

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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH C. BECK

Appeal No. 2001-0129
Application No. 09/035,655

ON BRIEF

Before ABRAMS, NASE, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9 which all the claims pending in the application.

The appellant's invention relates to a package for animal bedding which comprises a rigid planar fibrous pad disposed within a plastic pouch. An understanding of the invention can be derived from a reading of exemplary claim 1 which appears in the appendix to the appellant's brief.

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The prior art

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

| | | |
|--------------------------------|-----------|----------|
| Masuda et al. (Masuda) 1989 | 4,813,210 | Mar. 21, |
| Siciliano 1990 | 4,961,735 | Oct. 9, |

The rejections

Claims 1 through 9 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

Claims 1 through 3, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Masuda.

Claims 4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Masuda in view of Siciliano.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper

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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.

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OPINION

In reaching our decision in this appeal, we have give 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.

We turn first to the examiner's rejection of claims 1 through 9 under 35 U.S.C. § 112, first paragraph. We initially note that an analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contains sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

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In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an 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 being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court, "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

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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." In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports

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enablement¹ against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.

In the instant case, the examiner, noting that the appellant's specification states that the pads being formed are cotton based cellulosic fibers, states:

Cotton is well known to be a soft pliable fibrous material. The examiner believes that in order to make cotton rigid, some process must be applied to the material. The specification does not disclose any process for making cotton rigid or the amount of rigidity inherent in the pad.

¹ The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art knew at the time of filing the application.

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In summary, the examiner is unclear from [sic, from] the disclosure how the cotton pad is capable of being rigid, and as such the examiner believes that one having ordinary skill in the art is not enabled to make or use the invention. [examiner's answer at pages 4 and 5].

In our view, the examiner has not met his burden. Specifically, the examiner has not established that one skilled in the art could not make and use the claimed invention from the disclosure coupled with the information known in the art without undue experimentation. The examiner has not addressed what a person skilled in the art would have known about how to make the cotton based cellulose of the appellant's invention rigid. In our view, it would have been well within the skill of the ordinary skilled person in the art to ascertain through routine experimentation a process which would render the cotton-based cellulose fibers disclosed in the appellant's specification rigid. In this regard, we note that rigid cellulose material such as cardboard and the process of making same is notoriously well known. In view of the foregoing, we will not sustain the examiner's rejection of claims 1 through 9 under 35 U.S.C. § 112, paragraph one.

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We turn next to the examiner's rejection of claims 1 through 3, 5, 6, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by Masuda. In support of this rejection, it is the examiner's opinion that Masuda discloses a package containing a planar fibrous pad (medical device 1) disposed in a plastic pouch (sterile bag 2) which is hermetically sealed. The examiner is of the view that the sterile bag 2 containing the medical device 1 is capable of functioning as animal bedding. In regard to the recitation of a "rigid" planar fibrous pad, the examiner states:

The examiner points the applicant to col. 2, lines 2-9, wherein Masuda claims a medical device for use with the package being a "cellulose acetate hollow fiber *membrane* . . . preferable a *laminated polyester-aluminum-polyethylene sheet*". The examiner believes that a "cellulose acetate hollow fiber membrane . . . preferable a *laminated polyester-aluminum-polyethylene sheet*" does indeed anticipate a rigid planar fibrous pad as recited by the applicant in **claims 1 and 5**. [answer at page 9]

We agree with the appellant that Masuda does not disclose a rigid planar fibrous pad. The laminated polyester aluminum-polyethylene sheet referred to by the examiner is the oxygen-impermeable wrapper 4 not the medical device 1 which the examiner finds to be a planar fibrous pad (See Col. 1, line 51

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to Col.2, line 9). Masuda discloses that the medical device or planar fibrous pad is preferably a hollow blood processing device employing cellulose acetate hollow fibers (Col. 4, lines 40 to 62). Masuda does not disclose that the medical device or fibrous pad is rigid. Therefore, we will not sustain the examiner's rejection of claim 1 and claims 2 and 3 dependent thereon. Likewise, we will not sustain this rejection as it is directed to claim 5 and claims 6, 8 and 9 dependent thereon because claim 5 recites "providing at least one rigid, planar fibrous pad."

We turn next to the examiner's rejection of claims 4 and 7 under 35 U.S.C. § 103 as being unpatentable over Masuda in view of Siciliano. The examiner relies on Siciliano for teaching a pad formed from an absorbent material being fabricated from cotton. The examiner concludes:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the planar fibrous pad as taught by Masuda of cotton as taught by Siciliano since cotton material is an effective material for absorbance of body fluids . . . [examiner's answer at page 7].

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We will not sustain this rejection as it is directed to claims 4 and 7 which are dependent on claims 1 and 5 respectively because Siciliano like Masuda does not disclose a rigid pad. Rather, Siciliano discloses a bandage comprised of cotton terry cloth.

The decision of the examiner is reversed.

REVERSED

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|-----------------------------|---|-----------------|
| NEAL E. ABRAMS |) | |
| Administrative Patent Judge |) | |
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| |) | |
| |) | BOARD OF PATENT |
| JEFFREY V. NASE |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
| |) | |
| |) | |
| |) | |
| MURRIEL E. CRAWFORD |) | |
| Administrative Patent Judge |) | |

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Application No. 09/035,655

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Copies:

_____ APJ CRAWFORD

_____ APJ NASE

_____ APJ ABRAMS

DECISION: REVERSED

Panel Change: Yes No

Prepared: May 24, 2002

3 MEM. CONF. Y N

OB/HD

GAU: 3600

PALM: ____

ACTS 2 ____

BOOK ____

DISK (FOIA) ____

MONTHLY REPORT ____