

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HOWARD P. GROGER, SHUFANG LUO, K. PETER LO, MARTIN  
WEISS, JAMES M. SLOAN, and RUSSELL J. CHURCHILL

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Appeal No. 2000-0391  
Application No. 08/553,773

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REHEARING

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Before KIMLIN, WALTZ, and PAWLIKOWSKI, Administrative Patent  
Judges.

WALTZ, Administrative Patent Judge.

**ON REQUEST FOR REHEARING**

Pursuant to the provisions of 37 CFR § 1.197(b) (1997), appellants have submitted a Request for Rehearing dated Mar. 14, 2002, (hereafter "Request"), of our Decision dated Feb. 15, 2002, affirming the examiner's rejection of claims 1, 10, and 19-26 under 35 U.S.C. § 112, first paragraph, for lack of enablement,

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while reversing the examiner's rejection under the same basis of claims 2-4, 6-7, 11 and 27-28 (Decision, page 2).

Appellants request rehearing based on only one issue. Appellants argue that "[t]he Board has found that all necessary § 112 first paragraph support exists for narrower dependent claims (B)" and "[t]he broad claims [designated as "A"] are thus logically shown and admitted to be supported and to meet all statutory requirements" (Request, page 2).

Appellants' argument is not well taken. It is well settled that "the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art." *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (see the Decision, page 8). In an analysis of a rejection under the enablement requirement of section 112, a relevant inquiry is "whether the scope of enablement provided to one of ordinary skill in the art by the disclosure is such as to be commensurate with the scope of protection sought by the claims." *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). What is necessary to meet the enablement requirement is that the inventor "provide a disclosure sufficient to enable one skilled in the art to carry out the invention commensurate with the scope of [his] claims."

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*Amgen Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991). Accordingly, the scope of the claim must be considered in any analysis under section 112. Therefore, the enablement disclosure may be commensurate in scope with narrower claims while not sufficiently enabling for claims of a broader scope.

The scope of each group of claims considered in the Decision is very different, as noted by appellants themselves in the Brief (pages 13-14; see the Decision, page 9). The scope of the claims included in the affirmance of the examiner's rejection did not specify the dye, i.e., the dye and polymer matrix must both be determined for any given analyte (Decision, page 8). Similarly, the scope of the claims included in the reversal of the examiner's rejection was much more narrow, i.e., the dye was specified (Decision, page 9). Accordingly, the scope of enablement required varied with the scope of the claims.

Appellants have not cited any legal precedent or reasoning that supports their argument. Appellants' citation of *In re Bundy*, 209 USPQ 48 (CCPA 1981) (Request, page 2), does not appear to support their argument since the holding in this decision is mainly directed to best mode and utility issues, not enablement for the varying scope of claims as presented herein. As

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discussed above, the analysis of the examiner's rejection in our Decision took into account the scope of the claims, as required by the statute and the holdings of our reviewing court. Accordingly, we do not find in the Request any argument convincing us of error in the conclusions we reached in our Decision.

Therefore, appellants' Request for Rehearing is denied.

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

**DENIED**

Edward C. Kimlin	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
Thomas A. Waltz	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
Beverly A. Pawlikowski	)	
Administrative Patent Judge	)	

TAW/tdl

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