

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY A. SIMS

Appeal No. 2005-1035
Application No. 09/800,153

ON BRIEF

Before GARRIS, WALTZ, and TIMM, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-5 and 7-12.

The subject matter on appeal relates to a system for distributing pesticide into interior walls of a building. With reference to the Appellant's drawing, the system comprises a port 9 mounted in an exterior wall of the building, wherein the port is adapted to receive a discharge portion of a fluid injection device 46 which includes an inert gas inlet, a pesticide inlet, and valve means for selectively providing inert gas and pesticide to the discharge portion. The system further comprises a distribution

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manifold 18 connected downstream of the port and a plurality of elongate tubing members 30, 34 connected to the outlets of the distribution manifold, each tubing member extending through at least one wall of the building and having fluid discharge openings 38 spaced along the tubing members. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A system for distributing pesticide into interior walls of a building comprising
a port mounted in an exterior wall of the building, said port being adapted to receive a discharge portion of a fluid injection device wherein the injection device includes an inert gas inlet, a pesticide inlet, and valve means for selectively providing inert gas and pesticide to the discharge portion,
a distribution manifold connected downstream of the port having an inlet portion and a plurality of outlets,
a plurality of elongate tubing members connected to the outlets, each tubing member extending through at last [sic, least] one wall of the building and having fluid discharge openings spaced along said tubing members.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

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|--------------|-----------|---------------|
| Hill | 2,246,731 | June 24, 1941 |
| Wing | 2,862,765 | Dec. 2, 1958 |
| Jackson | 4,800,672 | Jan. 31, 1989 |
| Konieczynski | 4,917,296 | Apr. 17, 1990 |
| Cann | 5,310,114 | May 10, 1994 |

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson in view of Wing, and the remaining appealed claims are correspondingly rejected over these references in various combinations with the other references listed above.

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For a complete exposition of the opposing viewpoints expressed by the Appellant and by the Examiner concerning these rejections, we refer to the brief and reply brief as well as to the answer.

OPINION

We cannot sustain any of these rejections. Our reasons follow.

Both the Appellant and the Examiner interpret appealed claim 1, which is the sole independent claim on appeal, as requiring a fluid injection device, and both agree that the centralized fumigation (i.e., pesticide distributing) system of Jackson fails to include such a device. However, the Appellant and the Examiner disagree with respect to the obviousness of providing Jackson's system with the aforementioned fluid injection device vis-à-vis the Examiner's conclusion that "[i]t would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the injection device of Wing to the system of Jackson to utilize a non-explosive propellant (Wing, column 2, line 38)" (Answer, page 4).

In addition, the Appellant and the Examiner disagree with respect to the claim 1 recitation "a plurality of elongate tubing

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members connected to the outlets, each tubing member extending through at last [sic, least] one wall of the building and having fluid discharge openings spaced along said tubing members."

According to the Appellant, "Jackson and the combination of Jackson and Wing fail to teach of any tubing member extending through at least one wall of the building and having fluid discharge openings spaced along the tubing members unlike the claimed system of Applicant's claim 1" (Brief, page 13). In this regard, the Appellant emphasizes that, in Jackson's system, "pesticide is simply pumped from a tank until a mist is emitted through foggers 53 at the end of the lines" and that "[t]here are no openings in the tubing along the way to the foggers 53" (Brief, page 13). On the other hand, the Examiner urges that "[A]ppellant's argument is not commensurate in scope with the claimed invention" (Answer, page 8).

In the Examiner's view, "Jackson discloses a plurality of elongated tubing members 55, 52, 51 connected to the outlets (i.e., outlets of distribution manifold 57), each tubing member 55, 52, 51 extending through at least one wall of the building and having fluid discharge openings [i.e., foggers] 53 spaced along said tubing members 55, 52, 51." Further regarding this viewpoint, the Examiner emphasizes that "[t]he claim [i.e., appealed claim 1] is not limited to one straight tube having multiple outlets along

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its length, as suggested by applicant" (Answer, page 9).

As previously indicated, the Appellant and the Examiner both interpret appealed claim 1 as requiring a fluid injection device. This interpretation is erroneous. Pursuant to its express language, claim 1 is directed to

A system for distributing pesticide into interior walls of a building comprising a port mounted in an exterior wall of the building, said port being adapted to receive a discharge portion of a fluid injection device wherein the injection device includes an inert gas inlet, a pesticide inlet, and valve means for selectively providing inert gas and pesticide to the discharge portion [emphasis added].

Significantly, this quoted recitation concerning a fluid injection device is in relation to the here claimed port "being adapted to receive" such a device. That is, claim 1 requires not merely a port of any kind but rather a port which is capable of receiving the discharge portion of a particular type of fluid injection device (i.e., an injection device which includes an inert gas inlet, a pesticide inlet, and a valve means for selectively providing inert gas and pesticide to the discharge portion). However, claim 1 plainly does not contain any language which requires the fluid injection device itself to be part of the here claimed "system for distributing pesticide into interior walls of a building." Thus, because of the way in which it has been drafted, claim 1 must be interpreted as drawn to the subcombination of a

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pesticide distributing system, which comprises a port having the previously described capability, rather than drawn to such a system in combination with a fluid injection device pursuant to the erroneous claim construction shared by the Appellant and the Examiner.

Under these circumstances, we need not and will not assess the merits of the Examiner's obviousness conclusion vis-à-vis providing Jackson's system with the injection device of Wing. This is because such an assessment would be inappropriately advisory in light of our finding that the independent claim on appeal does not require an injection device of any kind.

As a consequence of the foregoing, the Examiner's proposed combination of Jackson and Wing, regardless of its propriety, is not relevant to the question of whether the Examiner's rejection of claim 1 should be sustained. Instead, the resolution of this question depends upon whether the Examiner has properly interpreted claim 1 to be so broad in scope that the tubing members and discharge openings thereof encompass Jackson's "tubing members" 55, 52, 51 and "discharge openings" 53 as urged in the paragraph bridging pages 8 and 9 of the answer.

In this regard, we appreciate the Examiner's point that Figure 1 of Jackson shows a plurality of "discharge openings" or fogging nozzles 53. While the Appellant is correct that only

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one nozzle 53 is associated with each tube 51, the Examiner has correctly pointed out that Figure 1 of Jackson shows the plurality of nozzles 53 (as well as the tubes 51 associated therewith) are "spaced along" tubes 52. Viewed from this perspective, the Examiner believes that the claim 1 requirements involving tubing members and discharge openings spaced along the tubing members are satisfied by the aforementioned tubes and nozzles shown in Figure 1 of Jackson.

The deficiency of the Examiner's analysis is that it fails to account for the claim 1 requirement "each tubing member extending through at l[e]ast one wall of the building." As clearly shown in Figure 1 of patentee's drawing, the only "tubing member" which extends through a building wall is tube 51 (which extends through the upper tie beam 17 of building wall 13). However, these tubes 51 unquestionably fail to satisfy the claim 1 requirements under consideration because each tube 51 includes only a single fogging nozzle 53 at the end thereof (see Figure 1 and lines 61-62 in column 3). Stated otherwise, patentee's tubes 51 meet the claim 1 limitation "extending through at l[e]ast one wall of the building" but fail to satisfy the claim 1 requirement "having fluid discharge openings spaced along said tubing members." On the other hand, while this last mentioned requirement may be satisfied by Jackson's tubes 52 as noted by the Examiner, Figure 1 of the patent clearly

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shows that none of these tubes 52 extend through a building wall as required by appealed claim 1.

For the reasons set forth above, it cannot be gainsaid that the Examiner has erroneously determined that the claim 1 requirements involving tubing members and discharge openings are satisfied by the tubes and nozzles of Jackson's fumigation system. Significantly, the Examiner has not advanced on the record of this appeal any position as to whether it would have been obvious to modify patentee's system so as to result in the arrangement of tubing members and discharge openings required by claim 1.

We are compelled by these circumstances to reverse the Examiner's rejection of independent claim 1 and of dependent claims 2-5, 7 and 8 as being unpatentable over Jackson in view of Wing. Because the other rejections before us do not cure the previously discussed infirmities of the Examiner's position, we are also compelled to reverse the rejection of claim 9 based on Jackson, Wing and Hill, the rejection of claim 10 based on Jackson, Wing and Cann, the rejection of claim 11 based on Jackson, Wing, Cann and Hill, as well as the rejection of claim 12 based on Jackson, Wing and Konieczynski.

In summary, we have not sustained any of the rejections advanced by the Examiner on this appeal.

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REMAND

As stated earlier, the Examiner has expressed no position on this appeal regarding the obviousness of modifying Jackson's fumigation system in such a manner as to result in the arrangement of tubing members and discharge openings required by independent claim 1. Concerning this issue, it is significant that the last full paragraph on page 2 of the subject specification describes the Appellant's prior art patents for a pesticide distributing system "in which lengths of flexible tubing having a plurality of spaced, tiny discharge orifices are distributed throughout the walls of a building" (specification, page 2, lines, 11-12). Indeed, the application file record reflects that at least one of the Appellant's prior art patents (i.e., U.S. Patent No. 4,944,110) was cited on an information disclosure statement filed June 1, 2001 and that the Examiner considered this patent on February 7, 2003.

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Notwithstanding this consideration, it is apparent that the Examiner should carefully review the teachings of the Appellant's prior art patents described on page 2 of the subject specification in order to determine whether one or both of these teachings in combination with the teachings of Jackson would have suggested to one having ordinary skill in this art modifying Jackson's centralized fumigation system so as to replace the single fogging nozzle per tube (i.e., tube 51) arrangement thereof with a plurality of fluid discharge openings spaced along the tubes in accordance with the teachings of the Appellant's prior art patents. From our perspective, an artisan would have been motivated by these last mentioned teachings to so modify Jackson's system in order to release pesticide into each wall void (e.g., see lines 1-16 in column 4 of U.S. Patent No. 4,944,110). Such a provision would have been desirable or even necessary when using Jackson's system for fumigating a building, such as a multiple story building, having a plurality of vertically spaced wall voids.

Therefore, in response to this remand, the Examiner must determine, and make of record the results of this determination, the propriety of rejecting at least appealed independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Jackson in view of one or both of the Appellant's prior art patents discussed above.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is **not** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

SUMMARY

The decision of the Examiner is reversed and the application is remanded to the Examiner.

REVERSED & REMANDED

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| BRADLEY R. GARRIS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| THOMAS A. WALTZ |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| CATHERINE TIMM |) | |
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