

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AGIS KYDONIEUS,
CUILIAN LIN, KISHORE SHAH
and
LESLIE KLEM

Appeal No. 1998-2392
Application 08/338,917

ON BRIEF

Before COHEN, McQUADE and GRON, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 1998-2392
Application No. 08/338,917

This is an appeal from the final rejection of claims 1 through 30, all of the claims in the application.

Appellants' invention pertains to a collection vessel to receive and contain body wastes, IV solutions, blood, blood products and other biological materials, to an ostomy bag, and to a method of collecting exudates from an ostomy bag which reduces the odors usually associated with such procedures. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 10, and 30,¹ respective copies of which appear in APPENDIX A of the brief filed December 15, 1997 (Paper No. 19).

The examiner cites the document listed below:

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| Wilfong et al. (Wilfong) | 5,496,295 | Mar. 5, 1996 (filed Dec. 6, 1993) |
|--------------------------|-----------|--------------------------------------|

The following rejection is the sole rejection before us for review.

¹ The recitation of "said barrier material" on the last two lines of claim 30 lacks antecedent basis in the claim. This matter should be rectified during any further prosecution before the examiner.

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Claims 1 through 30 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which fails to adequately teach how to make and/or use the invention.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 20),² while the complete statement of appellants' argument can be found in the brief filed December 15, 1997 (Paper No. 19).

OPINION

In reaching our conclusion on the issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, and the respective

² On page 3 of the answer, the examiner lists respective documents to ROLANDO and KRUEGER. However, the rejection does not refer to these documents. It appears, therefore, that their inclusion in the answer was inadvertent, and we shall, accordingly, not make further mention thereof.

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viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We reverse the rejection of claims 1 through 30 under 35 U.S.C. § 112, first paragraph.

The text of the rejection before us (answer, pages 3 and 4) reveals that the examiner is questioning whether the claimed invention is based upon an underlying disclosure that is enabling. To be enabling, a disclosure must contain a description that enables those skilled in the art to make and use a claimed invention, without undue experimentation. See Enzo Biochem, Inc. v. Calgene Inc., 188 F.3d 1362, 1371, 52 USPQ2d 1129, 1135 (Fed. Cir. 1999).

An examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement and must keep in mind that a specification must be taken as in compliance with the enabling requirement of 35 U.S.C. § 112, unless there is reason to doubt the objective truth of the statements contained therein. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

In the present case, it is apparent to us that the examiner has not satisfied the requisite burden of proof to

support a lack of enablement rejection. Simply stated, the Wilfong teaching³ (a moisture barrier layer comprised of a mesophase propylene-based material), relied upon by the examiner, does not prove that appellants' claimed invention would not have been enabled by the underlying disclosure. Appellants rely upon an "oriented" liquid crystal polymer that is disclosed as providing the greatest contribution to gas impermeability (specification, page 3, lines 25 through 29). Further, the specification

(page 14) supports the noted low permeability attribute of an oriented liquid crystal polymer layer by the comparative results found in "TABLE 1 - OXYGEN PERMEATION" of Example 1. In light of the above, this panel of the board concludes that the rejection lacks proof that the claimed subject matter, inclusive of an "oriented" liquid crystal polymer layer, is based upon an underlying disclosure that is nonenabling.

³ U.S. Patent No. 5,496,295.

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In summary, we have reversed the rejection of appellants' claims 1 through 30 under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is reversed.

REVERSED

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| | IRWIN CHARLES COHEN |) | |
| | Administrative Patent Judge |) | |
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| | JOHN P. McQUADE |) | APPEALS AND |
| | Administrative Patent Judge |) | INTERFER- |
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| | TEDDY S. GRON |) | |
| | Administrative Patent Judge |) | |

ICC:psb

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