

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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MANFRED MULLER, WERNER REICHELDT,  
PETER FRANK and CHRISTOPHER RHOADES

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Appeal No. 2001-2021  
Application No. 09/206,393

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HEARD: February 19, 2002

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Before STAAB, McQUADE and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

#### DECISION ON APPEAL

Manfred Muller et al. appeal from the final rejection of claims 28 through 38, all of the claims pending in the application.

#### THE INVENTION

The invention relates to "a control element arrangement for controlling the longitudinal and/or the lateral movement of a motor vehicle" (specification, page 1). Representative claim 28 reads as follows:

Appeal No. 2001-2021  
Application No. 09/206,393

28. Control element arrangement for controlling movement of a motor vehicle, comprising:

spaced joy sticks adjacent a left hand and a right hand of a vehicle driver and arranged to be operable independently of one another

wherein each joy stick is configured to be selectively operable with the left hand or a right hand of a vehicle driver for a desired movement of the motor vehicle, one joy stick being arranged on a transmission tunnel and the other joy stick being arranged on an interior side of a driver's door of the motor vehicle, and at least one of the joy sticks being removable from its vehicle-interior-side operating position so as to be operable outside the motor vehicle.

#### THE REJECTION

Claims 28 through 38 stand rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" (final rejection, Paper No. 20, page 2). The examiner's explanation of this rejection focuses on the joy stick limitations in the claims, to wit:

[i]n regards to claims 28-31, 37, and 38, [and presumably claims 32 through 36 which depend from claim 31,] Applicant does not properly disclose the claimed invention in such a way to enable one skilled in the art how to make or use it. More specifically, it is unclear in light of the

Appeal No. 2001-2021  
Application No. 09/206,393

disclosure how the joy sticks optionally control vehicle movement. The disclosure clearly sets out the structural location of the joy sticks but fails to provide how they work.

In regards to claims 28-30 and 37, it is unclear in light of [the] disclosure how the joy stick maintains its control function while removed from the vehicle-interior-side operating position and operated outside the motor vehicle. The art of motor vehicles which utilize a joy stick to act as a control element is old and well known, wherein the joystick is generally electrical in nature and connected by wires (as seen in US Patent 5,086,870 to Bolduc). Applicant states that the joy stick is removed from the interior of the motor vehicle and used outside the motor vehicle but fails to [disclose] how the connection between the joy stick and the controlled device is still in communication once the joy stick is removed [final rejection, pages 2 and 3].

Attention is directed to the brief (Paper No. 25) for the appellants' argument and to the answer (Paper No. 26) for the examiner's response.

#### DISCUSSION

The examiner's statement and explanation of the appealed rejection are inconsonant in that the statement of the rejection identifies a written description issue while the explanation of the rejection pertains to enablement matters. The written description and enablement provisions of 35 U.S.C. § 112, first paragraph, are, of course, separate and distinct.

Appeal No. 2001-2021  
Application No. 09/206,393

Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). For the sake of completeness, we shall review the rejection as if it were predicated on both.

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).

A review of the originally filed disclosure in the instant application shows that it provides support throughout for the joy stick limitations recited in the appealed claims. Thus, it is not evident why this disclosure would not reasonably convey to the artisan that the appellants had possession at that time of the subject matter now recited in these claims.

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure,

Appeal No. 2001-2021  
Application No. 09/206,393

considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

Although the appellants' disclosure does not go into specific detail as to how the joy sticks recited in the appealed claims function to control the movement of the motor vehicle, the examiner has not cogently explained why this lack of detail would have prevented a person of ordinary skill in the art from making and using the claimed vehicle control arrangement without undue experimentation. Indeed, U.S. Patent No. 5,086,870 to Bolduc which is cited in the explanation of the rejection and U.S. Patent Nos. 5,128,671 to Thomas, Jr. and 5,249,272 to Stern which are discussed in and appended to the appellants' brief ostensibly demonstrate that the joy stick limitations in the claims relate to relatively simple and straightforward elements that, in and of

Appeal No. 2001-2021  
Application No. 09/206,393

themselves, would have been quite familiar to a person of ordinary skill in the art.

Hence, the examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 28 through 38, whether based on the written description requirement or the enablement requirement, or both, is not well founded. Accordingly, we shall not sustain this rejection.

SUMMARY

The decision of the examiner to reject claims 28 through 38 is reversed.

REVERSED

Appeal No. 2001-2021  
Application No. 09/206,393

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

JPM/gjh

Appeal No. 2001-2021  
Application No. 09/206,393

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Appeal No. 2001-2021  
Application No. 09/206,393

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REVERSED

HEARD: 3 MEMBER CONFERENCE

November 13, 2002