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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK H. KILAWEE, LEONARD J. KADLEC,
JAMES R. MOCK, SR., and MARNIE J. LIETZ

Appeal 2016-008179
Application 13/303,915
Technology Center 1700

Before JAMES C. HOUSEL, CHRISTOPHER C. KENNEDY, and
MICHAEL G. McMANUS, *Administrative Patent Judges*.

HOUSEL, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellants¹ request rehearing of a DECISION ON APPEAL dated September 29, 2017,² affirming the Examiner's decision that claims 1–11 are unpatentable over the prior art of record.

A Request for Rehearing³ must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the Briefs before the Board and evidence not previously relied upon in the Briefs are not permitted in a Request for

¹ According to Appellants, the real party in interest is Ecolab USA Incorporated. Appeal Br. 2.

² Hereinafter, "Decision."

³ Hereinafter, "Request".

Rehearing except as permitted by 37 C.F.R. §§ 41.52(a)(2) and (a)(3). *See* 37 C.F.R. § 41.52(a)(1)(2015).

We have reconsidered our Decision, in light of Appellants' comments in the Request, and we find no error in the disposition of the affirmed rejections. We remain of the opinion that the subject matter of the claims is unpatentable in view of the applied prior art.

I.

The Board's Decision affirmed the Examiner's rejections under 35 U.S.C. § 103(a) of

claims 1, 6–8, 10, and 11 as unpatentable over Kadlec (US 2006/0283808, published Dec. 21, 2006) in view of Allen (US 5,422,014, issued June 6, 1995) as evidenced by Robinson (R. A. Robinson et al., *The 'Strong' Acids*, Electrolyte Solutions, 370-391 (2002) (Dover Publ.));

claims 2–4 as unpatentable over the above combination further in view of Chandler (WO 01/19957 A2, published Mar, 22, 2001);

claim 5 as unpatentable over the combination of Kadlec, Allen, and Robinson, further in view of Forsberg (US 6,058,718, issued May 9, 2000); and

claim 9 as unpatentable over the combination of Kadlec, Allen, and Robinson, further in view of Biberger (US 2010/0188236 A1, published July 29, 2010).

In the Request, Appellants argue that the Decision misapprehends or overlooks Appellants' argument with respect to Allen and Kadlec (Req. 2). In particular, Appellants urge that the argument is not that Allen's manifold must be bodily incorporated into Kadlec, but instead that neither Kadlec nor

Allen teaches or suggests that a manifold as recited in claim 1 should or could be incorporated into Kadlec's system (*id.*). Further, Appellants argue that, because the Decision admits Kadlec fails to disclose a manifold as claimed, nor the specific arrangement of the manifold inlets, Kadlec contains no teaching whatsoever concerning incorporation of a manifold of any kind (*id.*). Therefore, according to Appellants, Kadlec "may not be properly relied upon as teaching or suggesting anything with respect to incorporation of a manifold into its system, much less why or how the further specific modifications that would need to be made to the Allen manifold should or even could be made" (*id.* at 2–3).

Appellants further argue that the Decision overlooked that neither Kadlec nor Allen teaches or suggests a system in which a sanitizer sensor is outside the manifold and in which the inlets are ordered as recited in claim 1 (*id.* at 3). Appellants contend that the Decision fails to provide any evidentiary basis for such modifications and overlooks Appellants' traversal of an alleged taking of Official Notice by the Examiner in the Reply Brief on the basis that, at the very least, Allen teaches away from the claimed order (*id.* at 3–4).

Appellants further argue that the Decision is unsupported and improper with regard to the alleged assertion that modification of Kadlec to include a manifold only requires integrating the flows of sampled water, acid, and sanitizer, while leaving Kadlec's sample cell unmodified (*id.* at 5). According to Appellants, the Decision overlooks that neither Kadlec nor Allen provides any basis for this assertion (*id.* at 5–6).

In addition, Appellants argue that the Decision's assertion that Allen does not teach away because Allen does not criticize, discredit, or otherwise

discourage a different order when the sample cell is separated from the flows of sample water, acid, and sanitizer as taught in Kadlec is also unsupported and improper (*id.* at 6). According to Appellants, Allen does discourage not having the acid upstream of the oxidation-reduction potential (ORP) sensor (*id.* at 7), because Allen recognizes that the acid may assist in removing scale deposits on the sensor (*id.*).

As such, Appellants reiterate their arguments that modifying Kadlec to include a manifold and to further modify that manifold to include the arrangement of inlets as recited in claim 1 would not have been obvious to one of ordinary skill in the art absent impermissible hindsight (*id.* at 8).

II.

Appellants request our reconsideration of the affirmance of the rejections of claims 1–11, but limit their arguments to claim 1. Accordingly, we address Appellants' Request focusing on claim 1 only.

Though Appellants argue that Kadlec's lack of a manifold negates reliance on Kadlec as teaching anything regarding incorporation of a manifold into its system, we disagree. The Decision states that the Examiner "finds Kadlec teaches water from the sample cell is input into the circulation system prior to the sanitizer and acid inputs, and that the sanitizer is purposefully added downstream of the sensor so that it does not affect the reading" (Dec. 5). Contrary to Appellants' arguments, these teachings are relevant to how a manifold would have been incorporated into Kadlec's system. In particular, these teachings provide the logical basis for keeping Kadlec's sample cell outside the manifold to prevent sanitizer added downstream thereof from affecting its readings.

Moreover, there is no dispute that Allen discloses a manifold for use in an automated system for maintaining a body of water. Appellants, however, contend that Allen teaches away from the particular inlet order recited in claim 1 because Allen teaches that placement of the acid input upstream of the ORP sensor allows for removal of scale deposits therefrom. However, as the Decision states, the Examiner merely relies on Allen for the use of a manifold to handle the various inflows into the circulation system in Kadlec, not on Allen's inlet order (Dec. 8). In addition, the Decision states that although Allen provides a specific reason for arranging the acid upstream of the ORP and pH sensors, Allen does not discourage a different order, particularly where the sample cell is separated from the flows of sampled water, sanitizer, and acid as in Kadlec (Dec. 10).

Moreover, merely teaching an advantage of one arrangement alone does not discourage other arrangements. “[M]ere disclosure of alternative designs does not teach away.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). “A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009). Rather, teaching away requires “clear discouragement” from implementing a technical feature. *In re Ethicon, Inc.*, 844 F.3d 1344, 1351 (Fed. Cir. 2017). “A reference teaches away when it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1354 (Fed. Cir. 2012) (quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (quotations omitted)).

Accordingly, Appellants have not persuasively shown that the Board misapprehended or overlooked any of the arguments raised in the Briefs, or that the Decision should otherwise be modified or reversed.

III.

Appellants' Request for Rehearing has been granted to the limited extent that the Decision has been reconsidered in light of Appellants' arguments. However, the Request is otherwise denied, and the Decision is not modified in any respect.

This Decision on the Request for Rehearing incorporates our Decision, mailed September 29, 2017, and is final for the purposes of judicial review. *See* 37 C.F.R. § 41.52(a)(1).

IV.

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

REHEARING DENIED