

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANGELA L. PORTER
and DAVID PORTER

Appeal No. 2004-1058
Application 09/584,053

ON BRIEF

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Angela L. Porter et al. originally took this appeal from a first final rejection (Paper No. 12) of claims 12 through 18, 20 and 22 through 29, all of the claims pending in the application. Upon consideration of the appellants' main brief (Paper No. 16), the examiner reopened prosecution and issued a second and superseding final rejection (Paper No. 17). Pursuant to 37 CFR

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§ 1.193(b)(2)(ii), the appellants filed a supplemental brief (Paper No. 18) and requested that the appeal be reinstated. In response, the examiner entered an answer (Paper No. 19), noted a reply brief (Paper No. 20) filed by the appellants and forwarded the application to this Board for review of the current rejections of claims 12 through 18, 20 and 22 through 29.

THE INVENTION

The invention relates to "pet grooming . . . methods for removing loose hair from a furry pet such as a dog or cat" (specification, page 1). Representative claim 12 reads as follows:

12. A method of removing loose hair from a furry pet such as a dog or cat having loose hair and non-loose hair, the method comprising:

providing a grooming tool having an elongate handle portion extending generally along a handle axis, and a pet engageable portion secured to the handle portion, the pet engageable portion including a blade portion and a plurality of teeth, the blade portion including a blade edge, the teeth extending from the blade edge;

placing the pet engageable portion in engagement with the pet;

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pulling the handle portion generally along the handle axis while maintaining engagement of the pet engageable portion with the pet to cause the blade edge to engage the loose hair of the pet and pull it from the pet without cutting or pulling the non-loose hair from the pet.

THE PRIOR ART

The references relied on by the examiner to support the prior art rejections on appeal are:

Clements	441,136	Nov. 25, 1890
Deneen	797,184	Aug. 15, 1905

THE REJECTIONS

Claims 12 through 18, 20 and 22 through 29 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the enablement requirement.

Claims 12 through 18, 20 and 22 through 29 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

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Claims 12 through 18, 20 and 22 through 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Deneen.

Claims 12 through 18, 20 and 22 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deneen in view of Clements.

Attention is directed to the main, supplemental and reply briefs and to the second final rejection and answer for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection of claims 12 through 18, 20 and 22 through 29

According to the examiner, the appellants' specification fails to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, because

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Applicants' recitation [in independent claims 12, 24 and 28] that the grooming tool pulls loose hair from the pet "without cutting or pulling the non-loose hair [from the pet]" is not given patentable weight since it was not disclosed or verified how exactly the non-loose hair is not cut when the blade engages the pet hair. It was not disclosed how the grooming is performed (i.e. how loose hair versus non-loose hair is distinguished during the pulling). Applicants' [sic] have not established that their grooming tool will not cut non-loose hair [second final rejection, page 4].

Inasmuch as the appellants' specification contains a rather detailed and straightforward explanation of the method set forth in the appealed claims, and more particularly of the grooming tool blade edge and the role it plays in engaging loose hair and pulling it from the pet without cutting or pulling non-loose hair from the pet, the examiner's enablement concerns presumably stem from doubts as to whether the blade edge is actually capable of performing this function. The examiner has not cogently explained, however, and it is not apparent, why the appellants' specification lends credence to such doubts. In calling the enablement of a disclosure into question, an examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). Given the absence of such reasoning and any logical basis therefor in the present case, the

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appellants have no burden to establish that their grooming tool will function in the manner disclosed and claimed.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of independent claims 12, 24 and 28 and dependent claims 13 through 18, 20, 22, 23, 25 through 27 and 29.

II. The 35 U.S.C. § 112, second paragraph, rejection of claims 12 through 18, 20 and 22 through 29

This rejection rests on the examiner's contention that "the phrase 'such as' [in the preambles of independent claims 12, 24 and 28] renders the claim[s] indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention" (second final rejection, page 4).

The preambles of the three independent claims recite "A method of removing loose hair from a furry pet such as a dog or cat" The phrase "such as" merely specifies the dog or cat as an example of the furry pet upon which the claimed method is intended to be practiced. Hence, the reference to the dog or

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cat is part of the claimed invention to the extent that it expressly includes within the scope of the claims the practice of the specified method on these particular furry pets.¹ Thus, the examiner's position that the language in question renders the appealed claims indefinite is not well taken.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 12 through 18, 20 and 22 through 29.

III. The 35 U.S.C. § 102(b) rejection of claims 12 through 18, 20 and 22 through 29 as being anticipated by Deneen²

Deneen discloses a combined safety razor and hair cutter for shaving or trimming hair or a beard. The device includes a frame (see Figure 6), a comb 5 (see Figure 5), a razor blade 6 (see Figure 7), and a handle 10 (see Figure 8), with these elements

¹ The examiner has not questioned the meaning of the "furry pet" language.

² A cursory review of the Deneen patent shows that its specification is incomplete, apparently due to a publishing error. For purposes of this appeal, we have considered this reference for what it discloses in its drawing figures and on the two pages of specification which are present.

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being arranged as shown in Figures 1 through 4 "so that either the comb or blade side of the device may be used for trimming the hair or shaving, as may be desired" (page 1, column 2).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

As conceded by the examiner, "Deneen is silent as to whether the device is used on an animal" (answer, page 6). Hence, Deneen does not meet the various limitations in independent claims 12, 24 and 28 requiring the performance of the recited method steps on a furry pet. Moreover, even if Deneen did teach the use of the device on a furry pet, the examiner's finding (see pages 4 and 5 in the second final rejection and page 6 in the answer) that the blade edge of the device would "engage the loose hair of the pet and pull it from the pet without cutting or pulling the non-loose hair from the pet" when pulled along the handle axis as recited in claims 12, 24 and 28 conflicts with Deneen's

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disclosure that the razor blade functions to either shave or trim (cut) hair or a beard. The examiner's position here rests on an assertion (see page 6 in the answer) that the appellants' blade is similar to the blade disclosed by Deneen. The appellants' blade, however, has an edge 34 defined by planar surfaces 36 and 38 which meet at an angle B of between approximately 30° and 50° , preferably approximately 40° (see page 5 in the specification and Figure 5 in the drawings). Clearly, such blade edge is not nearly as sharp as the razor blade edge disclosed by Deneen. Thus, the examiner's proposition that the two blade edges are comparable is without merit.

For the above reasons, the examiner's determination that Deneen is anticipatory with respect to the subject matter recited in independent claims 12, 24 and 28 is not well founded. Consequently, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 12, 24 and 28, and dependent claims 13 through 18, 20, 22, 23, 25 through 27 and 29, as being anticipated by Deneen.

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IV. The 35 U.S.C. § 103(a) rejection of claims 12 through 18, 20 and 22 through 29 as being unpatentable over Deneen in view of Clements

Assuming (correctly) that Deneen might not meet the limitations in the appealed claims relating to the furry pet, the examiner turns to Clements to supply this deficiency.

Clements discloses a comb designed to remove loose hair and other foreign matter from an animal to be groomed. The comb includes a blade having a series of teeth formed with blunt tips 4 to avoid scratching the animal's hide and sharp sides 2 and roots 3 to take hold of and remove the loose hair and foreign matter.

In proposing to combine Deneen and Clements, the examiner concludes that it would have been obvious "to use the tool of Deneen on a pet/animal since Clements teaches that such devices are well known to remove loose hair from the animal" (second final rejection, page 7). The devices respectively disclosed by Deneen and Clements, however, embody distinct constructions for the performance of decidedly different functions. In short, Clements contains no teaching which would have suggested using

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the Deneen device on a furry pet. Moreover, even if Clements did contain such a suggestion, this use of the Deneen device would not, for the reasons explained above, respond to the limitations in independent claims 12, 24 and 28 requiring the blade edge to "engage the loose hair of the pet and pull it from the pet without cutting or pulling the non-loose hair from the pet" when pulled along the handle axis. Thus, the combined teachings of Deneen and Clements do not justify the examiner's conclusion of obviousness with respect to the subject matter recited in claims 12, 24 and 28.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 12, 24 and 28, and dependent claims 13 through 18, 20, 22, 23, 25 through 27 and 29, as being unpatentable over Deneen in view of Clements.

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SUMMARY

The decision of the examiner to reject claims 12 through 18,
20 and 22 through 29 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
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)	
JOHN P. MCQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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Jennifer D. Bahr)	
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