

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL P. KALAMARAS

Appeal No. 1999-0391
Application 08/225,229¹

ON BRIEF

Before BARRETT, DIXON and FRAHM, Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1, 6, 22, and 26. Claims 5, 8 to 19, and 25 stand withdrawn as being drawn to a non-elected invention. Claims 2 to 4, 7, 20, 21, 23, and 24 stand allowed.

¹ Application for patent filed April 8, 1994.

The subject matter on appeal is directed to a beverage vessel (i.e., drinking glass) having a lower compartment with entertainment means (i.e., a light) therein (see Figures 1 to 3, 5 to 7, and 8 and the accompanying text in the specification), and a method of producing the two-compartment beverage vessel.

Representative apparatus claim 1 is reproduced below:

1. A beverage vessel comprising:

(a) an optically transparent housing having a cylindrical portion extending between a top circular edge and a bottom circular edge, the bottom circular edge having an inner circular recess forming an inner circular shoulder, the housing having a circular dividing platform forming an upper compartment and a lower compartment, the lower compartment having a volume determined approximately by a height between the bottom circular edge and the circular dividing platform and a diameter of the cylindrical portion; and

(b) a base having a cylindrical base portion, the cylindrical base portion having an upper circular edge, the upper circular edge engaging the inner circular recess and abutting the inner circular shoulder, the base having a circular base bottom parallel to the circular dividing platform and in spaced apart planar relation from the bottom circular edge of the cylindrical portion of the housing, so that the volume of the lower compartment is increased by an amount determined approximately by second height between the bottom circular edge and the circular base bottom and a diameter of the cylindrical base portion.

Representative method claim 22 is reproduced below:

22. A method of producing a two-compartment beverage vessel that has a lower compartment formed as a continuous extension of an upper compartment, the lower compartment being increasable in size without having to modify an optically transparent housing that forms the upper compartment and the lower compartment, comprising the steps of:

(a) molding the optically transparent housing having a cylindrical portion, the housing having a cylindrical housing wall and circular dividing platform formed within the cylindrical housing wall forming

the upper compartment and the lower compartment;

(b) molding a base having a circular base platform and a cylindrical base wall that will increase the size of the lower compartment when the base is connected to the housing;

(c) inserting means for attracting attention into the lower compartment of the beverage vessel;
and

(d) sealing the lower compartment by connecting the base to the housing by connecting a lower edge of the cylindrical housing wall to an upper edge of the cylindrical base wall.

The following references are relied on by the examiner:

Ditto et al. (Ditto)	4,344,113	Aug. 10, 1982
Runge	4,390,928	Jun. 28, 1983
Von Kohorn	4,616,304	Oct. 7, 1986

Claims 1 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ditto.

Claims 22 and 26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Runge and Von Kohorn.

Rather than repeat the positions of appellant and the examiner, reference is made to the Briefs and the Answer for the respective details thereof.²

OPINION

In reaching our conclusion on the issues raised in this appeal, we have carefully considered

² We note that the Reply Brief of June 10, 1997, has been entered and considered by the examiner as per the letter from the examiner of February 25, 1999. We also note that the Information Disclosure Statement of June 26, 1996, has not been considered as per the letter from the examiner of October 10, 1996.

appellant's specification and claims, the applied prior art, and the respective viewpoints of

appellant and the examiner. As a consequence of our review, we are in general agreement with the examiner's statement of the rejection (Answer, pages 3 to 5), stating that claims 1 and 6 on appeal would have been anticipated by Ditto, and stating that claims 22 and 26 on appeal would have been obvious to one of ordinary skill in the art at the time the invention was made in light of the collective teachings of Runge and Von Kohorn. For the reasons generally set forth by the examiner (Answer, pages 5 to 9), and for the reasons which follow, we will sustain the rejections of claims 1, 6, 22, and 26 under 35 U.S.C. §§ 102(b) and 103.

Rejection of Claims 1 and 6 Under 35 U.S.C. § 102(b) Over Ditto:

Appellant argues that Ditto teaches a coaster which "has nothing to do with a beverage vessel" (Brief, page 4), and that therefore "it is impossible that the Figure 6 embodiment of Ditto show a beverage vessel as claimed in claim 1" (Brief, page 4).

At the outset, we note that a claim preamble has the import that the claim as a whole suggests for it. Where the claim preamble is used to recite structural limitations of the claimed invention, the PTO and courts give effect to that usage. Conversely, where a structurally complete invention in the claim body is defined and uses the preamble only to state a purpose or intended use for the invention,

Appeal No. 1999-0391
Application 08/225,229

the preamble is not a claim limitation. Rowe v. Dror, 112 F.3d 473, 477, 42 USPQ2d 1550, 1552 (Fed. Cir. 1997).

In the case before us, we are in agreement with the examiner that the preamble of representative claim 1 on appeal should not be given patentable weight. We find that the body of claim 1 on appeal defines a structurally complete invention and uses the preamble only to state a purpose or intended use for the invention. Our close review of claim 1 reveals that the term "beverage vessel" is only recited once in the preamble of claim 1 on appeal, and does not appear again in the claim, nor is the term "beverage vessel" in any way tied to other claim limitations or elements in claim 1. Thus, any reference which meets the structural limitations of the body of claim 1 would anticipate appellant's claimed invention, regardless of its purpose or intended use. Here, we find that the coaster of Ditto anticipates appellant's representative claim 1.

Even assuming, for the sake of argument, that claim 1 required a "beverage vessel," we conclude that Ditto still anticipates claim 1 since the coaster shown in Ditto's Figure 6 is technically a vessel which is for holding a beverage. Specifically, housing 74 has an upper compartment 78 which holds a beverage (i.e., liquid in glass 80). In the alternative, housing 74 is capable of holding liquid

directly therein since it has a recessed area. This meets the language of claim 1, especially to the extent set forth in the broad claim language. We note that claim 1 does not call for a drinking glass, nor does claim 1 specify dimensions or a volume for the "vessel" or upper compartment.

Appellant argues (Brief, pages 5 to 6) that Ditto fails to teach a "lower compartment" of the housing as defined in claim 1 on appeal. We disagree. As noted by the examiner, Figure 6 of Ditto does indeed show a lower compartment defined in that it has "a volume determined approximately by a height between the bottom circular edge and the circular dividing platform and a diameter of the cylindrical portion" (see claim 1 on appeal). We are in agreement with the examiner's explanation at page 6 of the Answer that the volume immediately below the arcuate portion 75 constitutes a "lower compartment" as defined in claim 1, especially to the extent this feature is broadly recited in the claim. We agree with the examiner that the lower compartment is defined by the convex upper edge defined by base 75 of the compartment, over to the upper circular edge 67 of housing 74, down to the bottom circular edge at 76, and across to the other bottom circular edge on the right hand side of the figure. We also agree with the examiner (Answer, pages 6 to 7) that the lower compartment of Ditto is increasable by a volume defined by the base diameter and a second height between the bottom circular edge 76 and the circular base bottom 72. Accordingly, we find that Ditto anticipates claim 1 on appeal.

With respect to dependent claim 6 on appeal, appellant argues (Brief, page 6) that Ditto's

Figure 6 does not teach that bulb device 28 (i.e., the "entertaining device") is within the lower compartment. We disagree. Clearly, as seen in Figure 6, bulb 28 extends upwardly into the lower compartment since the bulb breaks the parallel line extending in the horizontal direction from one bottom circular edge 76 of the lower compartment to the other. Here again, as above in relation to our discussion of claim 1, we agree with the examiner's definition of the "lower compartment," and we find that the lower compartment of Ditto meets appellant's broad claim limitations.

In light of the foregoing, we shall sustain the examiner's rejection of claims 1 and 6 under 35 U.S.C. § 102(b) as being anticipated by Ditto.

Rejection of Claims 22 and 26 Under 35 U.S.C. § 103 Over Runge and Von Kohorn:

At the outset, we note that the test for obviousness involves consideration of what the combined teachings, as opposed to the individual teachings, of the references would have suggested to those of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this light, appellant's argument (Brief, pages 9 to 10) that Von Kohorn fails to teach or suggest a transparent housing is not found persuasive, since the examiner relies upon Runge to teach this feature. We find that the combined teachings of the applied references would have taught or suggested the recited invention of claim 22 on appeal to one of ordinary skill in the art at the time the invention was made. In other

words, presuming full knowledge of the prior art in the relevant field, the combination of the applied references, when taken as a whole, is deemed to fairly teach or suggest appellant's claimed method of producing a two-compartment beverage vessel having a lower compartment which is increasable in size including molding a housing and a base, inserting an attention attracting means (e.g., a light), and sealing the lower compartment by connecting the base to the housing. Accordingly, we agree with the examiner's reasoning in support of the rejection found at pages 7 to 8 of the Answer.

Appellant argues (Brief, pages 9 to 10) that Runge and Von Kohorn both teach housings having opaque chamber walls which do not transmit light, and that these teachings clearly lead away from the transparent housing of appellant's invention. As only the Runge reference was

relied upon by the examiner as teaching a transparent housing, we will only address appellant's arguments as to this reference. We agree with the examiner (Answer, pages 7 to 8) that Runge teaches and/or strongly suggests a transparent housing. Specifically, we agree with the examiner that Runge's discussion of the lower housing wall (column 4, lines 65 to 68) indicates the housing being transparent and then coated with an opaque material only as to the lower part. We also note that Runge teaches that the circular dividing platform 3 is transparent (column 3, lines 56 to 61; column 5 lines 26 to 29; and column 6, lines 2 to 4) and is integrally formed with the upper and lower compartment walls to form the housing. Furthermore, our review of claims 13 to 15 of Runge

shows that the upper and lower housing as well as the dividing portion may be made of glass or plexiglass (i.e., transparent). See Runge, claim 13.

Appellant also argues (Brief, page 10; Reply Brief, pages 1 to 3) that Von Kohorn teaches reducing a lower compartment volume, and therefore teaches away from the claimed feature of increasing the lower compartment volume. We disagree, and note that the examiner relies upon the Figure 3 embodiment of Von Kohorn, and not the Figure 2 embodiment as argued by appellant, in supporting the § 103 rejection. While appellant's assertion as to the Figure 2 embodiment described at column 5, lines 2 to 6 of the reference may be accurate, we will sustain the examiner's rejection based on the Figure 3 embodiment, which in our opinion, shows a two-compartment housing 31 having upper and lower compartments wherein the lower compartment is increasable in size by connecting a base 38 to the housing 31.

As to the fact that Von Kohorn pertains to an illuminated flower pot, we see no problem with the motivation for making the combination of Runge and Von Kohorn. One of ordinary skill in the art looking at the two-compartment beverage vessel of Runge, and concerned with improving a method of increasing the size of the lower compartment so as to provide a way to insert an entertaining or attention attracting device (e.g., a light, battery, and switch), would logically look to Von Kohorn. Both references pertain to two-compartment housings having a circular dividing platform and a light means in the lower compartment wherein the "size" of the lower compartment is increased by adding the base to

Appeal No. 1999-0391
Application 08/225,229

the housing. In any event, we note that the broad language of claim 22 on appeal merely calls for increasing the "size" of the housing, and not the "volume" of the housing as in contrast with claim 1. Given its broadest interpretation, we find that claim 22 is therefore taught or suggested by even Runge taken alone, since the base portion 10 increases the exterior "size" or perimeter of the housing 8. In other words, because claim 22 on appeal fails to positively require that the interior "volume" of the housing or lower compartment be increasing by the addition of the base portion, we find that Runge alone meets all of the salient features of claim 22 on appeal.

We are not persuaded by appellant's argument (Brief, page 10) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. Clearly, the artisan would have had no need for recourse to appellant's disclosure for direction to increase the size of a

lower compartment such as provided by Von Kohorn. All that is involved is the application of knowledge clearly present in the prior art. In re Sheckler, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971).

Lastly, appellant argues as to dependent claim 26 (Brief, page 11) that Ditto fails to teach or suggest the features of claim 26. This argument is not understood, since Ditto is applied as to the § 102

Appeal No. 1999-0391
Application 08/225,229

rejection of claims 1 and 6. Accordingly, since effectively no arguments are presented as to dependent claim 26, claim 26 will stand or fall with its independent claim 22. 37 CFR § 1.192(c)(7)(1995).

In light of the foregoing, the differences between the subject matter recited in claims 22 and 26 and the prior art references are such that the claimed subject matter as a whole would have been obvious within the meaning of 35 U.S.C. § 103. Accordingly, we shall sustain the rejection of claims 22 and 26 as being obvious over Runge and Von Kohorn.

CONCLUSION

The decision of the examiner rejecting claims 1 and 6 under 35 U.S.C. § 102(b) over Ditto is affirmed.

The decision of the examiner rejecting claims 22 and 26 under 35 U.S.C. § 103 over Runge and Von Kohorn 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

Appeal No. 1999-0391
Application 08/225,229

LEE E. BARRETT)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
JOSEPH L. DIXON)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
ERIC FRAHM)
Administrative Patent Judge)

EF/pgg

Wray, Riley, Narasimhan
1493 Chain Bridge Rd.

Appeal No. 1999-0391
Application 08/225,229

Ste. 300
McLean, VA 22101