

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELGE MONONEN

Appeal No. 1997-3798
Application No. 08/272,018

ON BRIEF

Before ABRAMS, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9, 11 and 14 to 16, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a coat weight control system to reduce variation in coating across paper width (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Leppanen et al. 1989 (Leppanen)	4,833,941	May 30,
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Eriksson	WO 93/05887	April 1, 1993
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Claims 2 to 6, 11 and 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 reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 1 to 8, 11 and 14 to 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eriksson.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Eriksson in view of Leppanen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 26, mailed May 2, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 25, filed February 10, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The written description rejection

We will not sustain the rejection of claims 2 to 6, 11 and 14 to 16 under 35 U.S.C. § 112, first paragraph.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description

requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116). Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563-64, 19 USPQ2d at 1116-17 and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner has identified three claimed limitations as not complying with the written description requirement (answer, pp. 4-5). Specifically, the examiner directs our attention to the last paragraph of claim 2, claim 15 and claim 16. The appellant argues (brief, pp. 9-10) that the rejection is in error since the drawings (e.g., Figures 2 and 4) clearly depict the claimed limitations in question. The examiner found this argument unpersuasive (answer, p. 8) since the drawings do not clearly show the claimed rectangular portion.

It is our view that the inventor had possession, as of the filing date of this application, the specific subject matter set forth in the last paragraph of claim 2, claim 15 and claim 16. The original specification clearly described (p. 5) that the backing bar had "keyhole slots 28 which each comprise a circular hole in the bar with a slot in the back of the bar at the same side as the connections 22." Figures 2 and 4 of the original drawings clearly depict each keyhole slot 28 as including a circular hole and a slot. The slot portion of each keyhole slot 28 is depicted in Figures 2 and 4 as two lines that appear to us to be at least substantially parallel to each other. From the drawings and the description of the keyhole slots 28, we conclude that the appellant has conveyed with reasonable clarity to those skilled in the art that, as of the filing date of this application, he was in possession of the now claimed invention. In that regard, it is our opinion that one skilled in that art would have drawn from the appellant's description of the keyhole slots 28 and the showing thereof in Figures 2 and 4 an understanding that the slot portion of the keyhole slot was rectangular.

For the reasons set forth above, the decision of the examiner to reject claims 2 to 6, 11 and 14 to 16 under 35 U.S.C. § 112, first paragraph, is reversed.¹

The obviousness rejections

We will not sustain the rejection of claims 1 to 9, 11 and 14 to 16 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

¹ The issues of whether the appellant's proposed amendments to the drawings and the specification are "new matter" are not appealable issues, however, the examiner should review the objections in light of our decision on the written description rejection.

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Independent claim 1 includes the limitation that at least one of the keyhole slots in the flexible elongated backing bar include an opening which is enlarged relative to its connecting portion. Independent claim 2 includes the limitation that at least one of the keyhole slots in the flexible backing bar include a rectangular portion and a circular portion wherein the diameter of the circular portion is greater than the width of the rectangular portion.

The examiner determined (answer, p. 5) that the above-noted limitations of claims 1 and 2 were not taught by Eriksson. The examiner then concluded that the claimed shape of the keyhole slot would have been a matter of choice which a person of ordinary skill in the art would have found obvious absent a showing that the particular shape produced unexpected results.

We agree with the appellant's argument (brief, pp. 10-12) that the examiner's rejection of claims 1 and 2 is in error. In that regard, the examiner's determination of obviousness has not been supported by any evidence that would have led an artisan to arrive at the claimed invention. Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is

not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In our view, the only suggestion for modifying Eriksson in the manner proposed by the examiner to meet the above-noted limitations of claims 1 and 2 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 and 2, and claims 3 to 9, 11 and 14 to 16 dependent thereon, under 35 U.S.C. § 103 is reversed.²

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 to 6, 11 and 14 to 16 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 1 to 9, 11 and 14 to 16 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)
Administrative Patent Judge)
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) BOARD OF PATENT

² We have reviewed Leppanen applied in the rejection of claim 9 but find nothing therein which makes up for the deficiencies of Eriksson discussed above.

JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 1997-3798
Application No. 08/272,018

Page 13

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Appeal No. 1997-3798
Application No. 08/272,018

Page 14

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