

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

---

Ex parte ALLEN R. MCNEILL

---

Appeal No. 2003-0778  
Application No. 09/564,131

---

ON BRIEF

---

Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13 .  
Claims 14-26 have been indicated to be allowable. No other claims are pending in this  
application.

BACKGROUND

The appellant's invention relates to a barbecue grill accessory and, in particular, to "a loop form divider wall that is placed in a conventional charcoal barbecue grill to divide the heat chamber of the barbecue grill into inner and outer volumes, the outer volume being a circular volume" (specification, page 1). The loop supports charcoal in a piled ridge around the divider and controls the charcoal briquets so that they burn slowly in a path along the outer periphery of the loop divider (specification, page 3). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Jones	793,379	Jun. 27, 1905
Sainsbury	5,074,279	Dec. 24, 1991
Lamkin (British patent specification)	2253	Jan. 13, 1910

The following rejections are before us for review.

Claims 1-13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1-4, 7 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lamkin.

Claims 1-4 and 7-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jones.

Claims 1-4, 7 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sainsbury.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 20) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 19 and 21) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### ***The indefiniteness rejection***

The basis of the examiner's rejection of claims 1-13 under the second paragraph of 35 U.S.C. § 112 is that claim 1, and thus claims 2-13 which depend therefrom, recite the same structure first by recitation of structure (i.e., "a divider in the form of a loop") and second by recitation of means plus function (i.e., "means for retaining charcoal ... to control burning of the charcoal around the loop form of the divider ..."). According to the examiner, this double recitation of a single structure creates an inconsistency which renders the claims indefinite (see answer, pages 4-5).

Claim 1 recites "a divider in the form of a loop, the divider being dimensioned ... to divide an interior volume of the heat chamber into an inner volume within the loop form of the divider and an outer volume outside the loop form of the divider" and goes

on to recite “the divider having means for retaining charcoal ... to control burning ... when the divider is received inside the heat chamber and charcoal is positioned in the heat chamber around the divider and burned.” The use of the terminology “the divider **having means**” implies that the divider in the form of a loop has some particular structure thereon or a part thereof which performs the function of retaining charcoal outside the inner volume of the heat chamber. This recitation, however, is inconsistent with appellant’s underlying disclosure, which indicates, on page 3 of the specification, that

[t]he present invention provides a divider in the form of a loop that is positioned in the heat chamber of the conventional barbecue grill to support charcoal in a piled ridge around the divider. The loop controls the charcoal briquets so that they burn slowly in a path along the outer periphery of the loop divider.

As disclosed by appellant in the specification, the structure which performs the function of retaining the charcoal outside the inner volume to control burning as recited in claim 1 is the entirety of the loop divider itself, not some structure thereon or part thereof. As such, we agree with the examiner that there is an inconsistency between the language of claim 1, and hence claims 2-13 which depend therefrom and thus incorporate this inconsistency, and appellant’s underlying disclosure, thereby rendering the claims indefinite under the second paragraph of 35 U.S.C. § 112. See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971). It thus follows that we shall sustain the examiner’s rejection of claims 1-13 under the second paragraph of 35 U.S.C. § 112.

***The anticipation rejections***

We recognize the inconsistency implicit in our decision to sustain the rejection of claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention with a determination that these claims are anticipated under 35 U.S.C. § 102. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to anticipation under 35 U.S.C. § 102 is not made. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984). For the reasons outlined below, we interpret appellant's claim 1 as requiring a barbecue grill accessory comprising a divider in the form of a loop, the divider being dimensioned to be received inside the heat chamber of the charcoal barbecue grill and to divide an interior volume of the heat chamber into an inner volume within the loop and an outer volume outside the loop, the divider being capable of retaining charcoal outside the inner volume and outside the loop to control burning of the charcoal around the loop when the divider is received inside the heat chamber and charcoal is positioned in the heat chamber around the divider and burned.

Appellant (brief, pages 9-10) urges that the "means for ..." limitation of claim 1 should be interpreted as a recitation under the sixth paragraph of 35 U.S.C. § 112. We note, however, that the sixth paragraph of 35 U.S.C. § 112 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

As pointed out in In re Hyatt, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983), the sixth paragraph of 35 U.S.C. § 112 is directed specifically to combination claims and does not address single means claims<sup>1</sup>. In the instant case, since the structure which performs the function following the “means for ...” recitation in claim 1 is, in fact, the divider in the form of a loop, the claim is directed solely to the divider in the form of a loop and is thus not a claim for a combination. The provisions of the sixth paragraph of 35 U.S.C. § 112 therefore do not apply to the claims before us.

Moreover, as aptly pointed out by the examiner on pages 7 and 8 of the answer, claim 1 recites structure (i.e., a divider in the form of a loop) for performing the function in the “means for ...” clause. Thus, the sixth paragraph of 35 U.S.C. § 112, which addresses a claim for a combination “expressed as a means or step for performing a specified function **without the recital of structure**” is, by its own terms, not applicable thereto.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed

---

<sup>1</sup> “The long-recognized problem with a single means claim is that it covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor.” Id.

invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Each of the references, Lamkin, Jones and Sainsbury, discloses a loop structure which appears reasonably capable of being used in combination with a barbecue grill to retain charcoal outside the inner volume and outside the loop form to control burning of the charcoal in the manner recited in claim 1 and appellant has not explained why the metal loop in any of these references is not capable of performing such function. The Lamkin attachment is used to maintain a kettle raised from the burner or cooking surface so as to form a heating chamber within the band; the Jones support consists of a band or ring of metal for sustaining a plate, bowl, cup or other dish above the surface of the top of a stove or range to prevent burning of the contents thereof and Sainsbury's draft controller confines charcoal to a restricted area (inside the loop as illustrated) of the barbecue grill while at the same time providing draft control. None of the references cited by the examiner teaches or suggests using the loop of metal material in

combination with a barbecue grill and charcoal briquets so as to retain the charcoal briquets outside the loop to control burning. As pointed out by the examiner on page 9 of the answer, however, appellant's claims are directed solely to the divider in the form of a loop and not to the combination of the divider, barbecue grill and briquets. For the reasons discussed above, we interpret claim 1 as merely requiring a divider in the form of a loop which is capable of performing the function recited in claim 1. Accordingly, we agree with the examiner that the subject matter of claim 1 is fully anticipated by the loop structure disclosed in any of Lamkin, Jones and Sainsbury.

For the foregoing reasons, we shall sustain the rejections of claim 1 as being anticipated by Lamkin, as being anticipated by Jones and as being anticipated by Sainsbury. We shall also sustain the rejection of claims 2, 3, 7 and 13, which appellant has grouped with claim 1, as being anticipated by Lamkin, the rejection of claims 2, 3 and 7, which appellant has grouped with claim 1, as being anticipated by Jones and the rejection of claims 2, 3, 7 and 13, which appellant has grouped with claim 1, as being anticipated by Sainsbury. See pages 6 and 7 of appellant's brief.

With respect to the rejection of claim 4 as being anticipated by Lamkin, appellant concedes on page 12 of the brief that the band of Lamkin comprises a plurality of openings<sup>2</sup>, but argues that Lamkin lacks any disclosure that these openings function to control charcoal burning around the attachment. First, as pointed out by the examiner

---

<sup>2</sup> Appellant refers to openings a<sup>1</sup> (a slot a<sup>1</sup> is provided in the alternative fastening arrangement shown in Figure 3), but we also note that Lamkin's band (Figure 1) is provided with a plurality of slots a<sup>1</sup> and punch-outs to form lugs a<sup>3</sup>.

on page 9 of the answer, claim 4 does not require the openings themselves to perform the function of controlling charcoal burning. Rather, claim 4 merely recites that the means for retaining charcoal to control burning includes a plurality of openings. Second, for the reasons discussed above, we do not interpret the “means for ...” language of the claims as a recitation under 35 U.S.C. § 112, sixth paragraph. The slots a<sup>1</sup> and the punchouts to form the lugs a<sup>3</sup> both reasonably appear to be fully capable of functioning to control burning by permitting passage of air therethrough when used in combination with a barbecue grill and charcoal briquets.<sup>3</sup> Accordingly, the functional language of claim 4 does not in this instance serve to patentably distinguish over the band of Lamkin. See, e.g., In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 230-31 (CCPA 1971) and Ex parte Cordova, 10 USPQ2d 1949, 1950-51 (Bd. Pat. App. & Int. 1987). It is also well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Thus, we shall also sustain the rejection of claim 4 as being anticipated by Lamkin.

Appellant makes a similar argument with respect to the rejection of claim 4 as being anticipated by Jones. Specifically, appellant appears to concede that the band of Jones comprises a plurality of openings (air holes 2). These air holes likewise appear reasonably capable of functioning to control the burning when used in combination with

---

<sup>3</sup> As discussed above, claim 4 does not recite the combination of the divider, grill and charcoal briquets.

a barbecue grill and charcoal briquets. For the same reasons set forth supra in our discussion of the rejection of claim 4 as being anticipated by Lamkin, we find appellant's argument that claim 4 defines over Jones to be unpersuasive. We therefore shall also sustain the rejection of claim 4 as being anticipated by Jones.

With respect to claim 8, appellant argues on page 14 of the brief that the examiner has not identified the structure in Jones that responds to the holding tab recited in claim 8 and points out that the key 4 of Jones is a separate element. Consequently, according to appellant, the key 4 is not a part of the band and one skilled in the art would not interpret Jones as comprising one end of a divider wall having a holding tab, as recited in claim 8 (see brief, page 14). We disagree.

As noted by the examiner on page 12 of the answer, claim 8 does not require that the holding tab be integral (or unitary) with the divider wall. We find reasonable the examiner's position that the key 4 is a "holding tab" as broadly recited in claim 8 and that the end of Jones' band through which the key 4 passes "has" said holding tab. Thus, we shall sustain the examiner's rejection of claim 8 as being anticipated by Jones.

We shall also sustain the examiner's rejection of claim 9 as being anticipated by Jones. With the key 4 disposed in a slot 3 of one end of Jones' band 1, the key forms a "protruding rim, edge, rib or collar used to strengthen an object, hold the object in place, or attach the object to another object" and thus meets the definition of "flange" offered by appellant on page 15 of the brief.

Appellant (brief, page 15) argues that claim 10 is not anticipated by Jones because Jones' band does not comprise a flange having a distal edge with a shape that conforms to a shape of the bottom structural wall of the charcoal barbecue grill. Inasmuch as claim 10 is directed only to the divider loop and does not recite a barbecue grill, much less a barbecue grill having a particular shape of bottom structural wall, the key 4 of Jones meets this limitation. Thus, we shall also sustain the rejection of claim 10 as being anticipated by Jones.

Claim 11 merely calls for a flange projecting outwardly of the divider wall and separating a beginning of a path of charcoal from an end of a path of charcoal around the divider wall. Claim 11 does not require that the flange prevent passage of air or flames between the recited beginning and end of the path. Thus, with respect to claim 11, we share the examiner's view, as expressed on page 12 of the answer, that the aperture 8 would not prevent the key 4 from performing the function recited in the claim. It thus follows that we shall also sustain the rejection of claim 11 as being anticipated by Jones.

Finally, with respect to the rejection of claim 4 as being anticipated by Sainsbury, we conclude that the openings 54 of Sainsbury fully respond to the openings recited in claim 4 for the same reasons discussed above with respect to the rejections of this claim as being anticipated by Lamkin and by Jones. Thus, we shall also sustain the rejection of claim 4 as being anticipated by Sainsbury.

#### CONCLUSION

To summarize, each of the examiner's rejections is sustained. The examiner's decision 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

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

Appeal No. 2003-0778  
Application No. 09/564,131

Page 13

Thompson Coburn, LLP  
One Firststar Plaza  
Suite 3500  
St. Louis, MO 63101