

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22 (90/004,207)

Paper No. 21 (90/004,210)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARKHAM L. WHEELER

Appeal No. 97-3100
Reexamination Nos. (90/004,207 and 90/004,210)¹

HEARD: September 18, 1997

Before STONER, Chief Administrative Patent Judge, and LYDDANE and CRAWFORD, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 and 2, which are all of the claims pending in this proceeding.

¹ Merged reexamination proceeding for U.S. Patent No. 4,217,940, issued August 19, 1980, to Markham L. Wheeler, and based on application 05/680,168 filed on April 26, 1976. Reexamination requests filed April 5, 1996, and April 8, 1996.

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The subject matter on appeal is directed to a funnel having an integral pouring spout. Claims 1 and 2 describe the invention and are reproduced below:

1. A funnel having an integral pouring spout comprising:

a base portion having a funnel configuration providing a large open top and tapering downwardly to a reduced dimensioned open bottom; and

a spout portion affixed to the tapered interior surface of the base portion, the spout portion being open at the bottom and forming an open ended conduit at the top, the conduit terminating above the open top of said base portion, the bottom of the spout portion having spaced apart sidewalls flared outwardly and partially around the lower interior surface of the base portion, the sidewalls tapering towards the conduit to funnel fluid out of said base portion open bottom to said conduit when the funnel is tilted downwardly in the direction of the spout portion.

2. A funnel according to claim 1 including:

an open bottom cap having an axial opening in the top receiving the lower portion of said base portion, the bottom of the funnel base portion terminating below the cap top, the cap having internal threads whereby the funnel may be threadably positioned on the threaded nozzle of a container or the like.

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 103 are:

Lang, Jr. (Lang)	137,139	Mar. 25, 1873
Livingstone	2,763,403	Sept. 18, 1956
Mill (Great Britain)	678,883	Sept. 10, 1952

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Miyao et al. (Miyao)² 382,948 July 19, 1974
[Japanese Isho Koho (Design Publication)]

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by any of Mill, Lang, or Miyao.

Claim 2 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Miyao, and in the alternative, under 35 U.S.C. § 103 as being unpatentable over Miyao in view of Livingstone.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 3 through 8 of the examiner's answer, to pages 6 through 24 of the appellant's brief and to the reply brief for the full exposition thereof.

OPINION

Our evaluation of the patentability issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art, and the respective positions advanced by the appellant and the examiner. With respect to the applied references, we have considered all of the disclosure of each reference for what it would have fairly

² We have relied upon the English language translation of this reference which is of record in the application file of the instant application for our understanding of this reference. A copy of this translation appears in Exhibit 21 of the Reply by Requestor (Paper No. 7 of Reexam Control No. 90/004,210, dated October 15, 1996).

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taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, we have taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). On the basis of the knowledge and level of skill in the art at the time of appellant's invention, as reflected by the applied references, it is our conclusion that the examiner's rejections of claim 1 under 35 U.S.C. § 102(b) based on Mill, Lang and Miyao and claim 2 alternatively under 35 U.S.C. §§ 102(b) and 103 based on Miyao are not well founded. Our reasoning for this determination follows.

We initially observe that an anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Additionally, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something

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disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983) cert. denied, 465 U.S. 1026 (1984) (and overruled-in-part on another issue) SRI Int'l v. Matsushita Elec. Corp. Of Am., 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of properties that are inherently possessed by the reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S. Ct. 1362 (1996), quoting from In re Le Grice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

With this as background, we first address the examiner's rejection of appealed claim 1 under § 102(b) based on Mill. Mill discloses a "drip retaining means for a bottle or other container" (page 1, lines 8-9) which the examiner has characterized as

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a funnel (see Figure 4) having an integral pouring spout comprising: a "base portion" 12' having a "funnel configuration" providing a "large open top". . .and a "spout portion" 11' affixed to the "tapered interior surface" (unnumbered) of the "base portion" 12',...the bottom of the "spout portion" 11' having "spaced apart sidewalls" flared outwardly and partially around the "lower interior surface" (unnumbered) of the "base portion" 12', the "sidewalls" tapering towards the "conduit" to funnel fluid out of said "base portion" open bottom to said "conduit" when the funnel is tilted downwardly in the direction of the "spout portion" 12'. [answer, pages 3 and 4]

In rebuttal, the appellant argues that Mill does not disclose a "funnel" and that Mill "does not disclose any construction having a 'spout portion having spaced apart sidewalls flared outwardly and partially around the lower surface of the base portion...'" (brief, page 7).

Inasmuch as the trough forming walls 12' of the device of Mill provide a funneling effect, we agree that the device of Mill provides funnel structure in general. However, we must agree with the appellant that Mill fails to disclose the bottom of the spout portion 11' "having spaced apart sidewalls flared outwardly and partially around the lower interior surface of the base portion" as required by appealed claim 1. The hole 14 depicted in Figure 4 of Mill (as well as in Figures 1 and 5 through 8) is merely an aperture in the continuous wall defining the spout or neck 11'. Clearly, this hole or aperture can not and does not define "spaced apart sidewalls" as claimed. Therefore, since

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every element recited in appealed claim 1 is not found in the Mill reference, the rejection of appealed claim 1 under 35 U.S.C. § 102(b) based on Mill cannot be sustained.

Considering next the examiner's rejection of appealed claim 1 under § 102(b) based on the patent to Lang, we note that the examiner regards the patent to Lang as disclosing

a funnel having an integral pouring spout comprising: a "base portion" h having a funnel configuration providing a "large open top" (the upper rim of element h) and tapering downwardly to a "reduced dimensioned open bottom" (the lower end of element h); and a "spout portion" (that portion defined by elements e) affixed to the "tapered interior surface" of the "base portion" h, the "spout portion" being open at the bottom and forming an "open ended conduit" (the upper end of elements e above element h) at the top, the "conduit" terminating above the open top of said "base portion", the bottom of the "spout portion" having "spaced apart sidewalls" e flared outwardly and partially around the "lower interior surface" of the "base portion" h, the "sidewalls" e tapering towards the "conduit" to funnel fluid out of said "base portion" h open bottom to said "conduit" when the funnel is tilted downwardly in the direction of the "spout portion". [answer, page 5]

It is clear from viewing the drawings of Lang that the molasses pitcher top disclosed therein provides funnel structure (flange h) with an integral pouring spout f. In fact, at the oral hearing, appellant's representative conceded that the device of Lang provides funnel structure as claimed except that it does not include a conduit that terminates above the flange as required by

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appealed claim 1. In this regard, we note that appealed claim 1 recites, inter alia:

a spout portion. . .open at the bottom and forming an open ended conduit at the top, the conduit terminating above the open top of said base portion. . .[emphasis added]

It is important to note that in reexamination proceedings in which the U.S. Patent and Trademark Office is considering the patentability of claims of an expired patent, as is the case in the proceeding now before us³, which claims are not subject to amendment, a policy of liberal claim interpretation is properly applied. This policy favors a construction of a patent claim that will render it valid, i.e., a narrow construction, over a broad construction that would render it invalid. See Ex Parte Papst-Motoren, 1 USPQ2d 1655, 1656 (Bd. Pat. App. & Int. 1986).

While we are convinced that the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) would have been proper under the conventional rule of claim construction applicable where claims are subject to amendment since the "conduit" recited in appealed

³ We note that U.S. Patent No. 4,217,940 upon which these reexamination proceedings are based was issued August 19, 1980 (more than 17 years prior to the date of this decision) on application Serial No. 07/680,168, filed April 26, 1976 (more than 20 years prior to the date of this decision). Thus, it would appear that the term of this patent has expired whether it was based on 17 years from the date of issue or on 20 years from the earliest effective filing date.

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claim 1 could be read broadly enough to include merely the two linear converging portions of converging flanges e of Lang (Figure 1), under the circumstances of this case, it is our opinion that the language of appealed claim 1 is properly susceptible to a narrower or more limited construction. Thus, when the language of claim 1 reciting the "open ended conduit" formed by the spout portion is considered together with the spout portion 12 as depicted in Figures 1 through 4 of appellant's drawings which clearly portray the dispensing end of the "open ended conduit" as terminating "above the open top of said base portion," we think claim 1 can be construed, consistent with the drawings, as requiring the dispensing end of the conduit to terminate above the open top of the base.

We are mindful that it has been held improper for "inferential limitations" to be added to a claim. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). In the present case, however, we are not adding inferential limitations to claim 1. Rather, because claim 1 is no longer subject to amendment we are interpreting it narrowly, as discussed above, and construing the express claim language requiring the conduit to terminate "above the open top of said base portion" to include the dispensing end of the conduit. In conclusion, we hold that since appellant is foreclosed, under the circumstances of this

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case, from amending patent claim 1, we should accord the claim a liberal (i.e., narrow) construction, in light of the specification, "so as to protect only that phase of the claimed invention that constitutes patentable subject matter . . ." (In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969)). Giving claim 1 the narrow construction called for, we cannot sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) based on the patent to Lang.⁴ It is apparent from the drawings of Lang that the delivery spout f is formed in part by the converging flanges e and in part by the portion of the flange h bounded by the converging flanges e. Thus, since the flange h of Lang forms the base portion of the funnel configuration as noted by the examiner (above), clearly the dispensing end of the conduit defined by the linear portions of the converging flanges e and the portions of flange h delimited

⁴ The oral hearing appears to be the first instance where appellant has made the argument that the spout of Lang does not terminate above the flange h, and normally, since decisions of the Board of Patent Appeals and Interferences are based only on the written record, this argument would not be considered. However, in view of the fact that appellant's concession materially reduces the issues for our consideration with respect to the patent to Lang, and since this rejection is under 35 U.S.C. § 102(b) which requires that each and every element recited in the claim be disclosed in the reference in order to have an anticipation, we deem it to be appropriate to consider this argument in arriving at our decision on this appeal.

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thereby to form delivery spout f cannot terminate "above the open top" of the base portion h.

We next consider the examiner's rejection of appealed claim 1 under 35 U.S.C. § 102(b) based on Miyao. The examiner refers to page 12, lines 1 through 26 of the Reply by Requestor in Reexam Control No. 90/004,210 (Paper No. 7, dated October 15, 1996) for the explanation of the structure of the "Spout Cap" disclosed in Miyao. However, the drawing figure at the top of page 12 with its caption "Perspective View -- The Japanese 382948 Patent" and the discussion of "the drain-back spout" in lines 1 through 6 of the Reply by Requestor noted by the examiner do not actually refer to what is described in the title of the design publication Miyao nor to what is depicted in the six views of the design publication. Consequently we have not relied upon either the "Perspective View" drawn by the Requestor nor the explanation in lines 1 through 6 of page 12 of the Reply by Requestor (Paper No. 7) for our understanding of the disclosure of Miyao. Moreover, the perspective view, additional discussion, and photographic representations provided on pages 13 through 17 of the Reply by Requestor (Paper No. 7) go beyond the scope of interpretation and discussion of what is actually disclosed in the Miyao publication and have also not been relied upon by this panel of the Board.

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In particular, the appellant has argued on page 20 of the brief that Miyao "is devoid of any shading or contour lines" and that "there are not enough views in the Miyao reference to make up for the lack of shading and contour lines to enable the shape of all of its various wall portions to be known." The examiner responds on page 8 of the answer by stating that he

acknowledges that the drawings are devoid [sic,of] shading and contour lines; however, upon inspection of the drawings as a whole one of ordinary skill would come to the conclusion that the sidewalls of the spout portion do at least taper, as did P&G in their interpretation (see Reply by Requestor in Reexam Control No. 90/004,210, page 12, lines 1-26).

We observe that reexamination proceedings can only be based on "prior art consisting of patents or printed publications" in accordance with 35 U.S.C. § 301. Clearly, the Miyao reference is a printed publication, but the interpretation provided in the Reply by Requestor in Paper No. 7 is not. Accordingly, we must look solely to the disclosure of the Miyao publication for its relevance to the rejection of claim 1 under 35 U.S.C. § 102(b).

The only written disclosure in the Miyao design publication is that it is a design for a "Spout Cap for packing bottle" and that the "Rear view is symmetrical as front view." Notwithstanding the examiner's comments above, we are in agreement with the appellant's position that the six figures of

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drawings depicted in Miyao are insufficient to arrive at an understanding of precisely what configuration the "Spout Cap" design is to have. In particular, the sole cross-sectional view (identified as "A-A cross sectional View" in Miyao) is insufficient to indicate, even when considered with the "Plain [sic, Plan] View" and the "Bottom View," anything more than that the wall extending between the substantially cylindrical outer member and the inner somewhat U-shaped member extends at an angle upwardly to the right at the position the section A-A is taken (note the "Plain [sic] View"). It is not apparent from any of the drawing figures whether the angled wall member maintains the same angle from the section line shown around to the intersection of the substantially cylindrical outer member and the inner U-shaped member as seen in the "Plain [sic]" and "Bottom" views or whether the angle increases or decreases from that shown in the cross-sectional view. The position adopted by the examiner from the Reply by Requestor is that the angle increases so that the angled wall tapers down to the lowest point of the inner U-shaped member (as seen at the right side of the A-A cross sectional View), but we find nothing in the disclosure of Miyao to indicate that this is what was intended. We conclude that the disclosure of the "Spout Cap" of Miyao is indeterminate, and is at best ambiguous as discussed above. It is well settled that an

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anticipation rejection cannot be predicated on an ambiguous reference. See

In re Turlay, 304 F.2d 893, 134 USPQ 355 (CCPA 1962). Thus, we cannot sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b), or of claim 2 under 35 U.S.C. §§ 102(b) and 103 based on Miyao, noting that the patent to Livingstone applied in the § 103 rejection of claim 2 provides nothing which would clarify the ambiguities inherent in the disclosure of Miyao.

In view of the fact that we have concluded that the design disclosure of Miyao is indeterminate and ambiguous on its face, it is appropriate that we address the extrinsic evidence of record in these merged reexamination proceedings that pertains to the Miyao publication. This evidence appears in pages 12 through 16 and Exhibits 20 and 21 of the Reply by Requestor dated October 15, 1996 (Paper No. 7) and in the "SUBMISSION OF MATERIALS MADE AT THE REQUEST OF P&G," page 16 of, and Attachments 1 through 10 to, the Patent Owners Statement filed February 11, 1997 (Paper No. 11).

In this regard, we observe that extrinsic evidence has been used by the courts to interpret the meaning of terms in a claim. See Markman v. Westview Instruments, Inc., 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir.) (en banc), cert. granted, 116 S.Ct. 40 (1995), and on review of the other issues on appeal, the judgment was

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affirmed. Furthermore, with respect to evidence extrinsic to a single reference applied in an anticipation rejection under 35 U.S.C. § 102(b), such extrinsic evidence may be relied upon to explain, but not expand upon, the meaning of the reference. See In re Baxter Travenol Labs, 952 F.2d 388, 391, 21 USPQ2d 1281, 1284 (Fed. Cir. 1991). Such extrinsic evidence may be used to educate the decision-maker as to what the reference means to persons of ordinary skill in the field of the invention, but not to fill gaps in the reference. See Scripps Clinic & Research Found. v. Genetech Inc., 927 F.2d 1565, 1576-77, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). With this as background, we note that all of the extrinsic evidence noted above goes beyond merely explaining what the Miyao reference means to persons of ordinary skill in the field of the invention. First, there are repeated references throughout the submitted evidence referring to the "Spout Cap" of Miyao as a "drain-back" spout or system. See, for example, page 12, line 1 of the Reply by Requestor (Paper No. 7, dated October 15, 1996), and paragraph 11 of the translation of the "Affidavit of Shigeshi Miyao" (Attachment 3 appended to the Patent Owner's Statement dated February 11, 1997, Paper No. 11). We find nothing in the translation of the Miyao design publication that would have led one of ordinary skill to reach the conclusion that the "Spout Cap" depicted therein was to

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encompass a "drain back" spout or system for the reasons set forth above as well as for those below.

We additionally note that the perspective view provided by the Requestor, which first appears on page 12 of the Reply by Requestor (Paper No. 7) does not, and can not, follow from the various view depicted in the Miyao publication. Referring to the figure provided on page 3 of the Miyao affidavit (Attachment 3 to Paper No. 11) entitled "P & G Perspective View" which was labeled to include reference numerals, we note that spout portion 3 is depicted as having back edges 14 which are spaced a distance from the interior cylindrical side wall, or innermost surface 9, of the base portion 2, which distance is indicated in the "perspective view" as a "gap 13." This arrangement is described in subparagraph i) of paragraph 14 of the Miyao affidavit as follows:

i) There is a gap (13) between each back edge (14) of the open-backed conduit (12) in upper part (6) of the spout portion (3) and the innermost surface (9) of the base portion (2). Each gap (13) and the open-bottom (11) of the conduit (12) provides a drain-back and refill opening between the collection area and the inside of a container upon which the device has been installed.

Appendix C of the Miyao affidavit contains copies of photographs of a model constructed to conform to the "perspective view" in paragraph 14, with the photographs being arranged in an

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array corresponding to the figures illustrated in the Miyao design publication. Page 15 of the Reply by Requestor (Paper No. 7) includes a discussion of how the interpretation of the "perspective view" was utilized to make a three dimensional model which was "then photographed in an array (shown below) corresponding to that shown in the Japanese Patent and in perspective..." (page 15 of Paper No. 7), and page 16 of the Reply by Requestor (Paper No. 7) shows the above noted "array" and is apparently the origin of the copies of the photographs in Appendix C of the Miyao affidavit.

It is significant to note that the "Plain View" depicted in the photograph (page 16 of Paper No. 7) and in the copy of the photograph (paragraph 14 of the Miyao affidavit) both clearly show the gap (13) between each back edge 14 of the spout portion 3 and the innermost surface (9) of the base portion (2) whereas the "Plain View" of the Miyao publication relied upon in the rejection before us in this merged reexamination proceeding not only fails to show any similar "gap," but in fact clearly shows the back edges of the spout portion to intersect the innermost surface of the cylindrical base portion. Differences are also readily apparent between the "A-A cross sectional View" and the "Bottom View" appearing in the photographs (page 16 of Paper No. 7) and the corresponding figures of the Miyao publication.

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It is clear that the extrinsic evidence provided by the Reply by Requestor (Paper No. 7) and by the Miyao affidavit does not merely explain the meaning of the Miyao publication, but clearly expands the meaning thereof in an impermissible manner. The purported "perspective view," the model developed therefrom and the photographs taken of the model all include features that are neither depicted in the drawings of the Miyao publication nor that can be derived from any of the views of the design depicted in that publication. In view of the fact that reexamination proceedings can only be based on "prior art consisting of patents or printed publications" in accordance with 35 U.S.C. § 301, the rejection before us for our review can only be based on what is contained in the four corners of the Miyao publication, which, as we have determined above, is ambiguous at best.

Accordingly, since we have not sustained any of the examiner's rejections of the claims on appeal under either 35 U.S.C. § 102(b) or § 103, the decision of the examiner is reversed.

REVERSED

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Bruce H. Stoner, Jr., Chief)
Administrative Patent Judge)
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)
William E. Lyddane)
Administrative Patent Judge)
)
)
)
Murriel Crawford)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
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Manny D. Pokotilow
Caesar Rivise Bernstein
Cohen & Pokotilow
1635 Market St., 7 Penn Center, 12th Fl.
Philadelphia, PA 19103

Requestors:

Dinsmore & Shohl
1900 Chemed Center
255 Fifth Street
Cincinnati, OH 45202

Connolly, Bove, Lodge & Hutz
P.O. Box 2207
Wilmington, DE 19899