Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MELVIN L. LEVINSON

Appeal No. 2000-1731
Reexamination Application No. 90/005,124[1]

ON BRIEF

Before SMITH, PAK, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-4 and 7-29 in this reexamination of U.S. Patent No. 5,094,865. The patentability of the only other claims in the patent, claims 5 and 6, has been confirmed.

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[1]Reexamination proceeding for U.S. Patent 5,094,865, issued March 10, 1992 which is based on Application Serial Number 07/659,340, filed April 15, 1991 which is the national stage entry of Patent Cooperation Treaty Application Number PCT/US91/01042, internationally filed February 18, 1991.

BACKGROUND

Appellant's invention relates to a two stage method of cooking food in which both the top and the bottom are browned or crusted. Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. A method for browning/crusting food, in two stages, comprising:

in a first stage: placing a microwave-lossy browning/crusting device in a microwave chamber, where said browning/crusting device includes a food contacting surface and a microwave-absorptive material; placing said browning/crusting device on a non-metal, thermal insulating tray supporting said browning/crusting device; said browning/crusting device further being resistant to heat damage when exposed to infrared energy from a conventional infrared broiler; exposing said browning/crusting device to microwave energy until said food contacting surface is heated to a food browning/crusting temperature; placing said food to be browned/crusted on said food contacting surface to brown/crust said food in contact with said heated food contacting surface; and

in a second stage; exposing said browning/crusting device and said food to infrared energy; by placing said browning/crusting device, with said food on said food contacting surface, beneath a conventional infrared broiler until the surface of said food, opposed to said food contacting surface, is browned/crusted by said infrared energy from said conventional broiler.

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

Levinson	3,731,037	May 1, 1973
Levinson	3,881,027	Apr. 29, 1975
Sumi et al. (Sumi)	3,941,967	Mar. 2, 1976
Dills	4,188,520	Feb. 12, 1980
Levinson	4,306,133	Dec. 15, 1981
Schiffmann et al. (Schiffmann)	4,318,931	Mar. 9, 1982
Roudebush et al. (Roudebush)	4,396,635	Aug. 2, 1983

Bowen et al. (Bowen)	4,450,334	May 22, 1984
Teich et al. (Teich)	4,454,403	Jun. 12, 1984
Tanonis et al. (Tanonis)	4,542,271	Sep. 17, 1985
Bell et al. (Bell)	4,771,154	Sep. 13, 1988
Matsubara	4,822,966	Apr. 18, 1989

Whirlpool brochure, "Browning" (p. S000000915), (1983)

Corning, "Corning Microwave Plus", (1986)

The claims are rejected as follows:

1. Claims 1, 2, 4, 7, 8, 13-15, and 17-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning.

2. Claims 3 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and further in view of Bell or Dills.

3. Claim 9 and 24-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and further in view of Levinson ‘037 or ‘027.

4. Claim 10 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and Levinson ‘027 or ‘037 and further in view of Schiffmann.

5. Claim 11 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and Levinson ‘027 or ‘037, and further in view of Roudebush.

6. Claim 22 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and further in view of Bowen.

7. Claims 12 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and further in view of Matsubara.

8. Claims 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning and Levinson ‘027 or ‘037 and further in view of Levinson ‘133.

9. Claims 1-4, 7, 8, 12-16, 19-21 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell.

10. Claims 9 and 24-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell and further in view of Levinson ‘027 or ‘037.

11. Claims 10 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell and further in view of Schiffmann.

12. Claims 11 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell and further in view of Roudebush.

13. Claims 17 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell and further in view of Whirlpool.

14. Claim 22 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell and further in view of Bowen.

15. Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell and further in view of Levinson '133.

OPINION

U.S. Patent 5,094,865 issued to Levinson on March 10, 1992. On February 29, 1996, Levinson filed a complaint against Sears, Roebuck and Company for infringement of the patented process. The U.S. District Court for the District of New Jersey upheld the validity of the patent on summary judgement. See *Levinson v. Sears, Roebuck and Co.*, 1998 U.S. Dist. LEXIS 7158 (D. N.J. 1998). A third party, Whirlpool Corporation, requested reexamination of the patent on October 9, 1998 and also filed an opposition to Levinson's European counterpart patent. The reexamination was granted and the rejections listed above maintained.

Appellant argues that the Examiner ignored the District Court ruling on validity (Brief, page 13). We note that even though patents enjoy a presumption of validity during litigation, this presumption is not retained during reexamination proceedings. According to 35 U.S.C.

§ 305, "[r]eexamination will be conducted according to the procedures established for initial examination." While a litigant who is attacking the validity of a patent must overcome the presumption of validity as set forth in 35 U.S.C. § 282, the Examiner need not. The examiner must establish unpatentability by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994). The proof need not rise to the level of clear and convincing as it must for a conclusion of invalidity.

The difference in standards is a result of the different contexts of the proceedings. The Examiner is not attacking the validity of a patent, but is conducting a subjective examination of the claims in view of the prior art. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir.), *cert. denied*, 474 U.S. 828 (1985). "[T]he intent underlying reexamination is to 'start over' in the PTO." *Id.*, at 857, 225 USPQ at 4. Reexamination proceedings and court actions involving challenges to validity are intended to be distinct and independent. *Id.* This is not to say that the factual underpinnings of district court decisions are to be ignored. It is only to say that a court's ultimate conclusion of validity does not end the Examiner's inquiry regarding unpatentability[2]. The examiner need not climb as

[2]A similar situation exists with regard to opposition decisions rendered by the European Patent Office (EPO). The U.S. Examiner may consider the facts found by the EPO. However, because the legal conclusion is based on a different legal standard, i.e. inventive step rather than obviousness of the claimed subject matter as a whole, it would be improper for the Examiner to accept the EPO's legal conclusion without an independent legal analysis. That being said, we note that there is a disagreement between the Examiner and Appellant concerning whether the EPO decision should have been identified in Section (2) of the Brief in which Appellant is required to list related appeals and interferences. Normally we would not address the issue of where the identification of related appeals is contained

high up the ladder of proof as the litigant. Therefore, it is possible for the proof of unpatentability to rise to a level between the lower "preponderance of the evidence" rung of the ladder and the higher "clear and convincing" rung of the ladder. In which case the subject matter of the claim may be found valid during litigation but unpatentable upon a subsequent reexamination. With the preponderance of evidence burden of proof in mind we turn to the rejections.

There are many questions and issues presented in this appeal. However, we need only focus on two of the obviousness rejections to render our decision; rejection (1) applying Whirlpool in combination with Teich, Tanonis or Stewart and Corning, and rejection (9) applying Sumi in combination with Teich, Tanonis or Stewart and Bell.

Whirlpool taken with Teich, Tanonis or Stewart in view of Corning

Claim 1, the broadest of the rejected claims, is directed to a process for browning/crusting food in two stages. The process employs a microwave-lossy browning/crusting device having a food contacting surface and a microwave-absorptive material. The device is made of materials of high

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because disagreements as to the form of the Brief are petitionable not appealable matters. However, Appellant filed the Brief *pro se* and is most likely unfamiliar with this procedural requirement. Therefore, we think it appropriate to address the issue here.

37 CFR § 192(c)(2) requires Appellant to identify "all other appeals ... known ... which will directly affect ... or have a bearing on the Board's decision in the pending appeal." The rule does not limit disclosure to other appeals before the Board. The EPO decision involved a European patent issuing from the PCT parent of the application here on appeal and fact finding was done with respect to a number of the same prior art documents applied in the rejections we are to review. We believe it was entirely proper for Appellant to identify the EPO appellate decision in Section (2) of the Brief.

enough heat resistance to allow its use under a conventional infrared broiler. In the first stage of the process, the browning/crusting device, placed on a non-metal thermal insulating tray, is positioned within a microwave oven and is exposed to microwave energy until its food contacting surface is heated to a food browning/crusting temperature. Food is placed on the heated food contacting surface of the device to brown/crust the side of the food in contact with the heated surface. In the second stage, the browning/crusting device containing the food is placed beneath a conventional infrared broiler and exposed to infrared energy so the side of the food opposite the food contacting surface of the browning/crusting device is browned/crusted by the infrared energy of the broiler. The two stage process allows both sides of the food to be browned or crusted without turning the food over.

Claim 1, along with claims 2, 4, 7, 8, 13-15, and 17-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whirlpool taken with Teich, Tanonis or Stewart in view of Corning. The Examiner points us to the disclosure under the heading "Browning" on page 3 of Whirlpool. This section of Whirlpool discusses methods of improving browning under three bullets. Specifically the reference recites:

> To improve browning in the microwave oven:
> - Add paprika or a browning-and-seasoning sauce.
> - Use a browning dish that has a special coating on its outside bottom which lets it get very hot when preheated. Many foods can be seared, browned or stir-fried in the preheated browning dish.
> - After microwave cooking, brown food under the broiler of the conventional oven. Be sure to use a pan designed for broiler heat.

The Examiner concludes that Whirlpool "clearly teaches a two-stage method for browning and crusting food as set forth in claims 1, 13, and 14." (Answer, page 4). However, Appellant argues that Whirlpool teaches three separate independent methods of browning not a two-stage method (Brief, page 23). According to Appellant, the brochure was designed to introduce a novice to microwave cooking. If the cook did not own a browning dish or a combination oven, the cook could use paprika or a browning-and-seasoning sauce to give food the appearance of browning. If the cook did own a browning dish, the second method of preheating the browning dish and placing the food on the hot dish could be used. If the cook owned a combination microwave/conventional oven, the third method of first microwave cooking the food without browning and then browning under the broiler could be used. We are persuaded by Appellant's arguments and from a review of the prior art of record as a whole that Whirlpool teaches three alternative methods of browning and not a two step process combining the browning methods of bullets two and three.

As stated in *In re Kotzab*:

> A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (*quoting*
> *W. L. Gore & Assocs., Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

> Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-1317 (Fed. Cir. 2000)(citations omitted).

Furthermore, as stated in *In re Dow Chem. Co.*:

> The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.
>
> In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.

In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988)(citations omitted).

A review of the prior art as a whole convinces us that Appellant's interpretation of Whirlpool is the correct interpretation. We note that this case is particularly susceptible to hindsight reasoning. Having learned the details of Appellant's invention, it is easy to read the Whirlpool brochure as teaching the combination of bullets two and three as a two-step process. However, there are telltale signs in

Whirlpool and the prior art as whole that indicate that such a two-step process was in fact not envisioned.

In regard to the Whirlpool reference, the third bullet recites a two step process, but it is not the same two step process as claimed. The third bullet simply recites that the food is placed in the broiler "after microwave cooking". There is no reference to using a browning dish nor any reference to the process of the second bullet. Reading the third bullet alone, indicates that "after microwave cooking" is referring to conventional microwave cooking in which no browning takes place.

Furthermore, the method recited in the second bullet is directed to placing the browning dish in the microwave to preheat the dish and then browning the food on the preheated dish. The second bullet does not affirmatively state that the food itself is to be cooked within the microwave. However, the phase "after microwave cooking", in the third bullet is referring to microwave cooking the food itself. The difference in wording between the second and third bullets indicates that "after microwave cooking" in bullet number three is not referring to the microwave operation taking place in bullet number two.

In addition, Whirlpool specifically cautions under the third bullet to "[b]e sure to use a pan designed for broiler heat". As indicated by the Seth Levinson Declaration, many browning dishes on the market at the time were not designed for broiling. The "Microwave/Convection Cookbook" produced by General Electric specifically states that browning dishes are not to be used when

convection or combination cooking (Exhibit H, page 7). In addition, the browning dishes of Teich, Tanonis and Stewart are not disclosed as usable under broiler heat. In particular, Stewart teaches using materials that can withstand operating temperatures in the neighborhood of 425°F (col. 3, line 67 to col. 4, line 4) when conventional broilers reach temperatures of 450-475°F[3]. Tanonis indicates that body 11 of the dish need only possess heat resistance up to 150°C (302°F) (col. 4, lines 13-14). Corning does teach a browning dish that "can be used as a regular baking dish in a conventional oven at any temperature for added versatility." (page 2). Corning, however, makes no mention of combining microwave browning with broiling in two stage process. There is simply no evidence that those of ordinary skill in the art envisioned using browning dishes in the two stage process of the claims.

Finally Dills, a prior art reference further applied to reject claims 3 and 16, specifically describes that special utensils to effect browning when used in microwave ovens have been used "as an alternative" to browning using electrical heating elements (col. 3, lines 1-4).

In our view, the Examiner read into Whirlpool a teaching that was not there based on knowledge gained after reading Appellant's Specification. Two processes, taught by Whirlpool as alternatives, were combined by the Examiner without providing a reason, suggestion, or motivation which would lead one of ordinary skill in the art to make the combination. In order to establish a *prima facie* case of obviousness the Examiner must establish that the prior art would have suggested to one of

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[3]See, for instance, exhibit H, "Microwave/Convection Cookbook by General Electric, page 3.

ordinary kill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. *In re Dow Chem. Co., supra*. Because the Examiner has not established that there was a suggestion to combine the process of the second bullet and the process of the third bullet of Whirlpool, the Examiner has not established by a preponderance of evidence that Whirlpool in combination with Teich, Tanonis or Stewart and Corning rendered the claimed two stage process obvious at the time the invention was made.

We note that the fact that there is no affirmative teaching against using the dishes of Teich, Tanonis and Stewart under the broiler does not establish that one of ordinary skill in the art would have so used the dishes. The Examiner has the burden of proving there was a suggestion in the prior art to place the browning dish in a conventional infrared broiler and a reasonable expectation of success. The absence of a teaching against doing what Appellant has done does not satisfy that burden.

Sumi taken with Teich, Tanonis or Stewart in view of Bell

Claims 1-4, 7, 8, 12-16, 19-21 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi taken with Teich, Tanonis or Stewart in view of Bell. The rejection (Answer, pages 10-11) states that Sumi teaches various portions of the process and then states that the primary difference between the claims and Sumi is that Sumi does not teach using a non-metal, thermal insulating tray to support the browning/crusting device. However, upon a review of Sumi, we conclude that Sumi does not in fact teach the claimed two step browning process.

In regard to processes of browning, Sumi at column 1, lines 19-31 discloses:

> [The desire to scorch or brown microwave cooked foods] led to the use of scorching means concurrently with the cooking of a material in a microwave oven, which means heretofore comprised (1) incorporating an infrared or nichrome wire heater within the microwave oven, (2) using a dish comprising ferrite or silicon carbide ceramics as a microwave absorbing heating element, (3) flame spraying a resistive film to the rear surface of a heat-resisting glass with supporting metal legs attached thereto, (4) placing a material to be cooked on a microwave absorbing heating element which is provided with metal antennas, (5) placing a material to be cooked which is enclosed by an aluminum foil on the heating element, or the like.

This portion of Sumi is merely a list of alternative scorching or browning means. While the list includes using a infrared broiler element in a microwave oven as one option and using a browning dish as another option, nowhere does Sumi disclose a two-stage browning process in which the two options are combined. Column 1, lines 33-55 further discusses technique (1) in which a broiler element is used as the scorching or browning means. Here Sumi specifically states at column 1, lines 45-47 that "scorching cannot be achieved with a microwave oven which is not provided with a heater." Clearly, use of a browning dish is not contemplated in technique (1). Sumi then discusses techniques (2) through (5) at column 1, line 55 to column 2, line 29 in which different types of food holders brown the food. The description of techniques (2) through (5) contains no mention of browning using a broiling element. Technique (1) is at all times described as a separate and distinct alternative to the other prior art techniques (2) through (5).

The five techniques are presented in the Background of Invention. The invention of Sumi is directed to a cooking apparatus which has no need of the special electrical house wiring required of the combination oven of technique (1). Sumi instead uses a particular browning dish that requires no preheating and uses it to brown food in a regular microwave oven. We agree with Appellant that, absent Appellant's disclosure of the claimed invention, one of ordinary skill in the art of cooking would not have had the foresight to select and combine bits and pieces of the Sumi reference to create the claimed two stage process (Reply Brief, page 14). Again, there is no indication that one of ordinary skill in the art would have been led to carry out the two stage process claimed and would have had a reasonable expectation of success. *In re Dow Chem. Co.*, *supra*. The rejection provides no rationale for combining the disclosed alternatives.

We note that the secondary references do not remedy the defect in the rejection. None of Teich, Tanonis or Stewart describe using their browning dishes in a conventional infrared broiler and, as discussed above, Tanonic and Stewart specifically describe forming the body of their dishes from materials of lower heat resistance than that required for broiling. Bell does teach a two stage process of browning shown in Figure 3. Underside browning during microwave heating is achieved by placing the food on a support or utensil having a microwave absorbent coating 40 (col. 3, lines 35-40). However, in the process of Bell, tungsten-halogen lamps 4, 5 are used to brown the top of the food (col. 2, lines 3-7).

We note that the claims were expressly amended to further define the broiler as "a conventional infrared broiler". The Examiner has made no finding that the lamps of Bell are "conventional infrared broilers" within the meaning of the claim language. Appellant's patent disclosure refers to cooking "under the broiler of a conventional gas or electric kitchen range." (col. 1, lines 60-62). At column 5, lines 18-23 the disclosure states that the infrared broiler may be an electrical resistance thermal energy generator or a combustible gas burner. For the electrical resistance thermal energy generator the disclosure exemplifies electric heating elements such as resistance wire and nichrome bars. There is no indication that the tungsten-halogen lamps of Bell are conventional infrared broilers. Therefore, even if arguendo one of ordinary skill in the art were led to combine the teachings of Sumi and Bell to arrive at a two stage browning process for browning both the top and bottom of the food, one of ordinary skill in the art would have been led to use tungsten-halogen lamps not "conventional infrared broilers" and thus would not have arrived at the claimed invention.

We conclude that the Examiner has not shown by a preponderance of the evidence that the subject matter of the claims was obvious at the time the invention was made. In regard to the other rejections, none of the other references remedy the basic deficiencies in the above discussed rejections. Thus, no *prima facie* case of obviousness has been established. As a consequence we will not sustain any of the rejections.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4 and 7-29 under 35 U.S.C. § 103 is reversed.

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

REVERSED

JOHN D. SMITH Administrative Patent Judge	)))))) BOARD OF PATENT) APPEALS) AND) INTERFERENCES))))
CHUNG K. PAK Administrative Patent Judge	
CATHERINE TIMM Administrative Patent Judge	

lp

Melvin L. Levinson
8 Stratford Circle
Edison, NJ 08820-1830

Whirlpool Corporation, c/o
Kevin W. Guynn
Hill and Simpson
85th Floor Sears Tower
233 South Wacker Drive
Chicago, IL 60606

APPEAL NO. 2000-1731 - JUDGE TIMM
APPLICATION NO. 90/005,124

APJ TIMM

APJ SMITH

APJ PAK

DECISION: **REVERSED**

Prepared By: LETICIA PIHULIC

DRAFT TYPED: 12 Jan 01

FINAL TYPED: