

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HOWARD F. STEWART, DANIEL GRAIVER  
and ROBERT E. KALINOWSKI

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Appeal No. 96-2833  
Application 08/202,772<sup>1</sup>

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ON BRIEF

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Before WINTERS, KIMLIN, and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's final rejection of claims 1-12. Claims 13-29, which are the only other claims in the application, stand withdrawn from consideration by the

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<sup>1</sup> Application for patent filed February 28, 1994.

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examiner as being directed toward a nonelected invention.

*THE INVENTION*

Appellants claim a soap which includes a recited cleaning aid encapsulated by a poly(vinyl alcohol) hydrogel. Claim 1 is illustrative and reads as follows:

1. A soap comprising

(A) a poly(vinylalcohol) hydrogel and,

(B) a cleaning aid selected from a group consisting essentially of

(i) a non-ionic surface active agent;

(ii) a weakly ionic surface active agent;

(iii) a non-ionic detergent;

(iv) a weakly ionic detergent, and

(v) mixtures of (i) to (iv),

wherein the cleaning aid is encapsulated by the polyvinylalcohol hydrogel to form the soap.

*THE REFERENCES*

Fox et al. (Fox)	4,802,997	Feb. 7,
1989		
Graiver et al. (Graiver)	4,851,168	Jul. 25,

1989

*THE REJECTIONS*

Claims 1-12 stand rejected as follows: 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 their invention; under 35 U.S.C. § 112, first paragraph, "as failing to provide the full, clear, concise and exact terms of the description of the invention"; and under 35 U.S.C. § 103 as being obvious over the combined teachings of Graiver and Fox.<sup>2</sup>

*OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we do not sustain these rejections.

*Rejection under 35 U.S.C. § 112, second paragraph*

The relevant inquiry under 35 U.S.C. § 112, second

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<sup>2</sup>The examiner's reliance upon U.S. 4,155,870 to Jorgensen, U.S. 4,663,358 to Hyon et al., U.S. 4,976,953 to Orr et al., and U.S. 5,234,618 to Kamegai et al., is withdrawn in the examiner's answer (page 8).

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paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner argues that "soap" in appellants' claims is confusing because the claims do not recite that the soap contains a soap chemical ingredient (answer, page 7). By "soap chemical ingredient", the examiner apparently means a fat or an oil.

Appellants state in their specification (page 4, lines 10-14) that "the term 'soap' for purposes of this invention is a material which is a cleansing and emulsifying material or article which does not contain fats and oils as a major component. Preferred are 'soaps' which do not contain any fats and oils."

The examiner apparently considers appellants' definition of "soap" to be improper because it is inconsistent with the ordinary meaning of that term in the art. This position is

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legally unsound. As stated in *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996): "Although the words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history." See also, *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990) ("It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer [citation omitted], and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings. For this reason, an analysis of the specification and prosecution history is important to proper claim construction.").

The examiner has not carried his burden of explaining why the alleged inconsistency between appellants' definition of "soap" in their specification and the ordinary definition of that term would have caused appellants' claims, when

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interpreted by one of ordinary skill in the art in light of appellants' specification, the prior art and the prosecution history, to fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Moreover, in appellants' only independent claim, the "comprising" transition term opens the claim to elements other than those recited. See *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). The examiner has not explained why, with this transition term, the claims are not open to including whatever conventional ingredients the examiner considers to be required in a soap.

The examiner argues that "encapsulated" is indefinite because, in the examiner's view, appellants' cleaning aid is not encapsulated by the poly(vinyl alcohol) (answer, page 7). As indicated above, the relevant question under 35 U.S.C. § 112, second paragraph, is whether the language of appellants' claims, including the word "encapsulated", satisfies the above-stated test for definiteness. The examiner has not explained why appellants' claim language fails to do so.

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The examiner argues that a compound can be classified as both a detergent and a surface active agent and that, consequently, appellants' recitation of both surface active agents and detergents in their Markush group of cleaning aids renders appellants' claims indefinite (answer, page 6).

An examiner is not to consider a claim to be indefinite merely because a compound may be included in more than one member of a Markush group. *See Manual of Patenting Examining Procedure* § 2173.05(o) (7th ed., July 1998). The examiner has the burden of explaining why, because of the recited Markush group, appellants' claims fail to satisfy the above-recited test for definiteness, and the examiner has not carried this burden.

For the above reasons, we reverse the rejection of appellants' claims 1-12 under 35 U.S.C. § 112, second paragraph.

*Rejection under 35 U.S.C. § 112, first paragraph*

It is not clear whether the examiner has rejected the claims as failing to comply with the written description requirement or the enablement requirement of 35 U.S.C. § 112,

first paragraph. These are separate requirements. See *Moore*, 439 F.2d at 1235, 169 USPQ at 238-9. We have considered the examiner's arguments as they might apply to both of these requirements.

The examiner argues that an encapsulated non-soap ingredient is not a soap (answer, pages 3-4). The examiner apparently is arguing that appellants' specification either does not describe a soap or would not have enabled one of ordinary skill in the art to form a soap. In any event, the examiner's reasoning is deficient because he has not taken into account appellants' definition of "soap" discussed above.

The examiner argues that the same compound can be a detergent or surfactant (answer, page 4), but it is not clear why the examiner concludes from this argument that appellants' claims fail to meet the requirements of 35 U.S.C. § 112, first paragraph.

The examiner argues that appellants' poly(vinyl alcohol) hydrogel is an open-pore material (answer, page 5). The examiner apparently is arguing that appellants' specification would not have enabled one of ordinary skill in the art to

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encapsulate the recited cleaning aids with a poly(vinyl alcohol) hydrogel.

Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the 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 in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . 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 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 support of his argument, the examiner relies (answer, page 5) upon column 3, lines 44-46 of Fox. This reference discloses that "[g]enerally, synthetic hydrogels are formed by polymerizing a hydrophilic monomer in an aqueous solution

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under conditions where the polymer becomes crosslinked so as to form a three dimensional polymer network" (col. 3, lines 42-46). The examiner, however, has not explained why this disclosure indicates that if Fox's treatment material were prepared according to the process used by appellants, the polymer would not encapsulate the cleaning aid. According to appellants' process described in their specification (page 5, line 17 - page 6, line 2), poly(vinyl alcohol) is dissolved in a water/organic mixed solvent and, prior to crystallizing the poly(vinyl alcohol), one or more surfactants and/or detergents are added to the solution. Appellants state that they believe that the surfactants and/or detergents are encapsulated by a poly(vinyl alcohol) hydrogel (specification, page 5, lines 23-24). The examiner argues (answer, page 9) that the gentle mixing in appellants' examples 1 and 2 would not cause encapsulation of the cleaning aid, but the examiner provides no evidence or technical reasoning in support of this argument.

For the above reasons, we do not sustain the rejection under 35 U.S.C. § 112, first paragraph.

*Rejection under 35 U.S.C. § 103*

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Graiver discloses that a soap or other type of detergent can be dispersed in a poly(vinyl alcohol) hydrogel (col. 5, lines 18-26).

Fox discloses swelling a hydrogel with a treatment fluid which can include a surfactant, applying the swollen hydrogel to a textile surface, and applying force to cause the treatment fluid to exude from the hydrogel to the textile material (col. 2, lines 1-13 and 40-47; col. 6, lines 10-14).

The examiner argues that in Fox, a cleaning aid and a liquid are mixed before a hydrogel is formed (answer, page 9). If the examiner were correct, then the burden would shift to appellants to provide evidence that Fox's treatment composition does not necessarily or inherently possess the relied-upon encapsulation characteristic of appellants' claimed soap. *See In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See Best*, 562 F.2d at 1255, 195 USPQ at

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434; *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The examiner's interpretation of the relied-upon disclosure of Fox, however, is incorrect. Fox adds his treatment fluid to the hydrogel after the hydrogel has been formed, thereby swelling the hydrogel (col. 2, lines 4-6). In Fox's example 10, which is relied upon by the examiner (answer, page 9), ALCOSORB AB1, with which the other components are mixed, is a pre-formed hydrogel (col. 4, lines 4-6 and table 1).

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient to support a conclusion of obviousness of the invention recited in any of appellants' claims 1-12. Accordingly, we reverse the rejection under 35 U.S.C. § 103.

*DECISION*

The rejections of appellants' claims 1-12 under 35 U.S.C. § 112, first and second paragraphs, and under § 103 over the combined teachings of Graiver and Fox, are reversed.

REVERSED

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SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
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TERRY J. OWENS	)	)
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