

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** LARRICK H. GLENDENING  
and VINCENT J. SCUILLA

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Appeal No. 94-2818  
Application 07/834,771<sup>1</sup>

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HEARD: June 12, 1998

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Before KIMLIN, PAK and WALTZ, ***Administrative Patent Judges***.

WALTZ, ***Administrative Patent Judge***.

***DECISION ON APPEAL***

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 37, as amended subsequent to the final rejection in a response dated Sept. 1,

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<sup>1</sup> Application for patent filed February 13, 1992.

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1993 (Paper No. 10).<sup>2</sup> These are the only claims in this application.

According to appellants, the invention is directed to a method and apparatus for waste degradation (brief, paragraph bridging pages 1 and 2). This degradation is accomplished by metering a liquid culture medium from a bag through a feed line into the waste material, where the liquid culture medium is formed by adding water to the concentrated organisms which are stored in the bag (*Id.*).

Appellants state that all the claims are ?grouped together?, i.e., the claims stand or fall together (brief, page 8). Therefore this decision will be decided on the basis of claim 1, which is an independent claim and is illustrative of the subject matter on appeal. See 37 CFR § 1.192(c)(5)(1993), now 37 CFR § 1.192(c)(7)(1995). Claim 1 is reproduced below:

1. A method for treating a waste material to degrade the waste material, which comprises:

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<sup>2</sup> This amendment was entered as noted in the advisory action dated Sept. 14, 1993 (Paper No. 11). An earlier amendment dated July 7, 1993 (Paper No. 7), subsequent to the final rejection, was refused entry as noted in the advisory action dated July 23, 1993 (Paper No. 8).

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(a) providing a flexible bag for holding concentrated microorganisms that can degrade the waste material for storage and shipment in the bag prior to use;

(b) filling the bag with water to form a liquid culture medium with the microorganisms; and

(c) metering the liquid culture medium from the bag using a feed line leading from the bag into the waste material over time to degrade the waste material, wherein the liquid culture medium is maintained at ambient temperatures during the metering.

The examiner has relied upon the following references as evidence of obviousness:

Bond 6, 1979	4,138,036	Feb.
Clarke et al. (Clarke) 1983	4,415,085	Nov. 15,
Daggett et al. (Daggett) 7, 1989	4,879,239	Nov.
Miller et al. (Miller) 1990	4,911,832	Mar. 27,
Mogna 1990 (Published International Application)	WO 90/02167	Mar. 8,

Claims 1 through 37 stand rejected under 35 U.S.C. § 103 as unpatentable over Miller in view of Mogna, Clarke, Bond and Daggett.<sup>3</sup> We *affirm* this rejection for substantially the

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<sup>3</sup> The final rejection of claims 22-29 and 36 under the second paragraph of 35 U.S.C. § 112 has been withdrawn by the examiner in view of appellants' amendment dated Sept. 1, 1993 (see the advisory action dated Sept. 14, 1993 (Paper No. 11), and page 2

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reasons set forth by the examiner in the answer. We add the following remarks primarily for emphasis.

**OPINION**

The first step in determining the differences between the prior art and the claimed subject matter is to ascertain or interpret the scope of the claimed language.<sup>4</sup> It is well settled that, during patent prosecution, claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The method of appealed claim 1 requires three steps, namely, providing a flexible bag, filling the bag with water, and metering the liquid culture medium from the bag using a feed line leading from the bag into the waste material over time to degrade the waste material, with the liquid culture

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of the answer).

<sup>4</sup> See *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), and the *Manual of Patent Examining Procedure (MPEP)*, §2141.02, 6th ed. Rev. 3, July 1997.

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maintained at ambient temperatures during the metering.<sup>5</sup>

As noted by the examiner (answer, page 10), the claims do not exclude method steps such as found in Miller where flushing or pretreatment occurs since the method of claim 1 recites "comprising". The term "comprising" is a term of art used in claim language which means that the claimed elements or steps are essential, but other elements or steps may be added and be within the scope of the claims. See *Genentech Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). As stated by our reviewing court in *In re Herz*<sup>6</sup>:

It is axiomatic that claims are given their broadest reasonable construction consistent with the specification. [Citation omitted.] This complements the statutory requirement for particularity and distinctness (35 USC 112, second paragraph), so that an applicant who has not clearly limited his claims is in a weak position to assert a narrow construction.

Appellants' arguments are all directed to a narrow

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<sup>5</sup> Appellants admit that the third step of the method of claim 1 is well known in the art, i.e., "waste degradation accomplished through use of metering a liquid bioactive solution into the waste trap is known." (brief, page 14).

<sup>6</sup> 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

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construction of the claims but, as in *Herz*, the claims are not so limited.

Appellants' arguments regarding the secondary references are also not well taken. Appellants argue either limitations that are not found in appealed claim 1 or discuss the references individually, instead of correctly assessing the prior art as a whole. See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) ([T]he test is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention).

It should also be noted that, giving the broadest reasonable interpretation to the language of claim 1, there is no positive limitation in step (a) that the flexible bag actually contains concentrated microorganisms, only that it is capable of holding concentrated microorganisms?. Furthermore, giving the broadest reasonable interpretation, step (b) of claim 1 does not require that the bag contains the stored microorganisms while water is used to fill the bag to form a liquid culture medium. This step merely requires that the bag be filled with water to form a liquid culture medium, e.g.,

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the microorganisms could be added

with the water or after the water to form a liquid culture medium (as taught by Mogna, page 2, line 20-page 3, line 12).

For the foregoing reasons and the reasons expressed by the examiner in the answer, the claimed subject matter would have been *prima facie* obvious based on the disclosure and teachings of Miller, Mogna, Clarke, Bond and Daggett. Appellants have not presented sufficient evidence of nonobviousness to rebut this *prima facie* case of obviousness. Accordingly, the rejection of claims 1 through 37 under 35 U.S.C. § 103 as unpatentable over Miller in view of Mogna, Clarke, Bond and Daggett is affirmed.

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

**AFFIRMED**

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EDWARD C. KIMLIN )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
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