 under 35 U.S.C. § 103 is affirmed.

Claims 2 to 9 and 11 to 20 which depend from either claim 1 or claim 10 have not been separately argued by appellant as required in 37 CFR § 1.192(c)(7) and (8)(iv). Accordingly, we have determined that these claims must be treated as falling with their respective independent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Thus, it follows that the decision of the examiner to reject claims 2 to 9 and 11 to 20 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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