

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEVEN EUGENE LENTSCH, DALE W. GROTH,  
THOMAS R. OAKES, and BURTON M. BAUM

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Appeal No. 1996-2943  
Application No. 08/229,648

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REHEARING

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Before GARRIS, PAK, and KRATZ, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to a request, filed July 6, 2000, for rehearing of our decision on appeal, mailed May 10, 2000, wherein we sustained the examiner's section 103 rejections over Bowing in view of Oakes and over Oakes alone.

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Concerning the rejection over Bowing in view of Oakes, the appellants reiterate their argument that it is inappropriate to consider a method to be inherently practiced by the prior art. This argument is not well taken. It is well settled that a method may be inherently practiced by the prior art and that reliance upon inherency is not improper even though a rejection is based on 35 U.S.C. § 103 instead of § 102. In re Skoner, 517 F.2d 947, 950, 186 USPQ 80, 82-83 (CCPA 1975).

Additionally, the appellants argue that the rejection over Bowing in view of Oakes is improper because "[n]either reference disclose [sic] destaining or bleaching" (request, page 9).<sup>1</sup> We remain convinced, however, that the applied references would have suggested a method of cleaning ware

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<sup>1</sup>By way of clarification, the argued claims on appeal do not recite a "bleaching" function. Furthermore, the "destaining" recitation of these claims does not necessarily require a "bleaching" function. This is because the definition of "destaining" includes the removal of soil or foreign matter which is expressly taught by the applied references. Finally, notwithstanding the appellants' opposing viewpoint, we continue to consider it reasonable to conclude that an ordinarily skilled artisan would have recognized the hydrogen peroxide of the applied reference compositions as a bleach and thus would have expected these compositions to perform a bleaching function. This last mentioned issue should be explored in any further prosecution that may occur.

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products which includes the step of applying to the ware products a composition of the type under consideration.<sup>2</sup> Since the method suggested by these references would include the same step of applying the same composition as recited in the argued claims on appeal, this suggested method would necessarily produce the same results as the here claimed method including the destaining function at issue.

With respect to the section 103 rejection over Oakes alone, the appellants argue that we erred in concluding it would have been obvious for one with ordinary skill in the art to eliminate the C<sub>6</sub>-C<sub>18</sub> peroxy-carboxylic acid from patentee's composition along with its attendant biocidal function.<sup>3</sup> Specifically, the appellants argue that, contrary to the opinion expressed in our decision, this elimination would not

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<sup>2</sup>It is appropriate to emphasize that this conclusion of obviousness has not been contested with any reasonable specificity by the appellants in their request for rehearing.

<sup>3</sup>In the subject request, the appellants do not contest with any reasonable specificity our alternative position expressed on page 7 of the decision that the rejection would be proper even if the C<sub>6</sub>-C<sub>18</sub> peroxy-carboxylic acid component were not eliminated from the composition of Oakes because the "consisting essentially of" language of the appealed independent claims does not exclude such a component.

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have been motivated by the desire to obtain a lower-cost composition while still retaining a degree of, albeit reduced, biocidal activity. According to the appellants, this is because the reduced, biocidal activity resulting from this elimination would require a greater quantity of composition in order to provide equivalent biocidal activity thus negating the "lower-cost" of the modified composition.

The deficiency of the appellants' foregoing analysis is that it presumes that all of the methods envisioned by Oakes require "equivalent biocidal activity" (request, page 4). Plainly, this presumption is not well taken. The degree of biocidal activity required by a given method depends upon the degree of initial biological contamination in combination with the degree of sanitation necessary for the product being clean. It follows that a lesser degree of biocidal activity would be required by a method of cleaning items which have little if any biological contamination and/or which are to be used for purposes that do not demand complete sterilization of the items. We therefore maintain our conclusion that it would have been obvious to eliminate the above discussed component from Oakes' composition in order to reduce the cost thereof

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while maintaining a degree of biocidal activity adequate for a method in which such a degree of activity is adequate.

For the above stated reasons, the appellants' request for rehearing is denied with respect to making any changes in our decision sustaining the examiner's section 103 rejections.

DENIED

	Bradley R. Garris	)	
	Administrative Patent Judge	)	
		)	
		)	
	Chung K. Pak	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Peter F. Kratz	)	
	Administrative Patent Judge	)	

BRG:tdl

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