

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. BENZINGER

Appeal No. 98-2810
Application 08/471,457¹

ON BRIEF

Before ABRAMS, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 4, 5, 7 through 11, 13 through 15, 18 through 20 and 27, which are all the claims remaining in the application. Claims 1, 3,

¹ Application for patent filed June 6, 1995. According to appellant, this application is a continuation-in-part of Application 08/417,890, filed April 6, 1995, now abandoned.

6, 12, 16, 17 and 21 through 26 have been canceled.²

Appellant's invention relates to a shaving kit wherein a razor is allowed to soak in a soaking container in a solution of witch hazel after each use, typically overnight, and is then used while wet with the solution for a subsequent shave. On page 5 of the specification, it is noted that the resulting shave is rapid and comfortable, and that if there happen to be cuts or nicks the witch hazel alleviates pain as well as constricting the cuts/nicks to rapidly interrupt bleeding. In addition, on page 6 of the specification, it is noted that using appellant's shaving system/kit substantially extends the useful life time of the cutting edges of the blade. Independent claims 19 and 27 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellant's brief, is attached to this decision.

There are no prior art references relied upon by the examiner in rejecting the appealed claims.

Claim 19 stands rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that fails to provide an enabling disclosure. In regard to the embodiment of the invention seen in Figure 4 and described on pages 3 and 7 of the specification, the examiner urges that

“Applicant fails to disclose how a kit for shaving could be useful for medical purposes,

² Decided concurrently herewith is the appeal in appellant's copending application Serial No. 08/471,458, filed June 6, 1995 (Appeal No. 98-2837).

Appeal No. 98-2810
Application 08/471,457

as set forth in claim 19.”

Claims 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention. More specifically, the examiner notes that in dependent claims 13 and 14, lines 1-2, the terminology “with hazel solution” should be ---witch hazel solution--- to clarify the language of the claims.

Claims 2, 4, 5, 7 through 11, 13 through 15, 18 through 20 and 27 stand rejected under 35 U.S.C. § 101 because in the examiner’s view “the claimed invention is not supported by a specific asserted utility” (answer, page 5).

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 19, mailed December 1, 1997) for the examiner's reasoning in support of the rejections, and to appellant’s brief (Paper No. 17, filed October 17, 1997) and reply brief/corrected reply brief (Paper No. 20, filed February 6, 1998) for appellant’s arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the declaration evidence and product analysis report supplied by appellant, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claim 19 under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure. It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). See also In re Scarborough, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974). Moreover, in rejecting a claim for lack of enablement, it is also well settled that the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement in order to substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Once this is done, the burden shifts to appellant to rebut

Appeal No. 98-2810
Application 08/471,457

this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), cert. denied, 416 U.S. 935 (1974); In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

In the case before us, after reviewing the examiner's position, the disclosure on page 3, lines 23-25, and on page 7, lines 3-9, of appellant's specification and the argument set forth in the brief (page 9), we are of the opinion that the examiner has clearly not met his burden of advancing acceptable reasoning inconsistent with enablement. Like appellant, we are of the view that the original disclosure regarding the shaving kit of claim 19 on appeal would have readily apprised one of ordinary skill in the art that such kit (Figure 4) is useful for medical purposes, i.e., that the kit is designed primarily for a single-use medical purpose such as shaving a portion of a patient's body to remove hair therefrom prior to surgery. In our view, the examiner has advanced no reason why what is clearly a simple shaving kit useful for medical purposes would require undue experimentation on the part of one of ordinary skill in the art in order to implement in the context of appellant's invention.

After a careful consideration of appellant's disclosure and of the arguments on both sides, it is our opinion that the level of skill in this art is sufficiently high that the ordinarily skilled

Appeal No. 98-2810
Application 08/471,457

artisan would have been able to make and use appellant's claimed invention as set forth in claim 19 on appeal, based on appellant's disclosure, without the exercise of undue experimentation.

For the above reasons, we will not sustain the examiner's rejection of claim 19 under 35 U.S.C. 112, first paragraph, as being directed to a non-enabling disclosure.

The next rejection for our review is that of claims 13 and 14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention. In this instance, we note that appellant has filed two amendments, one on March 5, 1997 (Paper No. 11) and one on February 6, 1998 (Paper No. 21), both of which amendments make the appropriate corrections to claims 13 and 14, and both of which amendments the examiner has indicated would be entered. Indeed, the amendment filed February 6, 1998 has been entered. However, notwithstanding the entry of this amendment, the examiner has not withdrawn the rejection of claims 13 and 14 under 35 U.S.C. § 112, second paragraph. Note particularly, Paper No. 22, mailed March 11, 1998. Although we are of the view that the minor spelling error in claims 13 and 14 is hardly of such character as to rise to a level of indefiniteness which would preclude one of ordinary skill in the art from readily

Appeal No. 98-2810
Application 08/471,457

understanding the scope and content of the claimed subject matter, we also note that, given the entry of the amendment filed February 6, 1998, this ground of rejection has clearly been obviated and will therefore not be sustained.

We next look to the examiner's rejection of claims 2, 4, 5, 7 through 11, 13 through 15, 18 through 20 and 27 under 35 U.S.C. § 101 on the basis that “the claimed invention is not supported by a specific asserted utility” (answer, pages 4-5). After reviewing the original disclosure, the examiner’s position, the substantial evidence submitted by appellant in this case, and appellant’s arguments in the brief and reply brief, we are of the opinion that this rejection is clearly not sustainable. Appellant has set forth in the specification (e.g., page 5) that the shaving kit or system therein provides a shave which is rapid, smooth and comfortable, and that if there happen to be cuts, the witch hazel on the razor will alleviate pain as well as constricting any such cuts to rapidly interrupt bleeding. This asserted utility has not been challenged by the examiner and in our opinion would have been considered credible by a person of ordinary skill in the art, especially when considered in light of the evidence supplied by appellant in this case. Thus, since appellant has put forth one credible assertion of specific utility for the claimed subject matter, he has satisfied the utility requirement of 35 U.S.C. § 101. As noted in the Manual of

Appeal No. 98-2810
Application 08/471,457

Patent Examining Procedure, § 2107.01, even if other assertions of utility made by appellant were found not “credible,” such statements would not render the claimed invention lacking in utility.

Moreover, in this particular case, we share appellant’s view (brief, pages 4-8, and reply brief, pages 1-2) that a preponderance of the totality of the evidence under consideration establishes the credibility of both of appellant’s asserted utilities, i.e., that the claimed shaving kit assists in prolonging the useful life of the blade of a razor and in providing a smooth comfortable shave with minimal nicks and cuts. Like appellant, in view of the polishing of the cutting edges of the samples viewed in the photographs mentioned in paragraph 3 on page 3 of the “COOL IT™ Product Analysis Report, we find the examiner’s emphasis and reliance on this portion of the report, to the exclusion of the remainder of the report (particularly the ANALYSIS and CONCLUSIONS sections set forth on pages 4 and 5 of the report), to be unwarranted. Nor do we find any comment in the record from the examiner regarding the evidence presented by appellant in the form of the eight items mentioned at the top of page 5 of appellant’s brief.

In light of the foregoing, we will not sustain the examiner’s rejection of claims 2, 4, 5, 7 through 11, 13 through 15, 18 through 20 and 27 under 35 U.S.C. § 101.

Appeal No. 98-2810
Application 08/471,457

To summarize our decision, we note that 1) the examiner's rejection of claim 19 under 35 U.S.C. § 112, first paragraph, has not been sustained; 2) the examiner's rejection of claims 13 and 14 under 35 U.S.C. § 112, second paragraph, has not been sustained; and 3) the examiner's rejection of claims 2, 4, 5, 7 through 11, 13 through 15, 18 through 20 and 27 under 35 U.S.C. § 101 has not been sustained. The decision of the examiner in this case is, accordingly, reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
)	APPEALS AND
CHARLES E. FRANKFORT)	INTERFERENCES
Administrative Patent Judge)	
)	
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 98-2810
Application 08/471,457

CEF/dal

Appeal No. 98-2810
Application 08/471,457

MILLEN, WHITE, ZELANO AND BRANIGAN
ARLINGTON COURTHOUSE PLAZA 1
STE. 1400
2200 CLARENDON BLVD.
ARLINGTON, VA 22201

APPENDIX

19. A kit for shaving, useful for medical purposes, comprising a container with a solution of witch hazel extract and alcohol therein and a disposable razor immersed in the solution, the container being initially sealed.

27. A shaving kit comprising:

a shaving razor having at least one blade;

a solution of witch hazel; and

a soaking container receiving the solution of witch hazel for storing the razor with the blade thereof in the witch hazel after each shave to prolong the life of the blade and for dipping the razor in the solution of witch hazel during shaving to provide a smooth comfortable shave with minimal nicks and cuts.