

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD E. PLEASANT

Appeal No. 2000-1000
Application No. 08/392,062

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is taken from the final rejection of January 22, 1998 of claims 20 through 31 (Paper No. 23). Claims 4 through 9, the only other claims remaining in the application, stand allowed.

Appellant's invention relates to a self-clamping liquid barrier assembly for mounting into a liquid conduit groove of

Appeal No. 2000-1000
Application No. 08/392,062

a mold insert and to a clamping insert for a self-clamping liquid barrier dam assembly that mounts into a liquid conduit groove of a mold insert. A basic appreciation of the invention can be obtained from a reading of exemplary claims 20 and 26, respective copies of which appear in the APPENDIX to the revised brief filed March 8, 1999 (Paper No. 29).

The rejection that follows is the sole rejection on appeal.

Claims 20 through 31 stand rejected under 35 U.S.C. § 112, first paragraph, as being founded upon a specification which lacks descriptive support for the claimed invention.

The examiner's rejection and response to the argument made by appellant is set forth in the answer (Paper No. 30), while the full text of appellant's argument can be found on pages 5 through 9 of the revised brief (Paper No. 29).¹

¹ The examiner makes it clear that the first paragraph rejection under 35 U.S.C. § 112 addresses the description requirement alone (answer, page 4). On the other hand,
(continued...)

OPINION

In resolving the description requirement issue raised on appeal, this panel of the board has carefully considered appellant's specification and claims 20 and 26,² and the views advocated by appellant and the examiner, respectively. As a consequence of our review, we reach the conclusion that follows.

This panel of the board sustains the examiner's rejection of appellant's claims for the reasons given below.

¹(...continued)
appellant's argument is directed to both description and enablement matters. While our focus will appropriately be upon the description issue raised in the examiner's rejection, we will take into account the entirety of appellant's argument as it pertains to that issue.

² We focus our attention exclusively on the subject matter of independent claims 20 and 26 since appellant indicates that claims 20 through 25 stand or fall together and that claims 26 through 31 stand or fall together (revised brief, page 5).

Appeal No. 2000-1000
Application No. 08/392,062

As our review Court stated in In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

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 inventor 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. The content of the drawings may also be considered in determining compliance with the written description requirement. (citations omitted)

Of course, a claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the description requirement. See In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)). However, it must also be kept in mind that the fact one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure. See In re Barker, 559 F.2d 588, 593, 194 USPQ 490, 474 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978). Precisely how close the original description must come to comply with the description

Appeal No. 2000-1000
Application No. 08/392,062

requirement must be determined on a case-by-case basis. See
Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d
1111, 1116 (Fed. Cir. 1991).

The starting point for our analysis is appellant's
original disclosure, assessed in its entirety.

Considering the background of the invention, a clearly
apparent objective of appellant's disclosed invention is to
insure that a barrier dam assembly (dam) will not, during use,
slide or otherwise move around in a liquid conduit groove or
work loose since there is a danger that a loose dam would fly
away and cause injury to a lathe operator (specification, page
3, lines 4 through 12, page 4, lines 11 through 16, and page
14, lines 1 through 6 and lines 12 through 16).

Throughout the entirety of the specification, the
reference is continuously to plural components as regards
"locking members" such as "screws or pins" movable in "bores"
in the dam with the clamping of the dam to the "surfaces" of a
liquid conduit groove being accomplished by the engagement of

Appeal No. 2000-1000
Application No. 08/392,062

"locking members" with inwardly-facing "surfaces" of "recesses" or "undercuts" in the "sidewalls" of the liquid conduit groove (for example, page 4, line 20 to page 5, line 13). The specification (page 5, lines 10 through 13) clearly sets forth that "clamping" of the dam in the liquid conduit groove is "by the use of locking members that extend through bores in the dam body member into engagement with inwardly-facing surfaces of the undercuts." The specification (page 6, lines 17 through 20) further explains that the leading ends of the clamping (locking) members tend to "gouge into the undercut surfaces." As additionally discussed in the specification (page 13, line 21 to page 14, line 16), as the screws are driven, the dam body is "effectively wedged" with increasing "clamping forces" such that the dam assembly is "securely locked" in the liquid conduit groove and "will not slide about or work loose." As additionally described in the specification (page 14),

The combined actions of the clamping forces described above applied to the dam body member 50 and the frictional forces between the interengaged locking screws 66 and undercut surfaces 42 cause the dam assembly

Appeal No. 2000-1000
Application No. 08/392,062

14 [to] be reliably, securely and tightly
clamped within the liquid conduit groove
34.

As to the "preferred embodiment" of the invention (specification, page 7) appellant addresses "short locking screws" mounted within tapped "bores" with the screws being advanced into interfering engagement with inwardly facing "undercut surfaces" (Fig. 7). As a "modification" (specification, pages 7 and page 8, and pages 16 and 17), appellant describes short locking "pins" to be driven through dam member "bores" into interfering engagement with inwardly-facing "undercut surfaces" (Fig. 8). In the specification (page 17), relative to both embodiments (Figs. 7 and 8), appellant expressly indicates that a simple tool such as a screw driver or punch used to engage the exposed "heads" of the locking "screws or pins" is "all that is needed to effectuate the clamping of the dam assembly in place."

At this juncture, we direct our attention to the content of claims 20 and 26.

Appeal No. 2000-1000
Application No. 08/392,062

Independent claim 20 addresses a self-clamping liquid barrier dam assembly for mounting into a liquid conduit groove of a mold insert, with the combination comprising a body member located within the groove and having a bore extending therethrough, and a locking member located in the bore for having an end thereof driven into frictional engagement with an undercut surface of the liquid conduit groove.

Independent claim 26 recites a clamping element for a self-clamping liquid barrier dam assembly that mounts into a liquid conduit groove of a mold insert, the assembly including a body member that can be located entirely within the groove, with the clamping element comprising, a bore, and a locking member located in the bore, the locking member having an end thereof to be driven into frictional engagement with an undercut surface of the liquid conduit groove.

Like the examiner, we conclude that appellant's originally filed underlying disclosure, read as a whole, fails to reasonably convey to one skilled in the art that appellant

Appeal No. 2000-1000
Application No. 08/392,062

had possession of the later claimed subject matter of claims 20 and 26.

It is quite clear to us that the import of appellant's teaching, personified by the preferred and modified embodiments of Figs. 7 and 8, respectively, is that the objective of securely installing a liquid dam or barrier assembly is achieved by an undercut in each of the confronting sidewalls of the groove intended for gouging engagement by locking screws or pins to insure that the dam during use will not slide or otherwise move around or become loose to avoid the danger that a loose dam would fly away from a rotating insert and cause injury to a lathe operator. Thus, appellant teaches that the solution to the problem of a dam flying off a rotating insert and causing injury is to provide an undercut in each of the walls of the groove for engagement by locking members (screws or pins). Simply stated, appellant's specification offers no suggestion whatsoever that an undercut provided in a sidewall of the groove, when engaged by a screw or pin, would so secure a dam that the problem of the dam

Appeal No. 2000-1000
Application No. 08/392,062

flying off a rotating insert and causing injury would be solved thereby.

Clearly, appellant's disclosure can fairly be viewed as a restricted or narrow disclosure. It offers a preferred embodiment (Fig. 7) to solve the noted dam securement problem that requires an undercut in each of the two sidewalls of the conduit groove for engagement by locking screws located in bores in a body member of a dam. Further, it suggests an alternative arrangement for solving the problem (Fig. 8) wherein an undercut in each of the two sidewalls of the conduit groove is intended to be engaged by pins located in bores in a body member of a dam. As we see it, one skilled in the art would be informed by appellant's disclosure that an undercut in each of the two sidewalls of a conduit groove cooperating with locking members in respective body member bores is needed to insure that a dam is secured in place and won't fly away and cause injury. The provision of an undercut in each sidewall of the conduit groove for interengagement with locking members in respective body member bores is the only possible solution offered by appellant in the

Appeal No. 2000-1000
Application No. 08/392,062

specification. No variation is even suggested as to other than an undercut in each of the sidewalls of the conduit groove for coacting with locking members in respective body member bores. Thus, this panel of the board finds it reasonable to say that the inclusion of an undercut in each of the sidewalls of a conduit groove for engagement by locking members in respective body member bores is an essential structural attribute of appellant's invention, necessary to achieve the objective of a secure dam that won't fly away and cause injury.

Claims can be no broader than a supporting disclosure. For the reasons set forth above, appellant's narrow disclosure limits claim breadth. See Gentry Gallery v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998). Accordingly, each of claims 20 and 26 is simply not descriptively supported by the original specification, and the rejection thereof under 35 U.S.C. § 112, first paragraph, is clearly sound.

Appeal No. 2000-1000
Application No. 08/392,062

The argument presented by appellant (brief, pages 5 through 9) is simply not convincing of error on the part of the examiner in rejecting claims 20 and 26, in particular, under 35 U.S.C. § 112, first paragraph.

Appellant argues (revised brief, page 7), in rebuttal of the examiner's conclusion that the claimed subject matter lacks descriptive support, that

[o]ne can, in applicant's original application, locate one bore, and a second bore, one undercut and a second undercut, and one locking member and a second locking member.

On this basis, appellant asserts there is no reason to further address the issue of written description (revised brief, page 7).

While appellant may be able to refer in the argument to one bore and a second bore, etc., as above, this is not dispositive of the description issue on appeal. As is evident to us from a reading of each of claims 20 and 26, these

Appeal No. 2000-1000
Application No. 08/392,062

respective claims set forth an invention that was not originally contemplated by appellant and cannot be discerned from a reading of the original disclosure. In other words, appellant's underlying disclosure simply does not inform one skilled in the art of a self-clamping liquid barrier or of a clamping element for a self-clamping liquid barrier that has a bore and a locking member in the bore for frictional engagement with an undercut of a liquid conduit groove to achieve the disclosed advantage. Clearly, the subject matter of claims 20 and 26 is not disclosed as insuring that a dam will not, in use, slide or otherwise move around in the liquid conduit groove such that the loose dam would fly away and cause injury. Appellant's reference to a broad principle of permitting claims for subcombinations as well as for combinations (revised brief, page 8) simply does not apply to the specific inventions of respective claims 20 and 26, which inventions clearly lack support in the original disclosure, as explained above. It is also appellant's viewpoint that there is nothing in the original disclosure which clearly indicates that two locking elements, two bores, and two undercuts are "critical" (revised brief, page 9). We refer appellant to our

Appeal No. 2000-1000
Application No. 08/392,062

earlier conclusion, based upon an overall assessment of the original disclosure, that it is both reasonable and fair to say that the presence of an undercut in each of the sidewalls of a conduit groove for engagement by locking members in respective body member bores is an essential or critical structural attribute of appellant's invention, clearly necessary to achieve appellant's goal of a secure dam that won't fly away and cause injury.

In summary, this panel of the board has affirmed the rejection of claims 20 through 31 under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is affirmed.

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

AFFIRMED

Appeal No. 2000-1000
Application No. 08/392,062

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

ICC:pgg
ROGER S. DYBVIG
22 GREEN STREET
DAYTON, OH 45402