

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : Stephen John Luther
Filed : 02/04/2015
Art Unit : 3744
Examiner : MENGESHA, WEBESHET
Title : Cascading Ice Luge, Apparatus, and Methods

Commissioner for Patents
P.O. Box 1450
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Submitted via EFS
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Reply to Non-Final Office Action

Sir:

This correspondence is in response to the Non-Final Office Action dated 06/16/2016. Amendments to the claims are included with arguments and request for reconsideration. No new matter has been added.

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Amendment to the Claims

This listing of claims will replace all prior versions in the application.

I claim:

9. (amended) A method for making an ice luge for rapid chilling and dispensing beverages comprising,

freezing water in multiple trays to make multiple ice blocks, said multiple trays each configured to form a groove in each of said multiple ice blocks,

arranging said ice blocks in stepwise configuration and further arranging said ice blocks by positioning said ice blocks on shelves, with said ice blocks secured by a retaining member, ~~to form cascading ice luges.~~

further arranging said ice blocks so that beverage running through the groove on an ice block will cascade onto the groove of the ice block immediately below with minimal beverage loss, thereby producing a cascading flow of chilled beverage.

10. (cancelled)

11. (cancelled)

12. (amended) The method according to claim ~~11~~ 9 further comprising,

adjusting the level of the shelves ~~retaining members~~ relative to horizontal direction such that a ~~liquid~~ beverage applied to the upper end of the ice luge would flow to the lower end of the ice luge due to the force of gravity.

17. (new) A method for making an ice luge for rapid chilling and dispensing of beverages comprising,

arranging shelves, the upper surfaces of said shelves oriented at an angle to each other of about 12 degrees, said shelves each having a pair of front mounting blocks and having a pair of rear mounting blocks, said front and rear mounting blocks having threaded holes, said front mounting blocks being angled by about 12 degrees to provide for progressively increasing the pitch of each higher shelf, said shelves comprised of an upper shelf, a lowest shelf, and an intermediate shelf, said lowest shelf having a retaining member,

joining of said shelves to adjacent shelves using threaded bolts, said threaded bolts being received by said threaded holes,

supporting said upper shelf, wherein the upper shelf is supported by a support bracket, said support bracket configured to rest on a supporting surface such as a table or floor, said support brackets further having threaded portions which engage said threaded holes of said mounting blocks,

freezing ice blocks with preformed lanes,

placing each of said ice blocks on each of said shelves, with said ice blocks secured by said retaining member to prevent said ice blocks from sliding off the ice luge, wherein said ice blocks are arranged so that a beverage applied to a lane of the ice block on the upper shelf will cascade into the a lane of each successive lower ice block without loss of beverage.

18. (new) A method for making an ice luge for rapid chilling and dispensing of beverages comprising,

freezing water in multiple trays to make multiple ice blocks, said multiple trays each configured to form a preformed lane in each of said multiple ice blocks,

arranging shelves, in a Z configuration as described, with a base shelf having a retaining member, a connecting shelf and an upper shelf, said shelves arranged and connected by engaging threaded portions of L shaped brackets (52) with threaded holes in mounting blocks, said mounting blocks being affixed to said shelves, said shelves further arranged so that said connecting shelf is oriented at an angle of 84 degrees with respect to said base shelf,

positioning each of said ice blocks on each of said shelves in a Z configuration wherein said ice blocks are arranged so that a beverage applied to a lane of the ice block on the upper shelf will cascade into the a lane of the ice block on the connecting shelf, and beverage from said connecting shelf will subsequently cascade into a lane on the ice block positioned on the base shelf without loss of beverage.

Remarks

Amendment to the claims

Claim 9 was amended to incorporate the limitations of claims 10 and 11, which are now cancelled. Claim 12 has been amended to remove antecedent basis issues. Claims 9 and 12 should now be allowable. New Claims 17 and 18 are presented, and incorporate essentially equivalent limitations as were claimed for Claims 9 and 12 as well as additional limitations. Therefore Claims 17 and 18 should also be allowable.

Rejection under 35 U.S.C. 103

Although Claims 9 and 12 have been amended, Applicant believes the claims as originally presented were not obvious over the references cited by Examiner. The subject matter of original Claims 10-12 were found to contain allowable subject matter in the parent application. This is strong evidence for nonobviousness and is consistent with the conclusion that the grounds for rejection do not meet the criteria for *prima facie* obviousness because no new references have been presented in regard to obviousness and there is no clear error in the prior finding of allowable subject matter. Claims 9-12 were rejected over Fleeman in view of Kearney in a Non-Final Rejection (NFR) dated June 16, 2016. The subject matter of claims 10-12 was previously found to be allowable. However, the rejection of claim 9 is not based upon sufficient rationale and evidence. The problem solved by the instant invention is to make a large ice luge without a large freezer. The solution is to make a large ice luge from a multiplicity of smaller but fairly large ice blocks (i.e., ice blocks the size of which are suitable for making an ice luge typically requiring a walk-in freezer). The inventive act included the realization of the very problem to be solved. No evidence was presented in the rejection that a person of

ordinary skill in the art previously considered that there was such a problem to be solved.

Furthermore, there was no evidence in the prior art that remotely suggested the solution.

Recognition of the problem with the solution in this type of case, involving a fairly simple problem with a solution that seems straightforward once the problem is framed per the applicant's disclosure, is of the essence of the inventive step. No evidence was presented that a person of ordinary skill in the art at the time of the invention would have recognized the problem and the solution recognized by the inventor. *Mintz v. Dietz & Watson*, No. 10-1341 (Fed. Cir. May 30, 2012) (“[M]ust prove by ... evidence that a person of ordinary skill in the ... arts at the time of the invention would have recognized the ... problem recognized by the inventors and found it obvious to produce the ... structure disclosed.”)[emphasis added]. The rationale for obviousness proposed in the NFR is paraphrased below:

- Having “an ice scaffold to arrange the ice block[s] in stepwise configuration ... in order to provide a means for preserving the ice blocks, and keep it clean.”

The problem with this rationale is that the problem the artisan is asked to solve (keeping ice blocks in a cascading ice luge preserved and clean) presupposes the solution (arranging ice blocks to form a cascading ice luge) provided by the Applicant and places it in the hands of an artisan. The inventive step is prerequisite to posing the question that is presented to hypothetical POSITA for solution. To pose the question (how to preserve and keep sanitary an ice luge composed of multiple ice blocks) just so happens to prerequisite the inventor's solution, which was to make an ice luge from a multiplicity of ice blocks. Without first deciding to make an ice luge from a multiplicity of ice blocks (the solution), there could be no issue at all concerning whether the smaller ice blocks were preserved and sanitary. Stepwise ice cube trays

for small ice cubes in transit, as disclosed by Kearney, with shelves having pockets to keep the small ice cubes apart have no relevance to the instant invention and certainly would not have motivated an artisan to break up the ice sheet disclosed by Fleeman into smaller blocks of a size suitable for an ice luge. This presupposition of the novel inventive subject matter is clearly obtained in hindsight from the applicant's inventive disclosure. See *Graham v. John Deere Co.*, 383 U.S., 36, 86 S. Ct. 684, 16 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the invention in issue.") This issue has long been known¹. "Once the problem and solution appear together in the patent disclosure, the advance seems self-evident." *Mintz v. Dietz & Watson*, No. 2010-1341 (Fed. Cir. May 30, 2012) at 13. It should go without saying that presenting a hypothetical artisan possessing ordinary skill in the art at the time of the invention with a proxy problem, the solution of which is the same as the solution of the applicant-inventor begs the reader to solve the same problem solved by the inventor with the same solution. Absent evidence that the proxy problem was actually a problem and concerned real issues that would have motivated POSITA and that the artisan would have considered it as a problem needing a solution² (for example meeting a known but unmet need sufficient to drive the advance in the art), such an argument is clearly and obviously improper for relying on hindsight reconstruction. This is particularly true when the proxy issue is

¹ *Loom v. Higgins*, 105 U.S. 580, 591 (1882), "Now that [the invention] has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit." See also, "The fact that the invention seems simple after it is made does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down." *Expanded Metals v. Bradford*, 214 U.S. 366, 381 (1909). Regarding simple technology the Federal Circuit has state that "Once the problem and solution appear together in the patent disclosure, the advance seems self-evident." *Mintz v. Dietz & Watson*, No. 2010-1341 (Fed. Cir. 2012)

² Preservation and sanitation were not problems needing improvement in the primary reference, and the secondary reference offers no motivation to modify with the result, the result being the instant invention, in the manner described.

erroneously phrased such that raising the issue clearly presupposes the disclosed invention, which would not have been conceived other than by recognizing and solving the problem recognized, solved by, and disclosed by the inventor.

Newly amended Claim 9 also includes the imitation of a retaining member per the telephone interview and discussion with Examiner on July 14, Claim 12 includes all of the limitations of Claim 9 and therefore it should also be allowable. New Claims 17 and 18 are conceptually patterned after Claim 9 but with language that includes limitations of the newly claimed embodiments which were first disclosed in the C-I-P. The support members for these latter embodiments are in the form of a claimed bracket and a retaining panel is claimed as the retaining member. Additional limitations concerning the angular relationship of the various shelf surfaces are included and the means for maintaining the arrangement of the shelves is with mounting blocks are claimed.

New claims 17 and 18 also claim methods for making an ice luge using shelves arranged to support ice blocks with preformed lanes. These claims differ from Claims 9 and 12 in that the shelves are connected by means of mounting blocks with threaded holes. The positioning of the shelves is further specified by reciting the angles defined between the various shelves.

Regarding Claim 18, the expression, "in a Z configuration as described," refers to the configuration per written description. However, the Z configuration is effectively defined in the claim itself by inclusion of the additional limitation "said shelves further arranged so that said connecting shelf is oriented at an angle of 84 degrees with respect to said base shelf."

Conclusions

For the reasons discussed above, Applicant believes claims 9, 12, 17 and 18 are novel, nonobvious, and in proper form for allowance. Applicant therefore requests reconsideration and allowance of these claims.

Please note that Claims 17 and 18 claim subject matter first claimed after March 15, 2013, and the parent application was filed before March 15, 2013. These claims fall under the transitional category thus making the application a transitional application under 35 U.S.C. 100 AIA First inventor to file provisions. This should not affect allowance of claims 9 and 12 because the effective date of invention and the filing date of the parent application are one and the same³. The only possible difference regarding potentially relevant references would be that pre-AIA 102(e) references would be classified as AIA 102(b) references. Because there were no relevant references by another inventor filed before the parent application was filed and published after the filing date of the parent application under pre-AIA sections 102(e) and 103, the prior art available, in regard to Claims 9 and 12, would be exactly the same whether examined under pre-AIA or under AIA frameworks. Similarly, because new Claims 17 and 18 include most of the limitations as Claims 9 and 12, though worded slightly differently, and also claim further limitations, such as the means of joining shelves together, the angular relationship between shelves, Z configuration, etc., these claims should claim allowable subject matter under the provisions of both pre-AIA and AIA laws and rules.

Respectfully submitted,
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³ There were no affidavits or declarations under 37 CFR 1.131.

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1	Amendment/Req. Reconsideration-After Non-Final Reject	Reply_Jul_2016.pdf	130865 1460cebd6d6f6e3ffb327e73d8e2c05b10b1aad	no	10

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