

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DONALD J. BARRUS  
and STEVEN K. TETZLAFF

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Appeal No. 2001-2686  
Application Re 08/932,718

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HEARD: JANUARY 9, 2002

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Before MCCANDLISH, Senior Administrative Patent Judge, and  
ABRAMS and MCQUADE, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 7 through 12 in the above-identified broadened reissue application. All of the remaining claims in this reissue application, namely claims 1 through 6 (which are the original patent claims), have been allowed.<sup>1</sup>

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<sup>1</sup> As noted in the examiner's answer (see page 2) appellants' brief incorrectly states on page 2 that no claims are pending in the application. Contrary to this statement, claims 1 through 12 are pending in this application.

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Appellants' invention relates to a progressive cavity pump assembly having a flexible connector shaft (39) coupled at one end to a motor drive shaft (47) and at the other end to an orbital pump rotor (21). In contrast to the original patent claims (namely claims 1 through 6), which recite that both ends of the connector shaft are splined or are connected to splined couplings, the independent claims on appeal (namely claims 7 and 11) are broad enough to read on a connector shaft that lacks a splined connection at one of its ends. For example, claim 7 recites that the "at least one of the ends [of the connector shaft] is splined." Thus, the other end of the connector shaft may or may not be splined.

A copy of the appealed claims is appended to appellants' brief.

Claims 7 through 12 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based on a specification which fails to provide an enabling disclosure. No other rejections are involved in this appeal.

With regard to the standing rejection, the examiner states on page 3 of the answer that appellants' specification "does not reasonably provide enablement for

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a progressive cavity pump having a connector shaft with splines at only one end." In support of this position, the examiner states:

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Claims 7 and 11 as presented allow for the connector shaft having splines at only one end. Throughout the specification the description of the connector shaft and its advantages set forth that the connector shaft has splines at both ends. Note column 1 lines 27-31, column 2 the fourth paragraph, and column 3 lines 26-31. There is no disclosure of a connector shaft with a single splined end. See Gentry Gallery, Inc. v. Berkline Corp., 45 USPQ2d 1498 (CCPA).[sic]

The examiner's rejection of the appealed claims under the first paragraph of § 112 is not sustainable. The dispositive issue concerning the enablement requirement in the first paragraph of § 112 is whether an applicant's disclosure, considering the level of ordinary skill in the art as of the date of the applicant's application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). Factors that must be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the direction or guidance presented, (3) the presence or

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absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd.Pat.App. & Int. 1986). Prior art may be relied on to establish both the level of ordinary skill in the art and the fact that techniques or structures necessary to practice the invention were known in the art. Strahilevitz at 1233, 212 USPQ at 564.

In calling into question the enablement of appellant's disclosure, the examiner has the initial burden of advancing appropriate reasoning to support the conclusion that the disclosure is non-enabling. Strahilevitz at 1232, 212 USPQ at 563.

Contrary to what the examiner seems to have suggested on page 4 of the answer, the appealed claims are not limited to splines only at one end of the connector shaft. Instead, the claims define a construction having a splined connection at one end of the connector shaft and any type of connection at the other end of connector shaft. Thus, in substance,

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the appealed claims define a connector shaft which is splined at one end, but which may or may not be splined at the other end.

Admittedly, appellants' specification sets forth only a single embodiment having splines at both ends of the connector shaft for non-rotatably coupling the connector shaft to the motor drive shaft and the rotor. However, the claimed invention pertains to a mechanical art which is considered to be predictable so that a broad claim may be enabled by disclosure of a single embodiment. See Spectra-Physics v. Coherent, Inc., 827 F.2d 1524, 1530, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987) citing In re Cook, 439 F.2d 730, 735, 169 USPQ 298, 301 (CCPA 1971). Furthermore, the level of skill in the relevant art as evidenced by the prior art of record is sufficiently high to conclude that the skilled artisan would have been fully aware of well known prior art connections or couplings other than splined connections for coupling the connector shaft to the rotor and the motor drive shaft. For example, appellants' specification (see column 1, lines 21-25 of appellants' original patent) states that U-joints may be used to accommodate the orbital motion of the rotor. The examiner has not demonstrated that splined

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connections are required at both ends of the connector shaft to accommodate the orbital motion of the rotor.

The examiner's citation of the Gentry Gallery, Inc. v. The Berkline Corp.<sup>2</sup> (see page 4 of the answer) is misplaced. In Gentry Gallery, the court was concerned with the written description requirement in the first paragraph of § 112, not the enablement requirement in that paragraph of the statute.<sup>3</sup> The written description requirement and the enablement requirement in the first paragraph of § 112 are separate and distinct requirements. See In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 372 (Fed. Cir. 1984). These statutory requirements involve distinctly different tests as made evident by Wilder at 1519, 222 USPQ at 372 and Strahilevitz at 1232, 212 USPQ at 563. Thus, the question as to whether appellants' original disclosure describes a connector shaft with a single splined end (see page 4 of the answer) is not at issue in the test for meeting the enablement requirement. Furthermore, the question of obviousness or nonobviousness as argued by the examiner on page 7 of the answer is not an issue in applying the test for enablement.

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<sup>2</sup> 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998).

<sup>3</sup> Id. at 1479, 45 USPQ2d at 1503.

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For the foregoing reasons, we cannot agree that the examiner has met his initial burden of advancing appropriate reasoning to support the conclusion that appellants' disclosure is non-enabling. In any case, appellants' rebuttal evidence comprised of the prior art patents cited on page 6 of the main brief confirms that connections other than a splined connection are enabling. Upon consideration of the Wands factors outlined supra, we must reverse the examiner's decision to reject claims 7 through 12 based on the lack of compliance with the enablement requirement in the first paragraph of § 112.

REVERSED

Harrison E. McCandlish, Senior)	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
Neal E. Abrams	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
John P. McQuade	)	
Administrative Patent Judge	)	

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James E. Bradley  
FELSMAN, BRADLEY, GUNTER,  
DILLON & VADER, LLP  
One Riverway, Suite 1100  
Houston, TX 77056