

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOKUKI SATAKE,
KIYOSHI WATANABE, FUSAYUKI NANJO,
KOICHI TAKENOBU and HITOSHI MIYAMOTO

Appeal No. 1997-3697
Application 08/273,455

HEARD: January 9, 2001

Before WARREN, LIEBERMAN and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 3 and 4, all of the claims in the application.¹

We have carefully considered the record before us, and based thereon, find that we cannot sustain either of the grounds of rejection advanced by the examiner on appeal.²

¹ Amendment of May 3, 1995 (Paper No. 8).

² The examiner has not advanced the ground of rejection of claims 3 and 4 under the judicially created doctrine of obviousness-type double patenting over claim 5 of then co-pending application 08/296,134, now United States Patent 5,501,914, that was of record in the final rejection of July 17, 1995 (Paper

With respect to the ground under 35 U.S.C. § 112, first paragraph, enablement requirement, it is well settled that under § 112, first paragraph, the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification are in doubt, including reasons why the description of the invention in the specification would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation, in order to establish a *prima facie* case under the enablement requirement of the first paragraph of § 112. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). Thus, in order to make out a *prima facie* case under this section of the statute, more is required than an expression of doubt that the information in appellants' specification would not have enabled one of ordinary skill in this art to make the claimed apparatus encompassed by the appealed claims. *See generally, In re Mayhew*, 481 F.2d 1373, 179 USPQ 42, 45 (CCPA 1973) (CCPA 1976) (“We believe the rejection could have been proper only if evidence or reasoning had been advanced which would indicate that locating the cooling means at a point other than adjacent the exit point for the strip would not achieve the desired result of lowering the temperature of the spelter at that point. A statement merely doubting that this can be done is not enough.”). We must agree with appellants (brief, page 5) that the examiner (answer, page 3, citing the Office action of December 6, 1994 (Paper No. 5)) has not made out a *prima facie* case that the specification would not have enabled one of ordinary skill in this art to make the claimed apparatus without undue experimentation at the time the application was filed. We find that the examiner merely alleges that undue experimentation would be required to practice the claimed invention without reasonable explanation, supported by the record as a whole, why this would be so. Indeed, we find that appellants submitted

No. 10). While the examiner has not specifically withdrawn this ground of rejection, appellants note in the brief their belief that the “rejection has been obviated by the submission of a Terminal Disclaimer” (Paper No. 12, page 4) and the examiner did indicate in the answer that appellants' statement of the issues on appeal is correct (page 2). Appellants did file a terminal disclaimer along with the brief on December 18, 1995 (Paper No. 13). While we cannot find in the record where the examiner acknowledged receipt of this document and communicated the effect thereof on the ground of rejection,

evidence with respect to whether one of ordinary skill in this art would have had the knowledge to practice the invention as disclosed in the specification (brief, pages 5-8, and reply brief, pages 1-4) and the examiner has considered only one of the documents, alleging that undue experimentation would still be required even in view thereof (answer, pages 3-5). Accordingly, because the examiner has not carried the requisite burden, we reverse this ground of rejection.

Turning now to the ground of rejection under 35 U.S.C. § 102(b), it is well settled that anticipation under § 102 is a question of fact, based on the limitations in the claims, and that in order to make out a *prima facie* case of anticipation, the examiner must point out where each and every element of the claimed invention, arranged as required by the claims, is found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457, 221 USPQ 481, 485 (Fed. Cir. 1984). With respect to the interpretation to be made of the claim language in light of the written description in appellants' specification as interpreted by one of ordinary skill in this art, *see In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), we find that appellants do not quarrel with the meaning that the examiner has given to the terms "dimple," "two dimensions" (brief, page 8) and "array" (reply brief, page 4) in the phrase "two-dimensional array of dimples" (answer, page 3, citing the Office action of December 6, 1994 (Paper No. 5; page 4), and page 5). We observe that the definition of "array" relied on by the examiner is listed in *Webster's II New Riverside University Dictionary* 126 (1988) as "4. *Math.* a . . . ," as is also the case in *The American Heritage Dictionary Second College Edition* 129 (1982), which definition clearly has to do with the arrangement of recorded data. Thus, we find that the appropriate ordinary meaning of the term "array" in the context of the disclosed and claimed invention is "1. An orderly arrangement; esp. of troops." *Webster's II New Riverside University Dictionary, supra; Webster's II New Riverside University Dictionary, supra.* Accordingly, we conclude that, in the context of claim 3 and in light of the written description in appellants' specification, the claim phrase "two-dimensional array of dimples" is reasonably interpreted as an orderly arrangement

we will not consider this ground of rejection. *See Manual of Patent Examining Procedure* § 1208 (7th

of dimples, which arrangement necessarily includes the “corresponding protrusions, formed by the dimples,” wherein the dimples are in one outer layer and the protrusions are in the other outer layer of a single generating layer, which language encompasses the arrangement shown in specification Fig. 2.

We have compared the structure specified by the elements of claim 3, as we have interpreted the language thereof, with the structure shown in FIG. 3 of Ackerman et al. in light of the position advanced by the examiner and by appellants. We find that reference FIG. 3 illustrates an alternative configuration of that shown in reference FIG. 2, wherein reference FIG. 2 is “an enlarged sectional view as seen generally from line 2–2 in FIG. 1” (col. 6, lines 9-10, and col. 8, lines 59-60). It is apparent from reference FIG. 1 that the passageways 20 and 26, the latter including feed tube 24, in the core 14 are straight runs for the length thereof, wherein the configuration and the dimensions of the passageways do not change, with the sole exception where “[i]t would be desirable to provide a slight reduction in cross sectional area at the discharge end of the fuel passageways” (col. 6, line 22, to col. 7, line 12). It is apparent that reference FIGs. 2 and 3 represent merely a cross section of core 14, showing only the form of the passageways at that particular point and no other aspect of the structure of the passage ways over the remainder of the core. Accordingly, based on the structure disclosed by the reference taken as a whole, we agree with appellants’ characterization of this structure as one that is “corrugated” and indeed, there is no “two-dimensional array of dimples” as required by claims 3 and 4.

Accordingly, we reverse this ground of rejection because each and every element of the claimed invention, arranged as required by the claims, is not found in Ackerman et al.

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