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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RENE N. LAROSE and JOSEPH A. SCHULTZ

Appeal No. 95-1528
Application 07/952,684[1]

ON BRIEF

Before SOFOCLEOUS, GRON, and ELLIS, Administrative Patent Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal from an examiner's final rejection of Claims 39-57, all claims pending in this application. All claims stand finally rejected under 35 U.S.C. § 103 as unpatentable in

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[1] Application for patent filed September 29, 1992. According to applicants, this application is a continuation of Application 07/721,296, filed June 26, 1991, now abandoned.

view of the combined teachings of Frankel et al. (Frankel), U.S. 4,674,490, patented June 23, 1987, and Sheldon et al. (Sheldon), U.S. 4,932,359, patented June 12, 1990. Claim 39 adequately represents the subject matter of the claims on appeal and reads:

> 39. A method of reducing microorganism contamination of the environment of newly hatched poultry which comprises:
>
> providing a microaerosol apparatus for producing a microaerosol spray;
>
> providing a disinfectant;
>
> dispensing the disinfectant with the microaerosol apparatus in a substantially closed chamber in which newly hatched poultry are disposed substantially continuously from the time of initial pipping until essentially all the poultry have exited from their respective eggs.

The examiner's holding of unpatentability under 35 U.S.C. § 103 in view of the combined teachings of Frankel and Sheldon appears to be supported primarily by the examiner's finding that Sheldon itself reasonably suggests a process for disinfecting poultry which comprises dispensing disinfectant "in a substantially closed chamber in which newly hatched poultry are disposed" (Claim 39). The examiner states (Examiner's Answer (Ans.), p. 5, lines 1-10):

> Sheldon et al recognize that "hydrogen peroxide treatment is believed to increase the quality of chicks hatched and to reduce the number of chick deaths occurring within a few days after hatching" (See col. 4, lines 15-18). In recognition of the benefits of hydrogen peroxide treatment and that such treatment is safe to eggs and chicks, it would have been obvious to one of ordinary skill in the

> art to continuously dispense disinfectant on newly hatched poultry after removal from the microaerosol apparatus to improve the quality of the foul and to reduce the number of deaths of chicks a few days after hatching.

The examiner was not persuaded by appellants' contention that Sheldon teaches away from the claimed invention (Ans., pp. 6-7, bridging para.):

> . . . Sheldon et al do not expressly teach away from fogging or spraying after the actual time of pipping and hatching. In fact, Sheldon et al expressly teach the application of disinfectant to the eggs "within the hatcher until the actual time of pipping and hatching" (See col. 3, lines 45-48) and one of ordinary skill would expect that "hatching" means that the chick has broken out the shell.

The examiner expressly states that Frankel is relied upon "solely for the use of the microaerosol apparatus for dispensing fluid in micro-droplet sizes" (Ans., pp. 7-8, bridging sentence). The examiner points again to Sheldon's teaching (Ans., p. 8, last four lines). Ultimately, the examiner finds that the Sheldon's method of treating eggs with disinfectant "until the actual time of pipping and hatching" (See col. 3, lines 45-48) extends until the actual time the chick has emerged from the shell (Ans., pp. 10-11, bridging para.):

> . . . Sheldon et al do teach the application of fluid to hatched eggs. It is the Examiner's position that the term "hatched" suggests that the shell has broken and the chick has emerged from the shell. In view of the meaning of the word, "hatched", the Examiner equates the hatched egg to the chick such that Sheldon et al teach the exposure of fluid to eggs and chicks.

We hold that the examiner clearly erred in finding that Sheldon describes or reasonably suggests a process for disinfecting poultry which comprises dispensing disinfectant "in a substantially closed chamber in which newly hatched poultry are disposed." Not being able to determine how much the examiner's erroneous finding influenced the conclusion of unpatentability under 35 U.S.C. § 103 in view of the combined teachings of Frankel and Sheldon, we are constrained to reverse the examiner's decision and remand the case for further consideration in light of our decision and remarks.

Sheldon states (col. 1, l. 67, to col. 2, l. 2; emphasis added):

> The present invention comprises exposing hatchery eggs to a solution of hydrogen peroxide <u>prior to actual hatching</u> in order to disinfect and to significantly increase the hatchability of the eggs treated.

We read Sheldon's statement at col. 3, l. 45-48, in conjunction with his other statements at col. 2, l. 26-41; col. 2, l. 65-68; and col. 3, l. 10-32. Moreover, at col. 4, l. 23-26, Sheldon states:

> Finally, and very importantly, the exposure of hatchery eggs to hydrogen peroxide <u>prior to hatching</u> has quite unexpectedly been found to significantly increase the hatchability of the eggs treated.

Most instructive of what Sheldon's teaching would have meant to a person having ordinary skill in the art, however, is Sheldon's

own understanding of the mechanism responsible for the enhancement of hatchability by hydrogen peroxide. Sheldon theorizes that "a chemical alteration of the proteinaceous outer cuticle of the egg which functions to regulate respiratory activity and water loss across the shell and shell membranes and which acts as a barrier preventing microbial invasion into the egg" (Sheldon, col. 4, l. 57-65). Sheldon also suspects "generation of elevated oxygen levels within the shell due to the diffusion of hydrogen peroxide across the shell and shell membranes and its ultimate decomposition to oxygen" (Sheldon, col. 4, l. 67, to col. 5, l. 3). The mechanisms Sheldon proposes are wholly inconsistent with the examiner's findings.

Accordingly, we reverse the examiner's conclusion of the unpatentability of Claims 39-57 under 35 U.S.C. § 103 because it is based on clearly erroneous findings with regard to Sheldon's teaching.

Other Issues

We are obliged to remand this case to the examiner for (1) claim interpretation, (2) additional prior art findings, and (3) consideration of new grounds of rejection consistent with our decision on the appealed rejection. We especially recommend consideration of the following matters.

A. The methods appellants claim comprise the steps of "providing a disinfectant" and "dispensing the disinfectant with the microaerosol apparatus" (Claims 39, 46, and 57). Both the examiner and appellants appear to have presumed throughout the prosecution of the subject matter on appeal that a method which provides and dispenses "vaccine droplets," as does the method Frankel describes, does not describe a method which provides and dispenses "disinfectant" in accordance with the claimed method. We recommend that the examiner and appellants reconsider their interpretation of the scope of the term "disinfectant" in appellants' claims in light of the following definition of the term "disinfectant" in the specification (p. 6, first full para.):

> In some forms of the invention the disinfectant administered is hydrogen peroxide or glutaraldehyde or any other disinfectant which is (1) an effective antimicrobial agent, (2) minimizes the degree of physical damage to the avian respiratory tissue, (3) improves upon or does not decrease the percentage of chicks that survive the hatching process, (4) does not result in poor post hatch performance, and (5) is safe for people to work in the presence of the material.

If when giving the "disinfectant" of appellants' claims its broadest reasonable interpretation which is consistent with the description of the invention in the specification, the examiner

holds that the term “disinfectant” encompasses vaccine droplets, the examiner should consider whether Frankel itself describes the method appellants claim.

B. Calcaterra et al. (Calcaterra), U.S. 4,717,544, patented January 5, 1988 (of record), teaches that “gas phase disinfectants are known, including sulfur dioxide, glyoxal, iodine, chlorine, malondialdehyde, glutaraldehyde, methylene chloride, formaldehyde, and ammonia” (Calcaterra, col. 1, l. 30-33). Therefore, the examiner should consider whether the combined teachings of Sheldon and Kaitz, U.S. 2,993,832, patented July 25, 1961 (of record), would have led persons having ordinary skill in the art to treat incubating eggs and/or new-born chicks with disinfectant. Kaitz, teaches (Kaitz, col. 1, l. 8-16; emphasis added):

> One of the recognized methods of combating poultry diseases . . . involves <u>treatment of incubating eggs or new-born chicks with formaldehyde gas</u>. The gas is ordinarily generated by chemical reaction . . . <u>in a chamber containing incubating eggs or new-born chicks</u>.

We note the examiner’s citation of Kaitz and his references to Kaitz’ teaching of the use of “thermal energy along with a disinfectant to maintain an environment conducive to the hatchability of eggs through the effective control of poultry diseases” in the Examiner’s Answer (Ans., pp. 5-6, bridging para., and p. 8, first full para.). However, the examiner did

not include Kaitz in the statement of the rejection or cite or consider Kaitz' teaching to treat either incubating eggs or new-born chicks with a disinfectant in a chamber containing either incubating eggs or new-born chicks. While we might ad hoc consider Kaitz' teaching in its entirety and combine them with the teachings of Frankel and Sheldon and/or broadly consider the meaning of the term "disinfectant" in appellants' claims for the first time in light of the specification and reconsider Frankel's teaching in that new light with or without entering a new ground of rejection, we are constrained to simply reverse the appealed rejection and remand the case to the examiner for further prosecution in line with this decision and our remarks. To reverse and remand is, in our view, the action which best respects the court's admonition in In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970) of the practice of relying on prior art not included in the statement of the rejection on review and our authority under 35 U.S.C. § 134.

Accordingly, we reverse the examiner's rejection of Claims 39-57 under 35 U.S.C. § 103 and remand the case to the examiner for special action consistent with our decision and remarks.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedures § 708.01(d)(6th ed., rev. 3, July 1997). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED; REMANDED

Michael Sofocleous Administrative Patent Judge	)	
Teddy S. Gron Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Joan Ellis Administrative Patent Judge	)	

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