

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR E. WILSON and LIONEL A. WOOLFORD

Appeal No. 97-1176
Application 08/003,673¹

ON BRIEF

Before McCANDLISH, ABRAMS and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

Victor E. Wilson and Lionel A. Woolford (appellants) appeal from the examiner's rejection of claims 15, 16 and 19-24. No other claims remain pending.

This is the second appeal in the present application. In a decision issued May 26, 1995, this panel of the Board reversed

¹ Application for patent filed January 12, 1993.

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the examiner's rejection of claims 15, 16 and 19-24 under 35 U.S.C. § 103 and entered a new ground of rejection thereof under 35 U.S.C. § 112, first paragraph, pursuant to our authority under 37 CFR § 1.196(b). Appellants subsequently elected to amend the claims and have the matter reconsidered by the examiner.

Appellants' invention pertains to a device for dispensing a water treatment composition into a toilet tank. A copy of the appealed claims appears in the appendix to appellants' brief.

The prior art references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Bachman	1,321,586	Nov. 11, 1919
Spence (Great Britain)	13,146	July 5, 1893
Ekins (Great Britain)	23,517	Nov. 3, 1908
Hicks (Australian)	240,459	Feb. 2, 1961

Claims 15, 16 and 19-24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 15, 16 and 19-24 stand further rejected under 35 U.S.C. § 103 "as being unpatentable over Spence, Ekins, Bachman and Hicks" (office action mailed August 17, 1995 (Paper

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No. 29, page 2)).²

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 32), while the complete statement of appellants' argument can be found in the brief (Paper No. 31).

OPINION

Having carefully considered the content of the claims on appeal, the teachings of the applied references and the respective viewpoints advanced by appellants and the examiner, we shall not sustain either of the examiner's rejections. Our reasons follow.

Initially, we make note of the following claim language interpretation. Consistent with the application disclosure, we understand the recitation in the last paragraph of independent claim 15 of

said angularly and vertically spaced openings through said side wall being sufficiently small so that, in use, the contact between the water and the said body of water-erodible water-treatment composition by virtue of

² Although the examiner's answer cites only Spence and Ekins in the evidentiary basis of the rejection, it is clear from the record as a whole that, as with the previous appeal, both the examiner and appellants consider that the Bachman and Hicks references are relied upon in a secondary capacity to teach certain features of the dependent claims. In this regard, see page 2 of the office action mailed August 17, 1995, pages 2 and 8 of the brief, and pages 4 and 6 of the examiner's answer.

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the said openings does not have any significant effect on the dissolving of the water-erodible water-treatment composition

as referring to those angularly and vertically spaced openings initially disposed below the upper surface of the water-erodible water-treatment composition, i.e., the openings other than those "open" or "exposed" in the initial state (specification, page 7, second paragraph).

The 35 U.S.C. § 112, second paragraph, rejection

Considering first the rejection under § 112, the examiner is of the opinion that

Claim 15 is unclear [because] . . . [t]he meets [sic] and bounds of the phrases "essentially only" and "sufficiently small" as applied to the size of the openings, and the phrase "does not have any significant effect" as applied to the water treatment composition dissolution, can not be ascertained from the instant disclosure. . . . Appellant's [sic] have not . . . given a concrete example as to what a person could expect to practice without conflicting with such claim language (if patented). [answer, page 4]

The second paragraph of § 112 does not require the metes and bounds of the invention to be defined exactly, but instead with only a reasonable degree of precision. See, *inter alia*, *In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976) and *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). As the court stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ

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236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirement of the second paragraph of § 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a *reasonable* degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [emphasis added; footnote omitted]

Moreover, while we appreciate that definiteness problems sometimes arise when words of degree, such as "sufficiently small," are used in a claim, it is well settled that where the specification provides some standard for measuring that degree, indefiniteness under 35 U.S.C. § 112, second paragraph, will not lie. *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

In the present case, we are satisfied that those skilled in the art would be reasonably apprised of the subject matter encompassed by the appealed claims and that the metes and bounds are defined with a reasonable degree of precision. Pertinent portions of appellants' disclosure which shed light on and provide guidance for measuring the scope of the claim language

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found objectionable by the examiner read as follows:

. . . [T]he [water treatment] material is in solid or paste form and fills the interior of the cartridge 15 so that *essentially only* its upper surface makes effective contact with water, the apertures 27 being *sufficiently small* so that the contact between the water and the material 34 by virtue of the holes 27, *does not have any significant effect* on the dissolving or dispersion of the material 34. The material is desirably formulated so that it slowly dissolves in water, the pattern of holes 27 being effective to ensure that the material 34 is consumed evenly, so that its upper surface maintains a substantially flat profile as it slowly drops. [specification, page 7, lines 17-27; emphasis added]

* * *

As the water treatment material 34 is consumed and the level of its upper surface drops, further apertures 27 in the side wall of the cartridge casing 25 become exposed to thereby permit water collected within the casing to drain therefrom during the flushing cycle. Desirably, water within the housing 11 makes contact with the water treatment material *essentially only* across its upper surface, thus permitting the rate of dispersion of the water treatment material 34 to be effectively controlled. [specification, page 8, lines 23-31; emphasis added]

In our view, the ordinary skilled artisan would have no difficulty determining the metes and bounds of claim 15, and in particular the language pointed out by the examiner, when the claim language is read in light of the foregoing portions of appellants' disclosure. Accordingly, we will not sustain the

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examiner's rejection of the appealed claims under 35 U.S.C.
§ 112, second paragraph.

The 35 U.S.C. § 103 rejection

Turning to the standing § 103 rejection, even if we were to agree with the examiner that it would have been obvious to dispose the water treatment material D of Spence in a perforated casing in view of the teachings of Ekins, the claimed subject matter would not ensure. This is because, notwithstanding the examiner's argument to the contrary in the paragraph spanning pages 6 and 7 of the answer, there is nothing in the combined teachings of Spence and Ekins that teaches, suggests or infers that at least one of the openings in the casing should be above the upper surface of the body of water-treatment material so that the water within the housing makes contact with the water-treatment material essentially only across its upper surface, as called for in the penultimate paragraph of claim 15. Furthermore, there is nothing in the combined teachings of Spence and Ekins which suggests that the remaining openings in the casing should be of such size that the contact between the water in the housing and the water-treatment material by virtue of the remaining openings does not have any significant effect on the dissolving of the water-treatment material, as called for in the

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last paragraph of claim 15.

The Bachman and Hicks references, while pertinent to certain limitations of the dependent claims, do not overcome the deficiencies of Spence and Ekins noted above. Accordingly, we also will not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103.

Summary

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Administrative Patent Judge)	
)	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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