Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALVIN D. WILBANKS

Appeal No. 2000-0587
Application No. 08/998,728[1]

ON BRIEF

Before CALVERT, FRANKFORT, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 through 12 in this reissue application of Patent No. 5,595,018.[2] Claims 1 through 5, the original patent claims, have been allowed. Claims 1 through 12

[1] Filed December 29, 1997.

[2] Issued January 21, 1997.

constitute all of the claims pending in this application.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

The appellant's invention is directed to an insect killing system. A copy of the claims under appeal is set forth in the appendix to the appellant's brief (Paper No. 9).

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

Gagliano	3,041,773	Jul. 03, 1962
Nolen	5,205,064	Apr. 27, 1993

Claims 6 through 8 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nolen.

Claims 6 through 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gagliano.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 7) and to the answer (Paper No. 10) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9) for the appellant's arguments

thereagainst.

OPINION

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

The § 102(b) rejection based on Nolen

We will not sustain the 35 U.S.C. § 102(b) rejection of claims 6 through 8 and 11 based on Nolen.

Each of independent claims 6 and 11 requires a means for directing a flow of ambient air outwardly through an electrocution means or grid so as to attract insects to the electrocution means or grid for electrocution.

In the answer (p. 3), the examiner determined that "NOLEN shows means 34 for directing a flow of air (and carbon dioxide) outwardly through the electrocution grid so as to attract insects to the grid." The examiner's position is further explained in the final rejection wherein the examiner

stated:

> Nolen shows dispensing a spray of carbon dioxide gas from a spray head which sprays the gas perpendicular or radial to the electrocution grid 20 as shown in Fig. 3. Inherently, some ambient air with [sic, will] be drawn through the electrocution grid due to the pressure of the carbon dioxide gas. The molecules of carbon dioxide will strike ambient air and these

> collisions will cause nitrogen and oxygen molecules to be given energy which results in some the [sic, some of the] air being directed through the electrocution grid due to the energy transferred to the oxygen and nitrogen molecules.

See final rejection, pp. 3 and 4.

The appellant describes Nolen as disclosing:

> . . . a device which uses a pressurized canister 12 (see Fig. 3) that discharges a spray of carbon dioxide and octenol gas through activation of a spray head 34 by a cam 40 rotated by a motor 36. Fluorescent light bulbs 16 and 18 are also provided to attract insects visually by UV or IR light wavelengths (col. 4, ll. 9-12). (Emphasis original.)

See brief, p. 4. The appellant argues that "Nolen does not disclose means for directing a flow of ambient air through an electrocution grid so as to attract insects to the electrocution grid. Instead, the motor 36 and cam 40 cause an intermittent spray of carbon dioxide and/or octenol propellant to be emitted from canister 12" (emphasis original). Id. It is the appellant's position that the pressurized carbon dioxide/octenol mixture disclosed by Nolen is not ambient air. Id. at 5.

In addition, the appellant argues that:

> [t]he focus of the Office action down to the microscopic molecular level to reject the claims

illustrates that the Office action's interpretation of the claim language is beyond the broadest reasonable interpretation standard to be used during examination,

> since it is contrary to and not consistent with the specification, and is not within the realm of any real world interpretation of the claim language or the Nolen prior art reference by persons ordinarily skilled in the art.

Id. at 6.

We agree with the appellant's argument that Nolen fails to disclose a means for directing a flow of ambient air outwardly through an electrocution means or grid so as to attract insects to the electrocution means or grid for electrocution. Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, expressly, or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Note also W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); and Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781,

789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Where there is a reasonable basis to conclude the claimed subject matter may in fact be an inherent characteristic of the prior art the PTO possesses the authority to require the applicant to prove that the subject matter of the prior art does not possess the characteristics relied on. See In re Spada,
911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 597 (CCPA 1980); In re Best, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1977); In re Glass, 474 F.2d 1015, 1019, 176 USPQ 529, 532 (CCPA 1973); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971), and In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971). However, the examiner has the initial burden of establishing 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,
1463-64 (Bd. Pat. App. & Int. 1990). Here, we do not find the

examiner has discharged that initial burden.

Specifically, the examiner has adduced no factual basis or technical reasoning to support a determination that the intermittent discharge of carbon dioxide and/or octenol from the canister 12 of Nolen will necessarily produce a flow of ambient air directed outwardly through the electrocution grid by means of the transfer of energy from the pressurized contents of the canister. This determination by the examiner is, at best, speculative. Accordingly, we are constrained to reverse the examiner's decision to reject claims 6 and 11 under 35 U.S.C.
§ 102(b) as being anticipated by Nolen.

Claims 7 and 8 are dependent on claim 6 and contain all of the limitations of that claim. Therefore, we will also reverse the examiner's decision to reject claims 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by Nolen.

The § 102(b) rejection based on Gagliano

We will also not sustain the 35 U.S.C. § 102(b) rejection of claims 6 through 12 based on Gagliano.

Independent claims 6 and 11 call for an insect killing

system comprising an electrocution means or grid for electrocuting insects with said electrocution means or grid "extending along an axis thereof." We understand that "thereof" refers to the "insect killing system."

Claim 6 also requires a source of heat for heating ambient air and a "means for directing a flow of said heated ambient air outward radially through said electrocution means . . . so as to attract insects."

Claim 11 requires a "means for directing a flow of ambient air outwardly through said electrocution grid in a radial direction relative to said axis."

We agree with the appellant's argument (brief, p. 8) that Gagliano does not disclose means for directing a flow of ambient air, heated or unheated, through an electrocution means or grid to attract insects to the electrocution means or grid.

Gagliano discloses an insect attracting and killing device including a fluorescent lamp 34 for attracting insects to the device, a fan having a motor 28 for drawing the insects into the device, a conventional light bulb 43 having a

depression 44 in the upper end thereof for receipt of a fumigating liquid which is vaporized by the heat of the bulb 43 and distributed by the fan blast, electrical wires 22 and 23 for killing and cremating insects and a screen 18 filling opening 17a in wall 17. See col. 2, l. 70 to col. 3, l. 4 and col. 3, l. 28 to col. 4, l. 6. Gagliano teaches that the electrical wires 22 and 23 are preferred, but optional, because "insects will be trapped and killed solely by the whirling fan blades and their impact on screen 18." See col. 3, ll. 56-58. According to Gagliano, "an

extremely high air velocity is maintained" by the fan, thus "creating a powerful draft to suck the insects into the housing." Id. at 71-74.

The examiner determined (answer, p. 4) that insects would be attracted to the electrocution means or grid of Gagliano by the light bulb 34 and the "heated" air[3] passing through screen 18. However, once again, the examiner has adduced no factual basis or technical reasoning to support a determination that the "extremely high air velocity" maintained by the fan in Gagliano will necessarily attract insects. Since the examiner has not shown that the prior art structure performs the identical function, i.e., directing a flow of ambient air outwardly through an electrocution grid in a radial direction relative to the axis of the killing system so as to attract insects to the electrocution grid, specified in the means plus function limitation of claims 6 and 11, we are constrained to reverse the examiner's decision to reject claims 6 and 11 under 35 U.S.C.

[3] We note that the examiner has failed to identify where in Gagliano it is taught that the air passing through screen 18 is heated.

§ 102(b) as being anticipated by Gagliano.

Claims 7 through 10 and 12 are dependent on either independent claim 6 or independent claim 11, and contain all of the limitations of their respective independent claims. Therefore, we will also reverse the examiner's decision to reject claims 7 through 10 and 12 under 35 U.S.C. § 102(b) as being anticipated by Gagliano.

NEW GROUND OF REJECTION

In accordance with our authority under 37 CFR § 1.196(b), this panel of the board introduces the following new ground of rejection.

Claims 11 and 12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The sixth paragraph of 35 U.S.C. § 112 states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 11 recites, inter alia, “means for directing a flow of ambient air outwardly through said electrocution grid in a radial direction relative to said axis so as to attract

insects to said electrocution grid." The "means for directing . . . " is, as we see it, an element in a claim for a combination expressed as a means for performing a specified function without the recital of structure or materials in support thereof. Therefore, in accordance with the sixth paragraph of 35 U.S.C. § 112, this element shall be construed to cover the corresponding structure described in the appellant's specification and equivalents thereof.

Looking to the appellant's specification, the only structure described in the specification which performs the function of directing a flow of ambient air outwardly through the electrocution grid 40 is the fan 20. For example, the specification (p. 5) states that:

> [t]he floor 14 is adapted with a plurality of apertures 18, and further has a fan 20 therebetween for urging gaseous flow communication through the plurality of apertures 18.
>
> * * * * *
>
> [t]he inner shell 38 also has a heating zone 46 in an upper portion 48 thereof and a second plurality of apertures 50 on a periphery 52 of the shell 38

> for urging gas flow communication from the heating zone 46 through the second plurality of apertures 50 to the outer network of wires 41.

Thus, it is the fan 20 which directs a flow of ambient air outwardly through the electrocution grid 40. However, the specification does not describe the flow of ambient air per se as attracting insects. Rather, the specification (p. 5) teaches quite clearly that it is the "heated" ambient air that attracts insects, and in particular mosquitoes. The fan 20 is not described in the specification as performing the function of heating ambient air. In short, while the appellant's specification discloses structure for directing a flow of ambient air outwardly through an electrocution grid in a radial direction relative to an axis of the insect killing system, it does not disclose any structure which performs that function and which also causes the flow of ambient air to attract insects to the electrocution grid.

As our reviewing court stated in In re Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) (quoting In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)),

> [a]lthough paragraph six statutorily provides that one may use means-plus-function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect
> failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

In failing to disclose any structure for directing a flow of ambient air outwardly through the electrocution grid in a radial direction relative to an axis of the insect killing system so as to attract insects to the electrocution grid, the appellant has made it impossible for one of ordinary skill in the art to ascertain the metes and bounds of that claim limitation (the corresponding structure described in the specification and its equivalents) and, thus, has in effect failed to particularly point out and distinctly claim the invention. It is not clear, for example, whether the claim limitation may be met by the fan or whether some type of device for heating the ambient air is required.

Claim 12 is rejected for the same reasons as claim 11,

since claim 12 is dependent on claim 11 and contains the same indefinite language.

CONCLUSION

In summary, the examiner's rejections of claims 6 through 12 under 35 U.S.C. § 102 are reversed, and a new rejection of

claims 11 and 12 pursuant to our authority under 37 CFR § 1.196(b) has been entered.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner . . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . . .

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

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)	

JFG:hh

Vincent M. DeLuca
Rothell, Figg, Ernst, and Kurz
555 Thirteenth Street, N.W.
Suite 701 East Tower
Washington, D.C. 20004