

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte C. KERRY JONES

Appeal No. 1998-1714
Application No. 08/441,823

ON BRIEF

Before CALVERT, COHEN, and ABRAMS, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3 to 7 and 9 to 17, all the claims remaining in the application.

The appealed claims are drawn to a method for evaluating a person's handwashing technique (claims 1 and 3 to 6), a method for indicating areas of body part contact on surface areas of a defined space (claims 7 and 9 to 12), and a composition for washing one's hands (claims 13 to 17). They are reproduced in the appendix of appellant's brief.

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The references applied in the final rejection are:

Shiino et al. (Shiino)(Japanese Kokai) 6-271899 Sep. 27, 1994¹
Brochure, "'Glo-Germ' can help you become a 'Germ Detective'!"
(Glo-Germ company, undated) (Glo-Germ)²

An additional reference, applied herein in a rejection pursuant to 37 CFR § 1.196(b), is:

Klisch et al. (Klisch) 4,554,098 Nov. 19, 1985

The claims on appeal stand finally rejected as follows:

- (1) Claims 1, 3 to 7 and 9 to 17, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph.
- (2) Claims 1, 3 to 7 and 9 to 17, anticipated by Glo-Germ, under 35 U.S.C. § 102(b).
- (3) Claims 13 to 17, anticipated by Shiino, under 35 U.S.C. § 102(b);³

¹ In the final rejection, the claims were rejected over an abstract of this reference (WPI 94-347698/43). This Board has obtained the reference itself, and a translation thereof, prepared for the USPTO, which we shall use in evaluating the rejections. Copies of the reference and translation are forwarded herewith to appellant.

² This reference was submitted by appellant with a Supplemental Information Disclosure Statement filed on February 2, 1996. Although the reference is undated, appellant has not contended that it is not available as prior art against him.

³ Although the examiner specified § 102(b) as the applicable statutory basis (final rejection, page 2), we will treat the rejection as being under § 102(a), since Shiino was published less than one year prior to appellant's filing date.

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(4) Claims 1, 3 to 7 and 9 to 12, unpatentable over Shiino under 35 U.S.C. § 103(a).

Rejection (1)

The basis of this rejection, as stated on page 3 of the examiner's answer, is:

Page 5 of the specification, lines 22-25, [states] "The handwashing medium 18 may also be in the form of [a] liquid, as illustrated, a cream, a powder or a spray, with any of the more conventional handwashing media adapted for use with the present invention." Based on the specification, the handwashing medium could be any medium including lotion, powder, water, liquid, cream, or spray form. Thus, it is unclear and too broad that [sic] what is the handwashing medium. Clarification or/and correction is required.

We will not sustain this rejection. The criterion for compliance with § 112, second paragraph, is "whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed matter are distinct." In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975). In this case, we consider that it would be reasonably clear to one of ordinary skill, reading the claims in light of the disclosure quoted by the examiner, supra, what the scope of the claimed term "handwashing medium" is, i.e., a substance which is suitable for washing a person's hands, whether

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it be in the form of a liquid, cream, powder or spray. While this term may be broad, breadth of a claim is not to be equated with indefiniteness. See MPEP § 2173.04 (Rev. 1, Feb. 2000).

Rejection (2)

Considering first the rejection of claim 1, Glo-Germ discloses a process which is for essentially the same purpose as the method recited in claim 1, namely, teaching or demonstrating proper handwashing. As stated in Glo-Germ:

The Glo Germ kit contains a bottle of oil, a bottle of powder, and an ultra-violet lamp. The oil and the powder contain the plastic germs, and the lamp lets you become the "germ detective"!

To use the kit for handwash training, the oil is put on the student's hands like hand lotion. This spreads thousands of tiny plastic fluorescent [sic] "germs" on their hands. Then, as the student works through your normal handwashing procedure the fluorescent [sic] lamp may be used to spot the remaining "germs." Under the lamp, the plastic "germs" glow brightly so that they may be easily seen by the student.

The examiner, noting that appellant states in the specification that the handwashing medium may be a liquid or powder (see rejection (1), supra), takes the position that the oil and powder of Germ-Glo are a handwashing medium, as claimed, and therefore Glo-Germ anticipates the claim.

In order to anticipate a claim, a reference must disclose every limitation of the claimed invention, explicitly or

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inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As indicated above in our discussion of rejection (1), the term "handwashing medium" would not cover every known liquid, cream, etc., but is limited to substances which are suitable for washing one's hands. The oil and fluorescent powder are not disclosed by Glo-Germ as being handwashing media; while some oils may be suitable for washing the hands, many are not, so that Glo-Germ's generic disclosure of "oil" does not anticipate handwashing oils. In re Meyer, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979)(generic disclosure does not anticipate species). Moreover, it would seem evident that the oil and fluorescent powder of Glo-Germ is not a handwashing medium, because, as described by Glo-Germ, the oil and powder are applied to the hands, and then are followed by "normal handwashing procedure," after which the fluorescent lamp is used to spot the remaining powder. If the oil and powder were a handwashing medium, there would be no necessity for the subsequent normal handwashing procedure.

We therefore conclude that claim 1 is not anticipated by Glo-Germ.

Claim 7 requires, inter alia:

adding an invisible detection agent to a handwashing medium;

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applying the invisible detection agent
to a person's body part by washing the body
part with said handwashing medium;

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and claim 13 recites:

a washing agent for cleaning the hands
when applied to the hands and rinsed away
with a solvent such as water; and
a detection agent disposed in said
washing agent . . .

Since, as discussed above, Glo-Germ does not disclose adding the detection agent (fluorescent powder) to a handwashing medium or washing agent for cleaning the hands, neither of these claims is anticipated by Glo-Germ.

Accordingly, rejection (2) will not be sustained as to independent claims 1, 7 and 13, nor, it follows, as to dependent claims 3 to 6, 9 to 12 and 14 to 17.

Rejection (3)

The Shiino reference discloses that a detection agent (fluorescent material) is added to any of various detergents, such as alcohol detergents, hydrocarbon detergents, etc. (translation, paragraph [0004]). However, while some detergents within these categories may be washing agents for cleaning the hands, Shiino does not disclose any such detergents specifically, and therefore does not anticipate claim 13 or dependent claims 14 to 17.

Rejection (3) will not be sustained.

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Rejection (4)

Shiino discloses a process for cleaning parts, such as aluminum cases for electrolytic condensers (translation, paragraph [0014]), using a detergent solution. In order to detect any detergent remaining on the parts after cleaning, a fluorescent material or dye is added to the detergent solution (id., paragraph [0010]), and then after cleaning, the amount and location of residual detergent is detected using a UV lamp (id., paragraphs [0011] and [0012]). The examiner considers the methods of claims 1, 3 to 7 and 9 to 12 to have been obvious over Shiino because (answer, page 11):

One of ordinary skill in the art would have recognized that the cleaning method of [Shiino] would be used in the checking the fluorescent residual substance in order to measure the cleaning process. It would have [been] obvious to one of ordinary skill in the art at the time appellant's invention was made to have applied known cleaning method in the person's handwashing technique in order to check the residual of the fluorescent substance for checking the degree of the cleaning process.

We do not consider this rejection to be well taken. A rejection under § 103 must rest on a factual basis, and the PTO may not, because it may doubt the invention is patentable, resort to speculation, unfounded assumptions or hindsight basis reconstruction to supply deficiencies in its factual basis.

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In re Warner, 579 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967),
cert. denied, 389 U.S. 1057 (1968), quoted in In re GPAC, Inc.,
57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). We
find no disclosure in Shiino of applying the process disclosed
therein to anything other than parts, and there is no evidence
therein to support the examiner's finding that it would have been
obvious to apply it to a person's hands, which finding appears to
be based on impermissible hindsight gleaned from appellant's own
disclosure.

We therefore will not sustain rejection (4).

Rejections Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), the appealed claims are
rejected as follows:

(A) Claims 3, 4 and 13 to 17 are rejected as being unpatentable
for failing to comply with 35 U.S.C. § 112, second paragraph, in
that:

(i) Claims 3 and 4 are incomplete, being dependent on a claim
(claim 2) which has been cancelled. Ex parte Brice, 110 USPQ 560
(Bd. App. 1955).

(ii) In claim 13, line 7, "said fluorescent agent" has no
antecedent basis.

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(B) Claims 7 and 9 to 12 are rejected as being unpatentable for failure to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The method recited in these claims is directed to the embodiment described on page 7, lines 3 to 19 of the specification. Claim 7 recites "adding an invisible detection agent to a handwashing medium," and while this step is not described on page 7, the Abstract of the Disclosure does state in its last sentence that the fluorescent additive is "in a handwashing medium." However, we find no disclosure in the application as filed of the second step of claim 7, "applying the invisible detection agent to a person's body part by washing the body part with said handwashing medium" (emphasis added); all the specification states is that the detection agent "may be applied to one's body parts" (page 7, line 7). Moreover, in addition to the lack of any disclosure of the underlined claim language, one of ordinary skill would not be apprised by the specification that appellant was in possession thereof because washing a body part with the handwashing medium would be contrary to the purpose of the claimed method, in that it would tend to remove the detection agent from the body part, instead of leaving the detection agent on the body part so that it would be deposited on surface areas of the defined space when contacted by the body part (as recited

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in the fourth step of claim 7 and as disclosed at page 7, lines 8 to 11).

(C) Claims 1, 3 to 6 and 13 to 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shiino in view of Glo-Germ, or vice versa. As discussed above, Shiino discloses the desirability of determining how much residual detergent is left on parts being washed by adding a fluorescent material to the detergent and detecting the residue of such material after washing by means of a UV lamp. In view of Glo-Germ's disclosure of the desirability of demonstrating proper handwashing using fluorescent powder "germs," one of ordinary skill would have been motivated to apply the process of Shiino to a person's hands, using a detergent suitable for handwashing, in order to detect the fluorescent material remaining after washing the hands. Alternatively, in view of Shiino's disclosure that fluorescent material may be added to the solution used for washing, it would have been obvious to one of ordinary skill to add the Glo-Germ fluorescent material to the handwashing medium, instead of to an oil to be applied prior to handwashing. This would have the self-evident advantage of reducing the cost and complexity of the Glo-Germ process.

(D) Claims 13 to 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Klisch. This reference anticipates the

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claimed composition in that it discloses a composition comprising a washing agent for cleaning the hands when applied to the hands and rinsed away with water (liquid hand soap, col. 7, line 29) and a fluorescent agent (col. 7, line 41), which, being in solution, would be "generally invisible to the eye." The recitation in lines 7 to 9 of claim 13 (and including claim 16) of "wherein said fluorescent agent . . . the handwashing process" is simply a statement of intended result or use, which does not make a claim to the product patentable. In re Schrieber, supra.

Conclusion

The examiner's decision to reject claims 1, 3 to 7 and 9 to 17 is reversed. Claims 1, 3 to 7 and 9 to 17 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of

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rejection, to avoid termination of proceedings (37 CFR § 1.197(c)
as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

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

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
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AFFIRMED-IN-PART

Prepared: June 18, 2003