

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD P. PALESTRO, DALE R. MORGAN,  
MICHAEL D. ISEMAN and DONALD P. ROSIER

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Appeal No. 1996-3042  
Application 08/293,153<sup>1</sup>

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ON BRIEF

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Before METZ, JOHN D. SMITH and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's final rejection of claims 1-9, which are all of the claims remaining in the

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<sup>1</sup> Application for patent filed August 18, 1994. According to the appellants, the application is a continuation of Application 08/087,178, filed July 2, 1993, now abandoned; which is a continuation-in-part of Application 07/960,085, filed October 9, 1992, now abandoned.

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application.

*THE INVENTION*

Appellants claim a method for destroying airborne tuberculosis bacteria in air in a room by filtering the air, passing the air by at least one germicidal ultraviolet light bulb twice, and releasing the air including destroyed bacteria back into the room. Claim 1 is illustrative and reads as follows:

1. A method for destroying airborne tuberculosis bacteria in air in a room having a set of walls and a ceiling panel, comprising mounting a device behind a wall or ceiling panel of the room, filtering the air using a filter mounted on the device, drawing the air through a sterilization chamber in the device having at least one ultraviolet light bulb for irradiating the air with germicidal ultraviolet light such that the air passes the light bulb twice, and releasing the air including destroyed bacteria back into the room.

*THE REFERENCES*

Minto 1963	3,072,978	Jan. 15,
Sievers 1973	3,757,495	Sep. 11,
Nelson 1991	5,074,894	Dec. 24,

*THE REJECTIONS*

Claims 1-9 stand rejected under 35 U.S.C. § 112, first

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and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-3 and 7-9 over Sievers in view of Nelson; claims 4 and 5 over Sievers in view of Nelson and Minto; and claim 6 over Sievers in view of Nelson, Minto and appellants' acknowledged prior art on pages 8 and 9 of the specification.

*OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

*Rejection under 35 U.S.C. § 112, second paragraph*

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, sets out and

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circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner argues that it is unclear what process step is being recited in having air pass twice over the lights (answer page 3). That step is the step in the independent claim of "drawing the air through a sterilization chamber . . . such that the air passes the light bulb twice". The examiner has not explained why the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity. The rejection under 35 U.S.C. § 112, second paragraph, therefore, is reversed.

*Rejection under 35 U.S.C. § 112, first paragraph*

Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and

using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

The examiner argues that he fails to see how the air in the device shown in figure 2 of appellants' specification can make two passes over the lights (answer, pages 3 and 7). The examiner questions how the air can deflect off of baffle 184 in appellants' figure 2 and pass back in the opposite direction as shown in that figure (answer, page 7). The examiner states that he considers the flow path shown in appendix B of his answer, wherein the air makes one pass over each light and there is some turbulence next to baffles 182

and 184, to be the most probable flow path. See *id.*

The examiner has not backed up his assertion of nonenablement with acceptable evidence or reasoning. Instead, the examiner provides mere speculation that the air may flow along a path which is different than that shown in appellants' figure 2. Furthermore, even if the flow path proposed by the examiner and shown in appendix B of the answer is correct, the examiner has provided no technical reasoning as to why the turbulence shown in that figure would not be great enough to cause the air to pass at least one of the light bulbs twice.

Accordingly, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of lack of

enablement. Consequently, the rejection under 35 U.S.C. § 112, first paragraph, is reversed.

*Rejections under 35 U.S.C. § 103*

The examiner argues that in figure 2 of Sievers, the air flows past the first light bulb in section 26a then reflects off the top wall (42) and passes the second light bulb in

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section 26b (answer, page 8). Appellants' claims, however, require that the air passes a light bulb twice, not that it passes each of two light bulbs once.

We give appellants' claims their broadest reasonable interpretation consistent with the specification. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Herz*, 537 F.2d 549, 551, 190 USPQ 461, 463 (CCPA 1976); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976). In doing so, we conclude that the claims require that the air flows past a light bulb twice before it is released back into the room. Because the examiner has not explained where the applied references disclose or would have fairly suggested, to one of ordinary skill in the art, flowing air past a light bulb in this manner, the examiner has not carried his burden of establishing a *prima facie* case of obviousness of appellants' claimed invention. We therefore reverse the rejections under 35 U.S.C. § 103.

*DECISION*

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The rejections of claims 1-9 under 35 U.S.C. § 112, first and second paragraphs, and the rejections under 35 U.S.C. § 103 of claims 1-3 and 7-9 over Sievers in view of Nelson, claims 4 and 5 over Sievers in view of Nelson and Minto, and claim 6 over Sievers in view of Nelson, Minto and appellants' acknowledged prior art on pages 8 and 9 of the specification, are reversed.

*REVERSED*

ANDREW H. METZ	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN D. SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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