

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte C. RICHARD COSTIN

Appeal No. 95-4682
Application 08/107,536¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner finally rejecting claims 1 through 11. Claims 12 through 21 are also of record and stand withdrawn from further consideration.

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of appealed claims 1 through 10 under 35 U.S.C. ' 102(b)² as being anticipated by Evani³ or Kent et al. or Kmiec et al., or the ground of rejection of appealed

¹ Application for patent filed August 17, 1993.

² Each of the applied references is applicable prior art to the claimed invention under ' 102(b).

³ The references relied on by the examiner with respect to the grounds of rejection are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

claim 11 under 35 U.S.C. ' 103 as being unpatentable over Evani or Kent et al.

It is well settled that in making out a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claims, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). It is also well settled that in order to establish a *prima facie* case of obviousness, **A**[b]oth the suggestion and the reasonable expectation of success must be found in the prior art and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Thus, a *prima facie* case of obviousness is established by showing some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention, including each and every limitation of the claim, without recourse to the teachings in appellant's disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring).

The starting point in considering the claimed invention vis-à-vis the prior art under either ' 102(b) or ' 103 is to determine the invention encompassed by the claims under consideration. Indeed, the dispositive issue in this appeal is whether the claims can be construed to be limited to *drilling fluids* which term not only is used to define the compositions to which appealed claim 1 is drawn but also to define one of the ingredients in these compositions. The examiner contends that **A**the drilling fluids of the claims and the fluids of the prior art are only distinguished by intended use[@]which **A**does not distinguish two otherwise identical elements,[@]and takes the position that **A**drilling fluids can be interpreted as being fluids which can be used in drilling processes[@]and **A**should not be limited by what Appellant believes are conventional drilling fluids[@] (answer, pages 3-4). Appellant points to the definition of **A**drilling fluid[@] in his specification and contains that that definition must be used to define the term in the appealed claims (reply brief, pages 2-3).

We agree with appellant. In determining the subject matter sought to be patented, and mindful that we must give the broadest reasonable interpretation to the terms of the appealed claims consistent with appellant's specification as it would be interpreted by one of ordinary skill

in this art, we conclude that one of ordinary skill in this art would have concluded from the definition specified in appellant's specification (pages 3-4) that the term "drilling fluid" appearing in appealed claim 1 must be interpreted as a "water-based drilling mud." *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996), and cases cited therein (a claim term will be given its ordinary meaning unless appellant discloses a novel use of that term); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). *supra* ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art."). We further conclude that, as a matter of claim construction, the phrase "[a] drilling fluid composition" in appealed claim 1, when considered in the context of the claimed invention as a whole, including consideration thereof in light of the specification, must be given weight as a claim limitation which characterizes the claimed composition in order to give meaning to the claims and properly define the invention. *See generally In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857 [225 USPQ 792] (1984)), *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Thus, because the applied prior art does not disclose or suggest fluid compositions that contain components such that they can be fairly characterized as a "drilling fluid," each and every element of the appealed claims is not taught or suggested by the prior art. Accordingly, the examiner has not established a *prima facie* case under either ' 102(b) or ' 103.

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN
Administrative Patent Judge

JOHN D. SMITH
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

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) BOARD OF PATENT
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James A. Droble
1600 Market St., Ste. 3600
Philadelphia, PA 19103