

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL E. FFIELD,
JOHN W. SCHOOFF
and
STEVEN C. VAN SWEARINGEN

Appeal No. 98-0455
Application 08/467,247¹

ON BRIEF

¹ Application for patent filed June 6, 1995. According to appellants, the application is a division of Application 07/949,177 filed September 21, 1992, abandoned.

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Before ABRAMS, FRANKFORT and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 8. Subsequent to the final rejection in a paper filed April 7, 1997 (Paper No. 16), appellants canceled claims 1, 2, 5 and 6, and amended claim 8 to be dependent from claim 7. Accordingly, the only claims remaining in this application for our consideration on appeal are claims 3, 4, 7 and 8.

The subject matter on appeal is directed to a system and method of loading large parts onto a floor assembly jig which holds said parts in position for fastening together to make a large mechanical structure, such as a wing spar assembly for a large aircraft. The floor assembly jig (32) is best seen in Figure 1 of the application, while the parts loading system comprising the subject matter before us on appeal is shown somewhat schematically in Figures 12 and 13. A copy of

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claims 3, 4, 7 and 8 on appeal may be found in the Appendix of appellants' brief.

The sole rejection presented for our review is that of claims 3, 4, 7 and 8 under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an enabling disclosure, i.e., which fails to adequately teach one skilled in the art how to make and use the claimed invention. On pages 4 through 7 of the answer, the examiner presents his commentary as to why he considers the present disclosure to be insufficient. In particular, it is noted on page 5 of the examiner's answer that

[t]he examiner agrees that the steps of claims 3 and 4 are supported by the specification in accordance with 35 U.S.C. § 112 first paragraph with the exception of the "rotating" step. The only enablement provided by the specification with regards to rotation of the frame is that the frame is able to be rotated. The specification makes no mention as to how one would rotate the frame in accordance with the claimed rotating step. The disclosure involves assembling large mechanical parts of aircraft wings. It appears that some sort of mechanical assist device is necessary in order to provide the force necessary to perform this rotation of the frame while

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these large mechanical structures are mounted thereon. Even though it is well known to provide a mechanical assist device (e.g., hydraulic devices) to assist in moving large structures, no disclosure is present which would enable one of ordinary skill to utilize such a mechanical assist device in the rotation of the frame in this particular instance as claimed.

Rather than reiterate the full details of the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 18, mailed July 8, 1997) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 14, filed April 8, 1997) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, and to the respective positions articulated by appellants and the examiner. As a consequence of our review we have reached the determination which follows.

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Looking to the examiner's rejection of claims 3, 4, 7 and 8 on appeal, we observe that the first paragraph of 35 U.S.C. § 112 requires, inter alia, that the specification of a patent (or an application for patent) enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those skilled in the art to make and use the invention without "undue experimentation." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is "undue." Id. at 736-37, 8 USPQ2d at 1404.

Moreover, in rejecting a claim for lack of enablement, it is well settled that the examiner has the initial burden of producing reasons that substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 1232, 212

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

In the case before us, we believe the examiner has not met his burden of advancing acceptable reasons inconsistent with enablement. While we appreciate the examiner's discomfiture over the somewhat schematic illustration of the parts loading system in appellants' drawings, and the paucity of details concerning the mechanism by which the flip doors (92) and frame members (91) are pivoted in the manner set forth on pages 7 and 8 of the specification, we nonetheless do not find that this issue is such as to give rise to non-enablement when the disclosure as a whole is viewed from the perspective of one of ordinary skill in the art.

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In this regard, it is our opinion that the level of skill in this art (i.e, the handling of large parts for assembly into a large mechanical structure, such as a wing spar assembly for a large aircraft) is sufficiently high that the ordinarily skilled artisan would have been able to fashion a powered lifting mechanism of the type referred to on page 2 of the specification (as amended August 23, 1996) and as set forth in original claim 1 of the present application, based on appellants' disclosure, without the exercise of undue experimentation, and that the parts loading system and its powered lifting mechanism would be capable of operation in the manner claimed and as generally disclosed by appellants. The mere fact that skill in the art and/or material extraneous to the originally filed disclosure, but known to those of ordinary skill in the art at the time of filing of the application, might be relied upon by the artisan in making and using the disclosed parts loading system is not fatal. As the Court made clear in In re Gaubert, 524 F.2d 1222, 1226, 187 USPQ 664, 667 (CCPA 1975), citing Martin v. Johnson, 454 F.2d 746, 751, 172 USPQ 391, 195 (CCPA 1972),

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[e]nablement is the criterion, and every detail need not be set forth in the written specification if the skill in the art is such that the disclosure enables one to make the invention.

For the above reasons, we will not sustain the examiner's rejection of claims 3, 4, 7 and 8 under 35 U.S.C. § 112, first paragraph, as being directed to a non-enabling disclosure.

The decision of the examiner is reversed.

REVERSED

	NEAL E. ABRAMS)	
	Administrative Patent Judge)	
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)	
)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
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JEFFREY V. NASE)
Administrative Patent Judge)

psb

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