

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY R. ALLANSON, ANN MARIE SULLIVAN,
THOMAS C. MERLE, JOHN A. MACNEIL, JOHN GUNDLACH, and
JOHN COSTELLO

Appeal 2008-0039
Application 10/127,085
Technology Center 3700

Decided: February 21, 2008

Before DONALD E. ADAMS, LORA M. GREEN, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges.*

ADAMS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 21, 22, 25, 30, 35-37, 44, 50, 51, 53-55, and 64. The remaining pending claims, claims 24, 36-39, 31-34, 38, 39, 41-43, 45-49, and 56-63 stand objected to as dependent upon a rejected base claim (April 24, 2003 Office Action 5). We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to a disposable storage and dispensing carafe.

Claim 21 is illustrative:

21. A disposable storage and dispensing carafe comprising:
 - a portable body, said portable body further comprising a base and a first handle for manipulating said carafe to dispense contents therefrom;
 - a bag having an outlet opening and positioned within said portable body;
 - a collapsible insulating surface associated with said portable body and circumscribing said bag; and
 - a spout having an interior generally cylindrical channel defining an inlet opening and an outlet opening at opposite ends of said spout and configured to allow direct, in-line flow of fluid both into and out of said bag, said inlet opening being fixedly attached to said outlet opening of said bag, said spout being detachably held within a top surface of said portable body;
 - wherein said spout is positioned within said top surface of said portable body in an orientation with respect to said base so as to enable said carafe to be filled with a fluid when positioned with said spout vertically below a vertical fluid dispenser without requiring supplemental support of said carafe.

The Examiner relies on the following prior art references to show unpatentability:

Reed	US 5,119,972	Jun. 9, 1992
Kurtzahn	US 5,265,766	Nov. 30, 1993
Libit	US 6,032,826	Mar. 7, 2000

The rejection as presented by the Examiner is as follows:

Claims 21, 22, 25, 30, 35-37, 44, 50, 51, 53-55, and 64 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Kurtzahn, Reed, and Libit.

We affirm.

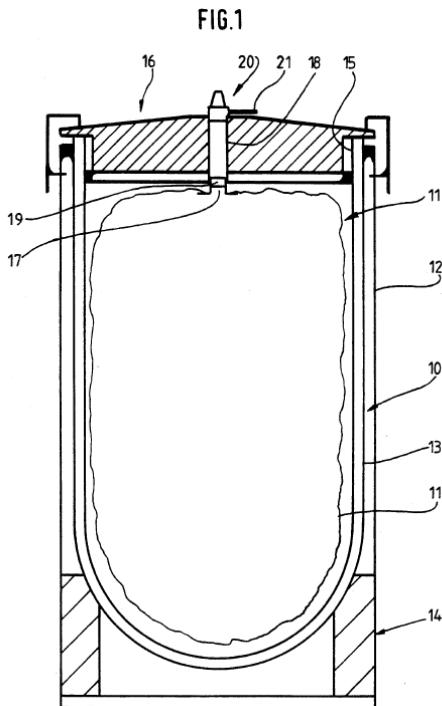
DISCUSSION

The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we limit our discussion to representative claim 21. Claims 22, 25, 30, 35-37, 44, 50, 51, 53-55, and 64 will stand or fall with claim 21.

Findings of Fact (FF):

Kurtzahn:

1. teaches a storage and dispensing carafe as illustrated in Figure 1 reproduced below.



“FIG. 1 shows an exemplary embodiment of . . . [Kurtzahn’s] apparatus with a vertical section of an insulating container” (Kurtzahn, col. 2, ll. 29-30);

2. teaches a carafe “comprising a portable body (outer wall 12 combined with bottom piece 14 and lid 16), a bag (inner layer 11), a spout (liquid passage 18 and valve 20) , spout holder/fastener (coupling 19), and an insulating jacket (13)” (December 31, 2003 Final Rejection (Final Rejection) 2¹);
3. teaches a “spout (liquid passage 18 and valve 20) . . . attached to an outlet opening (tube connection 17) of the bag (inner layer 11)” (*id.*);
4. teaches a spout comprising “an elongate, annular shaft configured for insertion through the body (lid 16) such that an upper end portion of the spout extends above the body” (*id.*).
5. teaches a spout having “an interior generally cylindrical channel defining an inlet opening and an outlet opening at opposite ends of the spout and configured to allow direct, in-line flow of fluid both into and out of the bag (inner layer 11)” (*id.*).
6. teaches a spout “detachably held within a top surface (lid 16) of the portable body by a spout holder (coupling 19), which acts as a fastener for removably connecting the bag to the body” (*id. at 3*).
7. teaches a spout

positioned within the top surface (lid 16) of the portable body in an orientation with respect to the base (bottom piece 14) so as to enable the carafe to be filled with a fluid when positioned with the spout . . . vertically below a vertical fluid dispenser (coffee brewer) without requiring supplemental support of the carafe

¹ The Examiner directs attention to the Final Rejection for the statement of the rejection (Ans. 3).

(*id.*).

8. teaches an “insulating jacket (13) . . . detachably connected to the body (outer wall 12 combined with bottom piece 14 and lid 16) and circumscribe[ing] the bag (plastic liner 20)” (*id.*).
9. does not teach “handles on the side of the carafe” (*id.*).
10. does not teach “a collapsible insulating jacket” (*id.* at 4).

Reed:

11. teaches a container with handles as illustrated in Figure 1 reproduced below.

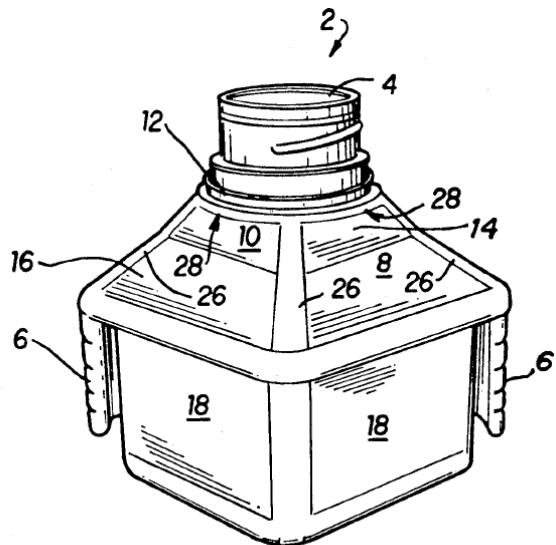


FIG. 1

- FIG. 1 “illustrates a perspective view of a container in accordance with . . . [Reed’s] invention as viewed from the side of the container” (Reed, col. 2, ll. 6-8);
12. teaches “(hand grips 6) to enable the user to transport the container by lifting, as described in [Reed,] column 2, lines 33-36” (Final Rejection 3).

13. does not teach a container comprising “a collapsible insulating jacket” (*id.* at 4).

Libit:

14. teaches “the use of corrugated cardboard, a collapsible material, as an insulating material, as described in [Libit,] column 5, lines 46-54” (*id.*);
15. provides “reasons why corrugated cardboard material is desirable as an insulating material in column 3, lines 31-35). These reasons include that the material is inexpensive and recyclable” (Ans. 3).

Analysis:

Claim 21 is drawn to a disposable² storage and dispensing carafe. Kurtzahn teaches a storage and dispensing carafe (FF 1). Claim 21 requires the carafe to comprise four elements:

- i. a portable body;
- ii. a bag;
- iii. a collapsible insulating surface; and
- iv. a spout.

Kurtzahn teaches a carafe comprising these four elements (FF 1-8).

Claim 21 requires that the bag has an outlet opening and is positioned within the portable body. Kurtzahn’s carafe has a bag comprising an outlet opening that is positioned within a portable body (FF 3).

² We interpret the term “disposable” to be a statement of the intended use or purpose of the claimed carafe. *See Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (“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.”).

Claim 21 requires that the spout has an interior that is a “generally cylindrical channel defining an inlet opening and an outlet opening at opposite ends of said spout and configured to allow direct, in-line flow of fluid both into and out of said bag, said inlet opening being fixedly attached to said outlet opening of said bag, said spout being detachably held within a top surface of said portable body.” The spout of Kurtzahn’s carafe meets the spout requirements of claim 21 (*id.*).

Claim 21 requires that the spout is positioned within said top surface of said portable body in an orientation with respect to said base so as to enable said carafe to be filled with a fluid when positioned with said spout vertically below a vertical fluid dispenser without requiring supplemental support of said carafe. The spout of Kurtzahn’s carafe meets the spout requirements of claim 21 (*id.*).

Claim 21 requires that the portable body further comprises a base. Kurtzahn’s carafe comprises a base (FF 1, 2, and 7).

Claim 21 requires that the portable body further comprises a first handle for manipulating said carafe to dispense contents therefrom. Kurtzahn does not teach a carafe comprising a handle (FF 9). However, Reed teaches a container comprising handles (FF 11 and 12). Based on this evidence the Examiner concludes that

[i]t would have been obvious to one with ordinary skill in the art at the time the invention was made to make the carafe of Kurtzahn et al. with handles, as taught by Reed et al., in order to provide a means for transporting the carafe by lifting. The handles could also be used to manipulate the carafe into the dispensing position.

(Final Rejection 3-4.)

We find no error in the Examiner's reasoning. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007).

Claim 21 requires the carafe to comprise a collapsible insulating surface that is associated with the portable body and circumscribing the bag. The combination of Kurtzahn and Reed does not teach a carafe comprising "a collapsible insulating jacket" (FF 10 and 13). However, Kurtzahn teaches an insulating jacket 13 (FF 1, 2) and Libit teaches "the use of corrugated cardboard, a collapsible material, as an insulating material" and provides reasons for choosing cardboard as an insulating material (FF 14 and 15). Based on this evidence, the Examiner concludes that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to use corrugated cardboard as the material for the insulating material, since it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

(Final Rejection 4.)

We find no error in the Examiner's reasoning.

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR, 127 S. Ct. at 1742.

In responding to the Examiner's prima facie case of obviousness, Appellants interpret Kurtzan to suggest that element 13 of Kurtzan's carafe must be made of glass. Specifically, Appellants assert that "[t]he Examiner's modification of Kurtzahn is . . . to replace the rigid, double-wall, airtight glass insulating member 13 of Kurtzahn . . . with a flexible cardboard sleeve" (App. Br. 6). We are not persuaded by Appellants' reading of Kurtzahn. Kurtzahn only prefers that insulating member 13 be made of glass and have double walls (Kurtzahn, col. 2, ll. 52-53). Contrary, to Appellants' intimation, we find no teaching in Kurtzahn that *requires* insulating member 13 to be made of glass.

We are also not persuaded by Appellants' intimation that a person of ordinary skill in the art would mindlessly utilize Libits' cardboard sleeve as the insulator element in Kurtzahn (*see e.g.*, App. Br. 6 ("[t]he Examiner's modification of Kurtzahn is thus to replace the . . . insulating member 13 of Kurtzahn . . . with a flexible cardboard sleeve having an open top, an open bottom, and at least partially open sidewalls designed particularly to bend under the weight of a cup placed therein")). Appellants' interpretation is not the rejection before us. The Examiner's rationale is not based on the direct substitution of Libits' cardboard sleeve into Kurtzahn's device. To the contrary, as discussed above, the Examiner's modification of the art is to use corrugated cardboard as the material for the insulating material, since it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

(Final Rejection 4).

Contrary to Appellants' intimation, the prior art suggests that Kurtzahn's insulation element 13 be made of corrugated cardboard. It is

proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR*, 127 S. Ct. at 1741. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” (*Id.* at 1742.)

For the foregoing reasons, we are not persuaded by Appellants’ assertion that

[r]eplacing the double glass wall insulating member 13 of Kurtzahn with a flexible, open, corrugated cardboard cup holder as taught by Libit would render the insert entirely unsuitable for (i) directly receiving hot beverages, (ii) supporting flexible bag 11, or (iii) providing long term insulation for the contents of bag 11.

(App. Br. 7.) Appellants fail to direct our attention to an evidentiary basis on this record that supports their conjecture. For the same reasons, we are also not persuaded by Appellants’ assertion that “the Examiner’s proposed combination clearly would not be a desirable modification of Kurtzahn” (*id.*).

We recognize Appellants’ assertion that the term “disposable” as it appears in the preamble of the claim is a material limitation on the claim (App. Br. 8-9). We disagree. The body of Appellants’ claim recites a structurally complete invention. Therefore we interpret the term “disposable” as it appears in the preamble of Appellants’ claim to state the intended purpose or use of the claimed carafe. “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). Accordingly, we are not persuaded

Appeal 2008-0039
Application 10/127,085

by Appellants' assertion that the term "disposable" is anything more than a statement of intended use or purpose.

CONCLUSION

In summary, we affirm the rejection of claims 21, 22, 25, 30, 35-37, 44, 50, 51, 53-55, and 64 under 35 U.S.C § 103(a) as unpatentable over the combination of Kurtzahn, Reed, and Libit.

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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