

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD BOHACIK and STANLEY DICKERSON

Appeal No. 2006-1951
Application No. 10/392,140
Technology Center 3700

ON BRIEF

Before LEVY, NAPPI, and FETTING, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10-13. Claims 1-9 and 14-16 have been withdrawn from consideration (brief, page 2).

We AFFIRM.

BACKGROUND

The appellants' invention relates to a blank for a sink (specification, page 1).

Claim 10 is representative of the invention, and is reproduced as follows:

10. A sink comprising

a drawn one piece metal body defining a floor and an upstanding wall extending peripherally of said floor; and

a peripheral metal frame welded to and extending upwardly from said wall of said body.

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

Just	2,456,065	Dec. 14, 1948
Wenning et al. (Wenning)	6,488,172	Dec. 3, 2002

Claims 10, 11 and 13 stand rejected under 35 U.S.C. § 102(b)¹ as being anticipated by Wenning.

¹ Because the Wennings patent issued less than one year prior to the filing of the application, we consider the rejection to under 35 U.S.C. § 102(e) rather than 102(b).

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wenning in view of Just.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed September 1, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 16, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's

answer. Upon consideration of the record before us, we make the determinations which follow.

From our review of the entire record before us, we will sustain, for the reasons which follow, the rejection of claims 10-13. We note at the outset that with respect to the anticipation rejection of claims 10, 12 and 13, that appellants have only presented arguments for independent claim 10. Accordingly, we select claim 10 as representative of the claims rejected under 35 U.S.C. § 102.

We start with the rejection of claims 10, 11 and 13 under 35 U.S.C. § 102(e) as being anticipated by Wenning. Turning to claim 10, we note as background that **it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists whether there was a recognition that it could be used to perform the claimed function.** See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Appellants assert (brief, page 3) that Wenning is non-analogous art because the reference is directed to a thermally insulated housing and does not use the term "sink." It is argued that Wenning describes the housing as being used for a domestic refrigerating appliance such as a household refrigerator or

freezer. Appellants assert (id.) that although the examiner considers the term "sink" as being met by the bottom 22 and tubular element 19 of Wenning, that the examiner's position is contrary to the use of the term "sink" as used by appellants and the dictionary definition of the term, supplied by appellants.

It is argued (brief, page 4) that cover 21 of Wenning does not form a floor as defined by the dictionary definition supplied by appellants. Moreover, it is argued (id.) that shell wall 23 of cover 21 of Wenning does not have an upstanding wall because shell wall 23 extends horizontally. Appellants additionally argue (brief, page 5) that tubular element 19 of Wenning extends horizontally from cover 21 and does not extend upwardly from wall 23 as required by claim 10. It is further argued that shell wall 19 does not extend upwardly from wall 23 because of the overlap joint between cover 21 and tubular element 19.

The examiner responds (answer, page 3) that the term "sink" defines no structure other than a receptacle which is met by Wenning. With respect to the dictionary definition provided by appellants, the examiner asserts that the primary definition is "pool" which is met by the Wenning structure and is not contrary to the definition by applicant and the dictionary.

We begin with claim construction. Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood.

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). "[R]esort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984).

With respect to the term "sink" as it appears in the preamble of claim 10, we note that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). "The determination of whether preamble recitations are structural limitations or mere statements of purpose or use 'can be resolved only on review of the entirety of the patent to gain an

understanding of what the inventors actually invented and intended to encompass by the claim.” Rowe, 112 F.3d at 478, 42 USPQ2d at 1553 (*citing Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)). In addition, we note Manual of Patent Examining Procedure (MPEP) section 2111.02 (Eighth Ed., Rev. 3, August 2005)² which recites that:

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. Catalina Mktg. Int 'l v. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See id. at 808-10, 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble’s effect on claim scope, as well as a hypothetical example illustrating these principles. “[A] claim preamble has the import that the claim as a whole suggests for it.” Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also Jansen v. Rexall Sundown, Inc., 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003) (In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering

² This section of the MPEP was in effect as of the date the examiner’s answer was mailed.

a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose.). Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim 10 recites "A sink comprising" The specification recites (page 1) "[t]his invention relates to a blank for a sink. More particularly, this invention relates to a blank for use in constructing a commercial sink." Inspection of the written description, claims and figures reveals that "sink" is not a structural limitation of the claims for the following reasons: First, the body of the claim defines a structurally complete invention. Second, the "sink" recitation in the preamble does not provide antecedent basis for any elements in the claim body. Third, nor does the term "sink" set out any relationship among the elements in the claim body. Because the preamble does not provide antecedent basis for any of the language in the body of the claim, and the body of the claim is complete without the preamble, we find that the preamble term "sink" is an introduction to the general field of the invention, and that the preamble fails to breathe life and meaning into the claim. **As such, we find that the term "sink" in the preamble is not a structural limitation of the claim, but is merely a recitation of the intended use of the claimed structure.** Accordingly, we decline to give patentable weight to the term "sink" as it appears in the preamble of claim 10.

From our review of Wenning, we find that figure 1 shows a first embodiment of a thermally insulated housing 10 which can be used for a domestic refrigerating appliance, such as a household refrigerator or freezer (col. 4, lines 34-37). Useful space 11 is lined by an inner housing shell 12. Inner shell 12 is a tubular element. It is produced by bending a stainless steel plate whose ends 14 face one another, and through bending, are connected to one another in a vacuum tight fashion through welding. The inner element 12 has a rectangular cross section. The end opposite loading section 13 is provided with a cover 15, which is manufactured from a stainless steel plate, for example, by a deep drawing method. Shell bottom 16 forms the rear wall of useful space 11 while shell wall 17 is designed to run around in one piece which engages the end section of tubular element 12. The engagement of the shell wall 17 over the end section produces an overlap joint between the tubular element 12 and the cover 15. The tubular element 12 and the cover 15 are connected in a vacuum tight manner by welding (col. 4, lines 39-60). Outside of the inner structure is an outer structure, similarly constructed, as noted by the examiner in the answer. Between the two

structures is thermal insulation layer 18 (col. 5, lines 1-22). The body of claim 10 recites in its entirety "a drawn one piece metal body defining a floor and an upstanding wall extending peripherally of said floor, and a peripheral metal frame welded to and extending upwardly from said wall of said body."

From the above disclosure of Wenning, we find that these limitations are met, because the shell bottom 15 of Wenning is drawn one piece metal body 15 having as upstanding wall 17 extending peripherally of the floor 116, and because peripheral metal frame 14 is welded to and extending upwardly from the wall 17 of the body 15. We additionally find that the inner or outer housing of Wenning, is capable of being used as a sink, to the same extent as is the sink of claim 10 because even though Wenning does not disclose a drain or water supply, these features are not recited in appellants' claim 10. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) ("It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.") The claim language is similarly met by outer shell 19, 21 and 23 as advanced by the examiner.

We are not persuaded by appellants assertion (brief, page 3) that claim 10 is not anticipated because Wenning is non analogous art. The issue of analogous art is not pertinent to a rejection under 35 U.S.C. § 102. We additionally note MPEP § 2131.05 which recites:

Arguments that the alleged anticipatory prior art is 'nonanalogous art' . . . is not germane to a rejection under section 102." Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1,

7 (CCPA 1982)).

Nor are we persuaded by appellants assertion (brief, page 4) that non-analogous structure cannot form the basis of a rejection under 35 U.S.C. § 102, citing Verdeggal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). From our review of this case, we find that the decision states (Verdeggal, at 1053) “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.³” From our claim construction, supra, we found that the term “sink” in the preamble did not breathe life and meaning into the claim, and was not given patentable weight.

The intended use of the sink does not, based upon the facts of this case, distinguish over the blanks used in the housing structure of Wennings.

Nor are we persuaded by appellants’ assertion (id.) that cover 21 of Wennings does not form a floor. Because element 16 is referred to as the shell bottom by Wennings (col. 4, lines 50-

³ Citations omitted.

52), we find that the bottom surface of the shell bottom forms the floor of the shell, in the same way as element 22 (outer shell bottom) forms the floor of shell bottom.

Nor are we persuaded by appellants' assertion (id.) that shell wall 23 of cover 21 is not upstanding, because shell wall 17 extends in a perpendicular direction from shell bottom 16 in the same manner as outer shell wall extends perpendicular to shell bottom 22. In a similar fashion, we are not persuaded by appellants' assertion (brief, page 5) that tubular element 19 of Wenning does not extend upwardly from the upstanding wall 23. Because tubular element 14, as well as tubular element 19 extend perpendicular to the bottom the shell, we find that the peripheral frames 14 and 19 extend upwardly from the walls 17 and 23 of Wenning. Note: the orientation of the structure, in and of itself, does not distinguish the structure from the prior art, and we read the housing from the bottom of the structure, irrespective of how the structure is oriented.

From all of the above, we find that the disclosure of Wenning is sufficient to establish a prima facie case of anticipation of claim 10, and are not convinced of any error on the part of the examiner in rejecting claim 10 under 35 U.S.C.

§ 102(e). The rejection of claim 10 under 35 U.S.C. § 102(e) is sustained, along with the rejection of claims 11 and 13, which fall with claim 10.

We turn next to the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Wenning in view of Just.

The examiner's position (answer, page 3) is that Just teaches welding abutting ends of an appliance. The examiner asserts (id.) that "[t]o provide for such a joining scheme for the edges of Wenning et al would have been obvious as same is taught in a similar art device." Appellants assert (brief, page 6) that Wenning specifically teaches away from using a butt weld because "if individual elements are butt connected to one another, it is not possible to entirely exclude the possibility of leaks occurring which adversely affect the vacuum insulation, (column 1, lines 45 to 49)." Appellants add (id.) that in Wenning, cover 21 is put into place after cover 15 has been put into place, and that butt welding shell wall 23 to tubular element 19 could damage thermal insulation 24 that is pressed into the cover.

We note at the outset that claim 12 does not recite butt welding. In addition, we disagree with appellants that Wenning

teaches away from butt welding. Although Wenning does disclose that with butt welding it is not possible to entirely exclude the possibility of leaks (col. 1, line 34-48). However, this disclosure is referring to prior art structures that relied upon U or L shaped members. In this prior art structure, it was also known to weld along adjoining flanges (col. 1, line 37). In this prior art structure, the welding of overlapping flanges also resulted in leaks (col. 1, lines 45-48).

In the invention of Wenning, which uses a cover 15 having a bottom portion 16, the cover is formed by a deep drawing method (col. 4, lines 49-52). We find no disclosure in Wenning, and none has been brought to our attention by appellants, that would suggest the deep drawn bottom member 15, 16, 17 would suffer from a possible leakage problem because the embodiment of the invention disclosed by Wenning only has straight weld lines, unlike the U or L shaped structures of the prior art disclosed by Wenning.

As broadly drafted, the claim is met by the offset facing edges of the tubular element 14 of Wenning and the bottom 15, 16 and 17 which are welded in an offset fashion. We find nothing in the language of claim 12 that would preclude the facing edges of

Wenning from being offset welded, and we decline to read limitations into the claim that are not found therein.

Appellants may be correct that in Wenning, the welding of the outer housing could conceivably harm the insulation. However, we have relied upon the inner housing of Wennings to meet the limitations of claim 10, and have alternatively relied upon the outer housing. In any event, appellants do not argue the teachings of Just. From the disclosure of Just of using a butt weld to secure the facing edges of a sink that is fabricated out of metal using seamless weld (col. 1, lines 7 and 8 and 36 and 37), we agree with the examiner that an artisan would have been motivated to weld facing elements in the structure of Wennings.

From all of the above, we find that the teachings of the prior art would have suggested the limitations of claim 12. The rejection of claim 12 under 35 U.S.C. § 103(a) is sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10, 11 and 13 under 35 U.S.C. § 102(e) is affirmed. The decision of the examiner to reject claim 12 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

STUART S. LEVY)	
Administrative Patent Judge)	
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ANTON W. FETTING)	
Administrative Patent Judge)	

Appeal No. 2006-1951
Application No. 10/392,140

Παγε 18

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Appeal No. 2006-1951
Application No. 10/392,140

Παγε 19

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