Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT DEMUTH,
JÜRG FAAS,
PETER FRITZSCHE,
and
EDUARD NÜSSLI

Appeal No. 2000-0331
Application No. 08/822,145

HEARD: NOVEMBER 29, 2001

Before HAIRSTON, BARRETT, and DIXON, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal[1] from the final rejection of claims 81 through 91.

The disclosed invention relates to a controlled cleaning

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[1] In the parent application, the Board in a decision dated January 23, 1997 affirmed the 35 U.S.C. § 112 lack of enablement rejection of claims 54 through 80.

process for fiber material in a fiber processing facility. A control system in the fiber processing facility adjusts the processing parameters of a coarse cleaning machine according to the identity of the fiber material delivered by a bale opening machine located upstream of the coarse cleaning machine.

Claim 81 is illustrative of the claimed invention, and it reads as follows:

> 81. A fiber processing facility comprising:
>
> a bale opening machine;
>
> a coarse cleaning machine;
>
> a control system, coupled to the bale opening machine and the coarse cleaning machine, identifying a fiber material to be processed; and
>
> the control system adjusting the processing parameters of the coarse cleaning machine according to the identity of the fiber material delivered by the bale opening machine.

No references were relied on by the examiner.

Claims 81 through 91 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of enablement.

Reference is made to the briefs (paper nos. 35 and 38) and the answer (paper no. 36) for the respective positions of

the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the lack of enablement rejection of claims 81 through 91.

According to the examiner (answer, pages 3 and 4):

> [T]here is no description as to how the control unit operates on the input signals to produce the desired results so as to enable one of ordinary skill in the art to practice the claimed invention without undue experimentation. One of the disclosed desired outputs, and which is now the focus of the present claims, is the adjustment of the parameters of the coarse cleaning machine based on input fiber characteristics. Also, as presently claimed, the parameters of the coarse cleaner are adjusted on the basis of an indication of the identity of the delivered fiber. This operation is briefly alluded to at page 34 of the specification. It is submitted that, not only is there no disclosure as to how the control unit operates to adjust coarse cleaning parameters for a single fiber, there is total lack of disclosure as to how the control unit would operate to adjust coarse cleaner parameters for a fiber processing system in which a plurality of fibers of different origin are delivered to the system . . . .

We agree with the examiner that the specification must teach those skilled in the art how to make and use the claimed invention without undue experimentation. Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert. denied, 118 S.Ct. 397 (1997). Appellants

argue (brief, pages 10 through 15; reply brief, pages 2 through 9) that the skilled artisan would find that the scope of the claims bears a reasonable correlation to the scope of enablement provided by the specification. To buttress their argument, appellants have submitted a declaration executed by Jürg Faas, one of the co-inventors of the subject application. In paragraph 4 of the declaration, Mr. Faas acknowledges that:

> [P]rior to the presently claimed invention, it was known to the ordinarily skilled artisan that the coarse cleaner can handle substantially a same maximum throughput as the bale opener. Further, prior to the presently claimed invention, it was known to the ordinarily skilled artisan that the coarse cleaner could not process different fiber materials at a same throughput rate and still maintain a predetermined quality unless the coarse cleaner settings were adjusted. At that time, it was necessary, as known to the ordinarily skilled artisan, to stop production as each new fiber material was introduced and to manually adjust the coarse cleaner settings to accommodate the new fiber material, then restart the process.

In paragraph 6, declarant states that:

> [I]t is my belief that the ordinarily skilled artisan would be able to empirically determine optimum settings of the coarse cleaner for specific fiber material bales (or provenances) through a trial and error procedure. My belief is supported by the fact that, as noted above, a certain amount of empirical determination was required prior to the present invention, however, the machines were required to be stopped and manually set as bales

> were changed. Therefore, in accordance with the original disclosure, I believe that the ordinarily skilled artisan would be able to repeat the empirical determination of the settings for the coarse cleaner for each type of bale or group of bales to be utilized in the textile process. Once established, it is my considered opinion that the ordinarily skilled artisan, in accordance with the original disclosure, would be able to store the empirically determined settings in a microcomputer adapted to automatically adjust the coarse cleaner settings. In this manner, adjustment of the coarse cleaner settings would occur without necessitating the time consuming stopping of the textile process to manually adjust the coarse cleaner settings, as required in the prior art. For a particular fiber material bale, using the disclosed information and knowledge that is common in the art, I believe that the ordinarily skilled artisan would be able to determine the optimum settings for the coarse cleaning device . . . . Because the amount of time for determining the optimum settings of the coarse cleaner in accordance with the empirical determination of the present invention is substantially the same amount of time as was required in the prior art to determine the optimum settings for the coarse cleaner for a particular fiber material bale, it is my conclusion that no undue experimentation would be necessary, nor would there be any particular hardship in practicing the claimed invention. Further, because the ordinarily skilled artisan is familiar with storing values in a microcomputer, I believe that the ordinarily skilled artisan would be able to store the optimally established settings in a microcomputer for each fiber material bale to be utilized in the process.

Based upon declarant's admission that the coarse fiber cleaning machine settings involve nothing more than automating

known prior art manual cleaning machine settings, we are of the opinion that the skilled artisan after reviewing the disclosure and the acknowledged prior art would know how to implement the automated control of the coarse cleaning machine without undue experimentation. Of equal importance, we find that the scope of the claims is less than or equal to the scope of the enablement of the disclosure. Stated differently, the scope of the claims on appeal bears a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art. National Recovery Techs. Inc. v. Magnetic Separation Sys. Inc., 166 F.3d 1190, 1195-96, 49 USPQ2d 1671, 1675-76 (Fed. Cir. 1999). We agree with appellants' argument (brief, page 18) that "the Declaration adequately rebuts the Examiner's assertions of non-enablement under 35 U.S.C. § 112, first paragraph, and that the Declarants' conclusions are based upon facts and the originally filed disclosure." Thus, the rejection of claims 81 through 91 is reversed because appellants have satisfied the enablement requirement of the first paragraph of 35 U.S.C. § 112.

DECISION

The decision of the examiner rejecting claims 81 through 91 under the first paragraph of 35 U.S.C. § 112 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

KWH:hh

GREENBLUM & BERNSTEIN, PLC
1941 ROLAND CLARKE PLACE
RESTON, VA 20191