

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHAN D. CRANE

Appeal No. 95-3959
Application 08/051,492¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, WILLIAM F. SMITH,
Administrative Patent Judge, and McKELVEY, Senior Administrative Patent Judge.,

William F. Smith, Administrative Patent Judge.

¹ Application for patent filed April 22, 1993.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 5. Claims 6 through 8 are pending but have been withdrawn from consideration by the examiner.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A method for providing nutrition to a pet suffering from an injury which manifests a hypermetabolic state, the method comprising the steps of

(a) preparing an enteral suspension of nutrients in syringeable form the composition of which is adjusted to present to the hypermetabolic animal the nutrients in sufficient amounts to attenuate a hypermetabolic response associated with the injury,

(b) filling a syringe with the syringeable composition, the syringe having a tip through the opening of which the syringeable composition can be discharged,

(c) inserting the tip of the syringe directly into the oral cavity of the animal,

(d) discharging the composition into the oral cavity of the animal at a controlled rate and then,

(e) continuing to discharge the syringeable composition into the oral cavity of the animal until the animal has swallowed the desired quantity of the syringeable composition.

The reference relied upon by the examiner is:

Henningfield et al. (Henningfield)	5,221,668	Jun. 22, 1993 (filed Feb. 26, 1992)
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Claims 1 through 5 stand rejected under 35 U.S.C. § 112, first paragraph, as being nonenabled, and under 35 U.S.C. § 112, second paragraph, as being indefinite. In addition, claims 1 through 5 stand rejected under 35 U.S.C. § 103 as unpatentable over Henningfield. We reverse the rejections under 35 U.S.C. § 112, first and second paragraphs, and vacate the rejection under 35 U.S.C. § 103.

Rejection Under 35 U.S.C. § 112, First Paragraph

As seen from claim 1 on appeal, the claimed invention is directed to a method for providing nutrition to a pet which involves the step of administering an enteral suspension of nutrients by a syringe. The examiner has determined that the claims on appeal are nonenabled for two separate reasons. First, the examiner states at page 3² of the Examiner's Answer:

As written, the disclosure fails to properly describe the composition of the nutritional supplement. More details are provided concerning the emulsion characteristics of the composition than anything else.

In addition, the examiner has determined at the second page 3 of the Examiner's Answer that

the disclosure is enabling only for claims limited to a method of providing nutrition wherein the emulsion contains no less than about 10% protein,

² The Examiner's Answer contains two page 3s. This citation is to the first page 3.

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about 3 to about 5% carbohydrate, 5 to about 10% fat, and optionally, 100% or greater of the NRC requirements for minerals and vitamins, 0.1 to 3.0% amino acids, and 0.11 to 5.0% fatty acids. Water content of the emulsion should be in the range of about 65-85% by weight.

Here, appellant claims his invention as broadly as it is disclosed in the supporting specification. Under these circumstances the burden is upon the examiner in the first instance to provide reasons why one would doubt the objective truth of the enabling statement set forth in the specification. In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). The first statement is so open-ended as to be essentially meaningless. Such a statement does not meet the examiner's burden of providing reasons why the claimed invention cannot be practiced by one skilled in the art. Nor does the second statement explain why one skilled in the art would not be able to make and use the claimed invention. Rather, the second statement appears to reflect the examiner's belief that appellant must limit the claims to the exemplified compositions or the preferred embodiments disclosed in the supporting specification. This is improper. See In re Anderson, 471 F.2d 1237, 1240-41, 176 USPQ 331, 333 (CCPA 1973)(It is improper to require an appellant to limit his claims to specific examples or preferred embodiments when there is clear disclosure of a broader invention).

The rejections under 35 U.S.C. § 112, first paragraph, are reversed.

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Rejection Under 35 U.S.C. § 112, Second Paragraph

The reasons set forth by the examiner at page 4 of the Examiner's Answer in support of this rejection are as follows:

The claims fail to particularly point out the claimed method in that they completely fail to claim the nutritional component of the claimed method. The claims read on any emulsion of any nutritional value. The claims are so broad, that they may be [sic] considered non-enabling.

The examiner has confused the definiteness requirement of 35 U.S.C. § 112, second paragraph, with the enablement requirement of 35 U.S.C. § 112, first paragraph. As set forth in In re Skoll, 523 F.2d 1392, 1395, 187 USPQ 481, 482-83 (CCPA 1975), the use of a broad term in a claim does not make that claim indefinite. See also In re Ehrreich, 590 F.2d 902, 906, 200 USPQ 504, 508 (CCPA 1979) (Rejection "not based on indefiniteness or lack of clarity of claim language, but only on the alleged lack of agreement with the scope of the specification" is reversed).

The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

Rejection Under 35 U.S.C. § 103

We vacate this rejection since the examiner has refused to make of record the complete factual basis relied upon in reaching his conclusion of obviousness.

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At page 6 of the first office action (Paper No. 4, mailed August 30, 1993), the examiner stated:

Applicant is also served judicial notice concerning the well known practice of feeding (or force-feeding) young or traumatized animals. There is nothing patentable about a method of administering nutrients via a dropper or syringe. These are art recognized equivalents.

Appellant timely challenged the examiner's taking of "judicial notice." See Paper No. 6, filed January 3, 1994, page 5 ("The Examiner is requested to provide a reference supporting the fact that force feeding is equivalent to feeding by syringe . . .").

In view of the timely challenge, the examiner should have made of record factual evidence in support of his assertion of well known facts in the next office action. This the examiner did not do. Rather, the examiner stated at page 8 of the final office action (Paper No. 7, mailed March 30, 1994),

If applicant wishes, several reference volumes of Veterinary Medicine will be cited during appeal As evidence, the commercial availability of several nutritional supplements is noted (available at any health food store), wherein administration is via dropper. Commercially available forms of these supplements will also be referenced at appeal.

Appellant renewed his request that the examiner provide appropriate evidence at page 9 of the Appeal Brief. One would think that the examiner would surely have supplied the promised factual support in the Examiner's Answer. However, the examiner did not do so. Rather, the examiner relied again upon his taking notice concerning "the well

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known practice of feeding (or force-feeding) young or traumatized animals” at page 6 of the Examiner’s Answer. Then the examiner stated at page 7 of the Examiner’s Answer:

If applicant wishes, several reference volumes of Veterinary Medicine will be cited during appeal As evidence, the commercial availability of several nutritional supplements is noted (available at any health food store), wherein administration is via dropper. Commercially available forms of these supplements will also be referenced at appeal.

Suffice it to say that the time for the appeal in this application has come and this appeal proceeding is almost gone, yet neither appellant nor this merits panel has the benefit of the evidence long promised by the examiner. It is not apparent at what point in time the examiner intends to make the promised evidence of record. We believe that the appropriate time has long since passed.

As is apparent, the rejection under 35 U.S.C. § 103 is not reviewable absent the promised factual evidence in support of the examiner’s assertions. Accordingly, we vacate the rejection under 35 U.S.C. § 103 and remand the application for the examiner to make of record the evidence the examiner has repeatedly stated is available to him. In so doing, the examiner should reopen prosecution and issue an appropriate office action which provides appellant a full and fair opportunity to respond.

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Summary

The rejections under 35 U.S.C. § 112, first and second paragraphs, are reversed. The rejection under 35 U.S.C. § 103 is vacated. The case is remanded to the examiner to take appropriate action.

REVERSED-IN-PART - VACATED-IN-PART

Bruce H. Stoner, Jr., Chief)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
William F. Smith)	APPEALS AND
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