

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER W. FORD

Appeal No. 1999-0510
Application No. 08/728,787

HEARD: Nov. 13, 2000

Before CALVERT, COHEN, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 and 6 to 20, all the claims remaining in the application.

The claims on appeal are drawn to a sterilizing separator device (claims 1, 2, 4 and 6), a system for sterilizing (claims 7 to 16), and a method of sterilizing (claims 17 to 20). They are reproduced in Appendix A of appellant's brief.

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The references applied in the final rejection are:

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| Mock | 2,467,331 | Apr. |
| 12, 1949 | | |
| Santi | 4,150,629 | Apr. 24, |
| 1979 | | |

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 1, 2, 4 and 6, unpatentable over Santi, under 35 U.S.C. § 103(a);
- (2) Claims 7 to 20, unpatentable over Mock in view of Santi, under 35 U.S.C. § 103(a).

Rejections Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), we enter the following new grounds of rejection.

(A) Claims 1, 2, 4 and 6 to 16 are rejected as being unpatentable for failure to comply with 35 U.S.C. § 112, first paragraph.

Claim 1 reads (emphasis added):

1. A sterilizing separator device, comprising:

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a woven mesh material adapted to receive a sterilizing medium, said woven mesh material having a proximal end and a distal end; and
a body portion between the proximal and distal ends, the body portion having a desired thickness with a plurality of openings therein through which said sterilizing medium circulates, the body portion being flexible and having a continuous length such that the body portion is folded upon itself in a serpentine pattern so that the body portion is interposed between layers of articles to maintain separation between the layers of articles, and said flexible body conforming to the thickness of the various layers of articles as said body is folded upon itself, and the sterilizing medium circulates through the openings and sterilizes the articles.

This claim does not comply with the first paragraph of § 112 in that there is no written description in the application as filed of the body or body portion of the woven mesh material being "folded upon itself," as recited in lines 6 and 9.¹ Appellant argues in the reply brief, page 2, that this expression means that the body is "folded 'on' or contacting itself," and that this is neither disclosed nor suggested by Santi or Mock.

¹ References herein to line numbers of claims are to the lines of the claims as reproduced in Appendix A of appellant's brief.

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To comply with the written description requirement of § 112, first paragraph, the application as filed must convey with reasonable clarity to those of ordinary skill in the art, either explicitly or inherently, that the applicant invented the subject matter claimed. Reiffin v. Microsoft Corp., 214 F.3d 1324, 1346, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000). In the present case, the application as filed does not show in the drawings, or explicitly disclose in the specification and/or claims, that the body portion of the separator device 60 is folded upon, i.e., contacts, itself. Nor is such contact inherently disclosed. At the oral hearing, counsel for appellant asserted that the folded separator would contact itself (i) at its edges (80 and 82) where the edges extended beyond the containers 10, or (ii) between the articles, if the articles in a layer were spaced sufficiently far apart. However, while one might visualize that such contact could possibly occur, neither of these possibilities is suggested in the disclosure; the width of the separator is described only as extending completely across the top surface of the layer of articles (page 8, lines 25 and 26, and page 9, lines 10 and 11), and the articles in each layer (e.g., 10a and 10b) are

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shown in the drawings as touching each other, with no space between them. That one of ordinary skill might realize from reading appellant's disclosure that the separator might possibly contact itself at one or more points when interposed between layers of articles is not a sufficient indication that such contact is inherently a part of appellant's invention. Cf. In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975). See also In re DeJarlais, 233 F.2d 323, 329, 110 USPQ 36, 41 (CCPA 1956)("That the claimed invention is inherent cannot be established by probabilities or possibilities.") In order for a disclosure to be inherent, the missing descriptive matter must necessarily be present in the specification such that one skilled in the art would recognize such a disclosure. Tronzo v. Biomet, Inc., 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998). Here, one of ordinary skill reading appellant's original application would not recognize therein a disclosure of folding the separator device "upon itself," as claimed.

Since the folded (or folding) "upon itself" limitation is also found in independent claim 7, that claim, as well as

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dependent claims 2, 4, 6 and 8 to 16, is included in this rejection.

(B) Claims 1, 2, 4 and 6 to 16 are rejected as being unpatentable for failing to comply with the second paragraph of 35 U.S.C.

§ 112.

Claim 1 recites in lines 6 to 8 that "the body portion is folded upon itself . . . so that the body portion is interposed between layers of articles to maintain separation between the layers of articles." Likewise, claim 7 recites in lines 6 to 7 "said separator means . . . folding upon itself so that the separator means is placed between layers of the plurality of articles." Since the recitation of the separator means being folded "upon itself" means, as appellant states on page 2 of the reply brief, that it is folded to contact itself, these recitations are self-contradictory in that the separator cannot be folded into contact with itself so that at the same time it is interposed or placed between layers of articles. In view of this contradictory language, the rejected claims are indefinite in that one of ordinary skill would not reasonably be apprised of their scope. See In re

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Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

(c) Claims 17 to 20 are rejected as being unpatentable for failure to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112.²

In step (c) of claim 17 it is recited that the separator devices "maintains a predetermined distance between the second and third layers of the plurality of articles and said first and second layer of articles resting on the first length of the separator device" (lines 9 to 11), but no written description of any such arrangement is contained in the application as filed. Rather, as shown in Fig. 5b, although the separator 70 does maintain a distance between second layer 66 and third layer 98, it is the third and fourth layers 98, 100 which rest on the first length 94 of the separator device, not the first and second layers.

The Final Rejection

Rejection (1)

² In reviewing claim 17, we note that in line 4, --of-- should be inserted after "plurality"; in lines 9 to 15 (two occurrences), "separator" should be --separator device--; and in line 15, "where as" is not clear.

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Appellant's primary argument in opposition to this rejection is that Santi does not disclose an article which can "conform to the article thickness as it is folded upon itself" (brief, page 5; also reply brief, page 2). However, as indicated in rejection (B) under 37 CFR § 1.196(b), supra, the "folded upon itself" language of claim 1 is indefinite. In such a situation, the claims should not be rejected over prior art if, as in this case, the rejection would have to be based on considerable speculation as to the meaning of the claimed terms and assumptions as to what the claims cover. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

Accordingly, we will not sustain the § 102(b) rejection of claims 1, 2, 4 and 6. This is a pro forma action which should not necessarily be taken as an indication that these claims would be patentable if the § 112, second paragraph, rejection were overcome.

Rejection (2)

For the same reasons as stated with regard to rejection (1), supra, the rejection of claims 7 to 16 will not be sustained, pro forma.

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In considering the rejection of claims 17 to 20, we will read claim 17 as though "first and second" in line 10 read --third and fourth--.

The basis of the rejection is set forth on pages 5 and 6 of the examiner's answer, and need not be repeated here.

After fully considering the record in light of the arguments presented in the appellant's brief and reply brief, and in the examiner's answer, we conclude that the rejection is not well taken.

Claims 17 to 20 are drawn to a method, and even if Mock and Santi were combined as proposed by the examiner, the claimed method would not have been obvious to one of ordinary skill. Mock appears to disclose only first and second layers of articles 25 with a "separator device" (basket 7) between them, not loading multiple layers as claimed. Also, Mock as modified by Santi would not result in a separator device "sandwiched" between layers of articles, nor a separator device which is flexible and conforms to the thickness of the layers of articles "as it is folded across the articles."

Rejection (2) therefore will not be sustained as to claims 17 to 20.

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Conclusion

The examiner's decision to reject claims 1, 2, 4 and 6 to 20 is reversed, the reversal being pro forma as to claims 1, 2, 4 and 6 to 16. Claims 1, 2, 4 and 6 to 20 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

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(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| IRWIN CHARLES COHEN |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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REVERSED; 37 CFR 1.196(b)

Prepared: September 24, 2001