

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WARREN E. SCHMIDT, RANDALL S. WAYLAND,  
JAMES R. HALLADAY, TEJBANS S. KOHLI

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Appeal No. 96-1121  
Application 07/873,309<sup>1</sup>

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ON BRIEF

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Before WEIFFENBACH, PAK and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-21, which are all of the claims in the application.

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<sup>1</sup> Application for patent filed April 24, 1992.

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Claim 1 is illustrative and reads as follows:

1. A fluid mounting for connecting a supported member to a supporting member, comprising:

(a) a housing formed to be attached to one of said supporting and supported members;

(b) a first elastomer section which is loaded primarily only in compression attached to said housing and defining at least a portion of a first fluid chamber;

(c) a second elastomer section which is loaded primarily only in shear attached to said housing and defining at least a portion of a second fluid chamber;

(d) at least one fluid passageway interconnecting said first and said second fluid chambers;

(e) a piston formed to be attached to the other of said supporting and supported members, said piston interacting with said first and said second fluid chambers and said first and said second elastomer sections such that relative movement between said supported member and supporting member oscillates a fluid through said at least one fluid passageway and back and forth between said first and said second fluid chambers.

*THE REJECTION*

Claims 1-21 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an enabling disclosure for the claimed invention.

Claims 1-14 stand rejected under 35 U.S.C. § 112, second

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

*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, these rejections will be reversed.

*Rejection under 35 U.S.C. § 112, first paragraph*

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).

The examiner asserts that appellants' specification is nonenabling because the claims do not recite a number of characteristics of the device described in the specification (answer, pages 3-5). The examiner does not explain, however,

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and it is not apparent to us, why one of ordinary skill in the art, in view of appellants' specification, could not have made and used appellants' claimed invention without undue experimentation. Accordingly, we find that the examiner has not carried his burden of establishing a *prima facie* case of lack of enablement.

*Rejection under 35 U.S.C. § 112, second paragraph*

The examiner asserts that there is no antecedent basis for "the other of said supporting and supported members" in element (e) of claim 1 and element (f) of claim 12 (answer, page 5).

The preamble of each of claims 1 and 12 recites that the fluid mounting is for connecting a supported member to a supporting member. Element (a) of each claim recites that the housing is to be attached to one of these members. Element (e) of claim 1 and element (f) of claim 12 state that the piston is to be attached to the other member. Thus, the meaning of "the other of said supporting and supported members" in claims 1 and 12 is clear. We therefore will not sustain the rejection under 35 U.S.C. § 112, second paragraph.

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*DECISION*

The rejections of claims 1-21 under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an enabling disclosure for the claimed invention, and of claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which appellants regard as the invention, are reversed.

*REVERSED*

CAMERON WEIFFENBACH )  
Administrative Patent Judge )  
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CHUNG K. PAK ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
 ) INTERFERENCES  
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TERRY J. OWENS )  
Administrative Patent Judge )

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