

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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT BUSCHEK et al.

Appeal No. 1997-2194
Application No. 08/195,018

HEARD: November 28, 2000

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 16, mailed December 4, 1995) of claims 1 to 3 and 6 to 19, which are all of the claims pending in this application.¹

We AFFIRM.

¹ Claims 1 to 3, 6 to 8 and 17 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention concerns a system for the preparation of liquids from at least one solid and at least one liquid phase, the system consisting of a storage vessel with the solid and a drying chamber with a desiccant (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cullen 1976	3,990,872	Nov. 9,
Sacherer et al. 1989 (Sacherer)	4,834,234	May 30,

Claims 1 to 3 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 the appellants regard as the invention.

Claims 1 to 3 and 6 to 19 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 1 to 3, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sacherer.

Claims 8 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sacherer in view of Cullen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 23, mailed July 29, 1996) and the supplemental answers (Paper Nos. 25, 28 and 31, mailed September 30, 1996, October 16, 1996 and November 29, 1996) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 22, filed May 13, 1996), reply brief (Paper No. 27, filed

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September 25, 1996) and response to new ground of rejection
(Paper No. 29, filed November 4, 1996) for the appellants'
arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 3 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims 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. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, we turn to the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. In the answer (p. 7), the examiner determined that claims 1 to 3 were indefinite since the claimed range of surface tension for wetting (i.e.,

smaller than 70 mN/m) "lacks a lower limit which would read on no surface tension."

The examiner has not explained why the claimed language cannot be understood with a reasonable degree of certainty. In fact, the examiner was able to determine that the limitation in question was readable on no surface tension. In our opinion the metes and bounds of the claimed language can be easily understood. Furthermore, it is well established that the mere breadth of a claim does not in and of itself make a claim indefinite.²

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3 under 35 U.S.C. § 112, second paragraph, is reversed.

The written description rejection

² Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

We sustain the rejection of claims 1 to 3 and 6 to 19 under 35 U.S.C. § 112, first paragraph.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description

requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

The examiner determined (Paper No. 25, p. 2) that the phrase "said desiccant chamber not communicating with the environment external to the desiccant chamber" recited in each of the independent claims on appeal lacks written description support in the application as originally filed. The appellants argue (see e.g., brief, pp. 10-11) that the above-quoted phrase is supported by Figure 1 and the specification (page 10, lines 12-13) that provide that the desiccant stopper 1 is closed to the outside by wall 2.

We have reviewed the originally filed disclosure and find no express or implicit disclosure for the above-quoted phrase. In fact, the original disclosure provides (page 10, lines 17-23) that (1) the wall 2 can exchange humidity to a slight extent between the environment and desiccant (page 10, lines 17-23); and (2) the separating element, which separates the

desiccant and the interior of the vessel³ from one another, is permeable to water vapor (paragraph bridging pages 11-12). In our view, the originally filed disclosure clearly teaches that the desiccant chamber does communicate with the environment external to the desiccant chamber. Thus, we find that the phrase "said desiccant chamber not communicating with the environment external to the desiccant chamber" violates the written description requirement of the first paragraph of 35 U.S.C. § 112.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3 and 6 to 19 under 35 U.S.C. § 112, first paragraph, is affirmed.

The obviousness rejections

We will not sustain the rejection of claims 1 to 3 and 6 to 19 under 35 U.S.C. § 103.

³ We note that the interior of the vessel is an environment external to the desiccant chamber.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the applied prior art before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the applied prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Rejections based on § 103 must rest on a factual

basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the two rejections under 35 U.S.C. § 103 before us in this appeal.

Claims 1 to 3, 6 and 7 recite an apparatus comprising, inter alia, a vessel defining a compartment, a desiccant article defining a desiccant chamber, and a separating element separating the desiccant chamber from the compartment, wherein the separating element is made of cardboard having a surface tension for wetting which is smaller than 70 mN/m.

Sacherer discloses a container for test strips for the analysis of body fluids, comprising a container body (2) with

a circular removal opening (2a), a sealing surface (14) facing the axis (A) of the opening and a stopper (3) for the closure of the removal opening (2a) which has a cover plate (4), a hollow plug (7) attached thereto with an outwardly facing sealing beading (8), a drying agent cell (6) within the hollow plug and a support element (10) by means of which the plug is supported radially inwardly, wherein the support element is so constructed that it abuts the hollow plug in a region axially displaced away from the cover plate (4) with regard to the zenithal line (15) of the sealing beading (8), whereas axially, at the height of the sealing beading (8), between the inner side of the hollow plug and the drying agent cell, even when the stopper (3) is in a position permitting removal, an annular gap (9) is present so that the hollow plug (7) is radially inwardly elastically deformable in the region of the sealing beading (8). Sacherer teaches (column 1, lines 17-30) that

[t]est strips are used more and more for the analysis of body fluids and especially of blood and urine. Test strips are extraordinarily sensitive to moisture, which means that packaging standards for these are very high. In order to guarantee the necessary storage stability, the test strip containers must be practically completely sealed for a long period of time

(at least two years). This tight sealing must also be maintained when the container is opened often (typically 50 times) in order to remove individual test strips.

In order to absorb the moisture which unavoidably gets in during the opening and closing of the test strip container, it must contain a sufficient amount of a drying agent.

Sacherer further teaches (column 3, lines 23-37) that the stopper (3) is made of a synthetic resin, preferably polyethylene or polypropylene and that the drying agent cell (6) is covered with a water vapour-permeable cardboard disc (10).

The examiner determined (answer, pp. 4-5) that claims 1 to 3, 6 and 7 differ from Sacherer by specifying a specific surface tension range (i.e., a surface tension for wetting which is smaller than 70 mN/m) and that the cardboard of Sacherer (i.e., cardboard disc (10)) would appear to encompass the claimed surface tension range. The appellants argue (brief, pp. 11-13) that the cardboard disc (10) of Sacherer would not encompass the claimed surface tension range.

When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). Here, the examiner has not meet this burden. While both Sacherer and the appellants make their separating element from cardboard, the appellants teach (specification, p. 12) that the cardboard is coated to ensure that the separating element is water repellent. Since Sacherer's cardboard disc (10) has no need to be water repellent and is not coated, we fail to see that the claimed specific surface tension range (i.e., a surface tension for wetting which is smaller than 70 mN/m) would be inherently met by Sacherer's cardboard disc (10).

For the reasons set forth above, the examiner has failed to establish the obviousness under 35 U.S.C. § 103 of the subject matter of claims 1 to 3, 6 and 7. Accordingly, the decision of the examiner to reject claims 1 to 3, 6 and 7 under 35 U.S.C.

§ 103 is reversed.

We now turn to the examiner's rejection of claims 8 to 19 under 35 U.S.C. § 103. The lynchpin of this rejection is the examiner's determination (answer, p. 6) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add liquid to the stored solid in the vessel of Sacherer. We do not agree. Sacherer clearly teaches to avoid liquid in his container since he desires to keep the test strips (i.e., the stored solid) dry. We have reviewed the reference to Cullen but find nothing therein which would have suggested adding liquid to Sacherer's container.

For the reasons set forth above, the examiner has failed to establish the obviousness under 35 U.S.C. § 103 of the subject matter of claims 8 to 19. Accordingly, the decision of the examiner to reject claims 8 to 19 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 under 35 U.S.C. § 112, second paragraph, is reversed; and the decision of the examiner to reject claims 1 to 3 and 6 to 19 under 35 U.S.C. § 112, first paragraph, is affirmed and the decision of the examiner to reject claims 1 to 3 and 6 to 19 under 35 U.S.C. § 103 is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
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