

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGES DRIESEN and PETER HILFINGER

Appeal No. 98-0606
Application 08/553,603¹

HEARD: MAY 3, 1999

Before COHEN, ABRAMS and STAAB, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-18, all the claims pending in the

¹ National stage application for patent filed November 14, 1995, pursuant to 35 U.S.C. § 371 based on International Application PCT/EP94/01326, filed April 27, 1994.

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application.

Appellants' invention pertains to a toothbrush comprising a brush section having bores into which bristles are secured by anchoring members made of a material that exhibits oligodynamic action. As explained in appellants' specification (page 2),

[o]ligodynamic action is generally understood to be the action of very small quantities of metal ions, especially a growth-inhibiting or destructive action of heavy metal traces on microorganisms, with the oligodynamic action of the metals diminishing in the following order: Cadmium - silver - brass - copper - mercury. Cadmium has the highest, mercury the lowest oligodynamic action.

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

1. A toothbrush comprising:

a brush section including a bristle carrier and bristles fixedly secured to the bristle carrier, and a separate member fixedly securing the bristles to the bristle carrier, said separate member being made of material with oligodynamic action.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are:

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Wells	3,857,134	Dec. 31, 1974
Braga (German Patent Document) ²	3,105,544	Jun. 16, 1982

The following rejections are before us for review:

- (1) claim 14, under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (2) claims 1, 2, 8, 10, 12, 14 and 18, under 35 U.S.C. § 102(b), as being anticipated by Wells; and
- (3) claims 3-7, 9, 11³, 13, and 15-17, under 35 U.S.C. § 103, as being unpatentable over Wells in view of Braga.

Rejection (1)

Looking first at the 35 U.S.C. § 112, second paragraph, rejection, it is the examiner's view that "the recitation [of claim 14] that the material is other than copper or stainless steel is indefinite because such is a negative limitation with indefinite bounds, where the scope of the claim cannot be

² Our understanding of this German language reference is derived from a translation prepared in the Patent and Trademark Office. A copy of the translation is attached to this opinion.

³ Claim 11 appears to have been inadvertently dropped from the statement of this rejection in the final rejection and answer.

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determined" (answer, page 3). On page 2 of the brief, appellants state that a proposed amendment after final rejection was submitted to address this claim deficiency. As indicated by the examiner in an advisory letter (Paper No. 8), and as acknowledged

by appellants on page 2 of the brief, the proposed amendment was not entered. Appellants have made no substantive argument with respect to this rejection.

The rejection under 35 U.S.C. § 112, second paragraph, is still before us, and claim 14 does not include the revision set forth in the unentered proposed amendment. Under these circumstances, we will sustain the examiner's rejection under § 112 since appellants have failed to point out any error in the rejection.

Rejection (2)

The sole issue with respect to the § 102 rejection is whether the word "toothbrush" appearing in the preamble of each of the claims distinguishes over Wells. The examiner

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contends that the word "toothbrush" in the preambles of the appealed claims is a statement of intended use only, and that any brush having the structure set forth in the body of claims anticipates the claimed subject matter. We do not agree.

Whether a preamble or introductory clause constitutes a limitation on a claim is a matter to be determined by the facts

of each case in view of the claimed invention as a whole. *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951). We agree with appellants' argument (brief, page 6, lines 10-12) that the word "toothbrush" as used in the present application would be understood by one of ordinary skill in the art to imply a particular type of personal hygiene product for use in a person's mouth (specification, page 6, lines 25-33). Further, appellants' specification makes it clear that the invention is directed to an

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improvement to a toothbrush, and not merely to an improvement in the field of brushes in general. Bearing in mind these circumstances, it is our view that when the appealed claims are read in light of the specification, they depend for their completeness on the preamble recitation "toothbrush" such that, in this instance, the term "toothbrush" is a limitation on the appealed claims and is not merely a statement of intended use. In other words, the term "toothbrush" in the preambles of the appealed claims has the effect of cutting back on the scope of the claims such that every brush that literally meets the terms of the body of an appealed claim does not necessarily anticipate that claim.

Wells, the alleged anticipatory reference, pertains to an improved staple-set brush. Wells states that staple-set brushes "are designed for a wide variety of uses, including hand use, hand-operated power tools and automatic power brushing equipment" (column 1, lines 6-9). The contour of the plate 1 of the brush "can be varied to meet the desired application" (column 1, lines 43-46). The plate 1 and backing element 1 of the brush are

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"formed into the desired shape" (column 2, line 20), and the holes for the tufts 2 "can be arranged in any pattern desired or necessary to meet the particular application" (column 2, lines 26-27). The tufts themselves can be composed "of any stranded material desired, available, and/or known in the art" (column 3, lines 11-12), including synthetics, vegetable fibers, metal wires, plastic coated wires, plastic coated glass fibers, or combinations thereof (column 3, lines 13-20). Wells does not disclose any specific use for the brush.

The brush of Wells is not disclosed as being a toothbrush, as that term would be understood by one of ordinary skill in the art when read in light of appellants' specification. Further, in

order for the brush of Wells to be capable of being used as a toothbrush, it would have to be sized, contoured and shaped so as to be capable of being received in a person's mouth, and provided with tufts that are compatible with such use. As is clear from the above discussion, Wells (1) pertains to a brush

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of general utility, (2) indicates that a variety of sizes, shapes and tuft materials may be utilized, and (3) offers little guidance with respect to the particulars of the brush. Accordingly, to the extent the examiner implies that the Wells brush is capable of being used as a toothbrush, that position is speculative. While we appreciate that the brush of Wells has all the structure recited in the body of independent claim 1, it does not meet the "toothbrush" limitation found in the preamble of that claim. A conclusion that the brush of Wells is a toothbrush, or is capable of functioning as a toothbrush, is simply not supported by Wells. Accordingly, the examiner's rejection will not be sustained.

Rejection (3)

The examiner contends that it would have been obvious to modify the anchoring rings 3 of Wells by making them of silver or

silver plated metal in view of Braga because

[i]t is considered known that bacteria can grow

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anywhere, and can occur in an industrial environment, where one may not wish to have bacteria growing because of the possibility of impurities affecting the work being treated by the brush in Wells. Therefore, such a suggestion [in Braga] of silver being used to fight bacteria could be desired by one using the brush in Wells. [Answer, page 6-7].

This position is not well founded. In brief, the proposed modification is a hindsight reconstruction based on appellants' disclosure rather than on anything that is fairly taught by the references themselves. In this regard, we do not share the examiner's view that one of ordinary skill in the art would have considered Braga's teaching of inhibiting the growth of bacteria on a toothbrush to suggest application of this concept to a general purpose brush, regardless of its use. In any event, even if we were to accept that it would have been obvious to modify Wells in the manner proposed, there remains the "toothbrush" limitation in the preamble of the claims which is not met by Wells. In light of the foregoing, we will not sustain the examiner's § 103 rejection based on Wells and Braga.

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Summary

The 35 U.S.C. § 112, second paragraph, rejection of claim 14 is affirmed.

The § 102 rejection of claims 1, 2, 8, 10, 12, 14 and 18 is reversed.

The § 103 rejection of claims 3-7, 9, 11, 13, and 15-17 is reversed.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

PATENT

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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NEAL E. ABRAMS)	BOARD OF
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	

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LAWRENCE J. STAAB)
Administrative Patent Judge)

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