

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOSEPH A. VON FRAUNHOFER

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Appeal No. 1998-2273  
Application 08/504,679

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ON BRIEF

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Before KIMLIN, WARREN and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 23. Claims 24 and 25 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b). Claim 1 is illustrative of the claims on appeal:

1. A method of treating metallic surfaces for corrosion inhibition, comprising the steps of:
  - a. introducing tobacco into a solution selected from the group consisting of alkaline media and basic media;
  - b. extracting tobacco residue from the tobacco in solution;and
  - c. applying the tobacco residue extracted in accordance with step “b” to the metallic surface.



*Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). It is further well settled that “[a]n inventor need not . . . explain every detail [of the invention] since he is speaking to those skilled in the art. What is conventional knowledge will be read into the disclosure. Accordingly, an applicant’s duty to tell all that is necessary to make or use varies greatly depending upon the art to which the invention pertains.” *In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981).

We interpret claims 1 and 13 in light of appellant’s specification as it would be interpreted by one of ordinary skill in this art, *see generally*, *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), to encompass methods of inhibiting corrosion of metallic surfaces with a tobacco residue extracted from “tobacco,” which term include leaves and other plant parts, by subjecting the tobacco to basic media or steam environment. These claims thus cover the application to a metallic surface of any residue extracted from tobacco by a solution of even slightly basic media, which includes water, or by steam. We find that it would be apparent to one skilled in the art that almost any substance covering a metallic surface would provide at least *temporary* immunity by *delaying* onset of corrosion, and thus is a Type IIA corrosion inhibitor, and therefore, it would not be necessary for appellant to describe to this person the exact nature of the extracted tobacco residue. Indeed, according to the written description in appellant’s disclosure, any extracted tobacco residue would provide at least this type of corrosion inhibition.

Accordingly, the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the objective enablement set forth in the specification would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation. We have carefully considered the examiner’s explanation based on the analysis “factors” set forth in *Wands, supra*, citing *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986), which appears in the record for the first time in the answer (pages 5-7), apparently because of appellant’s arguments in the brief (pages 2-6) demonstrate that the examiner had not previously carried the burden of establishing a *prima facie* case of

nonenablement based on undue experimentation. We determine that the examiner still has not carried this burden because the reasons provided under each of the *Wands* “factors” simply do not establish that one skilled in this art would have to engage in undue experimentation in order to practice this straight forward invention in light of the enablement provided to this person in the written description of appellant’s specification. Accordingly, we reverse this ground of rejection.

We now turn to the ground of rejection under § 103(a). The examiner contends that Merrell would have disclosed to one of ordinary skill in this art that “[r]esidue is removed from the tobacco, through the solution and pulping and heating with steam,” and is used in a solution to inhibit corrosion of the surfaces of a boiler, which the examiner finds to be made of a metallic material, because “the same materials would come from the extraction process, whether the solution was acidic or basic,” and while Merrell uses other components in the solution, the “mere application of tobacco residue is sufficient to meet the requirements of the claims” (answer, pages 8-9 and 13-15). We agree with the examiner’s position.

We find that the claimed methods encompassed by appealed claims 1 and 13 would include the use of other components in the extraction and application steps, such as the other raw materials of Merrell (lines 10-16), in view of the transitional term “comprising” which opens each of these claims to other steps and ingredients. *See, e.g., In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”). The use of the extracted residue produced by the process of Merrell when added to the boiler water would act as a Type IIA corrosion inhibitor, which satisfies the last step of the claimed method as encompassed by each appealed claim. Indeed, Merrell does use a “steam environment” which satisfies that limitation in claim 13, and on this record it would reasonably appear that the water inside the digester would be at least slightly “alkaline,” that is, “basic media” as specified in claim 1. We do not find in claim 1 a requirement that the application of the “tobacco residue extracted” must be from an “alkaline,” that is, “basic media” in which it was extracted, and Merrell does teach that the “product or pulp is removed or drawn off into cans for use” and then included in the boiler water solution. Claim 13 has no limitation with respect to either the pH of the steam environment or of the solution in

which it is used. Accordingly, *prima facie*, it is apparent that the claimed method of corrosion inhibition is identical or substantially identical to the process taught by Merrell. Thus, the burden falls upon appellants to establish by effective argument or objective evidence that the claimed invention patentably distinguishes over Merrell. *In re Best*, 562 F.2d 1252, 1254-56, 195 USPQ 430, 432-34 (CCPA 1977). Moreover, while the issue here has been framed by the examiner as one of obviousness under § 103, it reasonably appears to us that the method of Merrell falls within appealed claims 1 and 2, which is indeed evidence of a lack of novelty of the claimed invention as encompassed by the appealed claims that is, of course, “the ultimate of obviousness.” *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). Thus, to the extent that the method of Merrell anticipates the claimed method encompassed by appealed claims 1 and 13, the case of obviousness is irrebuttable. *Id.*

Accordingly, since a *prima facie* case of obviousness has been established over the applied prior art, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant’s arguments. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We have carefully considered all of appellant’s arguments (brief, page 7-9) and we agree with the examiner’s response thereto (answer, pages 13-15). We note again here for emphasis that appealed claim 1 does not specify that the application of the tobacco residue to the metal surface must be from an even slightly basic solution, and with respect to both claim 1 and claim 13, it is sufficient that the claimed invention and the disclosure of Merrell follow the same method steps even if the reasons for doing so are not the same, as the examiner points out (answer, pages 14-15).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Merrell with appellant’s countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1, 3, 4, 8, 13, 15, 16 and 19 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed-in-part.

*Other issues*

Further prosecution of the appealed claims before the examiner should include consideration of the following issues.

The appealed claims should be reviewed for compliance with 35 U.S.C. § 112, second paragraph, because it reasonably appears that at least several claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, claims 3 and 4 merely recite "a particular temperature" without specifying any temperature and the specification does not provide a specific definition of the term. Similarly, for example, the terms "static extraction" and "dynamic extraction" in claim 6 are not defined in such a generic manner in the written description in the specification (e.g., pages 18-20) or appear to have a common meaning in the art.

Claims 8 and 19 appear to be duplicates. In the event that these claims are held to be allowable, see Manual of Patent Examining Procedure § 706.03(K) Duplicate Claims (8th ed., Rev. 1, Feb. 2000; 700-34).

Finally, the appealed claims should be compared with claims 1 through 15 of United States Patent 5,435,941, issued July 25, 1995 from parent application 08/349,966, with respect to whether issues of double patenting arise.

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

*AFFIRMED-IN-PART*

