

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUNNAR LINDROOS and PAUL WALLSTROM

Appeal No. 1998-1778
Application No. 08/521,358¹

ON BRIEF

Before CALVERT, MEISTER, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

¹ Application for patent filed August 31, 1995. According to the appellants, the application is a continuation of Application No. 08/228,139, filed April 15, 1994, now U.S. Patent No. 5,495,626.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 9, 11 to 17 and 23-27. Claims 10 and 18-22 have been canceled. In the brief (p. 1), the appellants withdrew the appeal with regard to claims 1 to 5, 7, 8, 11, 14 to 17 and 24. Accordingly, the appeal is dismissed with respect to claims 1 to 5, 7, 8, 11, 14 to 17 and 24. Claims 6, 9, 12, 13, 23, 25, 26 and 27 remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to a vacuum sewer toilet system. An understanding of the invention can be derived from a reading of exemplary claims 1 and 9, which appear in the appendix to the appellants' brief.

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

Steltz
1969

3,474,469

Oct. 28,

Badger et al. 1982 (Badger)	4,357,719	Nov. 9,
Raupuk, Jr. et al. 1985 (Raupuk)	4,520,513	June 4,
Kenway 1987	4,678,879	July 7,
Stroby et al. 12, 1989 (Stroby)	4,865,631	Sep.
Ishii 1990	4,892,988	Jan. 9,
Olin et al. 1990 (Olin)	4,928,326	May 29,
Terve 1993	5,214,807	June 1,
Oldfelt et al. 21, 1993 (Oldfelt)	5,245,711	Sep.

Claims 12 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 9 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Terve in view of Olin and Kenway.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Terve in view of Olin, Kenway, Steltz and Ishii.

Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Terve in view of Olin, Kenway, Stroby and Badger.

Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Terve in view of Olin, Kenway, Stroby, Badger and Raupuk.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Terve in view of Olin, Kenway and Oldfelt.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed December 12, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (filed

October 14, 1997) and reply brief (filed February 17, 1998)
for the appellants' arguments thereagainst.

OPINION

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

The indefiniteness issue

We will not sustain the rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner stated (answer, pp. 5-6) that

[c]laims 12 and 13 are non-sequitur. The claims are directed to the Fig. 3 embodiment which does not include the "electrically operated device" defined in claim 1. Since the hybrid embodiment required to describe the claimed subject matter has been determined to be not supportable by the original disclosure (see petition decision mailed August 21, 1997), the claims remain indefinite.

The appellants argue (brief, p. 20) that claims 12 and 13 comply with the requirements of 35 U.S.C. § 112, second paragraph. Specifically, the appellants point out how claims 1, 12 and 13 are readable on Figure 3.² In addition, the appellants argue (reply brief, pp. 1-2) that claims 1, 12 and 13 are readable on newly presented Figure 3A.^{3,4}

In our view, claims 12 and 13 define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. Accordingly, claims 12 and 13 are

² The examiner did not respond to the appellants' argument in the answer.

³ Newly presented Figure 3A is based upon the disclosure set forth on page 8, lines 27-32, of the specification.

⁴ The examiner did not respond to this argument of the appellants.

considered by us to be definite, as required by the second paragraph of

35 U.S.C. § 112. Moreover, in this case, we fail to see how the examiner's determination that claims 12 and 13 were not readable on any original drawing figure, raised an issue of indefiniteness.⁵ In any event, it is our determination that claims 1, 12 and 13 are readable on original Figure 3 and newly presented Figure 3A.

The obviousness issues

We will not sustain the rejection of claims 6, 9, 23, 25, 26 and 27 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18

⁵ We can see how such a determination **might** raise a written description issue under the first paragraph of 35 U.S.C. § 112. It is our view that the subject matter of claims 12 and 13 does have written description support in the original disclosure.

USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Claims 9 and 27

We agree with the appellants' arguments that the combined teachings of the applied prior art (i.e., Terve, Olin and Kenway) would not have suggested the subject matter of claim 9 to one of ordinary skill in the art. Claim 9 requires an operational unit containing a solenoid valve and at least one electrical component to be sealed against humidity and exposed for operation by a person in the toilet compartment and otherwise protected against unauthorized human access. However, these limitations are not suggested by the applied prior art. In our view, the only possible suggestion for combining the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-

13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claim 9.

We have also reviewed the references additionally applied in the rejection of claim 27⁶ but find nothing therein which makes up for the deficiencies discussed above. Accordingly, we cannot sustain the examiner's rejection of claim 27 under 35 U.S.C.

§ 103.

⁶ Claim 27 depends from claim 9.

Claims 23 and 26

We agree with the appellants' arguments that the combined teachings of the applied prior art (i.e., Terve, Olin and Kenway for claim 23 and Terve, Olin, Kenway, Stroby and Badger for claim 26) would not have suggested the subject matter of those claims to one of ordinary skill in the art. Claims 23 and 26 both require an operational unit to contain an electrically operated device and all electrical components for controlling supply of operating current to the electrically operated device to be sealed against humidity and exposed for operation by a person in the toilet compartment and otherwise protected against unauthorized human access. However, these limitations are not suggested by the applied prior art. Once again, it is our view that the only possible suggestion for combining the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from impermissible hindsight knowledge derived from the appellants' own disclosure. It follows that we cannot sustain the examiner's rejection of claims 23 and 26.

Claim 6

We agree with the appellants' arguments that the combined teachings of the applied prior art (i.e., Terve, Olin, Kenway, Steltz and Ishii) would not have suggested the subject matter of claim 6 to one of ordinary skill in the art. Claim 6 requires an operational unit containing an electrically operated device and a low voltage membrane switch to be sealed against humidity and exposed for operation by a person in the toilet compartment and otherwise protected against unauthorized human access. However, these limitations are not suggested by the applied prior art. In our view, the only possible suggestion for combining the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. It follows that we cannot sustain the examiner's rejection of claim 6.

Claim 25

We agree with the appellants' arguments that the combined teachings of the applied prior art (i.e., Terve, Olin, Kenway, Stroby, Badger and Raupuk) would not have suggested the subject matter of claim 25 to one of ordinary skill in the art. Claim 25 requires both (1) an operational unit containing an electrically operated device and electrical components for controlling supply of operating current to the electrically operated device to be sealed against humidity and exposed for operation by a person in the toilet compartment and otherwise protected against unauthorized human access; and (2) a delay device wherein the closing of a rinse water supply valve is delayed slightly relative to the closing of a sewer valve. However, these limitations are not suggested by the applied prior art. Once again, it is our view that the only possible suggestion for combining the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from impermissible hindsight knowledge derived from the appellants' own disclosure. It follows that we cannot sustain the examiner's rejection of claim 25.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6, 9, 12, 13, 23, 25, 26 and 27 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 1998-1778 - JUDGE NASE
APPLICATION NO. 08/521,358

APJ NASE

APJ CALVERT

APJ MEISTER

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 17 Mar 99

FINAL TYPED: