

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KATUROU SAWAMURA

Appeal No. 2003-1268
Application No. 09/706,566

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 13, mailed September 6, 2002) of claims 9 to 24, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an automatic screw catching device applicable to the bit of a power driven screwdriver for driving screws into a work piece. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 9 to 24 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 enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 9 to 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed January 9, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed October 31, 2002) and reply brief (Paper No. 17, filed March 7, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claims 19 to 24 under 35 U.S.C. § 112, second paragraph, but not the rejection of claims 9 to 18.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In the final rejection (pp. 2-3) and the answer (pp. 3-4), the examiner set forth his rationale as to why claims 9 to 24 were indefinite.

The appellant has not specifically contested this rejection with respect to claims 19 to 24 in the brief or reply brief. In fact, the appellant (reply brief, p. 7) concedes the

lack of antecedent basis referenced by the examiner in independent claims 19 and 23 and submits that a simple amendment can correct these informalities. Accordingly, we summarily sustain the rejection of claims 19 to 24 under 35 U.S.C. § 112, second paragraph.

With respect to the examiner's rationale as to why claims 9 to 18 were indefinite, we find ourselves in total agreement with the appellant (brief, p. 10; reply brief, pp. 6-7) that these claims define the metes and bounds thereof with a reasonable degree of precision and particularity as required by the second paragraph of 35 U.S.C. § 112. Accordingly, we will not sustain the rejection of claims 9 to 18 under 35 U.S.C. § 112, second paragraph.

The enablement rejection

We will not sustain the rejection of claims 9 to 24 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is

whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation.

See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original

disclosure and all evidence in the record, weighing evidence that supports enablement¹ against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellant's disclosure, 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 appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

The sole basis for this rejection as set forth in the final rejection (p. 2) and the answer (p. 3) was as follows:

The device, as originally disclosed, appears to be inoperative as the sleeve 31 cannot be assembled on the bushing 11. From the description and drawings, the bushing 11 is a one-piece element with the flanges 111 and 112. Thus as the flanges are larger than the opening in the sleeve 31, the sleeve cannot be assembled on the bushing.

The above-noted basis for this rejection fails to meet the examiner's initial burden to establish a reasonable basis to question the enablement provided for the

¹ The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

claimed invention for the following reasons. First, the examiner has not set forth why the claimed invention cannot be assembled. Instead, the examiner has set forth why the disclosed device cannot be assembled. Second, the examiner has not set forth sufficient basis why the claimed invention, or for that matter the disclosed device, cannot be assembled without undue experimentation. Factors to be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or 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.² Lastly, there is ample evidence in the Declaration of the inventor (Paper No. 10, filed June 19, 2002) and the prior art cited in the brief, that a myriad of methods exist for making both the claimed invention and the invention as disclosed. That is, one skilled in the art would not require undue experimentation to assembly sleeve 31 onto the bushing 11.

For the reasons set forth above, the decision of the examiner to reject claims 9 to 24 under 35 U.S.C. § 112, first paragraph, is reversed.

² 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).

CONCLUSION

To summarize, the decision of the examiner to reject claims 9 to 24 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 9 to 18 under 35 U.S.C. § 112, second paragraph, is reversed; and the decision of the examiner to reject claims 19 to 24 under 35 U.S.C. § 112, second paragraph, 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-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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