

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VERNON A. TRIGGER

Appeal 2007-0003
Application 10/217,990
Technology Center 1700

Decided: July 27, 2007

Before CHARLES F. WARREN, and JEFFREY T. SMITH, and
LINDA M. GAUDETTE *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1 to 18. We have jurisdiction under 35 U.S.C. § 6.

Appellant's invention relate to a transition unit. According to Appellant, the transition unit has applications for rendering fluids and gases

environmentally friendly (Specification [0008]). Representative independent claim 1, as presented in the Brief, appears below:

1. A transition unit comprising:
 - an outer cylinder that is cylindrically shaped and made of steel;
 - a foundation for supporting the outer cylinder;
 - grounding rods connected to the outer cylinder and extending to a water table;
 - a lower support structure located within the outer cylinder;
 - an inner cylinder supported by the lower support structure; and
 - a canister located within the inner cylinder
- wherein the inner cylinder is operable to permit the transmission of electromagnetic energy to a material contained within the canister.

The Examiner relies on the following references in rejecting the appealed subject matter:

Vanderklaauw	US 5,575,591	Nov. 19, 1996
Botzem	US 5,920,602	Jul. 6, 1999
Schutz	US 6,156,969	Dec. 5, 2000

The Examiner entered the following grounds of rejection:

- I. Claims 1-18 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention.
- II. Claims 1-18 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

III. Claims 1-7 and 11-16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Botzem and Schutz.

IV. Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Botzem, Schutz, and Vanderklaauw.

I. Claims 1-18 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention.

The issue presented is: Has the Examiner established that the subject matter of claims 1-18 does not meet the enablement requirements of 35 U.S.C. § 112, first paragraph? We answer this question in the negative.

The Examiner contends that the Specification does not have an enabling disclosure for the subject matter of claims 1-18. Specifically, the Examiner states, “[t]he claims are supported by the specification that contains subject matter which was not described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification recites questionable terms such as ‘alchemic transition unit’, ‘device for transforming abiogenic substances into biogenic substances’, or ‘absorptive magnetic resonances emitted from the center of the Earth (or from space) and impinging upon the lower part of the apparatus’, or rotating and charged magnetic resonances.” (Answer 4).

Regarding claims 15 and 16, the Examiner asserts the claims “recite means for manipulation and transforming toxic fluids into non-toxic ones. The specification does not provide the description on how to achieve such a

transformation, since magnetic resonances in general, and non-existing charged magnetic resonances 'coming from the center of the Earth' in particular cannot change chemical structures.” (Answer 4).

The first paragraph of 35 U.S.C. § 112 requires nothing more than an objective enablement. *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). How such teaching is set forth, either by use of illustrative examples or by broad terminology, is irrelevant. *Id.* As those skilled in the art will appreciate, the Specification provides lists of suitable materials for forming the transition unit (Specification 5-9). Since Appellant’s Specification contains a written description of the suitable materials and their arrangement corresponding with the scope of the claims on appeal, compliance with the enablement requirement is presumed. *Marzocchi*, 439 F.2d at 223-24, 169 USPQ at 369-70.

It is the Examiner’s burden to present adequate basis for doubting the objective truth of Appellant’s statements in the Specification, i.e., to provide scientific reasoning and/or evidence as to why one of ordinary skill in the art would not have been able to make and use the full scope of the subject matter claimed based on the written description of the invention in the Specification without undue experimentation. *Id.* On this record, however, the Examiner has not carried this burden. The Examiner has not proffered adequate scientific reasoning and/or evidence to doubt the accuracy of Appellant’s statements in the Specification. (Answer 3-6). The Examiner has not adequately considered and explained, *inter alia*, the state of the prior art, the nature of the invention, the working examples and the amount of

guidance presented in the Specification. *See, e.g., In re Wands*, 858 F.2d 731, 735-37, 8 USPQ2d 1400, 1402-04 (Fed. Cir. 1988).

Accordingly, we are constrained to reverse the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 22, 23, 26, 27, and 30-32 as lacking an enabling disclosure for the subject matter presently claimed.

II. Claims 1-18 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

The first issue presented is: Has the Examiner established that the subject matter of claims 1-16 does not meet the requirements of 35 U.S.C. § 112, second paragraph? We answer this question in the negative.

The Examiner contends that the subject matter of claims 1-16 is indefinite in scope because “[i]t is not clear from the claims what structural elements of the claimed device would ensure the proper transmission [of electromagnetic energy].” (Answer 4).

“The legal standard for definiteness [under the second paragraph of 35 U.S.C. § 112] is whether a claim reasonably apprises those of skill in the art of its scope” *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is to determine whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The definiteness of the language employed in a claim must be analyzed not in a vacuum, but in light of the teachings of the particular application. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

After consideration of the present record, we determine that a person of ordinary skill in the art would have realized, just as the Examiner in the statement of the rejection, that materials transmit electromagnetic energy. (Answer 4). The Specification includes lists of representative materials suitable for use in the invention. (Specification 5-7). There is nothing inherently wrong with defining some part of an invention in functional terms or based upon specified properties. The identification of properties and functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). Thus, we determine that the claims reasonably apprise those of ordinary skill in the art of their scope. Accordingly, we reverse the Examiner's § 112, second paragraph, rejection of claims 1-16 as indefinite.

The second issue presented is: Has the Examiner established that the subject matter of claims 17 and 18 does not meet the requirements of 35 U.S.C. § 112, second paragraph? We answer this question in the affirmative.

We affirm the rejection of claims 17 and 18 for the reasons set forth in the answer. The Examiner notes that the Specification only includes the capital "K" designation in the formula (Specification [0023]). The Appellant has failed to specifically address the Examiner's criticism of the formula presented in claims 17 and 18. Accordingly, we affirm the Examiner's § 112, second paragraph, rejection of claims 17 and 18.

III. Claims 1-7, and 11-16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Botzem and Schutz.

Appellant contends that neither Botzem nor Schutz suggest the structure as recited in claim 1. Appellant contends that Botzem and Schutz fail to disclose that the grounding members extended to a water table. Appellant further contends that Botzem and Schutz are silent with respect to the unit or device being operable to prevent the transmission of electromagnetic energy to a material contained within the canister. (Br. 10-11).

The Examiner contends that Botzem describes a storage facility that meets the claimed invention except for the presence of grounding members. The Examiner contends Schutz discloses a transport and storage container that comprises grounding members. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art to employ grounding members in the apparatus of Botzem. (Answer 6-7).

Accordingly, the issues presented on the record in this appeal are as follows: (1) do Botzem and Schutz disclose, teach, or suggest an apparatus that meets the claimed transition unit? and (2) has the Examiner presented an explicit analysis of the reasons for including grounding members in the apparatus of Botzem?

We determine that the Examiner has established a prima facie case of obviousness in view of the referenced evidence, which prima facie case has not been adequately rebutted by Appellant's arguments. Therefore, we AFFIRM the § 103 rejection presented in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the

differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Hoeschele*, 406 F.2d 1403, 1406-07, 160 USPQ 809, 811-812 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom . . .”). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a

person of ordinary skill in the art to combine the elements” in the manner claimed. *KSR*, 127 S.Ct. at 1731, 82 USPQ2d at 1389.

Applying the preceding legal principles to the factual findings in the record of this appeal, we determine that the Examiner has established a *prima facie* case of obviousness. This case of *prima facie* obviousness has not been adequately rebutted by Appellant’s arguments.

Appellant argues that the structure of Botzem does not contain grounding members connected to the outer cylinder that extend into a water table. (Br. 10). Appellant also argues that Schulz fails to disclose grounding members that extend into a water table. (Br. 11). Appellant has not disputed that it would have been obvious to include grounding members in the apparatus of Botzem as suggested by the Examiner. Rather, Appellant’s arguments are directed to the location of the described apparatus. These arguments are not persuasive because they do not establish a non-obvious structural difference from the cited prior art.

Appellant argues that both Botzem and Schulz are silent with respect to the device as “being operable to permit the transmission of electromagnetic energy.” (Br. 11). It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) (“The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition.”); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish

over the prior art apparatus). Appellant has not argued that the materials which formed the device disclosed by Botzem and Schulz are not suitable for transmission of electromagnetic energy. Appellant's arguments (Br. 11) regarding the location of the device in proximity to a water table are not persuasive because the location of the device does not establish a structural difference.

As to claims 2-6 and 11-16, Appellant repeats his arguments regarding the device being operable from the transmission of electromagnetic energy. (Br. 11-16). These arguments are not persuasive for the reasons set forth above.

IV. Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Botzem, Schutz, and Vanderklaauw.

The Examiner contends that a person of ordinary skill in the art would have readily recognized that wings, flanges and centerlines are known means of alignment and support. In support of his position the Examiner cites the Vanderklaauw reference. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art to employ known means for alignment and support in the device suggested by Botzem and Schulz (Answer 8).

Appellant has failed to contest the Examiner's reasoning for citing the Vanderklaauw reference. Rather, Appellant repeats his arguments regarding the device being operable from the transmission of electromagnetic energy. (Br. 17-18). These arguments are not persuasive for the reasons set forth above.

CONCLUSION

The rejection of claims 1-18 under 35 U.S.C. § 112, first paragraph has been reversed.

The rejection of claims 1-16 under 35 U.S.C. § 112, second paragraph has been reversed.

The rejection of claims 17 and 18 under 35 U.S.C. § 112, second paragraph has been affirmed.

The rejection of claims 1-7 and 11-16 under 35 U.S.C. § 103(a) as unpatentable over Botzem and Schutz has been affirmed.

The rejection of claims 8-10 under 35 U.S.C. § 103(a) as unpatentable over Botzem, Schutz, and Vanderklaauw has been affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

sld/ls

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