

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EARL J. BRAXTON

Appeal No. 2000-1444
Application No. 09/040,245

ON BRIEF

Before CALVERT, ABRAMS, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18.
Claims 19 and 20 have been withdrawn as being directed to a non-elected invention.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method for the disposal, recovery and recycling of pharmaceuticals from human wastes. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Green	5,485,637	Jan. 23, 1996
Held <u>et al.</u> (Held)	5,508,004	Apr. 16, 1996

Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Green in view of Held.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 15) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 14) for the appellant's arguments thereagainst.

¹The examiner has stated the rejection as being on the basis of "Green and Held" (emphasis added), which could be interpreted as meaning either of the references, taken alone. However, it is clear that the examiner's intention was to combine the teachings of the two references, and it is to the combination of the references to which the appellant directed his arguments.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to removing pharmaceutical agents from human waste, a problem the appellant believes has not been considered by the prior art (specification, page 3). As manifested in independent claim 1, the invention comprises the steps of:

providing a portable waste receptacle which is configured to serve as a toilet for an individual who has been treated with a pharmaceutical agent, the receptacle being a self-contained unit which is capable of being sealed for transport of human wastes to a facility,

accumulating human wastes in the receptacle, the wastes containing the pharmaceutical agent and metabolized byproducts thereof,

transporting the waste receptacle and the human wastes contained therein to the facility, and

removing the pharmaceutical agent from the human wastes.

The examiner asserts that all of the claimed steps are disclosed by Green, with the exception that Green does not remove pharmaceutical agents. However, it is the examiner's view that Held "teaches a facility where waste (including 'pharmaceutical agents') is processed as spelled out on lines 35-39 of column 4," and therefore the

claimed method would have been obvious to one of ordinary skill in the art (Answer, page 4). The appellant argues that neither of the references is even concerned with the problem to which his invention is directed, and that even if the teachings of the two references were combined, the result would not be the claimed method (Brief, pages 7-10).

We begin our analysis by pointing out that the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Green discloses a holding tank for human wastes (Figure 1), and hospital wastes such as from an operating room, including "sharps" (Figures 5 and 6). The embodiment shown in Figure 1, which is configured to serve as a toilet for an individual, would appear to be capable of being utilized to accomplish all of the steps recited in claim 1. However,

Green makes no mention of pharmaceutical agents in human wastes, much less that the disclosed device is for the purpose of containing and transporting them, and therefore, while the disclosed apparatus may have the capability to perform the method, there is no suggestion in the reference of doing so.

Held discloses an apparatus and method for processing medical waste. Held's objective is to "disinfect" medical waste (as defined in seven categories in lines 30-40 of column 10), and then shred it and process it into a reclaimed, useable product (column 5, line 63-column 11, line 61). Contrary to the statement of the examiner that this reference specifically includes pharmaceutical agents in the list of medical waste, the fact of the matter is that these words are not even present in the reference. Nor, in our opinion, is the processing of pharmaceutical agents implied or inherent in the disclosure, whether contained in or separate from human wastes, unless such inherently would occur in the "disinfecting" process, a conclusion that is not supported by any evidence on the record.

Thus, as alleged by the appellant, neither of the references recognizes the problem to which the appellant has directed his inventive efforts. Furthermore, given that neither contains even a mention of pharmaceutical agents, we further agree with the appellant that there is absolutely no basis upon which to rest a conclusion that the combined teachings of the two references would have suggested the method recited in claim 1 to one of ordinary skill in the art. This being the case, it is our opinion that the combined teachings of Green

and Held fail to establish a prima facie case of obviousness with respect to the method recited in claim 1, and we will not sustain the rejection of this claim or, it follows, of claims 2-10, which depend therefrom.

Independent claim 11 sets forth the invention in somewhat different terms, but contains the same limitations. On the basis of the rationale expressed above with regard to claim 1, we also will not sustain the rejection of claims 11-18.

SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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REMY J. VAN OPHEM
755 W. BIG BEAVER ROAD
SUITE 1313
TROY, MI 48084-4903

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APPLICATION NO. 09/040,245

APJ ABRAMS

APJ McQUADE

APJ CALVERT

DECISION: REVERSED

Prepared By:

DRAFT TYPED: 29 Jan 02

FINAL TYPED: