

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-MARC AURIOL, PHILIPPE BORNES
and
SYLVAIN GUERIN

Appeal No. 2000-1473
Application No. 08/765,169

ON BRIEF

Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge and NASE, Administrative Patent Judge.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 14 to 16. Claims 1 to 13 and 17 to 23, the only other claims pending in this application, have been allowed.

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We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to a device for distributing parts singly. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 14 to 16 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 16, mailed January 12, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15, filed December 27, 1999) and reply brief (Paper No. 17, filed February 16, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain the rejection of claims 14 to 16 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In making a rejection on the ground of nonenablement, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting

disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellants to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports

enablement¹ against evidence that the specification is not enabling.

Thus, the dispositive issue on appeal is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.

In our opinion the examiner has not met his burden of proof by advancing acceptable reasoning inconsistent with enablement for the following reasons.

¹ The appellants may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure, but may not add new matter. The appellants may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

Factors which must be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Our review of the record reveals that the examiner has not applied the above-noted factors to determine that undue experimentation would be required to practice the invention or provided an explanation that clearly supports such a determination. Since the examiner has not weighed the factors, the examiner's conclusion of nonenablement cannot be sustained.

Furthermore, it is our view that it would not require undue experimentation to practice the invention as set forth in the claims under appeal for the reasons set forth by the appellants in the brief (pp. 3-7) and reply brief (pp. 1-4). In addition, contrary to the position of the examiner (answer, p. 4), it is our opinion that one skilled in the art would have been able to provide any necessary seals to the storage devices 20 and the body 35 of the selection means 31 to permit operation of the claimed device. Thus, we conclude that one skilled in the art could make and use the claimed invention from the disclosure without undue experimentation.

For the reasons set forth above, the decision of the examiner to reject claims 14 to 16 under 35 U.S.C. § 112, first paragraph, is reversed.

REMAND

We remand this application to the examiner to determine whether or not claims 1 to 23 are rejectable under 35 U.S.C.

§ 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claim 1 includes an element expressed in means-plus-function format. As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

In accordance with In re Donaldson, 16 F.3d at 1195, 29 USPQ2d at 1850, "if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112."

Accordingly, we remand the application to determine if the applicant has set forth an adequate disclosure as to what structure described in the specification corresponds to the "means for subjecting" clause of claim 1. If an adequate disclosure has not been set forth, a rejection under the second paragraph of section 112 should be made by the examiner. If an adequate disclosure has been set forth, the disclosed structure corresponding to the "means for subjecting" clause of claim 1 should be identified by the examiner.

In addition, we remand this application to the examiner to determine if the lack of proper antecedent basis for "inlet orifice" and "outlet orifice" in claim 1 renders claim 1 indefinite under 35 U.S.C. § 112, second paragraph.

CONCLUSION

To summarize, the decision of the examiner to reject claims 14 to 16 under 35 U.S.C. § 112, first paragraph, is reversed. In addition, this application has been remanded to the examiner for further action.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, Rev. 1, Feb. 2000).

REVERSED; REMANDED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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