

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN TAFFINDER

Appeal 2008-4667
Application 10/994,998
Technology Center 3700

Decided: November 5, 2008

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Karen Taffinder (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 13, 14, 18, and 21, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is to a candle capable of communicating a message intended to be a predictor of the gender of a pregnant mother's baby (Spec. 1:26-29). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A device comprising:
 - a. a first outer candle;
 - b. at least one second inner candle wherein the second inner candle is not visible until a portion of the first outer candle is consumed; and
 - c. the second candle is selected of a color blue or pink to signify the gender of a baby.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Elsamaloty	US 5,578,089	Nov. 26, 1996
Scherr	US 5,910,005	Jun. 8, 1999
Bucellato	US 6,328,935 B1	Dec. 11, 2001
Reed	US 2004/0031722 A1	Feb. 19, 2004

The following rejections are before us for review:

1. Claims 1 and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Scherr and Reed.

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2. Claims 14, 18, and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Scherr, Reed, Buccellato, and Elsamaloty.

ISSUES

The Appellant contends the Examiner erred in rejecting the claims because the inner layers of the Scherr candle are exposed during carving so that they are not concealed until after a first portion of the outer layers has been consumed as required by the claims (App. Br. 11; Reply Br. 4-5), Scherr's candle does not comprise an inner candle embedded within an outer candle (Reply Br. 4), and Scherr and Reed are non-analogous art to the Appellant's invention (Reply Br. 6-7). The Appellant further contends there is no motivation, teaching or suggestion for a skilled practitioner to somehow combine sculpted candle cores to the colored candles enclosed with greeting cards as taught by Reed (App. Br. 12-13, 16). The Appellant also contends the Examiner erred because the Examiner offered no evidence as to the level of skill in the pertinent art (Reply Br. 8).

The Examiner found that Scherr discloses a candle having all of the elements of claims 1 and 13 except that Scherr does not explicitly disclose specific colors for the inner layers (Ans. 4, 7-8). The Examiner found that Reed discloses a candle set where either pink or blue candles are sold to signify the gender of a newborn baby (Ans. 5). The Examiner concluded that it would have been obvious to modify the candle of Scherr to make the inner layer either pink or blue to indicate the gender of a baby (Ans. 5).

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The issues before us are as follows:

Has the Appellant shown the Examiner erred in determining that Scherr discloses a device including a first outer candle and a second inner candle where the second inner candle is not visible until a portion of the first outer candle is consumed?

Has the Appellant shown the Examiner erred in concluding that it would have been obvious, in view of the teaching of Reed to select the color of a candle to indicate gender of a newborn, to have used blue or pink for the color of an inner candle in Scherr?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellant's Specification does not provide a lexicographic definition of a first candle and a second candle, as claimed.
2. Appellant's Specification describes a candle formed by pouring a first paraffin or wax into a container, placing a candle wick in the center of the first wax, inserting a second, pre-formed candle over the wick and on top of the first wax, and then pouring the remainder of the first wax around and over the top of the second candle. Spec. 9:1-10:27; Figs. 6, 6A-6C. The Appellant's Specification further describes that "the manner of forming the

second candle and the method of building the first and second candle may vary in ways familiar to persons skilled in the art.”
Spec. 9:24-26.

3. Scherr discloses a candle core formed with a plurality of internal layers of varying colors and composition. Scherr, col. 1, ll. 63-65 and col. 4, ll. 4-8.
4. The candle core can be formed by a dipping process, a pouring process, or some other known process for producing cores with multiple layers. Scherr, col. 4, ll. 20-23.
5. Thus, Scherr’s candle core has an outer candle and at least one inner candle. Scherr, Fig. 2.
6. Scherr’s candle core has an outer surface that is intended to be carved or sculpted so that when the outer surface is carved or cut, the multi-color inner layers are exposed. Scherr, col. 1, ll. 21-22. Thus, Scherr’s candle core, when received by the purchaser, has an outer candle that conceals at least one inner candle of a different color beneath it.
7. Scherr’s candle core is capable of being lit. Scherr’s candle core includes a wick 15 that extends from the top center end 3c and is wound around to make a wick loop 17. Scherr, col. 4, ll. 1-2. Scherr discloses that after sculpturing, the wick 17 is trimmed off. Scherr, col. 8, ll. 16-17. One skilled in the art would understand this to mean that the wick loop 17 is trimmed off the end of the

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wick 15 so that the candle is ready to be lit. *See e.g.*, Scherr, Figs. 6-11 (showing a trimmed wick that is ready to be lit).

8. Scherr's candle core is made from a blend of waxes and resins such that its outer surface is pliable below a temperature of about 130° F. Scherr, col. 2, ll. 3-5 and col. 4, ll. 23-27. Thus, if a purchaser were to light the wick of the candle core without engaging in any of the sculpting or carving activities described in Scherr, then the inner candle of Scherr would be revealed for the first time as the outer candle melted away.
9. Scherr does not disclose any particular colors for the internal layers of the candle core.
10. One having ordinary skill in the art at the time of the invention would have known to customize the colors of candles depending on a particular occasion, including to make a candle pink to correspond to a female birth and blue to correspond to a male birth. Reed, p. 1, ¶0007.
11. The field of the Appellant's endeavor is the arts of candle making and candle retailing. Spec. 1:10-12.
12. Scherr directly pertains to the field of Appellant's endeavor, because it relates to a method of forming the intermediate candle core and the final sculpted candle product and it also relates to the method of retailing the candle kit containing the candle cores (Facts 3, 4, 6).

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13. Reed directly pertains to the field of Appellant's endeavor, because it relates to a packaged thematic candle card gift set that includes candle wax strips and wicks for making candles. Reed, p. 1, ¶¶0006, 0007. Thus, Reed pertains to the method of forming and retailing a candle product.
14. Scherr and Reed are analogous art to the Appellant's claimed invention.

PRINCIPLES OF LAW

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

Claim Construction

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims "their broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) ("Though understanding the claim language

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may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”) The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘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.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

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ANALYSIS

Rejection of claims 1 and 13 as unpatentable over Scherr and Reed

The Appellant argues claims 1 and 13 as a group (App. Br. 7). As such, we select claim 1 as a representative claim, and claim 13 stands or falls with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim Construction

The Appellant contends that Scherr's candle does not comprise an inner candle embedded within an outer candle (Reply Br. 4). In essence, this argument posits that Scherr's candle core layers are not the same as the claimed inner and outer candles. We must interpret the "outer candle" and "inner candle" of the claim to determine whether Scherr's disclosure meets these limitations.

Appellant's Specification does not provide a lexicographic definition of outer candle and inner candle, as claimed, and while it provides an exemplary embodiment in which a first material of a first color is poured around an inner, pre-formed candle made of a second, different color, the Specification describes that "the manner of forming the second candle and the method of building the first and second candle may vary in ways familiar to persons skilled in the art" (Facts 1 & 2). Thus, one having ordinary skill in the art would understand that to qualify as separate inner and outer candles requires only that the layers be formed of materials having different colors.

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Scope and Content of the Prior Art

Scherr discloses a candle core having first outer candle and at least a second inner candle where, when the candle core is received by the purchaser, the second inner candle is not visible through the first outer candle (Facts 3-6).

The Appellant contends the Examiner erred in rejecting the claims because the inner layers of the Scherr candle are exposed during carving so that they are not concealed “until a portion of the first outer candle is consumed” as required by the claim (App. Br. 11; Reply Br. 4-5). Claim 1 is directed to a device and is not directed to a method of use of the candle. Thus, the limitation that the second inner candle is not visible until a portion of the first outer candle is consumed imparts only a structural limitation of an outer candle that is capable of being “consumed” or melted and that obscures an inner candle until the outer candle has been partially melted away. Scherr discloses candle cores that, when received by the purchaser, contain a wick such that the outer candle is capable of being consumed (Fact 7), and the inner candle is not visible through the first outer candle until the outer candle is partially melted away (Facts 6 & 8). Thus, the intermediate candle core product disclosed in Scherr meets the structural limitation of an inner candle that is not visible until a portion of the outer candle is consumed. That this candle core is an intermediate product does not diminish its status as a valid reference against the Appellant’s claims because Scherr both intended and appreciated its existence. *See In re Mullin*, 481 F.2d 1333, 1335-6 (CCPA 1973).

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Differences between the Prior Art and the Claimed Subject Matter

Scherr does not disclose any particular colors for the internal layers of the candle core (Fact 9).

Level of Skill in the Art

Neither the Examiner nor the Appellant has specifically addressed the level of skill in the pertinent arts of candle making and candle retailing.¹ We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *In re GPAC*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (“The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art.”)(citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)).

One having ordinary skill in the art at the time of the invention would have known to customize the colors of candles depending on a particular occasion, including to make a candle pink to correspond to a female birth and blue to correspond to a male birth (Fact 10).

¹ The Appellant contends the Examiner erred, because the Examiner offered no evidence as to the level of skill in the pertinent art (Reply Br. 8). We do not find error where the prior art itself reflects an appropriate level of skill and the Appellants did not demonstrate a need for specific evidence on this issue. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

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Obviousness

Before we discuss the combination of Scherr and Reed, we note that the specific color for the inner candle in this case is a matter of choice, and does not involve any particular skill, nor does it result in any unexpected result or unique characteristic in the final candle product. Thus, a claim requiring at least one inner candle to be blue or pink does not render non-obvious a candle that is otherwise structurally the same as a candle disclosed in the prior art. *See e.g., In re Harris*, 484 F.2d 965, 967-68 (CCPA 1973) (affirming the Board’s holding that the choice of colors for filter material would have been obvious to one of ordinary skill in the art at the time of appellant’s invention when the prior art suggests the use of a yellow filter material containing particles of a second, different color); *see also In re Cornish*, 277 F.2d 185, 189 (CCPA 1960) (stating that various colors for use with a game apparatus “are a matter of choice”).

Even when we take into consideration the limitation of the specific color of the inner candle, we still reach a conclusion of obviousness. The Appellant contends there is no motivation, teaching or suggestion for a skilled practitioner to somehow combine sculpted candle cores to the colored candles enclosed with greeting cards as taught by Reed (App. Br. 12-13, 16). We find this argument unpersuasive because the Appellant is requiring that the candle of Reed is capable of being bodily incorporated into the candle of Scherr. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of

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those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). *See also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”). Rather, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 127 S.Ct. at 1740. Reed shows that it was known in the art to market candles of a specific color, such as blue or pink, to signify a special occasion, such as the birth of a child (Fact 10). Thus, Reed would have suggested to one having ordinary skill in the art to make Scherr’s candle having a color selected from blue or pink to signify the gender of a baby so as to make the candle more appealing to a wider consumer base by making a specialized novelty candle. As such, the subject matter claim 1 is obvious in view of Scherr and Reed.

Analogous Art

The Appellant argues for the first time in its Reply Brief that Scherr and Reed are non-analogous art to the Appellant’s invention (Reply Br. 6-7). We disagree.

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“The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006) (citing *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)).

In this case, the field of the Appellant’s endeavor is the arts of candle making and candle retailing (Fact 11). Scherr directly pertains to the field of Appellant’s endeavor, because it relates to a method of forming the intermediate candle core and the final sculpted candle product, and it also relates to the method of retailing the candle kit containing the candle cores (Fact 12). Likewise, Reed directly pertains to the field of Appellant’s endeavor, because it relates to a method of forming and retailing a candle product (Fact 13). As such, we find that both Scherr and Reed are analogous art to the Appellant’s invention (Fact 14).

Rejection of claims 14, 18, and 21 as unpatentable over Scherr, Reed, Buccellato, and Elsamaloty

The Appellant argues claims 14, 18, and 21 as a group (App. Br. 15). As such, we select claim 14 as representative, and claims 18 and 21 stand or fall with claim 14. 37 C.F.R. § 41.37(c)(1)(vii).

The Appellant relies on the same arguments they made for claim 1 in arguing for the patentability of claim 14, and further argue that Buccellato and Elsamaloty do not cure the deficiencies of Scherr and Reed (App. Br. 16-17). Claim 14, like claim 1, is directed to a candle and not a method of

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use of the candle. Claim 14 also similarly recites an outer candle component that covers the top of the inner candle component such that the inner candle component is not visible through the outer candle component until at least a portion of the first candle component is consumed. As explained *supra*, Scherr discloses a candle with the claimed inner and outer candle components (Facts 3-8). As we found no deficiencies in the combination of Scherr and Reed, the Appellant has not persuaded us of error in the Examiner's rejection of claims 14, 18, and 21.

CONCLUSIONS

We conclude the Appellant has failed to show that the Examiner erred in rejecting claims 1 and 13 under 35 U.S.C. § 103(a) as unpatentable over Scherr and Reed and claims 14, 18, and 21 under 35 U.S.C. § 103(a) as unpatentable over Scherr, Reed, Buccellato, and Elsamaloty.

DECISION

The decision of the Examiner to reject claims 1, 13, 14, 18, and 21 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

vsh

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