

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS L. RICHTER, JAMES WILSON and
DANIEL E. PEDERSEN

Appeal No. 1996-2873
Application No. 08/209,194

HEARD: May 1, 2000

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

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 50 through 65 and 67 through 80 which are all of the claims pending in the application. Claim 66 was canceled subsequent to the final Office action dated June 26, 1995, Paper No. 9.

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Claim 50 is representative of the subject matter on appeal and reads as follows:

50. An aqueous soluble drain sanitizing article for dispensing a chemical sanitizing agent for sanitizing running and standing drainage, said drain sanitizing article comprising an aqueous soluble sanitizing bar, said bar comprising (a) an effective amount of an antimicrobial sanitizer, and (b) an effective amount of hardener, said sanitizing bar having an interior wall, said interior wall defining an opening in said drain sanitizing article wherein when said drain sanitizing article is placed into a drain, said drain sanitizing article allows for the passage of drainage over the article and through said drain sanitizing article opening into the drain.

As evidence of obviousness, the examiner relies on the following prior art:

Mortimer et al. (Mortimer) 1900	656,992	Aug. 28,
Rising 1914	1,083,561	Jan. 6,
Watanabe et al. (Watanabe) 1980	4,218,432	Aug. 19,
Kramer et al. (Kramer) 1989	4,847,089	Jul. 11,
Globus 1990	4,954,316	Sep. 4,
Wiedrich et al. (Wiedrich) 1992	5,106,559	Apr. 21,
Bull 10, 1994	5,310,549	May

(filed Aug. 31, 1989)

Claims 50 through 65 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

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particularly point out and distinctly claim the subject matter which applicants regard as their invention. Claims 50 through 60 and 67 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure for the subject matter presently claimed. Claims 50 through 65 and 67 through 80 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Mortimer, Rising, Watanabe, Kramer, Wiedrich, Bull and Globus.

We reverse each of the foregoing rejections.¹

We reverse the examiner's decision rejecting claims 50 through 65 under 35 U.S.C. § 112, second paragraph, for those reasons expressed at pages 10 through 13 of the Brief.

We also reverse the examiner's decision rejecting claims 50 through 60 and 67 under 35 U.S.C. § 112, first paragraph, for those reasons expressed at pages 8 and 9 of the Brief. We only add that our reviewing court has held that

it is not necessary that a patent applicant test all the embodiments of his invention, ***In re***

¹The examiner has not repeated in the Answer the rejection of claims 50, 51 and 66 under 35 U.S.C. § 102(b) set forth in the final Office action. Accordingly, this § 102(b) rejection is presumed to have been withdrawn. ***Ex parte Emm***, 118 USPQ 180 (Bd. App. 1957)

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Angstadt, 537 F.2d 498, 502, 190 USPQ 214, 218 (CCPA 1976); what is necessary is that he provide a disclosure sufficient to enable one skilled in the art to carry out the invention commensurate with the scope of his claims.²

The examiner, however, has not demonstrated that the specification disclosure (including the working examples therein) referred by appellants at pages 8 and 9 of the Brief would not enable one of ordinary skill in the art to make and use the claimed aqueous soluble drain sanitizing article having an "effective amount of hardener". **In re Wands**, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); **In re Strahilevitz**, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982).

Further, we reverse the examiner's decision rejecting claims 50 through 65 and 67 through 80 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Mortimer, Rising, Watanabe, Kramer, Wiedrich, Bull and Globus for essentially those reasons expressed at pages 16 through 19 of the Brief. We add the following primarily for emphasis.

² **Amgen Inc. v. Chugai Pharms. Co.**, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991).

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According to page 8, lines 17-22, of the specification, the claimed shape of an aqueous soluble drain sanitizing article is not only useful for accommodating the funneling nature of drains, but also useful for providing "maximum contact between the chemical sanitizer ... and drain run-off..." Notwithstanding silence regarding the claimed shape of an aqueous soluble drain sanitizing article in the references relied upon by the examiner, the examiner states (Answer, page 5) that

since the donut shape of the instant invention is one of general knowledge [sic], and since the primary reference [Mortimer] permits [the use] of any shape, ...it would be obvious to attain the shape of the instant invention, since any shape would include the known donut shape.

However, the fatal flaw in the examiner's statement is that there is no suggestion or motivation to shape the aqueous soluble drain sanitizing article of the type described in Mortimer into the so-called "donut shape". The examiner simply has not proffered any evidence that it is desirable to use the "donut shape" in the sanitizing art. Nor has the examiner demonstrated that the "donut shape" is known to be used in the sanitizing art. On this record, for the reasons

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indicated *supra*, we are constrained to reverse the examiner's decision rejecting all of the appealed claims under 35 U.S.C. § 103 over the applied prior art.

In view of the foregoing, the decision of the examiner is reversed.

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

REVERSED

BRADLEY R. GARRIS)
Administrative Patent Judge)
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) BOARD OF PATENT

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CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
PETER F. KRATZ)	
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APJ KRATZ

APJ GARRIS

DECISION: REVESED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: April 24, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT