

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**

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CHRISTOPHER L. BEMIS

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Appeal No. 2006-2036  
Application No. 10/382,753  
Technology Center 3600

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ON BRIEF

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Before OWENS, LEVY and HORNER, *Administrative Patent Judges*.  
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1, 4, 5, 7, 8, 11, 12, 14, 15, 18, 19, and 21, all of the elected claims pending in the application. Claims 2, 3, 6, 9, 10, 13, 16, 17, and 20 have been withdrawn.

We reverse.

## BACKGROUND

The appellant's invention relates to a fluid capture system for collecting the discharge of fluids from the vicinity of an aircraft landing wheel. Claims 1 and 4 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Van Romer <i>et al.</i> (Van Romer)	5,090,588	Feb. 25, 1992
Telder	5,603,362	Feb. 18, 1997

The following rejections are before us for review.

1. Claims 1, 4, 5, 7, 8, 11, 12, 14, 15, 18, 19, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Telder.
2. Claims 1, 4, 7, 8, 11, 14, 15, 18, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Romer in view of Telder.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed December 30, 2005) for the examiner's complete reasoning in support of the rejection and to the appellant's brief (filed October 17, 2005) and reply brief (filed March 3, 2006) for the appellant's arguments.

## OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, Telder does not anticipate the invention as claimed, and the examiner has failed to set forth a prima facie case of obviousness.

### ***Rejection Under 35 U.S.C. § 102(b)***

In the rejection of independent claims 1, 8, and 15 the examiner has determined that Telder shows a fluid capture system having a fluid retaining means (oil changer 10) comprising a fluid damming means (side walls 27) and contour means (cutout 38) for permitting placement of the fluid retaining means in position below the aircraft adjacent the landing wheel of the aircraft. The examiner further found that the contour means of Telder is adapted to permit at least three sides of the landing wheel to be partially surrounded by the fluid damming means, and the fluid retaining means of Telder comprises substantially one integral piece structured and arranged to be placed substantially flat on the ground in position below the aircraft. (Examiner's Answer, p. 3).

The appellant contends, *inter alia*, that the Telder device does not disclose a fluid retaining means (claim 1) or fluid retainer (claim 8) or drip pan (claim 15) that is "structured and arranged to be placed substantially flat on the ground in position below the aircraft." (Appellant's Brief, pp. 13-14, 16, 17). Specifically, the appellant argues that: (1) the adjusting arrangement of the locking pin 35 and

height adjusting holes 33 physically prevents the fluid collecting tray 11 from being adjusted to a position substantially flat on the ground; (2) situating the collecting tray 11 at ground level, below the elevated opening of the collection container 17, would effectively prevent the intended fluid collection and retention operation of the apparatus; and (3) the bottom wall 30 of the collecting tray 11 slopes downwardly to collect the fluids at the low point via gravity so that if the collecting tray were somehow placed substantially flat on the ground, the Telder device would not function properly. (Appellant's Brief, pp. 13-14).

The examiner responds that the entire oil changer apparatus (10) of Telder anticipates the fluid retaining means of the claimed invention because this oil changer apparatus is structured and arranged with wheel arms (23) and casters (24) to be placed substantially flat on the ground in position below the aircraft. (Examiner's Answer, p. 6). The examiner makes the same argument for the fluid retainer of claim 8. (Examiner's Answer, p. 8).

We disagree with the examiner's application of Telder to the claims. Telder describes the oil changer (10) as comprising a collecting tray (11), a vertical stand (21), wheel arms (23) and casters (24). (Telder, col. 3, lines 4-6). Of these components, it is only the collecting tray (11) of Telder that retains the fluids discharged from the aircraft in the fluid capture system. Further, it is the collecting tray (11) that has the fluid damming means (claim 1), fluid dam (claim 8), contour means (claim 1) and contour (claim 8) as recited in the claims. We fail to see how the vertical stand, wheel arms and casters form part of the fluid retaining means (claim 1) or fluid retainer (claim 8).

The Examiner argued in the alternative that even if the fluid collecting tray 11 is interpreted as the fluid retaining means, the phrase, “structured and arranged to be placed substantially flat on the ground in position below the aircraft” is a functional recitation, and such a recitation of intended use is not given patentable weight. The examiner has determined that the structure 11 of Telder is capable of performing such intended use and thus anticipates the claims. (Examiner’s Answer, pp. 6-7). The examiner made the same arguments for claims 8 and 15 (Examiner’s Answer, pp. 8-10).

We disagree with the examiner’s interpretation of this limitation of the claims as being merely a functional limitation. The disputed language does not refer merely to a function of the recited system or to a desired result but rather it defines a physical property. *See e.g., In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). *See also In re Benson*, 418 F.2d 1251, 1254, 164 USPQ 22, 25 (CCPA 1969) (“Sometimes, as here, a material is as well defined by its intended use as by its dimensions or other physical characteristics, and in this case we know of no reason why the limitation in terms of use should not be placed in the claims and given meaning in their interpretation.”) Specifically, the claim language requires that the fluid retaining means (claim 1), fluid retainer (claim 8), and drip pan (claim 15) be structured to rest flat on the ground. This requires, as argued by the appellant, that the retainer have “a continuous horizontal surface spread out upon the ground so as to be level or even.” (Appellant’s Reply Brief, p. 2). Because the bottom wall 30 of the collection tray 11 of Telder slopes downwardly, it cannot be placed flat on the ground. As such, we do not sustain the examiner’s

rejection of claims 1, 8, and 15 under 35 U.S.C. § 102(b) as anticipated by Telder. The rejection of all of the remaining dependent claims is also not sustained because these rejections rely on the underlying rejection of their respective independent claims.

***Rejection under 35 U.S.C. § 103(a)***

The examiner also rejected claims 1, 4, 7, 8, 11, 14, 15, 18, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Van Romer in view of Telder. The examiner has determined that Van Romer shows a fluid capture system including fluid retaining means (10) having fluid damming means (14) and contour means for permitting placement of the fluid retaining means in position below the aircraft adjacent the landing wheel. The examiner has also determined that the fluid retaining means of Van Romer is substantially one integral piece structured and arranged to be placed substantially flat on the ground in position below the aircraft. The examiner admits that Van Romer fails to disclose contour means that partially surrounds the landing wheel and permits the landing wheel to remain outside the damming means. (Examiner's Answer, p. 4).

The examiner relies on Telder to teach a fluid capture system with contour means that permits the wheel to remain outside the fluid damming means while in position below the aircraft and that surrounds at least three sides of the landing wheel. (Examiner's Answer, p. 4). The examiner has determined,

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the contour means of Van Romer et al. with the cutout contour means as taught by Telder in order to provide a

cleaner environment by placing the drip pan under the engine in a manner that provides “a greater likelihood that all of the drained liquids will be captured” as described by Telder in column 3, lines 55-64. (Examiner’s Answer, p. 4).

The appellant argues, *inter alia*, that it is improper to combine the teachings of Van Romer and Telder because the devices are designed to perform different/incompatible functions in different/incompatible environments and operate in different/incompatible ways with different/incompatible types of airplanes. (Appellant’s Brief, p. 20). Specifically, the appellant argues that the Telder device is designed for changing oil and as such the casters (24) and narrow cutout (38) of the Telder device are designed so that the device can be carefully wheeled into position beneath a stationary plane. The Van Romer device, on the other hand, is designed to be used on crop spraying aircraft that are refueled or reloaded with chemicals at the field site. As such, the Van Romer device is designed so that a plane can be driven and positioned over a stationary containment device. The appellant argues that it would not work to use the cutout of Telder on the Van Romer device, because it would require the pilot to maneuver the plane into proper position to place the landing gear within the cutout, and the pilot would not be able to see the cutout or the landing gear from the cockpit. (Appellant’s Brief, pp. 20-21, Appellant’s Reply Brief, pp. 5-7). Also, Van Romer teaches that essentially the entire aircraft is to be parked over the portable containment (10), such that the landing wheels of the aircraft rest on the floor (12). (Appellant’s Brief, p. 22).

The appellant argues that there is no motivation to combine Van Romer and Telder because there is no teaching or suggestion within Van Romer, Telder, or elsewhere, to modify the Van Romer device to permit the landing wheel to remain outside the containment area nor is there teaching or suggestion to modify Van Romer to include the cutout of the Telder reference. (Appellant's Brief, pp. 22). The appellant notes that if the Van Romer containment device were modified to add the cutout of Telder, the containment device would be less likely to capture all of the crop spraying or fuel liquids since a portion of the plane would not be positioned over the containment area. (Appellant's Brief, p. 23).

The examiner responds that it would have been obvious to add the cutout of Telder to the Van Romer device to avoid having the wheel of the aircraft run over the damming means which could result in spillage of the fluid from the containment area. (Examiner's Answer, p. 12).

We agree with the appellant that there is not sufficient motivation to modify the Van Romer containment system to add the wheel cutout of Telder. Specifically, we hold that there would have been no motivation absent the teaching of the present invention for one skilled in the art at the time of the invention to modify Van Romer, which relates to a portable containment area for use with crop spraying aircraft, with the teaching of a wheel cutout of Telder, which relates to an oil changer device for aircraft. A review of Van Romer and Telder shows that a modification of Van Romer with the cutout of Telder would provide no advantage or beneficial result.

The portable containment device of Van Romer is designed to contain spills during loading and offloading of pesticides during applications at on-site farm field locations to prevent contact with the surrounding environment. (Van Romer, col. 1, lines 19-26). The Van Romer device is designed to withstand vehicle traffic onto and off of the unit without altering the unit and specifically to withstand vehicle traffic over the walls of the containment unit. (Van Romer, col. 2, lines 4-11). Further, the chief concerns described for the design of the Van Romer device were *easy access* and high likelihood of catching and preventing any spill from *any vehicle location*. (Van Romer, col. 5, lines 6-8).

Telder teaches an oil changer provided with a hinged door to fit around the nose wheel or landing gear of a single engine aircraft to ensure complete capture of fluids from the engine compartment. (Telder, col. 2, lines 9-11 and col. 3, lines 55-64). The Telder device is directed to capturing fluids only from the area below the engine compartment and does not teach or suggest using the device to capture any other fluids from beneath the aircraft.

As noted by the appellant, because the Van Romer device is designed to be placed in the field and then driven onto by the aircraft, if the wheel cutout of Telder were added, it would require the pilot to maneuver the aircraft to align the landing gear in the cutout. This would be difficult to implement and would frustrate the stated goal of Van Romer for easy access to the containment area. Further, the Van Romer containment area is designed with the collapsible side walls so that the wheels can be driven over the walls, and the entire plane can rest over the containment area. If the wheel cutout of Telder were added to the

containment area, it would frustrate the stated purpose of Van Romer to catch any spill from any location on the aircraft, because a portion of the aircraft would not be parked over the containment area. As such, we find no motivation to add a wheel cutout to the fluid containment area of Van Romer.

The examiner argues that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). (Examiner's Answer, p. 12). While we agree with the examiner's statement of the law, we find here that the combined teachings of Van Romer and Telder would not have led one of ordinary skill in the art at the time of the invention to have added a cutout to the containment device of Van Romer, because (1) the addition of a wheel cutout to the containment device of Van Romer would change the basic principle under which the Van Romer device was designed to operate by not allowing the pilot to simply drive over the side walls of the containment device to park the entire aircraft over the containment device; and (2) adding a wheel cutout to the containment device of Van Romer would not allow the containment device to capture fluids from any location on the aircraft since the portion of the aircraft forward of the wheels would not be positioned over the containment area.

As such, we hold that the examiner has failed to set forth a prima facie case of obviousness, because one skilled in the art would not have been motivated at the

time of the invention absent the teaching of the present invention to modify the containment area of Van Romer to add a cutout as taught in Telder. From our perspective, the Examiner's rejection appears to be premised on impermissible hindsight reasoning.

***Restriction Requirement***

The appellant seeks to have the Board review the propriety of a restriction requirement made by the examiner in the present application. Any challenge to a final requirement for restriction should be taken by petition to the Director pursuant to 37 C.F.R. §§ 1.181 and 1.144. As such, this matter is not properly before the Board, and we decline to review the restriction requirement. *See* M.P.E.P. §§ 1002 and 1201.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4, 5, 7, 8, 11, 12, 14, 15, 18, 19, and 21 is reversed.

*REVERSED*

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TERRY J. OWENS	)	
Administrative Patent Judge	)	
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STUART S. LEVY	)	APPEALS
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LINDA E. HORNER	)	
Administrative Patent Judge	)	

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