

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN GOLDSCHMIDT
and
ANDREW HAHN

Appeal No. 2000-0030
Application No. 08/723,451

ON BRIEF

Before CALVERT, FRANKFORT, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10. Claims 11, 12 and 13, the only other claims pending in the application, stand allowed.

Appellants' invention is directed to a pollution

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prevention system which avoids the discharge of laboratory waste, i.e., both hazardous and benign laboratory waste, into a public sewer system and subsequently into the natural environment. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellants' brief, is attached to this decision.

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

Kaump 1982	4,349,436	Sep. 14,
Been 1987	4,641,680	Feb. 10,

Claims 1 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Been in view of Kaump.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's

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answer (Paper No. 17, mailed July 16, 1999) for the reasoning in support of the rejection, and to appellants' substitute brief (Paper No. 16, filed May 20, 1999) for the arguments thereagainst.

OPINION

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

The examiner's rejection of claims 1 through 10 on appeal under 35 U.S.C. § 103 based on the collective teachings of Been and Kaump recognizes that the pollution prevention system of Been includes a combination of a laboratory sink (16) with a drain, a waste collection tank (12) connected to the drain,

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and a drip pan or container (14) located beneath the waste collection tank. The examiner notes (answer, page 3) that Been shows an outlet at (34) which includes a cap (col. 2, line 50). In the examiner's view, Been lacks a second valved outlet. The examiner urges that it would have been obvious to one of ordinary skill in the collection tank art to provide a tank with any number of outlets desired and points to the collection tank in the gray water collection system of Kaump, which has a valved outlet in line (38) and a valved outlet at (44) connected to a sewer line (60), as being exemplary. From these teachings the examiner concludes (answer, page 4) that since both references teach collection tanks downstream of a sink it would have been obvious to one of ordinary skill in the art to employ the multiple valved outlets of Kaump in the similar environment of Been.

Appellants argue, and we strongly agree, that given the disparate nature of the waste solvent collection receptacle seen in Been and the gray water collection system disclosed in Kaump, one of ordinary skill in the art would have found no

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reason to combine Been with Kaump so as to arrive at appellants' claimed pollution prevention system as defined in the claims on appeal. More specifically, in our view, even if it would have been obvious to one of ordinary skill in the art to provide the outlet (34) of the solvent collection tank (12) in Been with a valve as seen in the outlet line (38) of Kaump, we see no reason why one of ordinary skill in the art would have remotely considered providing the waste solvent tank of Been with a second valved outlet connected to a public sewage system, as required in the claims before us on appeal. Such a modification of the solvent collection tank (12) of Been would be antithetical to the entire teachings of that patent relating to the safe collection and disposal of corrosive waste solvents and the need expressed therein to avoid pollution of the environment. As for the Kaump patent, even though this reference appears to include all of the basic structural features of appellants' claim 1 on appeal, we note that the arrangement and operation of the grate (50) and the overflow (62) therein will provide some flow into the sewer drain line (60) whenever there is flow of water into the tank

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(10), thus the system in Kaump cannot function as a pollution prevention system that avoids the discharge of hazardous and benign laboratory waste into a public sewage system and subsequently into the environment, as required in appellants' claim 1.

Like appellants, it is our view that the examiner's position in this appeal represents a clear case of impermissible hindsight reconstruction of the claimed invention based on appellants' own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266 n.15, 23 USPQ2d 1780, 1783-84 n.15 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Since we have determined that the teachings and suggestions found in Been and Kaump would not have made the subject matter as a whole of independent claims 1, 6 and 9 on

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appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103. It follows that the examiner's rejection of dependent claims 2 through 5, 7, 8 and 10 under 35 U.S.C. § 103 will likewise not be sustained.

Accordingly, the decision of the examiner to reject claims 1 through 10 under 35 U.S.C. § 103 is reversed.

As for appellants' assertions that the Been reference is incomplete and should be removed or withdrawn as a reference, we note that this reference is good for all it teaches or suggests to one of ordinary skill in the art even though one of the sheets of drawings may have been unavailable and thus not supplied to appellants during prosecution of the present application. We have secured a copy of the missing page of drawings from the patented file of the Been patent and enclose a copy thereof for appellants' convenience.

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REVERSED

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IAN A. CALVERT))
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

CEF:hh

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APPENDIX

1. A pollution prevention system which avoids the discharge, inadvertent and otherwise, of laboratory waste, hazardous and benign, into a public sewage system and then into the exterior environment comprising in combination, a laboratory sink provided with a drain, and means for collecting waste material from said sink connected to said drain and provided with at least a pair of valved outlets, one outlet leading to the exterior of said means for collecting waste material and the other outlet connected to said public sewage system.