

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHERWIN MENDELL

Appeal No. 96-0926
Application 07/995,683¹

ON BRIEF

Before DOWNEY, METZ and ELLIS, ***Administrative Patent Judges.***

METZ, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 3 through 5. In his Answer (Paper Number 11), the examiner has withdrawn the rejection of claims 1 through 5 under 35 U.S.C. § 101. Thus, claims 1 and 2 remain in the application but are no longer rejected by the

¹ Application for patent filed December 23, 1992.

Appeal No. 96-0926
Application No. 07/995,683

examiner, either on formal grounds or substantive grounds.

THE INVENTION

The claimed invention is directed to a method for reversing

physiological and psychological human dependency induced by certain chemicals which method comprises the conjoint use of acupuncture therapy and hypnosis. Appellant alleges to have discovered that the conjoint, simultaneous use of hypnosis and acupuncture intensifies the effectiveness of the acupuncture, yielding results greater than the sum of the effect of either treatment alone. Appellant also claims an apparatus for carrying out his conjoint therapy.

The appealed claims are reproduced below for a more facile understanding of the claimed invention.

Claim 2. An apparatus for reversing psychological human dependency induced by chemicals such as nicotine, alcohol, or drugs comprising:

means for applying acupuncture to a patient in accordance with predetermined body areas for reducing psychological human dependency; and

means used with said acupuncture means for inducing hypnosis through audio stimuli to said patient while said patient is being treated with acupuncture to reverse human physiological dependency based on cigarette smoking, alcohol, or

drug addiction.

Claim 3. An apparatus
as in Claim 2, including:

audio means for
storing and broadcasting specific instructions for
self-hypnosis for use in conjunction with
acupressure for reducing human physiological
dependency.

Claim 4. A system for the self-administration
of hypnosis and acupressure on one's person for
eliminating chemical dependency comprising:

a tape means for storing audio and video
instructions and sounds to induce self-administered
hypnosis to a subject;

a pressure inducement bar oblong
in shape with at least one blunt end for allowing
the subject to apply self-administered pressure to
their body at selective areas; and

an acupressure
chart for indicating to the subject selective areas
of the human body where acupressure should be
applied.

Claim 5. A method to reduce compulsive disorders
such as overeating, comprising the steps of:

self-inducing hypnosis on ones person by
listening to taped instructions and sounds;

observing a pictorial chart to
determine specific body locations in which to apply
self-administered acupressure;

applying self-administered
acupressure to said specific body points;

suggesting to the
subject through the use of said taped instructions,
while in a hypnotic state, to reduce and cease said

Appeal No. 96-0926
Application No. 07/995,683

compulsive disorder;

terminating the self-induced hypnosis; and

terminating the self-administered acupressure.

THE REJECTIONS

The examiner has not relied on any prior art to reject the appealed claims. Rather claims 3 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention. Claims 4 and 5 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure. We reverse.

OPINION

The examiner has not set forth in his Answer a statement of any of the rejections before us. Rather, the examiner has referred us to the Final Rejection wherein we are informed

[t]he rejections are the same as those set forth in the Final Office Action, paper #6, except that the rejection under 35 USC 101 has been withdrawn.

In Paper Number 6, the examiner explains that because appellant discloses the use of a "kit" as a means to apply acupressure and a means to induce hypnosis, the apparatus of claims 3 and 4 must be claimed as a "kit".

We are unable to determine if the examiner's position is

Appeal No. 96-0926
Application No. 07/995,683

founded on the requirement in the second paragraph of 35
U.S.C.

§ 112 that an applicant for patent present claims for that
which applicant regards as his or her invention or if the
rejection is founded on the requirement for particularity in a
claim. Under either theory, the examiner's rejection cannot
be sustained as it lacks any sound factual or legal basis.

Absent evidence to the contrary, the claims presented by
an applicant must be presumed to be for that which applicant
regards as his invention. In re Moore, 439 F.2d 1232, 1235,
169 USPQ 236, 238 (CCPA 1971). Moreover, it is incumbent upon
the examiner to establish that one of ordinary skill in the
art would not have been able to ascertain the scope of
protection defined by the claim when read in light of the
supporting specification. Moore, *ibid*. This the examiner has
not done. In the first instance, the examiner has not
explained why a "kit" cannot be considered to be an
"apparatus" or "system". Secondly, appellant describes his
invention both as a "kit" and as an apparatus. See page 4,
lines 16 through 27 of the specification. Therefore, we
reverse the examiner's rejection under 35 U.S.C. § 112,
paragraph two.

Appeal No. 96-0926
Application No. 07/995,683

In meeting the enablement requirement of 35 U.S.C. § 112, an application need not teach, and preferably omits, that which is well-known in the art. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). How such a teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 USC § 112 unless there is reason to doubt the objective truth of the statements relied upon therein for enabling support. In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

We hold the examiner has failed to discharge his initial burden of making out a *prima facie* case of lack of enablement. Glaring by its absence in the record is any evidence supporting the examiner's theories for why appellants' claims are not enabled by their disclosure. We find ample disclosure in appellant's specification and in the art cited in the record which establishes that acupuncture and hypnosis are individually well-known therapies for treating debilitating physiological and psychological disorders. The only basis for

Appeal No. 96-0926
Application No. 07/995,683

the examiner's position is his conjecture that a person under hypnosis would not be conscious enough to perform the other steps in appellant's treatment. While not entirely without logic, the problem with the examiner's position is that there is no evidence which supports the examiner's mere hypothesis. The examiner has failed to make out a *prima facie* case of lack of enablement as was his burden. Accordingly, we reverse the rejection under the first paragraph of 35 U.S.C. § 112.

OTHER ISSUES

As we have noted above, appellant acknowledges in his specification that acupressure and hypnosis are, respectively, known therapies for treating various psychological and physiological disorders (see page 2, lines 10 through 14 of the specification). The prior art cited in the record substantiates appellant's recognition.

We recommend that the examiner and appellant, upon return of this application to the examining group, reconsider the patentability of the claimed subject matter of claims 1 through 5 under 35 U.S.C. § 103 under the theory that the conjoint use of two individually well-known therapies for their combined attendant functions would have been obvious. Compare In re

Appeal No. 96-0926
Application No. 07/995,683

Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). In considering this rejection, due recognition to the evidence of record in the nature of the declarations under 37 C.F.R. § 1.132 must be given. Appellant's observation that he discovered or observed an effect greater than would have been expected must also be considered in the context the observation is set forth (page 2, lines 14 through 21 of the specification).

We also observe that in three of the declarations under 37 C.F.R. § 1.132, the declarants (Gutentag, Tate and Otto) state that they have been patients of Dr. Mendell for more than one year prior to the filing date of the instant application. The examiner should make inquiry to determine if any of the treatments declarants received was given prior to one year before the critical date of December 23, 1992. If therapy within the claimed subject matter here on appeal was given more than one year prior to December 23, 1992, a statutory bar under 35 U.S.C. § 102(b) may have occurred.

We also observe that in each of claims 1, 2, 3 and 5, appellant has used the terminology "such as" to describe the various chemicals which cause the disorders or to describe the disorders themselves. Such language renders the claims

Appeal No. 96-0926
Application No. 07/995,683

indefinite because it cannot be determined if the language is merely exemplary or limiting. Ex parte Wu, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Int. 1989). Nevertheless, appellant may overcome this problem by simply deleting the objectionable

language or by using so-called Markush terminology to recite that the chemical which causes the disorder is one "selected from the group consisting of A, B, C and D." Finally, we observe that "alcohol", presumably ethanol, and "nicotine" are drugs. Accordingly, the terminology "chemicals such as nicotine, alcohol or drugs" is confusing.

SUMMARY

The rejection of claims 3 and 4 under 35 U.S.C. § 112, second paragraph, is **reversed**. The rejection of claims 4 and 5 under 35 U.S.C. § 112, first paragraph, is **reversed**. The decision of the examiner is **reversed**.

REVERSED

MARY F. DOWNEY)
Administrative Patent Judge)

