

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(2) is not binding precedent of the Board.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. 64

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL P. DEFRANK and ROBERT J. ROSATI

Appeal No. 1998-2823
Application No. 08/458,010

HEARD: December 05, 2000

Before CALVERT, FRANKFORT, and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8, 9, 15, 17, 18, 20 through 22, 26, 27 and 32 through 51. Claims 1 through 7, 10 through 14, 16, 19, 23 through 25 and 28 through 31 have been canceled. In the advisory action mailed March 25, 1997 (Paper No. 40), the examiner has

Appeal No. 1998-2823
Application No. 08/458,010

indicated that the rejection of claim 18 has been withdrawn and that claim 18 is now considered to be allowable.

Accordingly,

the appeal as to claim 18 is dismissed, leaving claims 8, 9, 15, 17, 20 through 22, 26, 27 and 32 through 51 for our consideration on appeal.¹

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b). In addition, we REMAND the application to the examiner for further consideration.

The subject matter on appeal is directed to a biomedical apparatus (claims 8, 9, 15, 17, 20 through 22, 32 through 38 and 44), to a method of communicating energy from a patient (claims 26, 27 and 39) and to a probe having replaceable elements (claims 40 through 43 and 45 through 51). An understanding of the invention can be derived from a reading of exemplary claims 8, 26 and 40, copies of which appear in

¹ Claims 17, 20 and 27 were amended subsequent to the final rejection. See Paper Nos. 38 and 46.

Appeal No. 1998-2823
Application No. 08/458,010

"Exhibit A" attached to appellants' main brief.²

Claims 8, 9, 15, 17, 20 through 22, 26, 27 and 32 through 51 stand rejected under 35 U.S.C. § 112, first paragraph.^{3,4}

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 49) for the examiner's complete reasoning in support of the rejection, and to the main and reply briefs (Paper Nos. 47 and 50, respectively) 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.

² All references in this decision to appellants' main brief refer to the second amended brief filed October 6, 1997 (Paper No. 47).

³ The inclusion of claim 18 in the statement of the ground of rejection at page 4 of the answer was an obvious typographical error.

⁴ The rejection of claim 26 under 35 U.S.C. § 103 (referred to as Issue B in appellants' main brief (p. 8)) was withdrawn in the answer (p. 3).

Appeal No. 1998-2823
Application No. 08/458,010

We will not sustain the examiner's rejection of claims 8, 9, 15, 17, 20 through 22, 26, 27 and 32 through 51 under 35 U.S.C. § 112, first paragraph.⁵

At the outset we note that at page 2 of the final rejection (Paper No. 35) the examiner objected to the specification "under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention" and as failing to "provide support for the invention as is now claimed." Regarding the failing to "provide support" issue, the examiner stated that "[t]he claimed invention, e.g., claims 17, 20-22, 34, 38 and 44, i.e., 'non-resilient,' does not to [sic] appear to be supported by the specification as originally filed." See final rejection, p. 3. However, this ground of rejection has been withdrawn. See advisory action mailed March 25, 1997 (Paper No. 40) and the answer, p. 2.

⁵ We note that the language "the replaceable window" in claim 17 lacks antecedent basis in the claim and should properly read --the removable window--. This informality is worthy of correction upon return of the application to the jurisdiction of the examiner.

Appeal No. 1998-2823
Application No. 08/458,010

In addition, the examiner has withdrawn the objection to the specification as lacking adequate written description for the claim terminology "electromagnetic energy," "first optical opening," "second optical opening," "non-resilient material which is transparent," "first and second openings" and "diffusion means." See answer, p. 2. Thus, the only objections to claim terminology in the final rejection which the examiner has not withdrawn are the objections to "brittle" (claims 32 and 40) and "energy" (claim 26). See final rejection, p. 3 and answer, p. 4.

The answer (p. 7) also identifies the claim terminology "energy detector," "first position," "received energy," "energy conducting passage," "energy conducting member," "insulation means" and "replaceable elements" as lacking antecedent basis.

It is the examiner's position that the original disclosure of zinc selenide as a suitable glass-like material for the window 22 (specification, p. 5) does not provide support for the limitation a "window formed of a brittle

Appeal No. 1998-2823
Application No. 08/458,010

material" (emphasis supplied) set forth, for example, in independent claims 17, 26 and 40. See answer, p. 6.

The examiner also determined that the terminology "energy," "energy detector," "received energy," "energy conducting passage," and "energy conducting member" lack antecedent basis because only electromagnetic or infrared energy is described in the original disclosure. Likewise, the examiner determined that the language "insulation means" and "replaceable elements" lack antecedent basis because only an air gap insulation means and a replaceable window and sleeve, respectively, are described in the original disclosure. Finally, the examiner believes the terminology "first position" to lack antecedent basis in the disclosure. See answer, p. 7.

We understand the examiner's characterization of the claim terminology "brittle," "energy," "energy detector," "first position," "received energy," "energy conducting passage,"

Appeal No. 1998-2823
Application No. 08/458,010

"energy conducting member," "insulation means" and "replaceable elements" as lacking antecedent basis⁶ as being predicated on an alleged failure of the specification to comply with the written description requirement (new matter) of 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Our reviewing Court has also made it clear that by disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an

⁶ The requirement that the terms and phrases used in the claims must find clear support or antecedent basis in the description is a requirement of the rules, specifically, 37 CFR § 1.75(d)(1).

Appeal No. 1998-2823
Application No. 08/458,010

advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. In re Smythe, 480 F.2d 1376, 1384, 178 USPQ 279, 285 (CCPA 1973).

Although the appellants' original disclosure does not expressly describe zinc selenide as a "brittle material," appellants argue (main brief, pp. 15-16) that the record includes evidence that at the time the application was filed an artisan would have been aware that zinc selenide was a brittle material. Based on the evidence of record, it is our determination that the disclosure of the application as originally filed reasonably conveys to the artisan that appellants had possession at that time of a window 22 formed of a brittle material and the recitation of such a window in claims 17, 26, and 40 does not pose a written description problem.

Turning next to the examiner's determination that the terminology "energy," "energy detector," "received energy," "energy conducting passage," and "energy conducting member"

Appeal No. 1998-2823
Application No. 08/458,010

lack antecedent basis because only electromagnetic or infrared energy

is described in the original disclosure, we agree with appellants' argument (main brief, pp. 16-17) that the original disclosure of electromagnetic energy (see, e.g., original claim 1) and infrared energy (see, e.g., original claim 10) provides descriptive support for the noted terminology.

As to the terminology "first position," appellants argue that the term is used to define a location to which electromagnetic energy is communicated. As explained at page 3 of the reply brief:

[s]upport for Appellants' use of the term "first position" is thus found in the specification as originally filed on page 3, lines 25-27, where Appellants, describing Figure 2, state that "the waveguide is generally cylindrical in shape and extends axially through the heat sink 20 for communication of infrared energy from the temperature source to the infrared detector." This clearly indicates that infrared energy is being communicated from a temperature source, such as a patient, to another location, which Appellants have identified in the claims as a "first position."

We agree with appellants that the terminology "first position"

Appeal No. 1998-2823
Application No. 08/458,010

does not pose a written description problem.

With regard to the terminology "insulation means" and "replaceable elements," the examiner acknowledges, supra, that the original disclosure describes an air gap insulation means and

a replaceable window and sleeve. Further, it is readily apparent that the closed air space or air gap 25 which is described as "providing a layer of insulative air around the probe" (specification, p. 7) constitutes an "insulation means" and that the window and sleeve which are described as being readily removable and replaceable (id. at p. 5) constitute "replaceable elements." Thus, here again the disclosure of the application as originally filed would reasonably convey to the artisan that appellants had possession at that time of "insulation means" and "replaceable elements" as recited in the claims.

For the above reasons, we will not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 8, 9, 15, 17, 20 through 22, 26, 27 and 32 through 51.

Appeal No. 1998-2823
Application No. 08/458,010

NEW GROUND OF REJECTION

In accordance with our authority under 37 CFR § 1.196(b), this panel of the board introduces the following new ground of rejection.

Claim 27 is 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.

Claim 27 recites the limitation "said second optical opening" in line 5 (as reproduced in "Exhibit A"). There is insufficient antecedent basis for this limitation in the claim.

REMAND

The scope of enablement required by 35 U.S.C. § 112, first paragraph, must bear a "reasonable correlation" to the scope of the claims (see, e.g., In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)) and "the specification must teach those skilled in the art how to make and use the full

Appeal No. 1998-2823
Application No. 08/458,010

scope of the claimed invention without 'undue experimentation'" (In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)).

At page 5 of the answer, the examiner indicates a belief that the scope of enablement provided to one of ordinary skill in the art by the disclosure is not commensurate with the scope of protection sought by the claims. However, no rejection based on this ground is found in the final rejection.

Accordingly, we also remand the application to the examiner to consider whether any claim should be rejected under 35 U.S.C. § 112, first paragraph, on the basis that the scope of

the claims is not commensurate with the scope of enablement. See Manual of Patent Examining Procedure (MPEP) § 2164.08 (7th ed., rev. 1, Feb. 2000).

CONCLUSION

To summarize, the decision of the examiner to reject

Appeal No. 1998-2823
Application No. 08/458,010

claims 8, 9, 15, 17, 20 through 22, 26, 27 and 32 through 51
under

35 U.S.C. § 112, first paragraph, is reversed. In addition,
pursuant to 37 CFR § 1.196(b), we have entered a new ground of
rejection against claim 27 under 35 U.S.C. § 112, second
paragraph, and have remanded the application to the examiner
for further consideration under 35 U.S.C. § 112, first
paragraph.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant
to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final
rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203
Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR §
1.196(b) provides, "A new ground of rejection shall not be
considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that appellants, WITHIN
TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of
the following two options with respect to the new ground of
rejection to avoid termination of proceedings (37 CFR
§ 1.197(c)) as to the rejected claims:

Appeal No. 1998-2823
Application No. 08/458,010

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b); REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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Appeal No. 1998-2823
Application No. 08/458,010

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