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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/457,961	03/13/2017	Maura Elizabeth Erwin	Erwin-1	8109
32132	7590	06/18/2020	EXAMINER	
LAMORTE & ASSOCIATES P.C. P.O. BOX 434 YARDLEY, PA 19067			CLEVELAND, TIMOTHY C	
			ART UNIT	PAPER NUMBER
			1774	
			NOTIFICATION DATE	DELIVERY MODE
			06/18/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MAURA ELIZABETH ERWIN

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Appeal 2019-004831  
Application 15/457,961  
Technology Center 1700

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Before CATHERINE Q. TIMM, BRIAN D. RANGE, and  
DEBRA L. DENNETT, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–5, 7–12, and 16. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Maura E. Erwin. Appeal Br. 2.

CLAIMED SUBJECT MATTER<sup>2</sup>

Appellant describes the invention as relating to a device for sanitizing a handheld implement such as a pen or pencil. Spec. 1:5–12. The Specification explains that placing the object in an alcohol solution (as barbers do might do with a razor) will harm a pen or marker’s ability to write. *Id.* at 2:13–3:10. Ultraviolet light systems may also have disadvantages. *Id.* at 4:5–22. Thus, the invention seeks to improve upon prior art systems. *Id.* at 4:23–5:7. Figure 2, reproduced below, illustrates the invention.

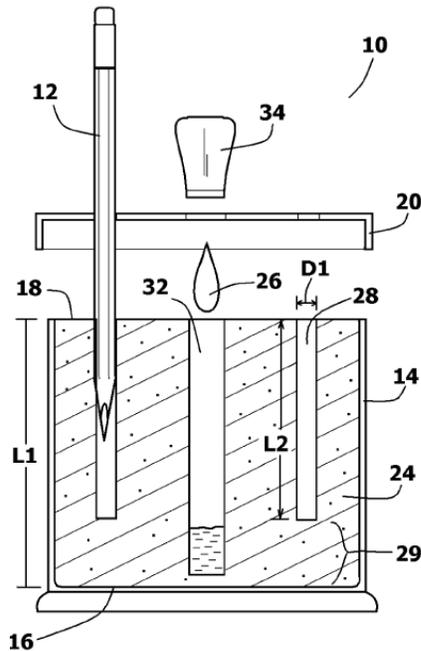


FIG. 2

Figure 2 is a cross-sectional view of an exemplary embodiment of a sanitizing station shown in conjunction with some writing implements. Spec.

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<sup>2</sup> In this Decision, we refer to the Final Office Action dated October 9, 2018 (“Final Act.”), the Appeal Brief filed February 6, 2019 (“Appeal Br.”), and the Examiner’s Answer dated March 28, 2019 (“Ans.”).

6:22–7:2. As Figure 2 depicts, parallel hollow shafts 28 are formed in the body of open cell foam 24. Spec. 8:22–9:1. Important to the decision below, the Specification describes Figure 2’s solid area 29 as follows: “solid area 29 within the body of open cell foam 24 . . . exists below the hollow shafts 28 but above the closed bottom 16 of the container 14.” *Id.* at 9:4–6.

Claims 1 and 10 are the only independent claims on appeal. Claim 1 is illustrative and is reproduced below with emphasis added to certain recitations argued on appeal:

1. A device for holding and sanitizing handheld implements, comprising:
  - a container having a closed bottom and an open top, wherein a first length exists between said open top and said closed bottom;
  - a body of open cell foam disposed in said container;
  - a plurality of hollow shafts formed in said body of open cell foam are accessible through said open top of said container, and wherein each of said plurality of hollow shafts has a second length that is less than said first length, therein leaving an uninterrupted area of said body of open cell foam interposed between said plurality of hollow shafts and said closed bottom of said container; and
  - a volume of a liquid disinfectant only sufficient to partially fill said container where occupied by said uninterrupted area of said body of open cell foam**, wherein said body of open cell foam wicks at least some of said volume of said liquid disinfectant around each of said plurality of hollow shafts.

Appeal Br. 18 (Claims App.). Claim 10 similarly recites, among other things, “a liquid disinfectant held within said container at a volume only sufficient to partially saturate said uninterrupted area of said open foam material.” *Id.* at 20.

## REFERENCES

The Examiner relies upon the prior art below in rejecting the claims on appeal:

<u>Name</u>	<u>Reference</u>	<u>Date</u>
Price	US 6,142,297	Nov. 7, 2000
Martz	US 6,270,275 B1	Aug. 7, 2001
Scheuing et al. ("Scheuing")	US 2010/0143494 A1	June 10, 2010
Vaillancourt et al. ("Vaillancourt")	US 2011/0030726 A1	Feb. 10, 2011

## REJECTIONS

The Examiner maintains (Ans. 3) the following rejections on appeal:

- A. Claims 1–5, 7–12, and 16 under 35 U.S.C. § 112 as indefinite. Ans. 3.
- B. Claims 4 and 12 under 35 U.S.C. § 112 as being in improper dependent form. *Id.* at 4.
- C. Claims 1, 3, 5, 7, 8, and 10 under 35 U.S.C. § 103 as obvious over Price in view of Vaillancourt. *Id.* at 4.
- D. Claims 2 and 11 under 35 U.S.C. § 103 as obvious over Price in view of Vaillancourt and Scheuing. *Id.* at 6.
- E. Claims 9 and 16 under 35 U.S.C. § 103 as obvious over Price in view of Vaillancourt and Martz. *Id.* at 7.

## OPINION

Rejection A, claims 1 and 10. The Examiner rejects claims 1 and 10 under 35 U.S.C. § 112 as indefinite. Ans. 3–4. In particular, the Examiner determines that these two independent claims are unclear because a person of ordinary skill “would not be able to interpret the metes and bounds of the claim” in view of the claims’ “only sufficient” recitation concerning volume of liquid disinfectant. *Id.* Appellant does not address this rejection. We,

therefore, summarily sustain the Examiner's rejection of claims 1 and 10. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential), (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”)). We also sustain the Examiner’s rejection of claims 2–5, 7–9, 11, 12, and 16 to the extent the Examiner’s rejection is based upon these claims being dependent on claims 1 and 10.

Rejection A, claim 7. Claim 7 recites, “[t]he device according to Claim 1, wherein said volume of liquid disinfectant is only sufficient to fully saturate said uninterrupted area of said body of open cell foam between said hollow shafts and said closed bottom of said container.” Independently of the rejection of claim 1 from which claim 7 depends, the Examiner rejects claim 7 under 35 U.S.C. § 112 as indefinite. Ans. 3.

During prosecution, “[a] claim is indefinite when it contains words or phrases whose meaning is unclear.” *Ex parte McAward*, Appeal No. 2015-006416, at 11 (PTAB Aug. 25, 2017) (quoting *In re Packard*, 751 F.3d 1307, 1314 (Fed. Cir. 2014)). Here, the Examiner determines that the “metes and bounds” of claim 7 are unclear because it is not clear whether full saturation is determined before or after the liquid is wicked by the remainder of the body of open cell foam. Ans. 3.

Appellant argues that the claim is clear and encompasses “liquid disinfectant . . . added in a volume that just fully saturates the body of open cell foam.” Appeal Br. 6. Appellant cites the Specification at 13:14–14:3 as clarifying the meaning of claim 7.

We agree with Appellant that claim 7 is not unclear. We begin by addressing the claims’ recited “uninterrupted area.” In particular, the

Specification defines solid area 29 in substantially the same manner claim 1 defines the recited “uninterrupted area.” The Specification explains that solid area 29 exists below the hollow shafts 28 but above the closed bottom 16 of the container 14. *Id.* at 9: 4–6; *see also* Fig. 2. Similarly, claims 1 and 10 recite that the uninterrupted area is the “body of open cell foam interposed between said plurality of hollow shafts and said closed bottom of said container.” Appeal Br. 18 (Claims App.). We, therefore, determine that the recited “uninterrupted area” is the body of open cell foam open cell foam located below the lowest point of the plurality of shafts but above the closed bottom of the container as illustrated by, for example, solid area 29 of Figure 2.

We next address claim 7 and wicking. Claim 1, which claim 7 depends from, recites that “said body of open cell foam wicks at least some of said volume of said liquid disinfectant around each of said plurality of hollow shafts.” Appeal Br. 18 (Claims App.); *see also* Spec. Fig. 2. The Specification explains how the invention seeks to avoid immersing a pen in liquid disinfectant because doing so will harm the pen’s ink. Spec. 1:14–5:7. With this context in mind, the Specification explains how “the body of open cell 24 foam reaches [a] saturation point” but “the level of the pooled disinfectant 26 will be below the bottom of the hollow shafts 28 that hold the writing implements 12.” *Id.* at 13:14–14:3.

Given the context provided by the Specification and the recitations of claims 1 and 7, a person of skill in the art also would have understood that claim 7 requires an amount of liquid disinfectant sufficient to fully saturate the uninterrupted area of the open cell foam. Claim 1’s recitations recognize that wicking of disinfectant above this area will occur. If liquid disinfectant

is wicked away from the uninterrupted area such that the uninterrupted area can still hold more liquid, then the uninterrupted area of the open cell foam will not be saturated. Thus, the Examiner's concern as to whether or not claim 7 determines saturation before or after wicking (Ans. 3, 7-8) is not well founded. We, therefore, do not sustain this rejection.

Rejection B, improper dependent form of claims 4 and 12. The Examiner rejects claims 4 and 12 under 35 U.S.C. § 112 as being in improper dependent form. *Id.* at 4. Claims 4 and 12 each recite a "fill bore" extending "into said uninterrupted area." Appeal Br. 19, 21 (Claims App.). As we understand the rejection, the Examiner determines that independent claims 1 and 10 require an "uninterrupted area" and that dependent claims 4 and 12 create a bore in the "uninterrupted area" such that the area is no longer "uninterrupted." Ans. 4, 8. Thus, in the Examiner's view, claims 4 and 12 present recitations contradictory to the recitations of claims 1 and 10.

Appellant argues that the "uninterrupted area" is the same as what the Specification refers to as solid area 29. Appeal Br. 7-8. We addressed the meaning of "uninterrupted area" above. Based on this construction, "uninterrupted" does not mean that the area must be solid foam. Just to the contrary, the claim states that the "uninterrupted area" is a "body of open cell foam." The term "uninterrupted," therefore, merely means that the area is not interrupted by the claims' "hollow shafts." Dependent claims 4 and 12 require a bore hole within the uninterrupted area, and independent claims 1 and 10 do not forbid such a hole. *See* Spec. Fig. 2. We, therefore, do not sustain this rejection.

Rejections C-E, obviousness. The Examiner rejects claims 1, 3, 5, 7, 8, and 10 under 35 U.S.C. § 103 as obvious over Price in view of

Vaillancourt. *Id.* at 4. The Examiner applies Scheuing as an additional reference in rejecting claims 2 and 11 (*id.* at 6) and applies Martz as an additional reference in rejecting claims 9 and 16 (*id.* at 7). We focus our discussion on error identified by Appellant.

The Examiner finds that Price teaches a container (tube 34) with a reservoir 50 and disinfecting liquid 52 held within the container. Ans. 4–5 (citing Price). The Examiner finds that Price does not teach holding “writing implements” but determines that Price is capable of such a use. *Id.* at 5. The Examiner finds that Price does not teach open cell foam. *Id.*

The Examiner finds that Vaillancourt teaches a device for scrubbing and sanitizing female luer devices (i.e., a needle-less connector (Vaillancourt ¶ 11)). Ans. 5–6 (citing Vaillancourt). The Examiner finds that “Vaillancourt discloses that the foam . . . absorb[s] and hold[s] the anti-bacterial solution with no leak-out.” *Id.* at 6. The Examiner explains why it would have been obvious to reach the fill recitations of claim 1 as follows:

a volume which is only sufficient to at least partially fill, to fully saturate, or to at least partially saturate the uninterrupted area of the open cell foam in the above combined apparatus would have been obvious to one of ordinary skill in the art because overfilling the foam material would produce leak-out and under filling the foam would have not resulted in enough solution to provide the desired results of sanitization of the workpiece.

*Id.*

Appellant argues that the Examiner has not adequately explained why use of a limited reservoir (i.e., a reservoir having claims 1 and 10’s recited volume) would have been obvious. Appeal Br. 13. We agree. In particular, the Price device is designed to sterilize thermometers. Appeal Br. 10–11;

Price 1:5–8. Price is content with dipping the thermometers in liquid. *See* Price Fig. 1 (showing sanitizing medium 52 covering probe 16); 2:51–58.

Vaillancourt, meanwhile, teaches a semi-closed cell foam insert impregnated with solution. Appeal Br. 11; Vaillancourt ¶¶ 68–70. Vaillancourt specifies what kind of foam should be used and the configuration of the foam as follows:

The insert **22** is made of a semi-closed cell, hydrophilic polyurethane medical grade foam with a moderate absorption rate. **The foam configuration and size is such as to hold 0.5 cc of an anti-bacterial solution with no solution leak-out.**

Vaillancourt ¶ 70 (emphasis added).

Vaillancourt paragraph 70 does not refer to “leak-out” as a problem to be solved. Rather, Vaillancourt teaches that its foam should be crafted such that it can hold 0.5 cc of anti-bacterial solution without leak-out.

Vaillancourt ¶ 70. Leak-out, in this context, refers to solution leaking out of the foam—not solution leaking out of the device. We note that Vaillancourt also suggests using 0.5 cc of anti-bacterial solution in conjunction with its device. *Id.* at ¶¶ 9, 98 (teaching embodiments using 0.50 cc of solution).

Thus, Vaillancourt suggests, for its device, using an amount of solution equivalent to the amount of solution the foam can hold—i.e., saturating the foam with the solution.

The Examiner, however, has not adequately explained why a person of skill in the art would have had reason to include Vaillancourt’s saturated foam into Price. Rather, the Examiner relies on avoiding “leak-out” as the reason for combining Vaillancourt’s foam with Price’s device. Ans. 6, 8. But the Examiner does not persuasively articulate why a person of skill in the art would have incorporated Vaillancourt’s foam into Price or why a person of

skill in the art, even if they incorporated Vaillancourt’s foam into Price, would have been concerned with disinfectant leaking out from the foam given that Price has no concern with disinfectant directly touching thermometers.

We, therefore, do not sustain the Examiner’s rejection of claims 1 and 10 as obvious over Price and Vaillancourt. Because the Examiner’s treatment of dependent claims does not cure the error addressed above, we also do not sustain the Examiner’s rejection of the dependent claims.

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–5, 7–12, 16	112	definiteness	1–5, 7–12, 16 <sup>3</sup>	
4, 12	112	improper dependent form		4, 12
1, 3, 5, 7, 8, 10	103	Price, Vaillancourt		1, 3, 5, 7, 8, 10
2, 11	103	Price, Vaillancourt, Scheuing		2, 11
9, 16	103	Price, Vaillancourt, Martz		9, 16
<b>Overall Outcome</b>			<b>1–5, 7–12, 16</b>	

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<sup>3</sup> As explained in this decision, we affirm the indefiniteness rejection of these claims to the extent the rejection is based claim 1 and claim 10’s recitation of “a volume of a liquid disinfectant only sufficient to partially fill said container where occupied by said uninterrupted area of said body of open cell foam.” We do not sustain the Examiner’s rejection based on claim 7’s recitation of “only sufficient to fully saturate.”

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TIME PERIOD FOR RESPONSE

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