

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY C. LEUNG

Appeal No. 2002-0266
Application No. 09/409,672

HEARD: May 22, 2002

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 25-36, 38-46 and 52-54. Claims 47-51 have been withdrawn from consideration as being directed to a non-elected species, and the remaining claims have been canceled.

We REVERSE AND REMAND TO THE EXAMINER.

BACKGROUND

The appellant's invention relates to an article for dispensing liquid materials. An understanding of the invention can be derived from a reading of exemplary claim 25, which appears in the appendix to the appellant's Brief.

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

Koreska <u>et al.</u> (Koreska)	4,784,506	Nov. 15, 1988
European Patent Application (EP)	0 170 526	Feb. 5, 1986
Japanese Unexamined Utility Model Application (JP) ¹	H2-135479	Nov. 9, 1990
PCT Published Patent Application (WO)	WO 91/09641	Jul. 11, 1991

Applicant's admission at page 4 of AMENDMENT AND RESPONSE TO ELECTION OF SPECIES REQUIREMENT (Paper No. 6, filed May 10, 2000).²

Claims 32, 33 and 44 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention

¹Our understanding of this foreign language reference was obtained from a PTO translation, a copy of which is enclosed.

²Which reads as follows: "In further response to the Election of Species Requirement, Applicant respectfully asserts that pending claims 25-36, 38-46, 48 and 52-55 are generic to and read on the elected species."

Claims 35, 38-46 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koreska in view of applicant's admission.

Claims 25-34, 52 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP, JP, WO and applicant's admission.

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koreska in view of applicant's admission, EP, JP and WO.³

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) and the final rejection (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 16) and Reply Brief (Paper No. 18) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 112

³A rejection of claims 25-34, 52 and 54 under the judicially created doctrine of obviousness-type double patenting, and a provisional rejection of claims 35-46, 48, 53 and 55 under the same doctrine, were overcome (see Papers 12 and 13).

It is the examiner's view that claims 32, 33 and 44 are indefinite because they depend from a base claim in which the applicator tip is recited as being "porous," but they recite materials "that are not known as being porous, e.g.'metal,' 'glass' and 'plastic,' and the disclosure appears to be silent as to holes or perforations being provided in such tips" (Paper No. 11, page 2). In response, the appellant has pointed out where reference to porous metal, glass and plastic is made in the specification as being known to one of ordinary skill in the art, and has submitted as evidence of this knowledge that over five thousand patents were uncovered in a word search on "porous metal," "porous glass," and "porous plastic" (Brief, pages 5-7).

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The appellant's evidence has persuaded us that the examiner's position is in error, and we will not sustain this rejection.

The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of these rejections is that claims 35, 38-46 and 53 are unpatentable over Koreska in view of the appellant's admission. As we understand this rejection, it is the examiner's view that all of the subject matter recited in these claims is disclosed in Koreska, except for the specific liquid that is to be dispensed, and for the materials from which the tips are made and the shapes of the tips. With regard to the liquid, the examiner points out that Koreska notes that similar liquids have been dispensed from similar applicators in discussing the background of the invention, and that it therefore would have been obvious to one of ordinary skill in the art to dispense them from the Koreska dispenser. With regard to the tip materials and shapes, the examiner takes

the view that the appellant's statement that claims 25-36, 38-46, 48 and 52-55 are generic and all read on the elected species in Paper No. 6 are an "admission" that "any of the tip shapes and materials disclosed in the specification are interchangeable with the one specifically shown in fig. 3, i.e, they are all obvious variants of one another" (Paper No. 11, page 5). The appellant argues in response that the statement to which the examiner makes reference was not an admission, and that the examiner is re-characterizing the election of species as such because he has been unable to cite references disclosing the various embodiments set forth in the claims.

Independent claim 35 recites an applicator body, a frangible vial held within the applicator body and containing a liquid adhesive, and a porous applicator tip having "a shape . . . selected from the group consisting of dome-shaped, conical, chisel and polygonal shapes." Koreska discloses a dispenser containing a frangible vial, and an applicator tip that is not described but appears to be in the shape of a cylinder. Thus, Koreska fails to disclose an applicator tip having any of the four shapes which constitute the group named in the claim. We agree with the appellant that the intent of the election of species was to identify those claims which the appellant believed corresponded to the species that was elected. It also is noted that while not pictured, all of the tips recited in claim 35 are mentioned in the specification.

The examiner has provided no authority, and we know of none, supporting his thesis that the election of species statement made by the appellant is an admission that

the subject matter recited in the elected claims constitutes “obvious variants” of one another. Nor has the examiner provided evidence that any of the four tip shapes recited in claim 35 would have been obvious in view of the cylindrical shape disclosed by Koreska. This being so, a prima facie case of obviousness has not been established with regard to the subject matter recited in independent claim 35, and we will not sustain the rejection of claim 35 or of dependent claims 38-46 and 53.

Claims 25-34, 52 and 54 stand rejected as being unpatentable over EP, JP, WO and applicant’s admission. Independent claim 25 sets forth an applicator tip comprising a porous support and a container body containing a synthetic or semi-synthetic monomer material, wherein the shape of the tip “is selected from the group consisting of dome-shaped, conical, cylindrical, chisel and polygonal shapes.” The examiner has taken the position that the combination of the three references “addresses . . . [the claimed] combination for the reasons advanced in the English translation of the Japanese office action submitted with the IDS filed 12/28/99,” and that the limitations regarding the tip are met by applicant’s admission (Paper No. 10, page 5).

EP discloses a container for storing and dispensing a dose of curable material and an accelerant therefor, wherein the curable material passes through a fibrous material containing the accelerant as it is being dispensed. JP discloses a soap dispenser in which perfume can be added to the soap immediately prior to exiting the dispenser, and WO is directed to a method for the formulation of fibrin sealant as it is

deposited upon the body site by the mixing of two ingredients. Even if one accepts at face value the examiner's position that all of the subject matter except for the tip shape would have been obvious in view of these three references, the rejection is fatally defective for the same reason as was the rejection of claim 25 for, as we stated above, it is our opinion that the election of species statement is not an admission that all of the tip shapes recited in the claim are interchangeable and obvious variants of one another. In this regard, the examiner has not pointed out that any of the recited shapes are present in the applied references.

The rejection of independent claim 35 and dependent claims 26-34, 52 and 54 is not sustained.

Finally, claim 36, which depends from claim 35, has been rejected as being unpatentable over Koreska in view of applicant's admission, EP, JP and WO. Claim 36 adds the limitation that the accelerator or initiator recited in claim 35 is disposed in or on the applicator tip. Adding the teachings of EP, JP and WO to Koreska does not overcome the problem we pointed out with consideration of the election of species to be an admission, and we will not sustain this rejection.

Remand To The Examiner

Unquestionably, the field of applicators for dispensing material from containers is well developed. This application is remanded to the examiner for consideration of determining whether the tip shapes recited in the claims on appeal are present in the

applicable prior art and, if so, whether new rejections of the claims should be entered by the examiner.

CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner for action consistent with the suggestion set forth above.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Aug. 200), item (D).

REVERSED AND REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

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) BOARD OF PATENT

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