

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOLGER GERLING

Appeal No. 2001-2204
Application No. 09/155,413

ON BRIEF

Before COHEN, STAAB, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 through 23. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to a method for mounting teeth to blanks, to an apparatus for connecting teeth to a saw blade blank, and to a device for mounting teeth to blanks. A basic understanding of the invention can be derived from a

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reading of exemplary claims 12, 19, and 23, respective copies of which appear in "Appendix I" of the main brief (Paper No. 11).

The following rejection is the sole rejection before us for review.¹

Claims 12 through 23² stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way to enable one skilled in the art to make and/or use the invention.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer (Paper No. 14), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 11 and 15).

¹ A final rejection of claims 12 through 23 under 35 U.S.C. § 103(a) was expressly withdrawn by the examiner in the answer (page 2).

² In error, the answer (page 2) set forth only claims 12 through 22 as being rejected under 35 U.S.C. § 112, first paragraph, whereas the final rejection (Paper No. 7) specified claims 12 through 23, as set forth above.

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OPINION

In reaching our conclusion on the enablement issue raised in this appeal, this panel of the board has carefully considered appellant's specification and claims,³ appendices II, III, and IV attached to the main brief, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We do not sustain the examiner's rejection under 35 U.S.C. § 112, first paragraph.

The test regarding enablement is whether a disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use a claimed invention without undue experimentation. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974). An examiner has the initial burden of producing reasons that substantiate a rejection based

³ The following informalities in the claims should be addressed by the examiner. In claims 12 and 23, clause e) is not grammatically sound. In claim 13, line 2, "data recorded" in step c) has no express antecedent basis in parent claim 12. Claim 18, line 1, step "d)" should apparently be step "e)."

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on lack of enablement. See In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982) and See In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Once this is done, the burden shifts to an appellant to rebut this conclusion by presenting evidence to prove that the disclosure is enabling. See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), **cert. denied**, 416 U.S. 935 (1974) and In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

We fully comprehend the examiner's viewpoint of the enablement issue as clearly articulated in the answer (pages 2 through 8). Akin to the examiner's perception, a reading of appellant's underlying specification reveals to us a disclosure that for the most part leaves it to those practicing the art the task of bringing into being the apparatus for practicing the invention. The issue, of course, is whether appellant's aforementioned underlying teaching would have enabled one skilled in the art to make and use the invention without undue experimentation. Taking into account the totality of the particular evidence and information before us, it is our opinion that the examiner has not produced reasons that substantiate a rejection based on lack of enablement. In other words, while

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effort would clearly have to be undertaken to make and use the claimed method and apparatus, the examiner has not convincingly established that the effort would certainly entail undue experimentation. On the other hand, appellant's submissions lend support to the view that the skill of those practicing the specific art at issue would have enabled them to make and use the disclosed invention without engaging in experimentation that would be considered undue. In particular, appellant relies upon the translated publication (DE 3 717 60) in Appendix II (the '610 publication), the same document referenced on page 1 of the present specification. Basically, the '610 document (Fig. 1) informs us that, when appellant's invention was made, those skilled in the art clearly had the requisite ability to effect an apparatus for automatically soldering hard metal teeth onto a circular saw blade at "exact" soldering positions (page 4). The Neff et al document (Appendix III) further instructs us that those skilled in the art, at the time of appellant's invention, had the ability to configure an apparatus for measuring and sorting component parts prior to their assembly (column 5, lines 45 through 47) wherein a contact rod measures critical dimensions of component parts, an optical encoder measures a location, and a microprocessor or computer compiles data (column 4, lines 50

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through 54 and column 4, lines 23 through 26). While as earlier pointed out, we fully appreciate the examiner's concern as to perceived deficiencies in appellant's disclosure, the latter documents fairly reveal a level of skill to this panel of the Board that would have permitted practitioners in the art to use the present disclosure to make and use the claimed method and apparatus without undue experimentation. Thus, it appears to us that those skilled in this art would have been well capable of analyzing obtained data to determine a configuration of each tooth on a blank, contrary to the examiner's point of view (answer, page 3). For the preceding reasons, we cannot support the rejection on appeal.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

ICC/lbg

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KOHLER SCHMID & PARTNER
RUPPMANNSTR 27
D-70565 STUTTGART
GERMANY

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APPLICATION NO. 09/155,413

APJ COHEN

APJ STAAB

APJ BAHR

DECISION: REVERSED

Prepared By: Lesley Brooks

GAU: 3700

OB/HD

DRAFT TYPED: 20 Jun 03

FINAL TYPED: