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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/634,624	12/06/2006	Alice Mary O'Donnell Kiely		5346

7590 05/19/2021  
Alice O. Kiely  
71 Stonewall Court  
Yorktown Heights, NY 10598

EXAMINER
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CHAWLA, JYOTI

ART UNIT	PAPER NUMBER
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1792

MAIL DATE	DELIVERY MODE
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05/19/2021

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ALICE MARY O'DONNELL KIELY

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Appeal 2020-002962  
Application 11/634,624  
Technology Center 1700

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Before TERRY J. OWENS, MICHAEL P. COLAIANNI, and  
DONNA M. PRAISS, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 41–54, 56, 57, and 59–64. We have jurisdiction under 35 U.S.C. § 6(b).<sup>2,3</sup> We AFFIRM.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Alice Mary O'Donnell Kiely. Appeal Br. 3.

<sup>2</sup> Our decision in this appeal is limited to a consideration of the Examiner's pending rejections. See Manual of Patent Examining Procedure (“MPEP”) § 1201 (9th ed. Rev. 10.2019, rev. June 2020). As a consequence, we will not address other issues discussed by Appellant relating to, for example, whether the claims are enabled, entry of claim amendments, etc.

<sup>3</sup> This application was the subject of Appeal No. 2013-000620 in which the Board affirmed the Examiner's rejections.

Appellant's invention is directed to a comestible kit or set for the creation of one or more assembly configurations (Claims 41, 51, and 57). The configurations comprise a torso comprising a selection from the group comprising a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit, or an appendage comprising a selection from the group comprising a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit (Claim 41).

Claim 41 is representative of the subject matter on appeal:

A comestible kit for the creation of one or more assembly configurations comprising:

(a) comprising a torso comprising a processed comestible generally shaped to represent a torso comprising a selection from the group comprising a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit, or

(b) comprising an appendage comprising a comestible generally shaped to represent an appendage comprising a selection from the group comprising a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit.

Appellant appeals the following rejections:

1. Claims 41–54, 56, 57, and 59–64 are rejected under 35 U.S.C. § 112, second paragraph, as failing to point out and particularly claim the subject matter which applicant regards as the invention.
2. Claims 41–46, 48–54, 56, and 61–64 are rejected under 35 U.S.C. § 102(b) as anticipated over Moreau (US 4,943,063, iss. July 24, 1990).
3. Claim 47 is rejected under 35 U.S.C. § 103(a) as unpatentable

over Moreau.

4. Claims 57, 59, and 60 are rejected under 35 U.S.C. § 103(a) as unpatentable over Moreau in view of Babos (US 4,431,395, iss. Feb. 14, 1984).

## FINDINGS OF FACT & ANALYSIS

Rejection (1): Indefiniteness

Claim 41

Appellant argues the Examiner’s rejection of claim 41 is improperly based upon the claim being open-ended, which is an insufficient basis for the rejection because breadth is not indefiniteness (Appeal Br. 9). This same argument is applied to claims 49, 51, 54, and 57 (Appeal Br. 11–12).

Appellant argues that use of the phrase “selection from the group comprising” in claim 41 is not an improper Markush group because such claim language was permitted by the Examiner in another application that issued as a patent (Appeal Br. 12).

Contrary to Appellant’s argument, claim 41 directed to a kit includes a listing of species of different shapes for the torso or appendage. The claim improperly uses the open-ended claim language comprising in reciting the species that are part of the Markush group. *See Abbott Labs. v. Baxter Pharm. Products, Inc.*, 334 F.3d 1274, 1281 (Fed. Cir. 2003) (“[A] proper Markush group is limited by the closed language term ‘consisting of.’”). *See also* MPEP § 2173.05(h) (“If a Markush grouping requires a material selected from an open list of alternatives (e.g., selected from the group ‘comprising’ or ‘consisting essentially of’ the recited alternatives), the claim

should generally be rejected under 35 U.S.C. 112(b) as indefinite because it is unclear what other alternatives are intended to be encompassed by the claim.”). A Markush group incorporated into “a claim should be ‘closed,’ i.e. it must be characterized with the transition phrase ‘consisting of,’ rather than ‘comprising’ or ‘including.’” *Abbott Labs.*, 334 F.3d at 1280.

Appellant relies upon *Multilayer Stretch Cling Film Holdings, Incorporated v. Berry Plastics Corporation*, 831 F.3d 1350 (Fed. Cir. 2016) for the proposition that the phrase “selection from the group comprising” is proper (Reply Br. 7). The court in *Multilayer Stretch Cling* does not state that “selected from the group comprising” is proper Markush group language. *Multilayer Stretch Cling*, 831 F.3d at 1358. Rather, the court stated reading proper Markush group language, “selected from the group consisting of,” as open-ended would render such language equivalent to “each layer comprising one or more of.” *Id.* The court went on to explain that using the transitional phrase consisting of creates a closed grouping, whereas the use of comprising creates an open-ended claim. *Id.* The court in *Multilayer Stretch Cling* did not endorse the use of “selected from the group comprising” as acceptable Markush group language. *Cf. Multilayer Stretch Cling*, 831 F.3d at 1358, with *Abbott Labs.*, 334 F.3d at 1280.

We are unpersuaded by Appellant’s argument that the Examiner’s issuance of a patent that included claims reciting “selected from the group comprising” indicates that the claims in the present case comply with § 112, ¶ 2 (Appeal Br. 12). Whether the claims in the present appeal comply with statutory requirements including § 112, ¶ 2, is not controlled by the fact that similar claims have been allowed by the United States Patent and Trademark Office in a different application. *In re Schechter*, 205 F.2d 185, 191 (CCPA

1953). It is well settled that the prosecution of one patent application does not affect the prosecution of an unrelated application. *In re Wertheim*, 541 F.2d 257, 264 (CCPA 1976) (holding that “[i]t is immaterial in ex parte prosecution whether the same or similar claims have been allowed to others”). *In re McDaniel*, 293 F.3d 1379, 1387 (Fed. Cir. 2002). *See also In re Giolito*, 530 F.2d 397, 400 (CCPA 1976)(“We reject appellants' argument that the instant claims are allowable because similar claims have been allowed in a patent. It is immaterial whether similar claims have been allowed to others.”). Rather compliance for each case with the statutory requirements is done on a case-by-case basis. *Id.*

We affirm the Examiner’s § 112, ¶ 2 rejection of claims 41, 49, 51, 54, and 57.

#### Claims 45 and 64

The Examiner finds that the terms whimsical and silly are subjective terms that lack a reasonable standard for determining the requisite degree required to satisfy the terms (Final Act. 3).

Appellant argues the Examiner has not established why the terms whimsical and silly are indefinite from the perspective of one of ordinary skill in the art (Appeal Br. 13). Appellant contends the Specification gives many examples that are understood by a person having ordinary skill in the art to be whimsical or silly (Appeal Br. 13). Appellant argues the Examiner’s rejection is based upon conclusory statements without regard to Appellant’s Specification (Appeal Br. 14). Appellant argues the Examiner provides no evidence of why a person having ordinary skill in the art would not understand what is recited in claims 45 and 64 (Appeal Br. 15).

Contrary to Appellant’s arguments, the Examiner finds the Specification fails to provide a definition of whimsical or silly that would provide some standard or measure to ascertain the scope of these terms (Final Act. 3; Ans. 5). Appellant and the Examiner agree that the Specification uses the terms whimsical and silly (Ans. 5; Appeal Br. 14). Appellant equates providing written descriptive support for the claim language with definiteness (Appeal Br. 14). The standard for definiteness under 35 U.S.C. § 112, ¶ 2, is whether a person of ordinary skill in the art would understand what is being claimed when the claim is read in light of the Specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). In this case, Appellant does not dispute that a formal definition of whimsical and silly has not been provided, but rather contends that the Figures and portions of the Specification cure that omission (Appeal Br. 13–15). Although the Specification provides examples of embodiments, there is no standard provided by Appellant in the Specification to ascertain when the torso or appendage is considered whimsical or silly within the meaning of claim. We find that the Examiner has provided a reasonable basis that a person of ordinary skill in the art would not understand in light of the Specification what is included within claims 45 and 64 by using the terms whimsical and silly.

We affirm the Examiner’s § 112, ¶ 2 rejection of claims 45 and 64.

The Examiner rejects claims 49, 52, and 54 under 35 U.S.C. § 112, ¶ 2 as invoking § 112, ¶ 6 by reciting “attachment means” without disclosing any corresponding structure for the attachment means in the Specification (Final Act. 3). Appellant does not specifically address this portion of the rejection or show reversible error with the Examiner’s means-plus-function

analysis of the claims (Appeal Br. 8–15). We affirm the Examiner’s § 112, ¶ 2 rejection of these claims as no error has been shown by Appellant.

REJECTIONS (2) TO (4): 35 U.S.C. §§ 102(b) & 103(a)

Appellant makes similar arguments for all claims under rejection (Appeal Br. 19–33). Specifically, Appellant argues that the Examiner’s interpretation of the claims is unreasonably broad and the Examiner has not shown that Moreau teaches a separate torso and separate appendage as required by the claims (Appeal Br. 19–33). Because Appellant makes similar arguments for all the claims, we select claim 41 as representative of the claims in addressing Appellant’s arguments. We begin our analysis of claim 41 by construing the claim.

Claim 41 recites a kit comprising “(a) comprising a torso comprising a processed comestible generally shaped to represent a torso . . . . or (b) comprising an appendage comprising a comestible generally shaped to represent an appendage . . . .” Claim 41 is open-ended by its use of the transitional term “comprising.” Claim 41 requires either a torso or an appendage, but may include other features by virtue of the open-ended transitional language in the claim. In other words, the claim is met by a kit having either a torso or an appendage as recited in the claim, but does not exclude a kit having both claim limitations and any additional limitation. Our interpretation is supported by the plain language in claim 41 and Appellant’s Figure 37, which Appellant describes as showing torso 102 and appendages 96 (Appeal Br. 18).

Appellant argues the term “torso” is factually distinct from an “appendage” in the claim (Appeal Br. 20, 21). Appellant argues the



Examiner's interpretation of torso as an "unfinished thing" is based on extrinsic evidence (i.e., dictionary definition) rather than relying on the intrinsic evidence provided in the Specification and Figures (Appeal Br. 19, 20). Appellant argues the Examiner interpretation of torso as an "unfinished thing" and an appendage as "an ancillary part attached to something" fails to provide what is already enabled: a torso or an appendage (Appeal Br. 20). Appellant argues that the interpretation of item 102 (torso) and item 96 (appendage) in Appellant's Figure 37 is clear and there is no reason why a person would adopt the Examiner's interpretation of "an unfinished thing, as torso" or "an ancillary part attached to something, as appendage." (Appeal Br. 22).

We understand Appellant to argue that the broadest reasonable interpretation of the claim includes a separate torso 102 and separate appendage 96 as shown in Appellant's Figure 37. The Examiner's claim interpretation, however, includes providing for a torso separate from an appendage (Final Act. 4-5). We do not find the Examiner to equate the same part of Moreau's structure as both the torso and the appendage (Final Act. 4-5). The Examiner's definitions of torso and appendage provide some meaning to these otherwise undefined terms. Appellant may exemplify embodiments where various shapes 102 may be used for the "torso" and various supports 96 may be used for the appendages (e.g., Figure 37), but there is no dispute that Appellant provides no formal definition of what constitutes a torso or an appendage. Given the breadth of what may be considered a torso and an appendage (i.e., an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit) (claim 41), we

discern no error in the Examiner interpretation of torso and appendage in an attempt to determine the metes and bounds of the claim.

Therefore, we construe torso as an unfinished thing where the thing may include but is not limited to a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit. We construe appendage as an ancillary part attached to something where the ancillary part may include, but is not limited to, a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit. The claim only requires either a torso or an appendage to be taught in the prior art to meet the claim.

With this proper claim construction in mind, we do not find reversible error in the Examiner's anticipation and obviousness rejections. The Examiner finds Moreau discloses construction sets made of moldable foodstuffs which are convertible into playthings (Final Act. 5). The Examiner finds that Moreau's edible block portions can be virtually anything including representations of characters and familiar objects of everyday life, including people and animals (Final Act. 5). The Examiner finds Moreau's edible block portions are a kit that when assembled create a plaything such as a truck, a plane or virtually anything (Final Act. 5). The Examiner further finds that the pieces of the kit that resemble the top of the truck, the tires on an automobile, or the floats on the plane may be considered appendages that are applied if desired (Final Act. 5). The Examiner correctly finds that Moreau teaches the "three-dimensional objects to be formed with the edible block-portions can be virtually anything, including representation of known characters and familiar objects of everyday life, people and animals, etc." (Col. 2, ll. 49-52).

Appellant argues that Moreau teaches block portions, not a separate torso or separate appendage (Appeal Br. 26). Appellant's argument is not persuasive because the block portions are assembled to form a depiction of whatever representation is desired to be formed (col. 1, ll. 65–68; col. 2, ll. 3–6, 49–52; col. 3, ll. 51–57). These block portions may represent a person or an animal, which would include a torso as properly construed above and recited in the claim. As noted above, under the proper claim construction, Moreau's teaching to form a torso is sufficient to anticipate claim 41. However, we agree with the Examiner that Moreau's use of block portions to form wheels for a car, floats for a plane, or roof portions 36 and 38 would reasonably constitute appendages within the meaning of claim 41 (Final Act. 5).

Appellant's arguments regarding the remaining claims mimic those made with claim 41 (i.e., Moreau does not teach a separate torso and separate appendage). *See, e.g.*, Appeal Br. 27–33. We are unpersuaded by those arguments for the same reasons discussed above.

Appellant contends the § 103 rejections of claims 47, 57, 59, and 60 over Moreau and Moreau in view of Babos have the same shortcoming as the rejection under § 102(b) over Moreau. Appellant argues again that Moreau or Moreau in view of Babos fail to teach forming a separate torso and a separate appendage. (Appeal Br. 32-33). We are not persuaded for the same reasons discussed above regarding the rejection over Moreau under § 102(b).

On this record, we affirm the Examiner's rejections under § 102(b) over Moreau, under § 103(a) over Moreau for claim 47, and under § 103(a) over Moreau in view of Babos for claims 57, 59, and 60.

DECISION

In summary:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
41–54, 56, 57, 59–64	112, ¶ 2	Indefiniteness	41–54, 56, 57, 59–64	
41–46, 48–54, 56, 61–64	102(b)	Moreau	41–46, 48–54, 56, 61– 64	
47	103(a)	Moreau	47	
57, 59, 60	103(a)	Moreau, Babos	57, 59, 60	
<b>Overall Outcome</b>			41–54, 56, 57, 59–64	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED