THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARK KIJOWSKI and STEPHEN P. LOMBARDO

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Appeal No. 95-4485
Application 08/097,589[1]

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ON BRIEF

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Before KIMLIN, WARREN and OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow

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[1] Application for patent filed July 26, 1993. According to appellants, the application is a continuation of Application 07/784,124, filed October 29, 1991, now abandoned; which is a continuation of Application of 07/591,103, filed September 28, 1990 now abandoned.

claims 1-12 as amended after final rejection, and from the examiner's final rejection of claims 13-15. These are all of the claims in the application.

THE INVENTION

Appellants' claimed invention is directed toward a method for extracting cholesterol from egg yolk by shearing a mixture of oil, yolk and water, within recited ranges of oil:yolk:water ratio and temperature, such that an oil-in-water emulsion is not formed, and centrifuging the mixture to separate it into a water phase which contains egg yolk reduced in cholesterol, and an oil phase. Claim 1 is illustrative and reads as follows:

> 1. A method of extracting cholesterol from egg yolk where the method comprises; diluting a wet egg yolk having a natural water content with water and mixing the diluted egg yolk with oil to form a mixture containing a ratio of oil to yolk to water between about 3:1:0.8 to about 1.5:1:0.4, shearing the mixture while the mixture is at a temperature between about 124EF to about 148EF, the shearing effective for not forming an oil-in-water emulsion, and recovering in a water phase an egg yolk reduced in cholesterol by subjecting the sheared mixture to centrifugation so as to separate the mixture into an oil phase and the water phase.

THE REJECTIONS

Claims 1-15 stand rejected under 35 U.S.C. § 112, first

paragraph, on the grounds that the specification fails to provide an enabling disclosure and that the specification as originally filed fails to provide adequate written descriptive support for the invention as now claimed.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we do not sustain these rejections.

Nonenablement rejection

A specification complies with the 35 U.S.C. § 112, first paragraph, enablement requirement if it allows those of ordinary skill in the art to make and use the claimed invention without undue experimentation. *See In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.,* 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

Appellants' specification provides typical and preferred ranges of oil:yolk:water ratios, and teaches that if too much water is present, an oil-in-water emulsion is formed (page 5,

lines 16-23). The specification states that "[w]hen an oil-in-water emulsion is formed it is extremely difficult, if not impossible, to separate the oil and yolk phases" (page 5, lines 23-25). In view of this statement, it is apparent that the statement in specification that "[a]fter shearing, the oil containing cholesterol is easily separated from the mixture by centrifugation" (page 6, lines 21-22) indicates the absence of an oil-in-water emulsion.

Appellants' specification does not contain any other teaching regarding the formation of oil-in-water-emulsions. The specification includes eight examples, but the examples do not state whether an oil-in-water emulsion is formed. However, the
data in Exhibit A-4 of the Rule 131 declaration of Kijowski and Lombardo (filed September 20, 1993, paper no. 26) indicate that the ratio of oil to water in Examples 1-3 and 5-8 in appellants' specification is such that no oil-in-water emulsion is formed in these examples.

The examiner argues that appellants' specification is not

enabling because it does not disclose that shearing and shear rates may be manipulated to avoid emulsion formation and does not teach how to determine the shearing and shear rates needed to avoid emulsion formation over the entire temperature and ingredient ratio ranges in appellants' claims (answer, page 3). This argument is not well taken because appellants' claims do not require that the shearing or shear rate be manipulated to avoid the formation of an oil-in-water emulsion. The claims state that the shearing is effective for not forming an oil-in-water emulsion, but this does not mean that the claims require that the shearing be manipulated. The claims are open to manipulating the ratio of oil to water, rather than manipulating the shearing,

such that no oil-in-water emulsion is formed. Furthermore, the examiner has provided no evidence or sound technical reasoning which shows that one of ordinary skill in the art could not have determined, through no more than routine experimentation, shearing conditions at which no oil-in-water emulsion is formed.

The examiner states that the variability of oil and water is the one variable disclosed in appellants' specification for avoiding emulsion formation, and that the examiner does not argue
that one of ordinary skill in the art would not have been able to avoid emulsion formation in view of the information in appellants' specification regarding this variable (answer, pages 7-8). For this reason and because, as discussed above, the avoidance of the formation of an oil-in-water formation in appellants' claimed method may be achieved by manipulating only the oil to water ratio, the examiner's nonenablement rejection is improper.

The examiner argues that the Rule 132 declaration of Kijowski and Lombardo (filed September 20, 1993) includes some runs in which the temperature and ingredient ratios fall within appellants' claims, yet an oil-in-water emulsion is formed (answer, pages 3-4 and 6). This argument is not persuasive because the examiner has not explained, and it is not apparent,

why, in view of appellants' specification, one of ordinary skill in the art would not have been able to determine, through no more than routine experimentation, the combinations of ingredient ratios and temperatures recited in appellants' claims at which the additional claim limitation is met which requires that an oil-in-water emulsion is not formed.

For the above reasons, we find that the examiner has not carried his initial burden of establishing a *prima facie* case of lack of enablement. Consequently, we do not sustain the nonenablement rejection.

Rejection for lack of adequate written descriptive support

A specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement, if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA

1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). It is not necessary that the application describe the presently-claimed invention exactly, but only sufficiently clearly that one of ordinary skill in the art would recognize from the disclosure that appellants invented it. *See Edwards*, 568 F.2d at 1351-2, 196 USPQ at 467; *Wertheim*, 541 F.2d at 262, 191 USPQ at 96. "[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

The examiner argues that "there is no support for shearing in a manner within a certain temperature range and ingredient ratio such that an oil-in-water emulsion is not formed" (answer, page 4).

As stated above, appellants' specification provides typical and preferred oil:yolk:water ratios, discloses that if

too much water is added, an oil-in-water emulsion is formed such that the oil and yolk phases are difficult, if not impossible, to separate, and teaches that after the shearing in their method, the oil containing cholesterol is separated easily from the mixture by centrifugation (page 5, lines 16-25; page 6, lines 21-22). The examiner does not explain, and it is not apparent, why

appellants' disclosure does not describe their claimed method sufficiently clearly that one of ordinary skill in the art would have recognized in the disclosure a description of appellants' claimed method. Consequently, we do not sustain the examiner's rejection of appellants' claimed invention as lacking an adequate written description in appellants' specification.

DECISION

The rejections of claims 1-15 under 35 U.S.C. § 112, first paragraph, on the grounds that the specification fails to provide an enabling disclosure and that the specification as originally filed fails to provide adequate written

descriptive support for the invention as now claimed, are reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)	

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