

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER LIFSON and JAMES W. BUSH

Appeal No. 2002-0009
Application 09/032,554

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 21 through 25 as amended subsequent to the final rejection in a paper filed on June 12, 2000 (Paper No. 13). Claims 21 through 25 are all of the claims remaining in the application. Claims 1 through 20 and 26 through 28 have been canceled.

As noted on page 1 of the specification, appellants' invention relates to an improved scroll compressor wherein the pressure of fluid vented to a back pressure chamber is controlled and optimized. More specifically, in contrast to the prior art (e.g., Figs. 1A, 1B of the application), in appellants' improved compressor the vent hole is effectively closed for a majority of the operational cycle of the compressor and open for only limited periods of time (see 77 and 78 of Fig. 5), thereby allowing a designer to ensure that the vent hole is exposed to an optimum selection of intermediate and discharge pressures, which is communicated to, and maintained in, the back pressure chamber. A copy of representative claims 21, 23 and 25 on appeal can be found in the Appendix to appellants' brief.

The sole rejection before us for review is that of claims 21 through 25 under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an adequate written description of the invention as now claimed.¹ In particular, the

¹ As noted on page 2 of the examiner's answer, all other rejections made by the examiner in the final rejection (Paper No. 10, mailed March 24, 2000) have been withdrawn.

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examiner contends (answer, page 3) that the original disclosure "does not disclose a back pressure chamber defined on a side of the base plate of the non-orbiting scroll."

Reference is made to the examiner's answer (Paper No. 22, mailed February 22, 2001) for the examiner's reasoning in support of the above-noted rejection. Appellants' arguments thereagainst are found in the brief (Paper No. 20, filed January 8, 2001) and reply brief (Paper No. 23, filed April 23, 2001).

OPINION

In reaching our conclusion on the written description issue raised in this appeal, we have carefully considered appellants' specification and claims, and the respective viewpoints advanced by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, will not be sustained. Our reasons for this determination follow.

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The test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 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. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) and Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). In this regard, we note that it is not necessary that the claimed subject matter under consideration be described identically in the specification, but the disclosure as originally filed must convey in some way to those skilled in the art that the applicants had at the time of filing invented the subject matter claimed. See, In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) and In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Thus, we recognize that a finding of an adequate written description under the first paragraph of 35 U.S.C. § 112 does not require literal support for the now claimed terminology in the originally filed specification. Precisely how close the original description must come to comply with the description requirement of 35 U.S.C. § 112, first paragraph, must be determined on a case-by-case basis.

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See Eiselstein v. Frank, 52 F.3d 1053, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

The examiner's main concern in the present case seems to be that the claims on appeal, while being readable on the disclosed embodiments set forth in appellants' application, may also be readable on an embodiment not expressly set forth in appellants' disclosure as originally filed. Thus, the examiner appears to be concerned that the claims before us on appeal are broader than the supporting disclosure, and to be of the view that appellants' description of representative prior art Figures 1A and 1B in the originally filed application somehow provides a narrow disclosure which limits permissible claim breadth. We do not agree.

In addition to pointing out that the claims on appeal actually read on the embodiments expressly disclosed in the present application, and also that they are not specifically claiming an embodiment wherein the back pressure chamber is behind the non-orbiting scroll, appellants have relied heavily on In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973) to support their position that it would have immediately and

naturally occurred to one of ordinary skill in the art upon reading their originally filed specification that the present invention is not limited to the form of prior art scroll compressor seen in Figures 1A and 1B of the present application, but is also applicable to other well known scroll compressors with back pressure chambers, i.e., those conceded by the examiner to be well known in the scroll compressor art wherein the back pressure chamber is behind the non-orbiting scroll, instead of behind the orbiting scroll as seen in Figures 1A and 1B.

Since we are in full agreement with appellants' arguments set forth in their brief and reply brief, we incorporate those positions as our own. As the Court noted in Smythe, 480 F.2d at 1382, 178 USPQ at 284, there is no *per se* rule that in every case where the description of the invention in the specification is narrower than that in the claims there has been a failure to fulfill the description requirement of 35 U.S.C. § 112, first paragraph. Rather, each case must be decided on its own facts to determine whether the application as originally filed clearly conveyed in any way to those skilled in the art, to whom it is addressed, the information that appellants invented the subject matter claimed. Since we believe that in this case appellants

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have met their burden and have provided a written description of their invention within the meaning of 35 U.S.C. § 112, first paragraph, we will not sustain the examiner's rejection.

The entire thrust of appellants' invention is directed to an improved way of tapping pressurized refrigerant from compression chambers of scroll compressors into a back pressure chamber that resists a separating force tending to separate the orbiting and non-orbiting scroll members of the compressor. While appellants have put forth the scroll compressor seen in Figures 1A, 1B as being "A known scroll compressor" (specification, page 1), it does not appear to us that appellants' invention disclosed in the specification is in any way limited to that particular type of scroll compressor. Indeed, the opening sentence of the specification is of general applicability (i.e, that the invention "relates to improved scroll compressors wherein the pressure of fluid vented to a back pressure chamber is controlled and optimized." Similarly, the statements found on page 4 of the specification under the heading "SUMMARY OF THE INVENTION" are of general applicability to any scroll compressor having a back pressure chamber. On page 13 of the specification, appellants expressly indicate that there are "many other variations that can

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be utilized for achieving the main goals of this invention" and that the examples described in the specification are "simply the most preferred embodiments at this time." Thus, we find nothing in the specification which unambiguously limits appellants' invention to a scroll compressor like that shown in Figures 1A and 1B, and conclude that one of ordinary skill in the art would have viewed appellants' venting system described in the specification as being of general applicability to scroll compressors.

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For the foregoing reasons, the decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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