

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* MICHAEL WITTHOFT

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Appeal 2007-0737  
Application 10/290,606  
Technology Center 1700

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ON BRIEF

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Before GRIMES, LINCK, and LEBOVITZ, *Administrative Patent Judges*.  
LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

Claims 1-5, 7, 9, and 10 are on appeal. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

This appeal involves claims to an ice cream scoop having a deformable exterior portion for manually ejecting ice cream from the ice cream-filled scoop. Claims 1-5, 7, 9, and 10-12 are pending (Answer 2). Claims 11 and 12 are withdrawn from consideration (*id.*)

The following prior art references are relied upon by the Examiner as evidence of unpatentability:

|                     |                     |               |
|---------------------|---------------------|---------------|
| Ellis               | U.S. Pat. 2,191,524 | Feb. 27, 1940 |
| Donovan             | U.S. Pat. 3,483,908 | Dec. 16, 1969 |
| DeWitt <sup>1</sup> | GB 2,048,756        | Dec. 17, 1980 |
| Burnham             | U.S. Pat. 4,244,470 | Jan. 13, 1981 |

Claims 1-5, 7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Ellis alone, or in view of Burnham, Donovan, or DeWitt. (Br. 2-3). The claims stand or fall together because Appellant has not separately argued the patentability of any individual claims. We select claim 1 as representative for the purpose of deciding this appeal. 37 C.F.R.

§ 41.37(c)(1)(vii). It reads as follows:

1. An ice cream scoop comprising a scoop portion and a handle portion, said scoop portion having an interior and an exterior and comprising a rim portion and a deformable portion, said rim portion being formed of a rigid material and said deformable portion being formed of an elastomer and forming at least a portion of the exterior of the scoop portion.

#### ISSUE ON APPEAL

The Examiner contends that it would have been obvious to the skilled worker to have eliminated the fluid or air pressure system utilized in Ellis's ice cream scoop to mechanically discharge ice cream from the scoop portion. This modification, the Examiner argues, would result in an ice cream scoop having a manually deformable exterior which performs the

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<sup>1</sup> Also referred to as "GB '756."

same function as Ellis's mechanical system and which meets the limitations of the claimed invention.

Appellant contends that there is no motivation to have eliminated the mechanical system from Ellis's scoop.

The question in this appeal is whether the prior art provides the requisite motivation under 35 U.S.C. § 103(a) to have modified Ellis's scoop by substituting manual operation for Ellis's mechanical pressure system to dislodge ice cream from an ice cream scoop.

#### DISCUSSION

A claimed invention is obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). To make this determination, we consider whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). "Underpinning this legal inquiry are four groups of factual findings . . . (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of

others. *Graham v. John Deere Co.*, 383 U.S. 1, 17. . . (1966).” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006).

On the record before us, we find sufficient evidence to establish prima facie obviousness of the claimed subject matter. After identifying the difference between the claimed invention and the prior art, the Examiner clearly articulates a reason that would have motivated the skilled worker to have modified the prior art (Answer 4). The Examiner also provides evidence from the scope and contents of the prior art that the modification was conventional and commensurate with the level of ordinary skill in the art (*id.* at 5). Because these findings are at issue, we explain the Examiner’s case in more detail below.

Ellis is the primary reference relied upon by the Examiner to establish the differences between the claimed invention and the prior art. Ellis describes an ice cream “dipper” which utilizes “a pneumatic or hydraulic method of operation.” (Ellis at p. 1, col. 1, ll. 25-27.) The dipper comprises a rigid exterior dipper shell (10) and a flexible interior diaphragm (12) within the rigid shell (Ellis at p. 1, col. 1, ll. 1-5; col. 2, ll. 8-11). The dipper also “includes an ejector bulb (15) that acts as a pump to compress air between the exterior rigid shell and the interior flexible diaphragm. When the user pumps air into the area between [the ] rigid exterior shell and the flexible interior diaphragm of the scoop, the diaphragm deforms and displaces the ice cream from the scoop (see page 2, left column, lines 40-50).” (Br. 3.)

The Examiner asserts that “Ellis teaches the basic claimed ice cream scoop,” but does not describe that the claimed “deformable portion” forms “at least a portion of the exterior of the scoop” as required by claim 1 (Answer 3-4). The Examiner argues that the “reason” this structure is missing is because Ellis “uses a complicated air pressure” system in which air is forced between the rigid exterior shell and the deformable interior diaphragm, inverting the diaphragm to release the ice cream from the scoop (*id.* at 4). The Examiner asserts that it would have been obvious to have eliminated the structures “taught in Ellis to apply the air pressure and [instead, to have] simply used the operator’s hand to depress the deformable portion, such being fairly conventional in the art.” (*id.*)

*Scope and content of the prior art/level of ordinary skill*

Secondary references are relied upon by the Examiner to establish that it was conventional at the time the application was filed to utilize deformable containers to manually eject hardened foods from food molds. We review these disclosures briefly:

1) DeWitt describes a mold for making confectionary products in which the mold “has at least one base wall portion which is of greater flexibility than the other wall portions.” (Abstract; p. 1, ll. 97-102; Fig. 1). Ejection is accomplished by applying pressure to the outer surface of the more flexible base wall (p. 1, ll. 123-129).

2) Donovan describes “containers having bottom portions flexibly designed to aid in the discharge of a substantially solid substance substantially in one piece.” (Col. 1, ll. 46-49.) The sidewalls of the container are “provided with a series of substantially parallel ribs 20 which

provide increased resistance to deformation in the lateral direction.” (Col. 2, ll. 19-24.) The container can also be constructed to have “a bottom 32 of relatively thin thickness in comparison to the thickness of the sidewall 30.” (Col. 2, ll. 37-39.)

3) Burnham discloses a receptacle for holding refrigerated units of ice cream for individual servings. The receptacle comprises two hinged parts which, “when disposed face-to-face define an enclosure of predetermined shape for holding a molding of hardenable substance.” (Col. 1, ll. 17-21.) “The enclosure is comprised of a thin wall yieldably flexible plastic such as to enable displacing a portion of the wall inwardly of the part containing the frozen substance when the parts have been separated from each other to enable ejecting the hardenable substance therefrom.” (Col. 1, ll. 23-28.)

In addition to showing what was conventional at the time the application was filed, these disclosures also establish that the ordinary skilled worker was familiar with making deformable containers to discharge hardened foods, and was capable of making several different designs, including designs in which 1) the sides were made more rigid than the deformable bottom by varying the material thickness (e.g., Donovan), 2) the sides and deformable bottom were of the same deformability (Burnham), and 3) the sides were made more rigid by adding structure to increase their resistance (Donovan). Thus, making a deformable container using different design strategies was commensurate with the level of ordinary skill in the art at the time the claimed invention was made.

*Teaching, suggestion, motivation*

Burnham, Dewitt, and Donovan provide sufficient evidence to establish that the concept of manually deforming a container bottom to eject food from it was well known to the person of ordinary skill in the art (*see supra*, p. 5-6). Ellis's ice cream dipper operates on the same principle, but uses a more sophisticated system that relies on air pressure, rather than a person's fingers, to deform the scoop and discharge the ice cream from it. Because manual deformation had been used repeatedly in the prior art to perform the same function that air or fluid pressure accomplishes in Ellis's dipper, we find the Examiner's prima facie case of obviousness supported by a preponderance of the evidence that the skilled worker would have recognized that it could have been applied to an ice scoop, eliminating the need for Ellis's more complicated system. There is no express suggestion to make the modification, but the suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art. "[T]he teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Appellant contends that the "the rigid exterior shell of Ellis cannot be eliminated" because it "would render Ellis inoperative." (Br. 4.) Appellant asserts that the rigid shell "is absolutely necessary to fulfill the function of deforming the flexible diaphragm . . . when using pneumatics or hydraulics.

Without the rigid shell, the air pumped from the ejector bulb 15 would not dislodge the ice cream.” (*id.*) We do not find this argument persuasive. As pointed out by the Examiner, without its rigid shell, “the operator would simply press down on the flexible portion using his or her hand to release the ice cream.” (Answer 6-7.)

Appellant also argues that if the rigid shell were removed, the vulcanizing cutter and ring to scoop the ice cream would have no structural support (Reply Br. 4). “Therefore, if one were to try to use the Ellis invention without the outer shell to scoop ice cream from a container, the whole dipper portion of the scoop would collapse, accordion-like, when pressed against ice cream.” (*id.*)

We do not find this argument persuasive. Ellis teaches the annular cutter for scooping the ice cream as rigid and a separate element from the rigid exterior shell (Ellis at p. 1, ll. 42-50). Consequently, eliminating the shell would leave a rigid “rim portion” as required by instant claim 1. Moreover, the Examiner has provided three references which describe how to make containers which do not collapse when inverted to discharge a solid food. Appellant’s argument fails to take in consideration that the skilled worker, motivated to have removed the rigid shell from Ellis’s dipper, would have known how to modify it to prevent it from collapsing “accordion-like.”

Appellant asserts that “each of the references cited describes an exterior formed of a single material. No suggestion exists to form the exterior of the containers of the secondary references from two different types of materials, one rigid and the other elastomeric.” (Br. 5). We do not find this argument persuasive. Dewitt and Donovan describe containers in

which the deformable portion is flexible, while the rim portion is rigid, albeit comprised of the same material. However, the prior art teaches that the deformable and rim portions may be formed of different materials. In Ellis, the “rigid” cutter or ring (11) is sealed to the “flexible” deformable diaphragm (p. 1, ll. 25-55). These parts perform the same function of the rigid and flexible portions of the DeWitt and Donovan containers. Thus, the skilled worker would have considered a construct made of two different materials, each having different rigidity, interchangeable with a construct made of the same material, but having portions of different rigidities.

Finally, Appellant argues that “[t]he Ellis patent expired many years ago, therefore anyone could still have marketed a product for many years. The fact there is no product on the market that solves the problem which Applicant’s invention solves is evidence of” the non-obviousness of the claimed invention (Reply Br. 7). As we understand it, Appellant is asserting a long-felt need, *i.e.*, a recognized problem existed in the art for a long time without solution.

We do not find this argument persuasive because no objective evidence has been submitted to support it. “[P]recedent requires that the applicant submit actual evidence of long-felt need, as opposed to argument. This is because ‘[a]bsent a showing of long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness.’ *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004); accord *In re Wright*, 569 F.2d 1124, 1127 (C.C.P.A. 1977).” *Kahn*, 441 F.3d at 990-91, 78 USPQ2d at 1338-39.

For the foregoing reasons, we find sufficient evidence of record to establish a prima facie case of obviousness of claim 1. Appellant has not provided adequate evidence to rebut it. Accordingly, the rejection of claim 1 is affirmed. Claims 2-5, 7, 9, and 10 fall with claim 1.

TIME PERIOD

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

*AFFIRMED*

|                             |   |                 |
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| Eric Grimes                 | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| Nancy J. Linck              | ) |                 |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) |                 |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
| Richard M. Lebovitz         | ) |                 |
| Administrative Patent Judge | ) |                 |

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