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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HEATHER J. SWANSON, NEYSA VOLKERT, JOEL E. ADAIR,
BRIAN T. DAVIS, SYATRIZAL HAMDALLAH, and
MAUDE CHRISTIAN MEIER

Appeal 2019-004921
Application 14/079,215
Technology Center 1600

Before ERIC B. GRIMES, RICHARD M. LEBOVITZ, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 2–11, 14, 15, and 18–23. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as S. C. Johnson & Son, Inc. Appeal Br. 2.

The prosecution in this application was continued as a “Request for Continued Application,” filed August 27, 2018, after a Board Decision entered July 20, 2018 in the same application affirmed the Examiner’s rejections of all pending claims (Decision on Appeal in Appeal No. 2017-008500 (“8500 Dec.”)).

Claims 2–11, 14, 15, and 18–23 stand finally rejected by the Examiner as follows:

1. Claims 2–11, 14, 15, and 18–23 under 35 U.S.C. § 112(b) (2012) or 35 U.S.C. § 112, second paragraph (2006), as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Final Act. 2.

2. Claims 2–11, 14, 15, and 18–23 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Final Act. 3–4.

3. Claims 2–11, 14, 15, and 18–23 under 35 U.S.C. § 102(a)(1) (2006) as anticipated by Balakrishnan et al. (US 2008/0226685 A1, published Sept. 18, 2008) (“Balakrishnan”). Final Act. 4.

4. Claims 2–11, 14, 15, and 18–23 under 35 U.S.C. § 103(a) (2006) as obvious in view of Balakrishnan. Final Act. 12.

Independent claim 18 is representative and is reproduced below:

18. A method of providing a passive volatile material dispenser to consumers, comprising:

providing a sealed pouch containing a passive volatile material dispenser having instructions, the passive volatile material dispenser comprising a porous substrate impregnated with an insect control active,

wherein the porous substrate has a TAPPI T 489 om-13 or TAPPI T 566 om-08 minimal bending moment of about 150 to about 275 g-cm,

wherein the porous substrate comprises a first wall portion and a second wall portion hingedly connected along a first hinge, and separably connected,

wherein the porous substrate comprises only the first hinge,

wherein upon activation the dispenser exhibits an effective release rate of the insect control active of about 0.1 to about 0.3 mg/hr, and

wherein the instructions direct a consumer to:

(i) open the pouch and remove the passive volatile material dispenser therefrom to activate the passive volatile material dispenser, and

(ii) place the activated passive volatile material dispenser substantially in a center of a room.

1. INDEFINITENESS

Claim 18 comprises a “passive volatile material dispenser comprising a porous substrate.” The porous substrate “comprises a first wall portion and a second wall portion” which is “hingedly connected along a first hinge, and separably connected, wherein the porous substrate comprises only the first hinge.”

The Examiner found the claim indefinite in the recitation of “comprises only the first hinge.” The Examiner stated that it is unclear whether “other hinges [can] be present as long as they are not the component

connecting the first and second wall portion.” Ans. 4. The Examiner also states that the term “hinge” does not appear in the Specification and that, although “Appellant appears to have a very particular interpretation of ‘hinge’ in mind . . . Appellant’s interpretation is not supported by the written description contained in the Appellant’s specification for the broad concept of ‘hinge.’” Ans. 5.

The application in this appeal and in Appeal 2017-008500 are the same, Serial No. 14/079,215. As discussed by the Examiner, in Appeal 2017-008500, the term “hingedly . . . connected” appeared in the rejected claim. The term appears in original claim 3 (Spec. 19), and “hingedly attached” appears in paragraph 28 of the Specification (“The substrate 12 includes a first wall portion 16 and a second wall portion 18 hingedly attached to the first wall portion along a fold line 20.”). The 8500 Decision acknowledged that the term “hinge” is not defined in the Specification, but interpreted it “to have its ordinary meaning as found in a general purpose dictionary, namely, to be a joint or flexible region that allows the wall portions to pivot.”² 8500 Dec. 8. This definition is consistent with Figure 6 of the Specification (*see below*) which shows wall portion 18 pivoting along fold line 20 and therefore “hingedly connected” to portion 16. Figure 6 of the Specification is reproduced below (annotations added):

² “A jointed or flexible device that allows the turning or pivoting of a part, such as a door or lid, on a stationary frame.”
<https://www.thefreedictionary.com/hinge> (last accessed July 7, 2018).

interpretation does not change the meaning of a single “hinge” to be “a joint or flexible region that allows the wall portions to pivot.” Indeed, the Examiner acknowledges this by referring to “1 hinge” and “3 hinges.” The claim, however, excludes the Examiner’s interpretation of “hingedly connected” to include a pivotal connection comprising three hinges because it recites “wherein the porous substrate comprises only the first hinge.” The claim language expressly recites that the substrate comprises “only the first hinge,” which means what it says, namely, only one hinge is present. This interpretation is consistent with the embodiment reproduced above which shows only a single hinge connecting the first and second wall portions.

The Examiner’s interpretation that more than one hinge can be present in the porous substrate at positions other than the connection between the first and second walls ignores the explicit limitation in the claim that “the porous substrate comprises only the first hinge.” It is therefore not a reasonable interpretation of the claims.

Consequently, the rejection of claim 18 as indefinite in the recitation of “wherein the porous substrate comprises only the first hinge” is reversed.

Independent claim 21 recites a “dispenser comprising a porous substrate . . . , the porous substrate comprising a first wall portion and a second wall portion hingedly connected along a first hinge, and separably connected, wherein the dispenser comprises only the first hinge.” This claim differs from claim 18 in reciting that the *dispenser* which comprises the substrate has “only the first hinge.” The indefiniteness of this claim is reversed for the same reason as claim 18 because it is clear from the language of the claim that only one hinge is present in the dispenser, and excludes the presence of other hinges.

2. INDEFINITENESS

Claim 18 recites “the porous substrate comprises a first wall portion and a second wall portion hingedly connected along a first hinge, and separably connected.” Claim 21 recites “the porous substrate comprising a first wall portion and a second wall portion hingedly connected along a first hinge, and separably connected.” The Examiner stated that the “concept of separably connected is unclear” because of the location of the comma. Final Act. 4. The Examiner explained: “Grammatically, for at least the reason of the location of the preceding comma, it is unclear the exact antecedent of the ‘separably connected’.” *Id.* The Examiner states that it is unclear “whether the off-setting comma is intended to have the antecedent for separably connected be the porous substrate.” Ans. 7.

The claims recite that “the porous substrate” comprises the first and second wall portions which are “hingedly connected . . . , and separably connected.” The most logical reading of the claim is that the first and second walls are “separably connected” because a separable connection must be between at least two parts of the walls, in addition to the connection between the two wall portions that forms the first hinge. This interpretation is also consistent with Figure 6 of the Specification which shows wall portions 16 and 18 separated from each other.

Thus, we find that the claim is definite. Consequently, the rejection of claims 18 and 21 as indefinite in the recitation of “separably connected” is reversed.

3. ANTICIPATION

The Examiner found the Balakrishnan describes an insect control article comprising a passive volatile material dispenser, where the dispenser is made of a porous substrate and impregnated with an insect control agent (pyrethroid and metofluthrin), meeting the claimed limitation of “the passive volatile material dispenser comprising a porous substrate impregnated with an insect control active” recited in claims 18 and 21. Final Act. 4–5.

The Examiner found that Figure 6 of Balakrishnan shows a honeycomb structure “wherein the substrate is formed into a substantially triangular form, which include walls hingedly connected. Further, it is noted that the substrates of Balakrishnan are able to be cut and are therefore separable.” Final Act. 5.

Figure 6 of Balakrishnan is reproduced below:

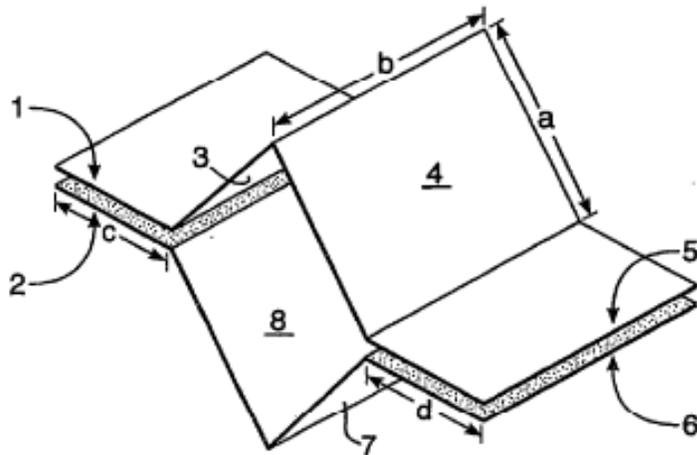


Figure 6 of Balakrishnan, reproduced above, shows the “honeycomb” structure referenced by the Examiner having hinges between walls 1 and 3, walls 3 and 4 (hinge is labeled “b”), and walls 4 and 5 on the top half of the honeycomb, and hinges between 2 and 8, 8 and 7, and 7 and 6 on the bottom half of the honeycomb.

Based on the Examiner’s interpretation of the claim that “hingedly connected” means that more than one hinge can be present, the Examiner found that Figure 6 of Balakrishnan satisfied all limitations of claims 18 and 21. Specifically, the Examiner also found that “the entire mechanism” shown in Figure 6 is the recited “hinge.” Final Act. 11.

As discussed in Rejection 1 based on indefiniteness, we interpret the claim to require a porous substrate with only one hinge which serves as a pivot between two walls. While we agree with the Examiner that “hingedly connected” could, in the abstract, be read to include more than one hinge, we found that this interpretation is not reasonable because claims 18 and 21 further recite that the porous substrate or dispenser comprises “only the first hinge,” excluding the presence of additional hinges. Figure 6 of

Balakrishnan shows a porous substrate defined by walls 1, 3, 4, and 5 (top half of the mechanism) which comprises three hinges (between walls 1 and 3, 3 and 4, and 4 and 5) and three hinges on the bottom half. While claims 18 and 21 do not limit the number of wall portions in the porous substrate, the claims do limit the number of hinges to “only the first hinge.” The porous substrate shown in Figure 6 of Balakrishnan comprises more than one hinge. Consequently, the Examiner did not establish that Balakrishnan describes the claim limitation of a porous substrate and a dispenser having “only the first hinge.”

The anticipation rejection of claims 18 and 21 based on Balakrishnan is reversed. The rejections of claims 2–11, 14, 15, 19, 20, 22, and 23, each which requires “only the first hinge” are reversed for the same reasons.

The Examiner rejected the same claims as obvious in view of Balakrishnan. The Examiner relied on the same interpretation of the claims as in the anticipation rejection based Balakrishnan. Final Act. 13. The obviousness rejection of claims 2–11, 14, 15, and 18–23 is also reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
2-11, 14, 15, 18-23	112	Indefiniteness		2-11, 14, 15, 18-23
2-11, 14, 15, 18-23	112	Indefiniteness		2-11, 14, 15, 18-23
2-11, 14, 15, 18-23	102	Balakrishnan		2-11, 14, 15, 18-23
2-11, 14, 15, 18-23	103	Balakrishnan		2-11, 14, 15, 18-23
Overall Outcome				2-11, 14, 15, 18-23

REVERSED