

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKIO TOGAMI and AKIRA TOMITAKA

Appeal No. 1998-2043
Application No. 08/606,601

ON BRIEF

Before HAIRSTON, KRASS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-12, which are all the claims in the application.

We affirm-in-part.

BACKGROUND

The disclosed invention is directed to a method and apparatus for loading magnetic tape to magnetic heads in a video tape recorder (VTR). Claim 1 is reproduced below.

1. An apparatus arranged to pull out, from a cassette, a tape contained in the cassette and to record and/or reproduce information on or from the tape, comprising:

(a) a rotary drum having a head for recording and/or reproducing information on or from the tape;

(b) a cassette mounting member on which the cassette is mountable and which is movable between a first position located away from said rotary drum and a second position located close to said rotary drum; and

(c) first and second tape guiding members arranged to pull out the tape from the cassette mounted on said cassette mounting member and to wrap the tape around said rotary drum, wherein at least said first tape guiding member pulls out the tape from the cassette before said cassette mounting member begins to move from the first position to the second position, and, after that, said first tape guiding member and said cassette mounting member move in directions of approaching said rotary drum.

Claims 1-12 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

Claims 7-10 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as failing to provide an enabling disclosure and/or failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

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Claims 1-10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

We refer to the Final Rejection (Paper No. 8) and the Examiner's Answer (Paper No. 11) for a statement of the examiner's position and to the Brief (Paper No. 10) and the Reply Brief (Paper No. 12) for appellants' position with respect to the claims which stand rejected.

OPINION

We address the rejections under the first and second paragraphs of section 112 separately, in inverse order. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) ("Any analysis...should begin with the determination of whether the claims satisfy the requirements of the second paragraph [of section 112]."). The rejection of claims 7-10 under "first and second paragraphs" will be considered first in view of the requirements of 35 U.S.C. § 112, second paragraph, and then in view of the requirements of the first paragraph of the statute.

Section 112, second paragraph rejections

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According to the examiner, claims 7-10 are “indefinite and incomplete...for failing to clearly and completely recite the critical movements of the cassette mounting member and first guide means [sic; first guiding member].” (Final Rejection, page 3.)

Appellants consider the rejection to be grounded on “undue breadth,” and assert that the independent claim (7) need not recite the movements of the cassette mounting member and guide members. (See Brief, pages 9-12.)

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. In re Vamco Mach., Inc., 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 635 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

We agree with appellants that the subject matter circumscribed by claim 7 is reasonably ascertainable, and there is no requirement of any recitation of the “critical movements,” as the examiner terms them, of the cassette mounting member and first

guiding member. Accepting the underlying premise of the rejection at face value -- that 35 U.S.C. § 112, second paragraph may require that the claims contain elements that the disclosure teaches as being critical or essential¹ -- the things alleged to be critical are not relevant to the subject matter of claims 7-10. The principal reason that the disclosed “movements” are not required to be present in claim 7 is that claim 7 is drawn to an apparatus, rather than a process. (Compare method claim 11, which has not been rejected for indefiniteness.) Claim 7 positively recites a “rotary drum,” a “cassette mounting member,” and “first and second tape guiding members.” The cassette mounting member is “supported for movement” between two positions with respect to the rotary drum, and the first and second guiding members are also “supported for movement” to wrap the tape around the drum. The structures set forth are thus consistent with the “movements” described in appellants’ disclosure.

Claim 7 ends with a “wherein” clause that serves to further limit (“at least”) the first tape guiding member. The clause may be read to refer, at least indirectly, to movements which are required in practicing the disclosed process. However, whatever may be required in the process, the “wherein” clause of claim 7 limits structure of the tape guiding members, rather than setting out the method for practicing appellants’ invention.

Thus, in our view a proper interpretation of claim 7 results in the conclusion that the claim sets forth an apparatus, and the recital of “movements” in the claim is not required for

¹ The examiner has cited no authority in support of the underlying premise.

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setting forth any essential subject matter. Further, the claim sets forth the metes and bounds of the invention with a reasonable degree of precision and particularly. We therefore do not sustain the rejection of claims 7-10 under 35 U.S.C. § 112, second paragraph.

We next turn to the rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph. According to the examiner, claim 1 is “incomplete and indefinite” because it fails to recite the structures that provide the actions recited in the “wherein” clause. “The guide members by themselves do not provide the listed results.” (Final Rejection, page 4.)

Appellants respond (Brief, page 13) that the rejection is deemed to be in error “[f]or the same reasons above addressing the rejection of claim 1 in Issue 1....” However, a review of the arguments presented with respect to claim 1 in “Issue 1” (Brief, pages 5-9) reveals that those arguments are directed to the question of enablement of the subject matter of claim 1. Indeed, “Issue 1,” as set forth on pages 4 and 5 of the Brief, is clearly recognized by appellants as arising from the rejection of claims 1-10 under 35 U.S.C. § 112, first paragraph for lack of enabling disclosure. Appellants’ position is thus not responsive to the rejection made under the second paragraph of the statute, which concerns whether the claims particularly point out and distinctly claim the relevant subject matter, rather than whether the disclosure enables one skilled in the art to make and use appellants’ invention.

The rejection of claims 1-6 for indefiniteness appears reasonable, in that the scope of base claim 1 seems to be ambiguous. In light of appellants' disclosure, the "first and second tape guiding members" recited in claim 1 refer to tape guiding members 10, 11 as shown in instant Figures 1-4. The tape guiding members are distinct from supportive structures such as arm 13 and shaft 13a, which are attached to tape guiding member 10 and which are responsible, in part, for effecting movement of tape guiding member 10. Although the "wherein" clause refers to movement of "at least" the first tape guiding member, there is nothing otherwise recited in the claim that is capable of imparting movement to "at least" the first tape guiding member. The claim thus, at the least, raises a question with respect to what structures the recitations set forth as making up the apparatus -- that is, what additional structure, in addition to that positively recited, might be included by the claim.²

In any event, appellants have not shown the rejection of claims 1-6 for indefiniteness to be in error, and indeed have failed to submit any suitable response to the rejection. We therefore sustain the rejection of claims 1-6 under 35 U.S.C. § 112, second paragraph.

We do not sustain the rejection of claims 7-10 under section 112, second paragraph, however. The "first sense rotational movement" of claim 7, alleged to render

² We observe that appellants must intend for the "wherein" clause of claim 1 to set forth further structure than that positively recited (i.e., in addition to the rotary drum, cassette mounting member, and tape guiding members). If the "wherein" clause does not do so, it appears that claim 1 would read on appellants' own admitted prior art, as represented by instant Figures 5-7.

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claim 7 indefinite (see Final Rejection, page 4), merely refers to rotational movement in a particular direction, such as that represented by the arrow in instant Figure 2. We agree with appellants to the extent that the recitation is reasonably clear in light of the teachings of the instant specification, and accordingly do not sustain the rejection of claims 7-10.

Section 112, first paragraph rejections

We next turn to the rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure.

The first paragraph of 35 U.S.C. 112 requires, inter alia, that the specification of a 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 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.

In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

The question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention; the specification need not disclose what is well known in the art. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (citing In re Myers, 410 F.2d 420, 161 USPQ 668 (CCPA 1969)). "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3

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USPQ2d 1737, 1743 (Fed. Cir. 1987). "Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962).

With the above-noted guidelines in mind, we do not agree that lack of enablement has been established. The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is indeed enabling. In re Wright, 999 F.2d 1557, 1561-62, 1510, 1513 (Fed. Cir. 1993).

However, the statement of the rejection (Final Rejection, page 2) does little to meet the initial burden. The rejection merely points out that there is "no disclosure" of the structure of certain mechanisms, which, without more, does not show lack of enablement. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The factors to be considered in determining whether a disclosure would require undue experimentation include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

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The statement of the rejection is thus plainly deficient.³ However, the examiner's position is fleshed out somewhat on pages 3 and 4 of the Answer. The examiner refers to instant prior art Figures 6 and 7, and draws attention to the fact that the (undisclosed) drive train system inherent in appellants' system is located differently from those that came before, since the instant invention locates the tape guiding members and arms on the movable cassette mounting member.

However, in our view, other factors -- not addressed in the rejection -- which are relevant to the enablement analysis outweigh the facts pointed out by the examiner upon which the instant rejection is based. The level of predictability in the mechanical and electrical arts is recognized as being relatively high. See, e.g., In re Hogan, 559 F.2d 595, 606, 194 USPQ 527, 537-38 (CCPA 1977) (taking notice of the high level of predictability in mechanical or electrical environments and the lower level of predictability expected in chemical reactions and physiological activity). The U.S. patents cited by the examiner as being pertinent to appellants' disclosure (in the Office action mailed Dec. 6, 1996, Paper No. 5), of record, are indicative of the state of the prior art, and the relative skill of those in the art. The disclosures of Takeda et al. (5,315,46), Yamabuchi et al. (5,361,180), and Lee et al. (5,459,626) appear to indicate that the mechanical structures that are

³ We note that, consistent with the law of our reviewing court, it is Office policy to consider all the relevant factors when making a rejection for lack of enablement. "The examiner's analysis must consider all the evidence related to each of these [In re Wands] factors, and any conclusion of nonenablement must be based on the evidence as a whole." Manual of Patent Examining Procedure § 2164.01(a), Seventh Edition, Rev. 1 (Feb. 2000).

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undisclosed by appellants would not require, for the skilled artisan, more than a modicum of experimentation to construct the desired expedients.

Appellants have submitted no evidence in response to the rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph. However, since the rejection fails to consider the evidence as a whole, we hold that the examiner's initial burden has not been met, and there was no requirement for evidence in rebuttal. We do not sustain the rejection.

Finally, we consider the rejection of claims 7-10 under 35 U.S.C. § 112, first paragraph, as set out on pages 2-3 of the Final Rejection. The rejection appears to be based on the position that critical limitations with respect to "timing" of movements are missing from the claims. See In re Mayhew, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976) (affirming rejection under 35 U.S.C. § 112, first paragraph, because claims which failed to recite essential features of invention were not supported by an enabling disclosure).

However, as we noted in the analysis of the requirements of claim 7 in our review of the rejection for indefiniteness, supra, claims 7-10 are drawn to an apparatus. As a factual matter, timing of movements cannot be considered critical when the invention is defined by mechanical structures, as opposed to being defined by process steps. We do not sustain the rejection of claims 7-10 under 35 U.S.C. § 112, first paragraph.

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CONCLUSION

The rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph is reversed. The rejection of claims 7-10 under 35 U.S.C. § 112, first and second paragraphs is reversed. The rejection of claims 1-6 under 35 U.S.C. § 112, second paragraph is affirmed. The rejection of claims 7-10 under 35 U.S.C. § 112, second paragraph is reversed.

The examiner's decision in rejecting claims 1-12 is thus affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
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