UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GROSS JUERGEN

Appeal 2008-1841
Application 10/296,083
Technology Center 3700

Decided: August 6, 2008

Before DEMETRA J. MILLS, LORA M. GREEN, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2, 3, and 6-18. We reverse, but enter a new ground of rejection.

STATEMENT OF THE CASE

The claims are directed to a "sanitary device" which comprises a water outlet nozzle. The device with the water nozzle can be utilized in "showers, whirlpools and the like" (Spec. ¶ 2).

Claims 2, 3, and 6-18 are pending. All the pending claims are appealed and stand rejected as follows:

1) Claims 2, 3, 6, 7, 9, 10, 12, and 18 under 35 U.S.C. § 102(b) by Lahme (translation of DE 29809369, Oct. 22, 1998) (Ans. 3);

2) Claims 2, 3, 6-13, 15, and 18 stand rejected under 35 U.S.C. § 102(b) by Steinhardt (U.S. Pat. No. 5,205,490, Apr. 27, 1993) (Ans. 4);

3) Claims 2, 3, 6-10, 12-14, and 18 under 35 U.S.C. § 102(b) as anticipated by Woolfenden (U.S. Pat. No. 1,677,160, Jul. 17, 1928) (Ans. 5); and

4) Claims 2, 3, 6-13, and 16-18 stand rejected under 35 U.S.C. § 103(a) as obvious over Stamp (U.S. Pat. No. 5,003,646, Apr. 2, 1991) and Ludlow (U.S. Pat. No. 5,754,989, May 26, 1998) (Ans. 5).

Claim 18, which is the only independent claim, is representative of the claimed subject matter and reads as follows:

> 18. A sanitary device, comprising:
>
> a front wall with a front portion for facing a user;
>
> a holder set back from the front portion, wherein the holder and the front wall are a continuous casting in one piece extending over a length, the holder forming with the front wall a chamber extending over the entire said length of the continuous casting;
>
> wherein on the front wall at least one opening forms with the front side a front edge;
>
> at least one water outlet nozzle fixed by retaining means to the holder; and,

> wherein the retaining means engage behind the front side of the front wall and the retaining means and the nozzle terminate substantially flush with the front edge of the opening.

CLAIM INTERPRETATION

Claim 18 is directed to a sanitary device having: 1) a front wall; and 2) a holder set back from the front wall. The front wall and holder are characterized in the claim as being "a continuous casting in one piece extending over a length." The device further comprises: 3) a chamber formed by the front wall and holder "extending over the entire said length of the continuous casting."

The device also comprises a 4) water outlet nozzle fixed by a 5) retaining means to the holder. The "retaining means and the nozzle terminate substantially flush with the front edge" of an opening in the front wall.

The phrase "continuous casting" refers to a process "in which metal is poured into an open-ended mold, being withdrawn as it solidifies so that the solid portion of the piece retains the fluid portion within the mold" (Exhibit 1 of Appeal Brief). As a result of this process, the casting piece has a cross-section which is the same at any point along its length (*see* App. Br. 13).

The phrase "continuous casting" is a product-by-process limitation, where the product is defined by the process through which it is made. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself." *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). However, when the process steps confer a structure or characteristic on the product which distinguishes it from products made by other processes, the process steps should be

considered. *See In re Garnero*, 412 F.2d 276, 279 (CCPA 1979). In this case, we find that continuous casting would result in a product which has a cross-section which is continuous over the entire length of the casting. Although we do not limit the claim to a product made by continuous casting, we require the product to have a continuously uniform cross-section – as it would when prepared by such a process.

By stating that the holder and front wall "are a continuous casting in one piece extending over a length", we interpret claim 18 to require that the holder and front wall have the same cross-section over the entire length of the piece. The chamber, formed by the holder and front wall, is also required by claim 18 to extend "the entire length said length of the continuous casting." We interpret this to mean that the chamber must also have a uniform cross-section over the length of the piece.

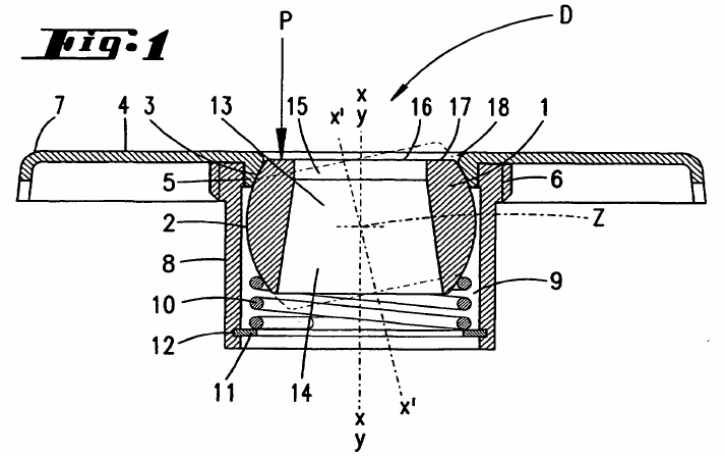
ANTICIPATION BY LAHME

Claims 2, 3, 6, 7, 9, 10, 12, and 18 stand rejected under 35 U.S.C. § 102(b) by Lahme.

Findings of Fact

1. Lahme describes a liquid outlet nozzle with a ball "for swimming pools, whirlpools or the like" (Lahme, at 1).

2. Fig. 1 of Lahme, reproduced below, shows the outlet nozzle in center cross section.



3. The liquid outlet nozzle, as shown in Fig. 1 above, comprises the following structural features:

4. • liquid outlet nozzle with ball **1** (Lahme, at 1, l. 2);

5. • front flange surface **4** (*id*. at 1, l. 7) with an opening (shown at **16, 17** if Fig. 1);

6. • ring shoulder **3**, with a taper **5**, which has a spherical shape to fit the liquid outlet nozzle **1** (*id*., at 1, ll. 2-8);

7. • external thread **6** used with a lock nut or sealing ring to hold the nozzle in place; and

8. • housing 8 for holding the nozzle ball in place with a compression spring **10** (*id*. at 1, ll. 18-24).

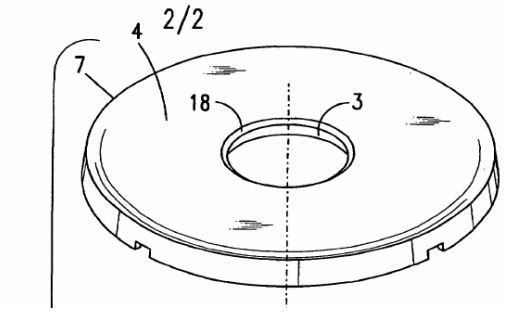
9. A chamber is formed by the inwardly curving surface **7**, front flange surface **4**, and external thread **6**/ring shoulder **3**.

10. The liquid outlet nozzle ball is shown in Fig. 1 as substantially flush with the outer edge of the opening in the front flange surface **4**.

11. The thread **6** and lock nut or sealing (FF 6) are shown in Fig. 1 as substantially flush with inner edge of the opening.

12. The housing **8** (FF 8) is shown in Fig. 1 as substantially flush with inner edge of the opening.

13. Fig. 3, reproduced below, shows an exploded view of the front flange surface **4** (*id*. at 4).



14. As shown in Fig. 4, the front surface of the liquid outlet nozzle forms a ring, and is therefore annular in shape.

Correspondence between the claim 1 and the liquid outlet nozzle of Lahme

13. Lahme's liquid outlet nozzle has a front flange surface **4** (FF 5) which corresponds to "a front wall with a front portion" of a "sanitary device" as in claim 1.

14. The liquid outlet nozzle has a ring shoulder **3** (FF 3) which meets the limitation of "a holder set back from the front portion" of the front wall of claim 1.

15. A chamber is formed by the inwardly curving surface **7**, front flange surface **4**, and external thread **6**/ring shoulder **3**, and thus meets the limitation of a chamber formed by the front wall and holder.

16. A cross-section of the annular outlet nozzle of Lahme is not the same along its entire length as required by claim 18, but is constantly becoming wider in length as the cross-section progresses from the edge to the nozzle's center.

Analysis

Anticipation requires that every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co*., 242 F.3d 1376, 1383 (Fed. Cir. 2001).

Appellant contends that Lahme does not describe a device that has a cross-section which is continuous along its entire length (App. Br. 12-13).

> The term "casting" [as in claim 18] is used as a noun in context, referring to an item. The shape of the item is "continuous." If the term "continuous" did not refer to a shape, it would be superfluous. In other words, the item ("casting" - a product) has a continuous shape (a structural limitation). The cross section of the continuous casting (defined for example by the opening in an extrusion die) is the same cross section proceeding along the length of the part.

(App. Br. 13.)

The Examiner contends that Lahme's device

> is clearly continuous over the axial length thereof. However, appellant's further reasoning that the term "continuous casting" requires the holder and front wall to exhibit a "continuous shape" or "same cross section" over the entire length thereof is neither consistent with the instant disclosure, nor stated in the "technical support" or "technical definitions" literature listed in the Evidence Appendix. In fact, appellant's claimed front wall (12) including both the opening (15) and the holder (21) with the circular projecting length/abutment (26) (claim 12) would appear impossible to create solely by an extrusion process as argued.

(Ans. 6-7.)

Appellant has the better argument. We have interpreted the phrase "continuous casting" as recited in claim 18 to impose a structural limitation on the claimed device. When a device is formed by continuous casting, the

metal is poured into an open-ended mold and is withdrawn as it solidifies (*see* Exhibit 1 of Appeal Brief; *see supra* Claim Interpretation). The opening in the casting die therefore determines the shape of the device, producing the uniformly same shape along its entire length (*see* App. Br. 13). The Examiner does not explain how this analysis is inconsistent with written description in the Specification or the technical definitions provided by Appellant. In sum, while the holder and chamber of Lahme's device could be characterized as continuous, it does not have the *same* continuous shape, but changes in dimension from the nozzle center to the nozzle edge when viewed in axial cross-section (FF 16).

In view of the foregoing, we reverse the rejection of claim 18, and dependent claims 2, 3, 6, 7, 9, 10, and 12.

ANTICIPATION BY STEINHARDT

Claims 2, 3, 6-13, 15, and 18 stand rejected under 35 U.S.C. § 102(b) by Steinhardt.

Findings of Fact

S1. Steinhardt describes a body spray nozzle (Steinhardt, Abstract).

S2. Fig. 4 shows a cross-section of the nozzle having brackets 65 and screws 66 to hold the nozzle in place (Steinhardt, at col. 4, ll. 50-52; Ans. 4).

S3. The brackets 65 are depicted in Fig. 4 as set back from the front panel.

S4. The Examiner finds that the brackets 65 meet the limitation of claim 18 of a "retaining means . . . substantially flush with the front edge of the opening (Ans. 8-9).

Analysis

The Examiner contends that the brackets 65 of Steinhardt's body spray nozzle are "substantially flush" with the opening of the panel "in the same sense as appellant's disclosed invention does" (Ans. 8). To reach this conclusion, the Examiner points to Fig. 3 of the Specification which shows a retaining means 29 and a flange 34 that " 'terminate' well behind the front edge 20" of the front wall (*id*.). The Examiner states that, since this is the only retaining means described in the Specification, it must therefore be "substantially flush with the front edge of the [front wall] opening" as required by claim 18 (see Ans. 8-9).

We do not agree with the Examiner that the brackets 65 of Steinhardt's body spray nozzle are "substantially flush with the front edge of the [front wall] opening" as required by claim 18. Figure 4 clearly shows the brackets set back from the front panel – "well behind the front edge" as acknowledged by the Examiner (Ans. 8; S3). The Examiner reaches "substantially flush" determination not by interpreting the language of the claim, but by reading a limitation from the Specification into them. "[W]hile it is true that claims are to be interpreted *in light* of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims." *Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed. Cir. 1988). We are mindful that during prosecution claims are to be given their broadest reasonable interpretation. *In re Buszard*, 504 F.3d 1364, 1366-67 (Fed. Cir. 2007). However, the Examiner has not explained how the phrase "substantially flush" as recited in claim 18 would have been broadly interpreted by persons of ordinary skill in the art to be met by the retaining structure 65 of Steinhardt, which shows

it set back from the front panel (FF S3). Thus, we reverse the rejection of independent claim 18, and dependent claims 3, 6-13, and 15.

ANTICIPATION BY WOOLFENDEN

Claims 2, 3, 6-10, 12-14, and 18 stand rejected under 35 U.S.C. § 102(b) as anticipated by Woolfenden.

Findings of Fact

W1. Woolfenden describes a water discharge nozzle device in bath tubs (Woolfenden, at cols. 1-2).

W2. The Examiner finds that the nozzle device has a "retaining means… (pg. 1 lns. 72-77) as claimed" (Ans. 5).

W3. At page 1, lines 71-77, Woolfenden states that "the nozzles 5 serve to secure the pipes 4 . . . to the tub. Thus said nozzles may seat upon the lower walls of the pockets 2 and may be formed with nipples 7 projecting through and threaded into said pipes."

W4. Nipples 7 are shown in Figs. 2 and 5 to be on the lower wall of the pocket, and not flush with edge 20 of the outer wall.

Analysis

Claim 18 requires the "retaining means" to "terminate substantially flush with the front edge" of an "opening in the front wall." The Examiner appears to find that nipples 7 of Woolfenden meet such limitation, but offers no explanation of how the claim language is satisfied. To the contrary, we agree with Appellant that the retaining mean is neither described nor shown to be flush with the opening wall edge 20 (*see* Woolfenden, Figs. 2 and 5), but rather is behind it on the lower wall of the pocket 2 (*see* App. Br. 19; FF W4).

OBVIOUSNESS OVER STAMP AND LUDLOW

Claims 2, 3, 6-13, and 16-18 stand rejected under 35 U.S.C. § 103(a) as obvious over Stamp and Ludlow.

Findings of Fact

SL1. Stamp describes a hydrotherapy device having a water wheel to provide a strong jet of water (Stamp, Abstract).

SL2. The device comprises a nozzle **26** attached to a circular front plate **28** which is flush with the external wall of the tub (Stamp, at col. 3, ll. 10-13; *see* Figs. 1 and 2).

SL3. A cylindrical housing **18** houses the nozzle **26** (*see* Stamp, Figs. 1 and 2).

SL4. The nozzle 26 is "integrally formed with the drive shaft 72" (Stamp, at col. 3, ll. 65-67)

SL5. The Examiner finds that the Stamps device comprises a front plate 28 which meets the limitation of claim 18's "front wall", a housing 18 which corresponds to the "holder" of claim 18, and a chamber which formed by the front plate 28 and housing 18 as in the claim (Ans. 5).

SL6. The Examiner thus concludes that Stamp describes all features of the claimed device, "except for the front wall and holder being one-piece" (Ans. 5).

SL7. The Examiner finds that Ludlow describes a similar device in which the front wall and holder are constructed from one piece (Ans. 6).

SL8. The Examiner states that "the front wall and holder of the Stamp sanitary device are not one-piece, as claimed", but "in consideration of Ludlow, it would have been obvious to one of ordinary skill in the sanitary

device art to associate one-piece construction … in order to facilitate molding." (*Id.)*

Analysis

Even were Ludlow's one-piece manufacturing followed, Stamp's structure would not meet the limitation in claim 1 of a chamber formed from the front wall and holder and having a uniform cross-section. If the one-piece hydrotherapy device of Stamp were sectioned equatorially, any portion of the device below the front wall would not have a chamber because the front wall would be absent. In axial cross-section, the device – which is cylindrical (FF SL3; Stamp. Fig. 1) – would not be same along its entire length as required by claim 18, but would constantly become wider in length as the cross-section progresses from the edge to the nozzle's center. Thus, we agree with Appellant that Stamp combined with Ludlow does meet the limitation of continuous casting as we have interpreted it. Accordingly, we reverse the rejection of claim 18, and dependent claims 3, 6-13, 16, and 17.

NEW GROUND OF REJECTION

The "one water outlet nozzle" of the device of claim 18 is "fixed by retaining means to the holder." The "retaining means" is engaged "behind the front side of the front wall" and "terminate[s] substantially flush with the front edge of the opening" of the front wall.

In the Final Office Action, the Examiner stated that the "retaining means" as disclosed in the Specification does not "terminate substantially flush [with the front edge of the opening] as recited" in claim 18 (Final Office Action 2). In view of this deficiency, the Examiner rejected claim 18 as lacking written description in the Specification (Final Office Action 2).

Appellant contends that the Examiner erred because the Specification describes a number of structures that may correspond to the "retaining means" of claim 18 (App. Br. 7). Appellant argues that the "covering 32" described in the Specification (at ¶¶ 19, 29) fulfills the function of a "retaining means" as required by claim 18 and is also flush with the front wall opening (*id*. at 8). Appellant defines "retaining means" as "having a retaining function or effect" (*id*. at 8). Appellant states that the "disclosed retaining means all engage behind the front side of the front wall, holding the nozzle in position in the opening, from engagements made to the rear of the front side" (*id*. at 8-9, fn. 1).

The Examiner does not appear to agree with the Appellant's characterization of the covering 32 as a retaining means, but dropped the rejection in favor of finding Steinhardt's retaining means – terminating "well behind" the front edge (Ans. 8) – to be "substantially flush" as required by claim 18. Thus, the Examiner took the position that since the covering 32 (which is flush) is not a retaining means, the only retaining means described in the Specification – elements 29 and 34 (Fig. 3) – which terminate far behind the front wall – must be what Appellant intended when he claimed the retaining means as "flush" and thus interpreted claim accordingly (Ans. 8-9).

We interpret the claim differently from the Examiner. The plain language of the claim requires the "retaining means" to be engaged "behind the front side of the front wall" and "terminate[s] substantially flush with the front edge of the opening". This does not read on a configuration where the retaining means is set well behind the front edge of the opening as required by claim 1. Upon review of the Specification, we find there is no written

description support for the "flush" limitation, and thus enter a new ground of rejection.

According to the Specification, "a holder is provided" with the device "which retains the water outlet nozzle in the opening so that it cannot twist and slide" (Spec. ¶ 11). "To fix the water outlet nozzle in the opening . . . are provided retaining means, which are preferably constituted by a flange on the water outlet nozzle and a counterpart and which embrace on either side the holder" (Spec. ¶ 17). Examples of retaining means are described in the Specification, including retaining means 29 (Fig. 3) and a collar 38 (Fig. 4), both which are located adjacent to the holder and not flush with the front opening (Spec. ¶ 17, ¶ 31).

The Specification also describes a covering which "terminates substantially flush with the front side of the front wall" (Spec. ¶ 19). An embodiment is described and shown in Figs. 3 and 4 in which a "covering 32 is fixed to the water outlet nozzle 16" (Spec. ¶ 29). Fig. 3 shows the covering 32 in contact with the showerhead 28 which holds the nozzle 16. The Specification does not describe or show the covering as *fixing* the nozzle "*to the holder*" as required by claim 18; this function is performed by the retaining means 29. Thus, while the covering is substantially flush with the front wall opening, it does not fix the nozzle to the holder. For this reason, we find that the Specification does not provide written descriptive support for this claim limitation. Moreover, we do not find it defined as an equivalent means as would be required by § 112, sixth paragraph. Accordingly, we reject claim 18, and dependent claims 2, 3, and 6-17 under 35 U.S.C. § 112, first paragraph for lack of written description.

CONCLUSION

In summary, we reverse all the prior art rejections over claims 2, 3, and 6-18, but enter a new ground of rejection of these claims under 35 U.S.C. § 112, first paragraph.

TIME PERIOD

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . .
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED, 37 C.F.R. § 41.50(b)

lp

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