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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM BOROUGHF

Appeal 2018-002722
Application 13/538,412
Technology Center 3700

Before EDWARD A. BROWN, BENJAMIN D. M. WOOD, and
BRANDON J. WARNER, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

William Boroughf (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–3, 5, 6, 12, 13, 17, and 21–24. Appeal Br. 2. Claims 4, 11, 14–16, and 18–20 have been withdrawn. *Id.* We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "in general relates to the collection, storage and disposal of used and spent liquids, and in particular to a disposable oil change kit for servicing engines." Spec. ¶ 2. Claim 1, reproduced below, is the sole independent claim and is representative of the subject matter on appeal.

1. A liquid disposal tool for the collection and disposal of liquids comprising:
 - a container with a bottom portion and a set of walls;
 - a peat moss absorbent resting on said bottom portion within said walls, said absorbent configured to collect said liquid;
 - a top cover diffuser;
 - an insert tray overlaying said absorbent, said insert tray contoured with a series of rows of conical depressions protruding downward into said absorbent layer, and a series of flat top protrusions in the series of rows, said series of flat top protrusions extending upward from said insert tray with a series of gaps that define the series of rows between the flat top protrusions; andwherein said flat top protrusions are wider than said gaps, where said gaps serve as channels to distribute the liquid or hydrocarbon materials, and said flat top protrusions serve as supports and as attachment points for said top cover diffuser.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:¹

Kahler	US 5,716,840	Feb. 10, 1998
Berrigan	US 5,763,083	June 9, 1998
MacQuoid	US 2003/0121802 A1	July 3, 2003
Hayakawa	US 6,793,092 B1	Sept. 21, 2004
Walker	US 2010/0043717 A1	Feb. 25, 2010
Hurwitz	US 2010/0136128 A1	June 3, 2010
St. Pierre	US 2011/0174740 A1	July 21, 2011
Pearce	US 2011/0253930 A1	Oct. 20, 2011
Hunter	US 2012/0311972 A1	Dec. 13, 2012
Simmons	US 8,479,945 B1	July 9, 2013

REJECTIONS

The following rejections are before us for review:

- I. Claims 1–3, 5, 6, 12, 13, 17, and 21–24 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3–4; *see also id.* at 2 (objecting to proposed amendments to the drawings and the Specification for the same issues regarding lack of original disclosure).

¹ We note that the latest prior art rejection of record, from which this appeal is taken, is based on Simmons; however, the remaining references listed have been previously made of record in this application and are cited by the Examiner as exemplary evidence that certain features or arrangements specified in the claims were known in the art at the time of the invention.

- II. Claims 1–3, 5, 6, 12, 13, 17, and 21–24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. *Id.* at 4.
- III. Claims 1–3, 5, 6, 12, 13, 17, and 21–24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Simmons. *Id.* at 5–6.

ANALYSIS

Rejection I – Written Description

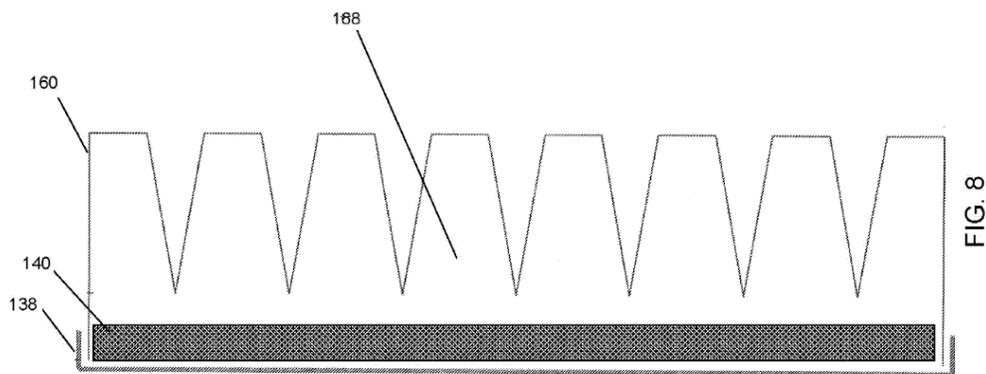
The Examiner finds that various claim recitations lack written description support, as they “were not described in applicant’s original specification in such a way as to show possession of the claimed invention by applicant (including some that are not described in the original specification at all).” Final Act. 3. In particular, with respect to the recited insert tray overlaying the absorbent, the Examiner identifies the current limitation “said insert tray [being] contoured with a series of rows of conical depressions protruding downward into said absorbent layer,” as presently recited in independent claim 1, to lack written description. *See id.*

The fundamental factual inquiry for sufficient written description is whether Appellant’s Specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Appellant was in possession of the invention as presently claimed. *See Ariad Pharms., Inc., v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–64 (Fed. Cir. 1991).

Appellant characterizes the proposed additions to the disclosure as an attempt to “show with further clarity,” or to “describe in further detail,” features now recited in the claims. Appeal Br. 9, 13. Specifically, Appellant

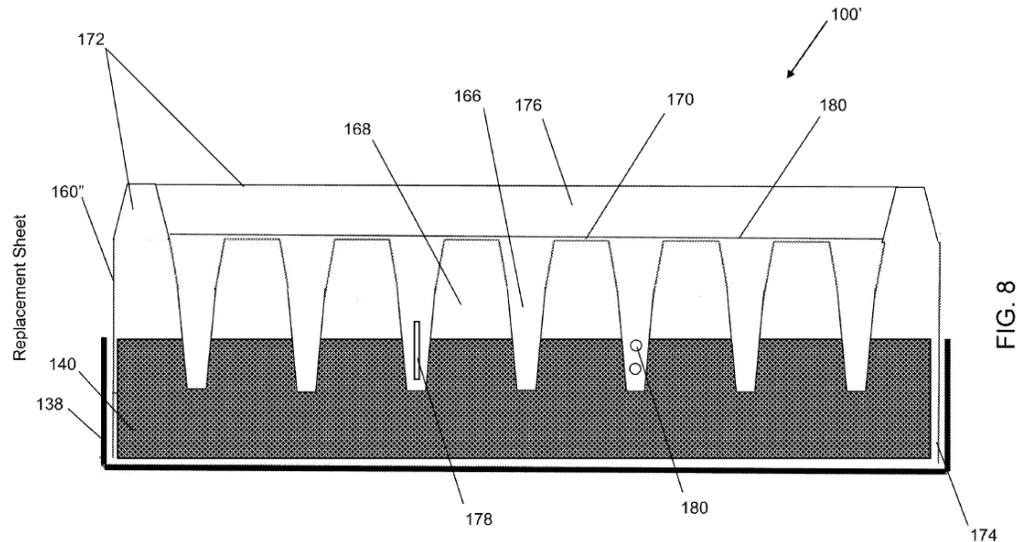
acknowledges that Figure 8 was proposed to be “amended to show the feature of the depressions 166 protruding into the absorbent 140,” asserting that this feature “was described throughout the original specification.” *Id.* at 9. In support of this assertion, Appellant directs us to Paragraph 26, but this portion of the disclosure relates to a non-elected sub-species (Group 2); as the Examiner correctly notes, Appellant does not identify disclosure of this feature in the context of the elected sub-species (Group 3). *See id.*; Ans. 6–7; *see also* Ans. 4 (referencing Appellant’s election made without traverse).

We are unpersuaded by Appellant’s characterization. As reproduced below, original Figure 8 depicts tray insert 160 overlaying absorbent 140 (contained within under tray 138), with depressions (unnumbered in this figure, but understood to be the lowermost “points” of tray insert 160) spaced above absorbent 140.



Appellant’s original Figure 8, above, does not disclose the identified limitation of the insert tray being “contoured with a series of rows of conical depressions protruding downward into said absorbent layer,” as now recited in claim 1.

In contrast, as reproduced below, proposed amended Figure 8 depicts a different embodiment of tray insert 160'' shown to be partially overlaying absorbent 140 (contained within under tray 138), with portions of this tray insert now protruding downward into absorbent 140.



Appellant's proposed amendments to Figure 8, above, which admittedly appear to depict the identified limitation now recited in claim 1, are not supported in the original disclosure, as the Examiner states.

Although we appreciate that one of ordinary skill in the art may understand from the original disclosure that the amount of absorbent in the tray may be varied (albeit from the context of a non-elected sub-species), the test for sufficient disclosure is not what may have been obvious in light of the original disclosure, but what was actually disclosed. In this way, the written description requirement of the first paragraph of 35 U.S.C. § 112 demands a fairly exacting description of the claimed invention in the Specification. *See Ariad*, 598 F.3d at 1352 (“a description that merely renders the invention obvious does not satisfy the requirement”); *see also*

MPEP § 2163 (“The Federal Circuit has pointed out that, under United States law, a description that merely renders a claimed invention obvious may not sufficiently describe the invention for the purposes of the written description requirement of 35 U.S.C. [§] 112.”) (citing *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1567 (Fed. Cir. 1997)).

In short, because we are not apprised of error in the Examiner’s finding that Appellant’s original Specification does not disclose the identified features now recited in the independent claim, we sustain the rejection based on lack of written description.

Rejection II – Indefiniteness

The Examiner also determines that the unsupported claim limitations (as in Rejection I above) also render the claims indefinite because “the limitations added to the claims cannot be properly interpreted.” Final Act. 4.

Although we agree with the Examiner that the claim recitations are not adequately supported by the original disclosure, as discussed in Rejection I above, the requirement for definiteness is separate and distinct. The Examiner does not explain how any limitations would be *unclear* to one of ordinary skill in the art—indeed, the ability to reasonably discern the metes and bounds of the claims is a necessary prerequisite to a finding that they are unsupported by the original disclosure.

Accordingly, because we are able to define the scope of the claims, we do not sustain the rejection based on indefiniteness.

Rejection III – Obviousness over Prior Art

The Examiner determines that incorporation of known design choices with Simmons renders obvious the claimed subject matter. *See* Final Act. 5–6; Ans. 13–14. In arguing against the prior art rejection, Appellant relies on an asserted deficiency in Simmons alone as sufficient evidence to support that some recited limitations (e.g., the absorbent being peat moss and “perhaps the depressions protruding downwardly into the absorbent layer” (Appeal Br. 16)) are not expressly shown in Simmons. *See* Appeal Br. 15–17. More generally, Appellant asserts that the rejection is deficient because “no evidence is of record to support the findings” related to these identified limitations. *Id.* at 15.

We are unpersuaded by Appellant’s assertion, which ignores the evidence of various other prior art references made of record in this case. *See* note 1 *supra*. In other words, contrary to Appellant’s assertion, the Examiner has provided evidence in the record for these findings sufficient to put Appellant on notice as to the factual basis for the conclusion of obviousness. For example, peat moss being a suitable absorbent was disclosed in at least Hunter, Pearce, MacQuoid, and Kahler (*see* Ans. 14), and at least substantially filling the interior of a housing for collecting oil with an oil absorbent material was disclosed in at least Kahler and Hayakawa (*see* Final Act. 5–6; Ans. 14) such that doing so in the structure of Simmons would result in the depressions protruding downwardly into the absorbent layer.

In short, because Appellant’s assertions do not demonstrate any lack of evidentiary support in the record for the Examiner’s conclusion of

obviousness, we are not apprised of error and we sustain the rejection based on the prior art.

DECISION

We AFFIRM the Examiner's decision rejecting claims 1–3, 5, 6, 12, 13, 17, and 21–24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We REVERSE the Examiner's decision rejecting claims 1–3, 5, 6, 12, 13, 17, and 21–24 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We AFFIRM the Examiner's decision rejecting claims 1–3, 5, 6, 12, 13, 17, and 21–24 under 35 U.S.C. § 103(a) as being unpatentable over Simmons.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED