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for publication and is not binding precedent of the Board.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 DONALD D. FOSTER and PHILIP L. NELSON

Appeal No. 2005-1833
Application No. 10/338,337

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 23-27, 30-34 and 38-42. Claims 28, 29, 35-37 and 43, the only other claims pending in this application, stand objected to as being dependent on a rejected claim.

BACKGROUND

The appellants' invention relates to a dual liquid dispenser comprising two pump housings and two pump plungers for dispensing two separate liquid components from

two separate container volumes. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The Applied Prior Art

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Castner et al. (Castner)	3,760,986	Sep. 25, 1973
Markey et al. (Markey)	6,082,588	Jul. 4, 2000

The Rejections

The following rejections are before us for review.

Claims 23-27, 30, 32-34 and 39-42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Castner.

Claims 31 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Castner in view of Markey.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed September 16, 2003) and answer (mailed June 30, 2004) for the examiner's complete reasoning in support of the rejections and to the brief (mailed March 19, 2004) and reply brief (mailed August 2, 2004) for the appellants' arguments thereagainst.

OPINION

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

Claims 23-27, 30 and 32

The dispositive issue in the appeal of the rejection of these claims as being anticipated by Castner is the meaning of the limitation "a pump housing having a connector cap, a first pump chamber, and a second pump chamber that are connected together as one monolithic piece" of claim 23. The examiner (1) contends that this limitation "can be interpreted as requiring only the two pump chambers to be formed monolithically" and (2) interprets the term "monolithic" as "constituting or acting as a single piece"[1] (answer, page 3). The appellant, on the other hand, argues that claim 23 should be interpreted as requiring the connector cap and the two pump chambers to be formed as one monolithic piece (reply brief, pages 2-3) and cites a definition of "monolithic" as "cast as a single piece" (reply brief, page 3). For the reasons which follow, we conclude that the appellants are correct on both points.

As for the interpretation of "monolithic," the definition offered by appellants in their reply brief is more consistent with the definitions cited in several dictionaries

[1] Although the examiner urges that this interpretation "is consistent with the dictionary definition" (answer, page 3), as pointed out by the appellants on page 3 of the reply brief, the examiner does not cite the dictionary from which this definition is extracted.

consulted by this panel and is clearly the meaning intended by the appellants, as evidenced in their reply brief. Furthermore, the examiner has cited no authority for a different definition. Accordingly, we interpret "monolithic" as used in appellants' claim 23 as "cast as a single piece."

The limitation at issue in claim 23 does not set aside the first and second pump chamber from the connector cap in any manner which would imply that only the first and second pump chambers, and not the connector cap, are modified by the phrase "that are connected together as one monolithic piece."[2] This is in contrast to the limitation "the first and second pump chambers being positioned side by side," in which the language makes clear that only the first and second pump chambers, and not the connector cap, are required to be positioned side by side.

It is quite apparent from each of Figures 2-4 of Castner[3] and for the reasons cited by the appellants on pages 10-11 of their brief that the cap member 20, 20′, 20″ is formed as a separate piece from the tubes 21, 22 or 21′, 22′ or 21″, 22″ and not as one monolithic piece therewith, as called for in claim 23. Consequently, the examiner's anticipation rejection must fall. The rejection of claim 23 and claims 24-27, 30 and 32 depending therefrom as being anticipated by Castner is <u>not</u> sustained.

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[2] On the other hand, a limitation such as "a pump housing having a connector cap, a first pump chamber, and a second pump chamber, the first and second pump chambers being connected together as one monolithic piece" would convey that only the first and second pump chambers are required to be connected together as one monolithic piece.

[3] As pointed out by the appellants, the solid lines separating these parts and the distinct sectioning of these respective parts in Figures 2-4 indicates that the connector cap and tubes are separately formed members.

Claim 31

The examiner's application of Markey provides no cure for the deficiency of Castner noted above. It follows that the rejection of claim 31, which depends from claim 23, as being unpatentable over Castner in view of Markey also cannot be sustained.

Claims 33, 34 and 39-42

The appellants argue on pages 13-14 of their brief that Castner lacks "a manifold interconnecting the first piston rod and the second piston rod as one monolithic piece." In particular, the appellants argue that Castner's head 40 (Figure 2) is not a manifold, that is, a pipe fitting with several outlets for connecting one pipe with others, because the passages 37, 38 are kept separate from each other and emerge from the head 40 at respective orifices 41, 42. Be that as it may, as pointed out by the examiner on page 4 of the answer, the passages 37′, 38′ from the hollow pistons 31′ and 32′ are brought together within the head 40′ of Castner's Figure 3 to form a single discharge passage 50 and the fluid from the two is ejected as a single stream through a single nozzle 51. As such, the examiner's statement on page 4 of the answer that the Figure 3 embodiment of Castner meets the manifold definition as presented by the appellant is correct. We also note that the sectioning in Figure 3 indicates that the head 40′ and the two hollow pistons 31′ and 32′ are formed as one monolithic piece. The rejection of claim 33 as being anticipated by Castner is sustained.

With respect to claim 34, which depends from claim 33, Castner's head 40′ has a bottom wall that interconnects the first and second hollow piston rods 31′ and 32′ through which the hollow piston rods open, via passages 37′, 38′, to communicate with an interior volume 50 of the head. The rejection of claim 34 as being anticipated by Castner is sustained.

The like rejection of claims 39-42 has not been separately argued apart from claim 33, thus allowing these claims to stand or fall with representative claim 33 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). The rejections of claims 39-42 is therefore also sustained.

Claim 38

Claim 38 depends from claim 33 and further recites a single spring positioned between the first and second piston rods and between the first and second pump chambers and the manifold. In Castner's dispenser (Figure 3), a spring 29′ and 30′ is provided in each pump chamber 23′ and 24′ to restore the pistons 31′, 32′ to their raised position after the head 40′ is released. As evidenced by Markey (see Figure 5), the use of a single spring disposed between the first and second pistons (chambers 118, 120) and between the first and second pump chambers (fluid accumulation chambers 110, 112) and the structure connecting the first and second pistons for restoring the pistons to their raised position upon release of the actuator 140 was well

known in the art at the time of the appellants' invention. To have replaced the two-spring arrangement of Castner with the single-spring arrangement of Markey as a well known alternative biasing arrangement would have been obvious to one of ordinary skill in the art, especially in light of the fact that the Castner pistons 31′, 32′ are connected by the head 40′ as one monolithic piece and will thus move vertically together.

The appellants' concern that removing the dual springs 29′ and 30′ from the interiors of the pump chambers 31′ and 32′ would negate the functioning of the springs in biasing the ball valves 27′ and 28′ downwardly is unfounded. As evidenced by Markey (column 4, lines 47-60) and the operation of spring-held ball check valves 35′ and 36′, normally closed check valves which open under differential pressure conditions on opposite sides of the valves are extremely well known in the art for use in dual chamber fluid dispensers. Accordingly, the removal of the dual springs 29′ and 30′ from the pump chambers in favor of a single spring would not have presented a problem to one of ordinary skill in the art at the time of the appellants' invention.

For the foregoing reasons, the appellants' arguments fail to persuade us of any error on the part of the examiner in rejecting claim 38 as being unpatentable over Castner in view of Markey. The rejection is sustained.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b), claims 23-32 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide descriptive support for the subject matter now being claimed. We initially observe that

the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

> 35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*.
>
> . . . drawings alone *may* be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

The connector cap and first and second pump chambers of appellants' dispenser were not described anywhere in the application as originally filed as being "connected together as one monolithic piece" as now recited in claim 23. Further, like Castner's cap member 20 and tubes 21, 22, the appellants' connector cap 18 and first and second pump chambers 32, 34 are illustrated in Figure 3 with a solid line drawn between them, thus indicating that they are not connected as one monolithic piece, that is, cast as a single piece. Further, the formation of appellants' connector cap 18 and first and second pump chambers 32, 34 would present the same problems imputed to such

formation of Castner's cap member and pump chambers as one monolithic piece on page 11 of the brief.

For the foregoing reasons, the original disclosure would not have conveyed to one of ordinary skill in the art that appellants were in possession of the invention now recited in claim 23 including, in particular, "a pump housing having a connector cap, first pump chamber and second pump chamber that are connected together as one monolithic piece," or as now recited in claims 24-32 which depend from claim 23 and thus also include the limitation lacking support in the original disclosure.

CONCLUSION

To summarize, the rejection of claims 23-27, 30, 32-34 and 39-42 as being anticipated by Castner is reversed as to claims 23-27, 30 and 32 and affirmed as to claims 33, 34 and 39-42 and the rejection of claims 31 and 38 as being unpatentable over Castner in view of Markey is reversed as to claim 31 and affirmed as to claim 38. The examiner's decision is affirmed-in-part. A new rejection of claims 23-32 under 35 U.S.C. § 112, first paragraph, is entered pursuant to 37 CFR § 41.50(b).

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 41.50(b)

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