

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIRO NAKAMATS

Appeal No. 97-4252
Application No. 08/226,520¹

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 5, 7, 8, 15 and 17. Claims 2, 3, 6, 9 to 14, 16, 18 and 20 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claims 19 and 21 have been canceled.

¹ Application for patent filed April 12, 1994.

Appeal No. 97-4252
Application No. 08/226,520

We AFFIRM.

BACKGROUND

The appellant's invention relates to a display apparatus. A copy of the claims under appeal appears in the appendix to the appellant's brief.

Claims 1, 4, 5, 7, 8, 15 and 17 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

Claims 1, 4, 5, 7, 8, 15 and 17 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 final rejection (Paper No. 12, mailed July 11, 1996) and the supplemental examiner's answer (Paper No. 26, mailed July 28, 1998) for the examiner's complete reasoning in support of the rejections, and to the

appellant's brief (Paper No. 17, filed March 20, 1997) and reply brief (Paper No. 21, filed August 28, 1997) 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.

It is appropriate to review the rejection under the second paragraph of 35 U.S.C. § 112 before we review the rejection under the first paragraph of 35 U.S.C. § 112 because the analysis of the claims under the first paragraph of 35 U.S.C.

§ 112 requires one to have determined exactly what subject matter the claims encompass under the second paragraph of 35 U.S.C. § 112. See In re Moore, 439 F.2d 1232, 169 USPQ 236, 238 (CCPA 1971).

The indefiniteness rejection

We sustain the rejection of claims 1, 4, 5, 7, 8, 15 and 17 under 35 U.S.C. § 112, second paragraph.

The examiner determined (final rejection, pp. 2-3) that the claims under appeal were indefinite because

[i]t is unclear what specific structure comprises the lighting control means. It is unclear from the specification and/or drawings how the lighting control means selectively lights individual respective one of the luminous devices at predetermined discrete positions of the luminous devices within a swing arc [sic, arc].

The appellant contested (reply brief, pp. 7-8) the examiner's determination that it was unclear how the lighting control means selectively lights individual respective one of the luminous devices at predetermined discrete positions of the luminous devices within a swing arc. In fact, the appellant believed that this issue mirrored the rejection made under the first paragraph of 35 U.S.C. § 112.

We agree with the appellant that the issue of how the lighting control means selectively lights individual respective one of the luminous devices at predetermined

discrete positions of the luminous devices within a swing arc is an issue under the first paragraph of 35 U.S.C. § 112.

Thus, the remaining issue is whether the claims under appeal are indefinite for being unclear as to what specific structure comprises the lighting control means. As to this issue, the appellant has not contested the examiner's determination. Accordingly, we are constrained to sustain the rejection under 35 U.S.C. § 112, second paragraph, because the appellant has not pointed out how the examiner erred in rejecting the claims under appeal.

Moreover, we note that the court in In re Donaldson, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) agreed with the general principle espoused in In re Lundberg, 244 F.2d 543, 547-48, 113 USPQ 530, 534 (CCPA 1957), that the sixth paragraph of section 112 does not exempt an applicant from the requirements of the first two paragraphs of that section. Although paragraph six statutorily provides that one may use means-plus-function language in a claim, one is still

subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. Thus, it is our view that the examiner had a legitimate rationale for questioning what specific structure comprises the claimed lighting control means which includes the claimed self-contained detection means.

For the reasons stated above, the decision of the examiner to reject claims 1, 4, 5, 7, 8, 15 and 17 under 35 U.S.C. § 112, second paragraph, is affirmed.

The enablement rejection

We will not sustain the rejection of claims 1, 4, 5, 7, 8, 15 and 17 under 35 U.S.C. § 112, first paragraph.

Claims 15 and 17

While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the enablement determination that we are obliged to do. Enablement rejections under 35 U.S.C. § 112, first paragraph, should not be based upon considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims. See In re Moore, supra. Cf. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) and In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). In that regard, we note that claims 15 and 17 add to parent claim 1 details as to the structure of the lighting control means. However, such details are confusing to us in that the structure recited in claims 15 and 17 appears to be better characterized as being the "self-contained detection means" of claim 1 rather than the "lighting control means" of claim 1. We are sufficiently unsure as to the scope of claims 15 and 17 that we consider it appropriate to reverse, pro forma, the examiner's rejection of claims 15 and 17 under 35 U.S.C. § 112, first paragraph.

Claims 1, 4, 5, 7 and 8

As pointed above, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 112, first paragraph, would not be made. However, in this instance, with respect to claims 1, 4, 5, 7 and 8 we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537 (Bd. App. 1984). For the purposes of this appeal, we construe appellant's claimed "lighting control means" as covering at least the specie of Figure 2 (e.g., battery 6, switch 11 and electric circuits 5 and 5') or the specie of Figure 7 (e.g., a servomotor and circuitry described in the paragraph bridging pages 8 and 9) and equivalents thereof.

The examiner determined (final rejection, p. 2) that the claims under appeal were nonenabled because

[t]he applicant does not specifically teach how the circuitry 5 and 5' and/or the specifics of the hanging weight or gyro controls the lighting of the plurality of luminous devices 2 according to the time T and/or the

position of the luminous devices as recited on page 4, line [sic, lines] 18-22 and page 5, lines 1-7.

The appellant argues (brief, pp. 6-13, reply brief, pp. 2-7) that

[t]he rejection is in error because the specification presents a sufficient disclosure to so enable one of ordinary skill in the art to practice the invention without undue experimentation.

We agree with the appellant.

An analysis of whether claims 1, 4, 5, 7 and 8 are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of claims 1, 4, 5, 7 and 8 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 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). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting

disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

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.² Moreover, it is clear to us that

² 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. 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).

claims 1, 4, 5, 7 and 8 are enabled by the specie of Figure 7, described in the paragraph bridging pages 8 and 9. In that regard, the appellant clearly teaches that a servo-motor is operable to detect angle and position of the bar 1 and that the luminous devices are lit according to the circuitry 5. While the exact details of the circuitry 5 have not been disclosed, the examiner has not presented any reasoning why one skilled in the art would have been unable to design the required circuitry from the appellant's disclosure coupled with information known in the art without undue experimentation.

For the reasons stated above, the decision of the examiner to reject claims 1, 4, 5, 7 and 8 under 35 U.S.C. § 112, first paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4, 5, 7, 8, 15 and 17 under 35 U.S.C. § 112, second paragraph, is affirmed and the decision of the examiner to

reject claims 1, 4, 5, 7, 8, 15 and 17 under 35 U.S.C. § 112,
first paragraph, is reversed.

Since at least one rejection of each of the appealed
claims has been affirmed, the decision of the examiner 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

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Administrative Patent Judge)	

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APPLICATION NO. 08/226,520

APJ NASE

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DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Mar 99

FINAL TYPED: