

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANET H. ELLIS CALVO and RAFAEL A. CALVO

Appeal No. 2001-0700
Application 09/154,938

ON BRIEF

Before STAAB, McQUADE, and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Janet H. Ellis Calvo et al. appeal from the final rejection of claims 1, 3, 6 and 10. Claims 7 and 9, the only other claims pending in the application, stand objected to as depending from a rejected base claim.

THE INVENTION

The invention relates to a funnel designed to fit over and seal against container fill openings of different size.

Representative claim 1 reads as follows:

1. A funnel adapted to fit over fill openings of containers comprising a unitary plastic body generally including a tapered portion having an enlarged fill opening and a smaller discharge opening and a portion engaging the discharge opening of the tapered portion;

said engaging portion having [an] outer generally cylindrical wall for extending over a container fill opening;

said engaging portion also including an inner wall which engages the container;

said inner wall of the engaging portion terminating in a sealing rim for sealing engagement with the top of a container at its fill opening;

said engaging portion includes an outward extending portion defining the sealing rim and a downward extending tubular portion defining the portion engaging the container when in use;

said funnel having a plurality of generally coaxial engaging portions for engagement with a plurality of different size fill opening containers;

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THE REJECTION

Claims 1, 3, 6 and 10 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the Swedish reference in
view of Smith.

Attention is directed to the appellant's main and reply
briefs (Paper Nos. 9 and 11) and to the examiner's answer
(Paper No. 10) for the respective positions of the appellants
and the examiner with regard to the merits of this

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rejection.^{3,4}

DISCUSSION

The Swedish reference discloses a funnel having two threaded engaging portions 1 and 2 with respective stop/sealing shoulders 3 and 4 for engaging and sealing against threaded container fill openings of different size.

Smith discloses a funnel which "is advantageously one

³ In the final rejection (Paper No. 6), claims 1 and 3 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Upon reconsideration (see page 2 in the answer), the examiner has withdrawn this rejection.

⁴ On page 4 in the answer, the examiner refers to U.S. Patent No. 2,703,670 to Voight to support his position. This patent, however, does not appear in the statement of the appealed rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); and MPEP § 706.02(j). Accordingly, we have not considered the teachings of Voight in reviewing the merits of the appealed rejection.

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contiguous piece of machined material such as lightweight aluminum, or molded material such as plastic" (column 3, lines 46 through 48). The funnel 100 consists of an upper conical part 120, 130, and a lower cylindrical part 140 for engaging the mouth of a jar. Of the lower cylindrical part, Smith teaches that

an engaging member such as threads [160] is provided on the funnel so that the funnel can be firmly affixed to the mouth of jars. In a preferred embodiment, threads are provided on the inside of a lower, cylindrical part [140] of the funnel for jars with threads on the outside of the mouth. . . .

In addition to the threads, the lower cylindrical part of the funnel has a rim [150], above the threads. The rim covers the rim of the jar mouth and thereby facilitates a tight, stable coupling between the funnel and the jar and a tight seal between the funnel and the jar. The rim also prevents leakage of the contents of the funnel between the funnel threads and jar threads during pouring [column 1, lines 21 through 38].

In rejecting the appealed claims under § 103(a), the examiner finds that the Swedish reference responds to all of the limitations therein except for those in independent claims 1 and 6 calling for the body of the claimed funnel to be "plastic," and concludes that it would have been obvious to

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one of ordinary skill in the art "to make the apparatus of [the] Swedish [reference] from plastic as a unitary, one piece mold[ing] as, for example, taught by Smith, in order to provide a lightweight, easily molded and non corrosive material" (answer, pages 3 and 4).

The appellants do not dispute that Smith would have suggested making the Swedish funnel of plastic. They do argue, however, that the rejection is unsound because the examiner's determination that the Swedish reference meets the limitations in claims 1 and 6 requiring the funnel body to be "unitary" is speculative and in fact inconsistent with the fair teachings of the reference. The appellants also contend that to the extent the examiner is now relying on Smith as being suggestive of a

funnel having a "unitary plastic body" as recited in claims 1 and 6, the rejection is an improper new ground of rejection

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which "should be disregarded in its entirety" (reply brief, page 4).

The question of whether the explanation of the appealed rejection in the examiner's answer (as compared with the explanation in the final rejection) constitutes an improper new ground of rejection is one which is not directly connected with the merits of the rejection. Hence, it is reviewable by petition to the Commissioner, rather than by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971)), and thus will not be further addressed in this decision.

As for the merits of the rejection, whether or not the Swedish reference fairly teaches that the funnel disclosed therein has a "unitary" body, Smith would have provided the artisan with ample suggestion or motivation to make the Swedish funnel of a unitary plastic body for the uncontested self-evident benefits noted by the examiner, i.e., to gain a funnel which is lightweight, corrosion-resistant and easily

manufactured. Moreover, viewing the references from a different perspective, the funnel disclosed by Smith responds to all of the limitations in the appealed claims except for those in claims 1 and 6 requiring a plurality of engaging portions for engagement with or attachment to a plurality of different size fill opening containers, and the Swedish reference would have suggested providing the Smith funnel with such a plurality of engagement portions for the advantage, expressly stated in the Swedish reference, of permitting attachment to a plurality of different sized fill opening containers.⁵

Thus, the combined teachings of the applied references fully support the examiner's conclusion that the differences between the subject matter recited in the appealed claims and the prior art are such that the subject matter as a whole

⁵Where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to an applicant, it is of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of on B in view of A, or to term one reference primary and the other secondary. In re Bush, 296 F.2d 491, 131 USPQ 263 (CCPA 1961).

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would have been obvious at the time the invention was made to a person having ordinary skill in the art. We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 3, 6 and 10.

SUMMARY

The decision of the examiner to reject claims 1, 3, 6 and 10 is affirmed.

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

AFFIRMED

LAWRENCE J. STAAB)
Administrative Patent Judge)
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