

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
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Ex parte GORDON SWEENIE  
and DON SPEARS  
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Appeal No. 1998-2436  
Application 08/550,667  
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ON BRIEF  
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Before KIMLIN, WALTZ and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, which are all the claims pending in this application.

Claim 1 is illustrative of the invention:

1. A synthetic turf having a substrate and a plurality of synthetic polymer turf filaments anchored in the substrate and extending therefrom, said filaments having a denier ranging between 100 and 1200, and each said filament having a substantially diamond-shaped cross section with a



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The examiner asserts that the original specification does not support the now claimed subject matter regarding a filament having a thickness which tapers from the lateral axis substantially symmetrically and "smoothly" about the longitudinal axis towards each tip. (Answer, page 3). The examiner states that the exactitude of the drawings is not such that one of ordinary skill in the art would understand that the disclosed invention is limited to such fibers. (Answer, pages 3-4).

Appellants argue that the word "smoothly" is embodied in the original specification in both Figure 2 and in the body of the specification in the concept of a "substantially diamond-shaped cross section." (Brief, pages 8-9).

We note that the drawings are part of the original disclosure.<sup>1</sup> We determine that one having ordinary skill in the art, upon observation of original Figure 2 (or amended Figure 2) would discern that the thickness tapers smoothly about the longitudinal axis 31. For example, the lines depicted in Figure 2 are not uneven.

We further note that the issue is whether original Figure 2 (or amended Figure 2) reasonably conveys to one of ordinary skill in the art that, as the filing date of the present application, the inventors had possession of the subject matter now claimed in claim 1. In re Edwards, 568 F.2d 1349, 1351-1352, 196 USPQ 465, 467

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(CCPA 1978). Here, Figure 2 adequately conveys to one of ordinary skill in the art a filament having a thickness which tapers substantially symmetrically and "smoothly" about a longitudinal axis.

In view of the above, we **reverse** the 35 U.S.C. § 112, first paragraph rejection of claims 1-10.

II. The 35 U.S.C. § 112, first paragraph, enablement rejection

The examiner states that in view of the declaration dated August 15, 1996 of Mr. Cole, "it is clear that the specification fails to actually teach how to produce the claimed diamond-shaped cross section filaments."

(Answer, page 5).

Beginning on page 16 of their brief, appellants state that the specification teaches that the filaments are formed by extruding various polymers. On page 17 of the brief, appellants state that a person skilled in the art of polymer extrusion "knows well that to obtain a filament having a certain shape, the spinnerette to which the polymer is extruded should have that shape".

Further, appellants state that it is well known that drawing and texturizing the extruded filaments can be used to further shape the extruded filaments. (brief,

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<sup>1</sup> We note (as indicated on page 5 of appellants' brief) that original Figure 2 was amended. We observe that original Figure 2 and amended Figure 2 each depict the same basic structure.

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page 17). Appellants point out, at the top of page 18 of the brief, that the original application does expressly mention the steps of drawing and texturizing the extruded filaments.

As the court in In re Gaubert, 524 F.2d 1222, 1226, 187 USPQ 664, 667 (CCPA 1975)(quoting from Martin v. Johnson, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972)) stated:

To satisfy § 112, the specification disclosure must be sufficiently complete to enable one of ordinary skill in the art to make the invention without undue experimentation, although the need for a minimum amount of experimentation is not fatal. \* \* \* [citations omitted.]

In the instant case, we determine that the examiner has not satisfied his initial burden of producing any reasonable line of reasoning which would substantiate a rejection based on a lack of enablement. See In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)(the examiner has initial burden of producing reasons which substantiate a rejection based on a lack of enablement).

Specifically, the examiner's analysis fails to take into account the state of the art discussed by appellants on pages 16-18 of their brief. Moreover, the examiner has not explained why undue experimentation is needed to arrive at the claimed subject matter, especially when one of ordinary skill in the art possesses the state of the art knowledge of polymer extrusion as pointed out on page

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17 of appellants' brief. It appears that the examiner views the Cole declaration (dated August 15, 1996) as providing more information than appellants' specification regarding how to make appellants' filaments. However, the examiner has not explained how this shows undue experimentation.

Accordingly, the examiner has not convincingly demonstrated that the artisan would not know how to make a filament having "a substantially diamond-shaped cross section" without undue experimentation.

Therefore, we **reverse** the examiner's decision rejecting claims 1-10 as lacking an enabling disclosure.

III. The 35 U.S.C. § 112, first paragraph, best mode rejection

The examiner asserts that the best mode contemplated by the inventor has not been disclosed in view of the evidence found in Mr. Cole's declaration filed August 15, 1996. (Answer, page 5).

On page 19 of the brief, appellants state that the original specification expressly sets forth the steps of drawing and texturizing the extruded filaments. Appellants point to page 8, line 13 and to page 8, line 21 of the specification.

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Upon our review of the specification, we must agree with appellants that the steps of drawing and texturizing are set forth in the original specification. We note that on page 10 of the answer, the examiner argues that the specification does not indicate that these steps are used to form the filaments of the instant invention. We disagree with the examiner's understanding of appellants' specification. The specification clearly sets forth that filament 20 can be texturized and that filament 20 can be drawn (page 8, lines 13 and 21 of appellants' specification).

It appears that the examiner views the Cole declaration (dated August 15, 1996) as providing more information than appellants' specification regarding the details of how to make appellants' filaments. Based upon this, the examiner concludes that appellants have withheld the best mode of carrying out the invention. We determine that the examiner has not met his burden for the following reasons.

Evaluation of whether the best mode requirement has been satisfied entails two underlying factual inquiries. One must first determine whether the inventor subjectively contemplated a best mode of practicing the claimed invention at the time the patent application was filed. United States Gypsum Co. v. National Gypsum Co., 74 F.3d 1209, 1212, 38 USPQ2d 1388, 1390 (Fed. Cir.

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1996).<sup>2</sup> If the inventor contemplated such a best mode, one must then determine whether, objectively, the specification adequately discloses the best mode such that those having ordinary skill in the art could practice it.<sup>3</sup> *Id.* See also Great N. Corp. v. Henry Molded Prods., 94 F.3d 1569, 1571, 39 USPQ2d 1997 (Fed. Cir. 1996).

In the present case, the examiner does not discuss whether the specification adequately discloses the best mode such that those having ordinary skill in the art could practice it. The examiner simply states that because the specification does not set forth the steps discussed in the Cole declaration, then appellants have withheld the best mode of carrying out the invention. (answer, page 5). The examiner does not explain how the Cole declaration shows that the specification does not adequately disclose the best mode such that one of ordinary skill in the art is unable to practice appellants' invention. Accordingly, the examiner has not met his burden.

In view of the above, we **reverse** the rejection of claims 1-10 under 35 U.S.C. § 112, first paragraph, best mode.

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<sup>2</sup>We note that the examiner has not raised this aspect of best mode in the present case as an issue before us, and therefore need not be considered.

<sup>3</sup> We note that this aspect of best mode has been raised by the examiner as an issue before us.

IV. The 35 U.S.C. § 103 rejections<sup>4</sup>

The examiner's position is that he interprets appellants' claim 1 as setting forth a cross section that is elliptical in shape. (Answer, page 6).

At the bottom of page 25 through page 26 of their brief, appellants state that their claimed invention is directed towards a filament having a thickness that tapers symmetrically and smoothly about the longitudinal axis from the medially located lateral axis towards each tip.

Hence, there exists a contested limitation with regard to claim 1. We note that implicit in our analysis, is that the claim must first have been correctly construed to define the scope and meaning of a contested limitation. Gechter v. Davidson, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). Here, we must construe the term "substantially diamond-shaped cross section" to ascertain its scope and meaning.

We determine that Figure 2 (original or amended), describes the shape of "substantially diamond-shaped cross section." In view of this definition provided by Figure 2, we must compare the illustrated cross section of Figure 2 with the teachings of Hisaaki. Our comments on this comparison are set forth below.

On page 6 of the answer, the examiner states that Hisaaki teaches a rectangular cross section with rounded

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<sup>4</sup> We note we need not discuss the secondary reference of Geerts in connection with the rejection of claims 6-10 because Geerts does not

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corners or an elliptical form. On page 12 of the answer, the examiner states that Hisaaki discloses filaments that range in cross section from rectangular to oval "which includes all shapes as one goes from rectangular to oval not just the two shapes of rectangular and oval".

Upon our review of Hisaaki, we observe on page 4 of the English translation, first paragraph, that Hisaaki discloses a yarn having either a rectangular cross section with round corners or an oval cross section. Also, at the top of page 6 of Hisaaki, Hisaaki discloses a yarn having a cross-section that is shaped rectangularly with rounded or a cross section shaped oval. On page 24 to page 25 of the brief, appellants recognize this same disclosure.

On page 25 of the brief, appellants state that Hisaaki "merely recites its variable contraction ratio yarns may take conventional yarn shapes whose cross sections range from rectangular to oval".

We are unable to find any disclosure in the English translation of Hisaaki that specifically indicates that cross sections of the fiber can range from rectangular to oval (to include all shapes in between rectangular and oval). However, even assuming, *arguendo*, that Hisaaki discloses that there is a range of shapes from rectangular to oval, we determine that the examiner has not met his burden of setting forth a prima facie case, for the following reasons.

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remedy the deficiencies noted in the primary reference to Hisaaki, *infra*.

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The examiner has not explained how appellants' filament, as depicted in Figure 2, is taught by Hisaaki, nor has the examiner explained why one of ordinary skill in the art would have particularly chosen appellants' shaped filament in view of Hisaaki. Whether or not Hisaaki discloses a range of shapes from rectangular to oval, the examiner has not explained how such a range of shapes would necessarily include the shape depicted in appellants' figure 2. Alternatively, the examiner has not explained why one of ordinary skill in the art would have altered the shape disclosed in Hisaaki in order to achieve appellants' claimed shape as depicted in Figure 2. We note that the examiner bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Hence, we conclude the examiner has not met his burden.

Accordingly, we **reverse** each of the 35 U.S.C. § 103 rejections.

#### V. Other issues

We note that appellants discuss, in their reply brief, the issue of the Section 132 objections to new matter, and

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whether such objections are petitionable or appealable.  
We do not review Section 132 objections.

**REVERSED**

Edward C. Kimlin )  
Administrative Patent Judge )  
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 ) BOARD OF  
PATENT Thomas A. Waltz )  
Administrative Patent Judge ) APPEALS AND  
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