

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. NOONE
and FRANK L. MITCHELL

Appeal No. 1995-1703
Application 07/897,304

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

David L. Noone et al. appeal from the final rejection of claims 1, 2, 4 through 15 and 18 through 21. Claims 3, 16 and 17, the only other claims pending in the application, stand finally rejected but have not been appealed (see the Notice of

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Appeal, Paper No. 13).

The record indicates that the instant application is a continuation-in-part of Application 07/868,754, filed April 14, 1992, now U.S. Patent No. 5,865,218, granted February 2, 1999. Application 07/868,754 was involved in an appeal to this Board (Appeal No. 95-1949) which was decided on January 2, 1996. The issues in the present appeal are essentially similar to the issues in the earlier appeal.

The invention relates to "a multi-layer hose which can be employed as a fuel line or vapor recovery line in a motor vehicle" (specification, page 1). In essence, the hose consists of an outer layer, an intermediate bonding layer and an interior layer. A copy of the claims on appeal appears in the appendix to the appellants' main brief (Paper No. 19).

Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which as originally filed does not support the invention now claimed.

Claims 1, 2, 4 through 15 and 18 through 21 stand

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rejected under 35 U.S.C. § 112, first paragraph, as being based on a

specification which does not provide an adequate written description of the claimed invention.¹

Claims 1, 2, 4 through 15 and 18 through 21 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.²

Reference is made to the appellants' main and reply briefs (Paper Nos. 19 and 21) and to the examiner's main and supplemental answers (Paper Nos. 20 and 22) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

¹ In the restatement of this rejection in the main answer (Paper No. 20), the examiner inadvertently omitted claims 18 through 20.

² Here again, the examiner inadvertently omitted claims 18 through 20 from the restatement of this rejection in the main answer.

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The first rejection rests on the examiner's determination (see page 5 in the main answer) that the appellants' specification fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, with respect to the recitation in claim 21 that the outer tubing layer has a "maximum destructive elongation value" of at least 150%. The appellants counter that "elongation value is commonly referred to as elongation value at break and that one skilled in the art would understand this from the specification taken in its entirety" (main brief, page 20).

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 inventor 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).

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It is not apparent, nor do the appellants even contend, that their disclosure provides anything approaching express support for the recitation in claim 21 that the elongation value of the outer tubing is a "maximum destructive" elongation value. Instead, the appellants seem to argue that the disclosure as a whole provides inherent support for this recitation. Claim limitations which are urged to be inherent in the disclosure must be shown as having clear support from the necessary and only reasonable construction to be given the disclosure by one skilled in the art. Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987). The appellants have failed to advance any evidence or cogent line of argument to this effect. Therefore, on the record before us, we are constrained to conclude that the disclosure of the application as originally filed would not reasonably convey to the artisan that the appellants had possession at that time of the subject matter now recited in claim 21.

Accordingly, we shall sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claim 21 as being based on

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a specification which as originally filed does not support the invention now claimed.

In rejecting claims 1, 2, 4 through 15 and 18 through 21 under 35 U.S.C. § 112, first paragraph, as being based on a specification which does not provide an adequate written description of the claimed invention, the examiner explains that

the specification fails to provide an adequate written description of a thermoplastic having an elongation value of at least 150% and an ability to withstand impacts of at least 2ft/lbs at temperatures below about -20EC. The materials SANTOPRENE, KRATON, SARLINK, and VICHEM have not been adequately described (see MPEP 608.01(v)). Since no thermoplastic material is adequately described in the specification, the claims are not supported by the specification [main answer, pages 5 and 6].

In connection with the first of these points, the examiner adds that "not only must this material have an ability to withstand impacts of at least 2ft/lbs at temperatures below about -20EC, but, the material must also have an **elongation value of at least 150% at temperatures below about -20EC**"

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(main answer, page 8).

The examiner's explanation is unclear as to whether the rejection is based on an alleged failure to comply with the written description requirement or the enablement requirement of 35 U.S.C. § 112, first paragraph, or both. The written description and enablement requirements are, of course, separate and distinct. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). For the sake of completeness, we shall evaluate the rejection in light of both requirements.

Before doing so, however, we find it necessary to make two observations about the claim language in question. First, the examiner's interpretation that the claims (via independent claims 1, 15 and 21) require a thermoplastic having an elongation value of at least 150% at temperatures below about -20°C is not well taken. The claim limitations in question, read on their face or in light of the underlying disclosure, simply do not support such an interpretation. For example, page 7 in the specification discusses the elongation value without any mention of temperature. Second, it is evident

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that the artisan would understand the recited "ft/lbs" impact parameter as referring to "foot-pounds," a unit of work, rather than to a somewhat incomprehensible foot per pound unit.

Turning now to the merits of the rejection insofar as the written description requirement is concerned, the claim limitations (claims 1, 15 and 21) requiring the outer and/or interior layers of the tubing to be made of a thermoplastic having an elongation value of at least 150% and an ability to withstand impacts of at least 2 ft/lbs at temperatures below about -20EC find express support in the original disclosure on specification pages 5 and 7 and in claims 1 and 15. The claim limitations (claims 10 and 19) relating to Santoprene, Kraton, Sarlink, and Vichem find express support in the original disclosure on specification pages 7, 8 and 12 and in claims 3, 10 and 19. Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that the appellants had possession at that time of subject matter embodying the claim limitations at issue (see Kaslow, supra).

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As for the enablement requirement, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the 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 disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

In short, the examiner has not advanced any cogent line of reasoning as to why the claim limitations in question might pose an enablement problem. Instead, the examiner (see pages 7 through 15 in the main answer) appears to have attempted to turn the tables on the appellants by bemoaning their failure to submit persuasive evidence of enablement. As indicated above, however, the initial burden in this regard falls on the examiner, not the appellants.

Hence, we shall not sustain the standing 35 U.S.C. § 112,

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first paragraph, rejection of claims 1, 2, 4 through 15 and 18 through 21 as being based on a specification which does not provide an adequate written description of the claimed invention.

As for the 35 U.S.C. § 112, second paragraph, rejection of claims 1, 2, 4 through 15 and 18 through 21, the examiner argues that these claims fail to particularly point out and distinctly claim the subject matter the appellants regard as the invention because

[t]he scope of the subject matter mentioned in the above objection under the first paragraph of 35 U.S.C. § 112 [is] not at all clear for the reasons expressed therein, which were deemed to render these claims ambiguous. Additionally the phrase "the outer tubing" twice [recited] in claim 1 (Amended) was noted to not find antecedent basis [main answer, page 6].

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For the reasons discussed above, the examiner's concerns regarding the appellants' disclosure are not well founded. Thus, the § 112, second paragraph, rejection is unsound to the degree that it is predicated on these concerns. As correctly pointed out by the examiner, however, the references to "the outer tubing" in claim 1 do lack a proper antecedent basis. The appellants have not challenged the examiner's determination that this inconsistency renders the scope of claim 1, and by implication the scope of the claims depending therefrom, indefinite.

Therefore, we shall sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claim 1, and of claims 2 and 4 through 14 which depend therefrom, but only on the basis of the antecedent problem in claim 1. We shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 15 and 18 through 21.

In summary, the decision of the examiner:

a) to reject claim 21 under 35 U.S.C. § 112, first paragraph, as being based on a specification which as

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originally filed does not support the invention now claimed is affirmed;

b) to reject claims 1, 2, 4 through 15 and 18 through 21 under 35 U.S.C. § 112, first paragraph, as being based on a specification which does not provide an adequate written description of the claimed invention is reversed; and

c) to reject claims 1, 2, 4 through 15 and 18 through 21 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention is affirmed with respect to claims 1, 2 and 4 through 14, and reversed with respect to claims 15 and 18 through 21.

AFFIRMED-IN-PART

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)
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) BOARD OF

PATENT

LAWRENCE J. STAAB)

APPEALS

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Administrative Patent Judge)	AND
)	
INTERFERENCES)	
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