

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte KEIZO YAMAMOTO, HIROSHI NONOGAKI,
TATSUHIRO NAKAMURA and YOSHITAKA TANINO

Appeal No. 2000-1166
Application 08/691,791

ON BRIEF

Before, PAK, WALTZ, and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner finally rejecting claims

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BACKGROUND

The invention is directed to a method for producing a dielectric lens for an antenna. Claim 1 which is representative of the claimed invention is reproduced below:

1. A method of producing a dielectric lens for an antenna, the method comprising:

a foam-molding step in which an expandable material which is a synthetic resin containing a foaming agent is injected into a cavity of a mold and is provided with a pressure,

the weight of the expandable material injected being within a range of about 85 to 91 percent of a theoretical limit weight which is determined by multiplying a volume of the cavity by the specific gravity of the expandable material, and

the volume of the expandable material being at least about 100 percent of a capacity of the cavity, and

the expandable material being foamed at an expansion ratio of not more than about 1.3.

The Examiner rejected claims 1, 3 to 10 and 13 to 18 under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure. (Answer, p. 4).

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OPINION

We reverse.

In rejecting claims 1, 3 to 10 and 13 to 18 under the first paragraph of 35 U.S.C. § 112, the Examiner asserts the specification does not describe the claimed subject matter in such a way as to enable a person of ordinary skill in the art to make and/or use the invention. (Answer, p. 4).

It is well settled that the burden of proof lies upon the Patent and Trademark Office in calling into question enablement of an applicants' disclosure. This burden requires that the Patent and Trademark Office advance acceptable reasoning inconsistent with enablement. Upon the advancement of acceptable reasoning, the burden then shifts to the applicants to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982).

The Examiner has not carried his initial burden of proof. In explaining his rationale for making the rejection before us, the Examiner states that the “[t]he disclosure is confusing with regard to volume and weight of expandable material

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‘over 91% by weight of the capacity (of the cavity)’ is injected. The computation of this theoretical weight limit is described at page 10, lines 5-8, using the volume of the cavity and the specific gravity of the expandable material. But then the actual volume of the expandable material to be introduced is to be at least equal to the volume of the cavity, as set forth at page 10, lines 8-12, and elsewhere in the disclosure, thus rendering the disclosure confusing and conflicting.” (Answer, p. 4). The Examiner does not assert that a person of ordinary skill in the art would not understand the relationship of specific gravity, weight percent and volume of the cavity. However, the Examiner asserts undue experimentation would be required because the disclosure is confusing and conflicting. (Answer p. 4, ll. 5-6). The Examiner does not rely on objective evidence to support this position.

Rather than carrying his initial burden of establishing a *prima facie* case, the Examiner has inappropriately leaped to the conclusion that the specification, as originally filed, does not provide an enabling disclosure for the invention as is now claimed. The only relevant concern of the Patent Office in questions of enablement should be over the truth of any assertions in the specification. The first paragraph of

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indication that the determination of the theoretical weight limit would require undue experimentation by a person of ordinary skill in the art. It is the initial burden of the Examiner to advance acceptable reasoning inconsistent with enablement. The Examiner has provided no basis for questioning the presumption of an enabling disclosure. Thus, the Examiner inappropriately has required the Appellants to carry the initial burden of proving that the claimed subject matter is enabling.

In essence, rather than carrying his initial burden of establishing a *prima facie* case of nonenablement, the Examiner has inappropriately leaped to a conclusion of nonenablement. The Examiner did not specifically apply the factual inquires as listed in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400,1404 (Fed. Cir. 1988) to establish nonenablement.

In light of the foregoing, we cannot uphold the Examiner's section 112, first paragraph, rejection of the appealed claims.

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CONCLUSION

The rejection of claims 1, 3 to 10 and 13 to 18 as unpatentable under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure is reversed.

REVERSED

CHUNG K. PAK
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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