

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

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELIZABETH J. GLADFELTER,
TINA D. OUTLAW, JAMES L. COPELAND,
RHONDA K. SCHULTZ, DANIEL K. BOCHE
and JEFF PETERSON

Appeal No. 1997-0043
Application 08/071,596

HEARD: September 12, 2000

Before KIMLIN, WARREN and DELMENDO, *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 5, 8 through 12 and 14 through 25, and refusing to allow claims 6, 7 and 13 as amended subsequent to the final rejection. Appellants cancelled claims 26 through 35. Thus, claims 1 through 25 are before us on appeal, which are all of the claims in the application.¹

¹ See specification, pages 47-50, and the amendments of August 3, 1992 and December 28, 1992 (application 07/699,662, Papers No. 4 and 10) and of February 4, 1994 and October 11, 1994 (present application, Papers No. 17 and 24).

We have carefully considered the record before us, and based thereon, find that we cannot sustain the grounds of rejection of claims 1 through 14 and 23 through 25 under 35 U.S.C. § 102 or, in the alternative, under 35 U.S.C. § 103 over Joshi et al., and of claims 15 through 22 under 35 U.S.C. § 103 over Joshi et al. in view of Ogar et al., KAO Corp. or Henkel.²

It is well settled that in order to establish 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, “[b]oth the suggestion and the expectation of success must be founded in the prior art, not in applicant’s disclosure.” *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that 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 as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants’ disclosure. *See generally, In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967).

We agree with appellants that the examiner has failed to carry his burden of establishing a *prima facie* case of anticipation and of obviousness with respect to the claimed invention. We have interpreted appealed claim 1 in light of appellants’ specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). We find that claim 1 specifies a solid system comprising “at least one *substantially continuous* surface for contact by an aqueous spray” formed by “a first shape comprising an inwardly curved bar . . . having an inner opening spanning between said bar top surface and said bottom surface” and “a second shape comprising an insert . . . [that] is

² The references relied on by the examiner are listed at page 3 of the answer.

removably fitted within said bar inner opening” in a manner to “complete said continuous outer wall,” wherein the “bar and . . . insert *may be separated without destruction* of either shape” (emphasis added). Thus, the bar and the insert would each have a separate surface such that when these shapes are removably fitted together, such that they can be separated without destruction, that is, can be fitted together, separated and refitted together, they form the substantially continuous outer surface of the claimed solid system.³

In comparing the claimed solid system encompassed by claim 1 with the Joshi et al., we find that, contrary to the examiner’s position (answer, e.g., pages 4-5, 7-8 and 9-10), the solid bar disclosed by the reference does not contain separate shapes that are removably fitted together as specified for the claimed solid in claim 1. Indeed, as pointed out by appellants in the principal brief, Joshi et al. teaches that the disclosed dual composition bar is formed of two different

³ We note that the issue of whether claim 1 satisfies the requirements of 35 U.S.C. § 112, second paragraph, is raised by the word “continuous,” appearing in the phrase “at least two cooperative shapes cooperating to form a solid having a continuous outer wall” in the preamble and in the phrase “said insert is fitted within said bar to complete said continuous outer wall” in clause “(b),” and the words “substantially continuous” appearing in the phrase “said bar and insert providing at least one substantially continuous surface for contact by an aqueous spray” in clause “(b).” While it would appear from the language of the claim that the word “continuous” would have its common dictionary meaning of “[e]xtending or prolonged without interruption or cessation,” *The American Heritage Dictionary Second College Edition* 317 (2d ed., 1982), this meaning is in conflict with the reasonable interpretation of claim 1 that the bar and the insert would each have a separate surface that together form the outer surface of the claimed solid system in a “substantially,” that is, not entirely, *see, e.g., York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996), “continuous surface for contact by an aqueous spray.” See specification, e.g., page 4, lines 14-16, and page 8, lines 6-9. However, we are of the view that the issue of indefiniteness we note here does not amount to the “considerable speculation” found by the predecessor to our reviewing court to require a technical reversal of a ground of rejection under 35 U.S.C. § 103 in *In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It further appears to us that if the language “inwardly curved bar” is intended to reflect the inward curve of the surface of outer wall **18** necessary to accept the part of insert **14** forming the “substantially continuous surface” as shown in specification FIG. **6**, as contended by counsel at oral hearing, then the language “said bar comprising” in lines 1-2 of clause “(a)” of claim 1 appears to be indefinite. This matter could be addressed by amending the cited phrase of clause “(a)” to read “said shape comprising.” These issues should be considered in any further prosecution of the appealed claims before the examiner.

materials that are mechanically interlocked by a tongue and groove interlocked, wherein the interlock is enhanced by squeezing the two materials together during the formation of the convoluted surface (co. 1, line 52-68). Thus, one of ordinary skill in this art would have found that the disclosed bar is essentially of unitary construction that is not formed so as to be separable into two parts at the tongue and groove interface.

Therefore, we find no disclosure in Joshi et al. which would support the examiner's positions that "the use of the tongue and groove mechanism inherently facilitates the possible removal of the two portions without damaging said portions" (answer, page 4) and that "it would have been obvious to one of ordinary skill in the art to formulate such a bar because of Joshi's teaching of an interlocking mechanism for two detergent compositions" (*id.*, page 5). Indeed, while the examiner admits that the reference "does not specifically state" or "teach" that "the bar is capable of separation into its two portions without destruction" (*id.*, pages 4-5), no evidence or reasonable scientific explanation is advanced on the record showing how the enhanced tongue and groove interlocking mechanism disclosed in Joshi et al. would necessarily inherently permit the separation of the bar into two parts without destruction of either part, such that the parts can be removably refitted together as required by claim 1, *see King, supra*, or why and how one of ordinary skill in this art would have reasonably modified the bar intended by Joshi et al. to be a unitary entity, to successfully achieve the requirements of the claimed invention. *See, e.g., In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Furthermore, we agree with appellants that the shape of the two individual parts forming the bar and the thus formed bar of Joshi et al. do not correspond to the shape of the bar and the insert formed by the claimed solid system encompassed by claim 1.

Thus, on this record, it is manifest that the only description of and direction to appellants' claimed invention as a whole on the record before us is supplied by appellants' own specification.

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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