

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD S. COK and JOHN R. FREDLUND

Appeal No. 1998-2707
Application No. 08/586,081

ON BRIEF

Before HAIRSTON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-16, which are all the claims in the application.

We reverse.

BACKGROUND

The invention is directed to a system for producing composite images which provides a measure of security to vendors and consumers. Representative claim 1 is reproduced below.

1. A system for producing composite images, comprising:
 - a) a digital image file containing a personal image and image control data related to the personal image;
 - b) a digital image file containing an image template and image template control data related to the image template;
 - c) a file containing composite image construction rules and composite control data related to the image construction rules; and
 - d) an image production system including,
 - i) a file containing production rule data including data indicating whether production is enabled or disabled;
 - ii) a control module for: receiving a customer order including customer order control data; retrieving the image control data, the image template control data, the composite control data and the production rule data; and generating an ENABLE/DISABLE control signal by comparing the production rule data with the image control data, the image template control data and the composite control data to generate the ENABLE/DISABLE control signal; and
 - iii) a composite image production module responsive to the ENABLE/DISABLE control signal for employing the personal image, the image template, and the composite image construction rules to produce the composite image.

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The examiner relies on the following reference:

Krahe et al. (Krahe)	5,608,542	Mar. 4, 1997 (filed Mar. 31, 1995)
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Claims 1-16 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement.

Claims 1, 5, 9, and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by Krahe.

Claims 2-4, 6, 8, 10-12, 14, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Krahe in view of "well known prior art."

We refer to the Final Rejection (mailed Oct. 28, 1997) and the Examiner's Answer (mailed June 8, 1998) for a statement of the examiner's position and to the Brief¹ (filed June 10, 1998; certificate of mailing June 5, 1998) for appellants' position with respect to the claims which stand rejected.

OPINION

Before turning to the instant rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph, we briefly review the requirements of the statute with respect to providing an enabling disclosure.

¹ Appellants filed an earlier brief on April 24, 1998. The brief to which we refer in this decision is that filed June 10, 1998, submitted as an "amended" brief, which removes reference to an amendment filed subsequent to the Final Rejection that was refused entry by the examiner.

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The first paragraph of 35 U.S.C. 112 requires, inter alia, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without 'undue experimentation.' In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is 'undue.' Id. at 736-37, 8 USPQ2d at 1404.

In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

The question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention; the specification need not disclose what is well known in the art. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (citing In re Myers, 410 F.2d 420, 161 USPQ 668 (CCPA 1969)). "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987). "Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962).

The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is indeed

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enabling. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The statement of the rejection (Answer at 5-6) does little to meet the initial burden. The rejection merely alleges that the specification does not enable an aspect of the claimed invention. A mere allegation cannot demonstrate lack of enablement. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The 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.

Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

The statement of the rejection is thus plainly deficient.² Moreover, the Answer's "Response to Arguments" section indicates that the examiner's standard for enablement was based on an improper legal footing. "Surely there are other circuits, templates or other mechanisms, which applicant has [sic; applicants have] not disclosed, to make the

² We note that Office policy is to consider all the relevant factors when making a rejection for lack of enablement. "The examiner's analysis must consider all the evidence related to each of these [Wands] factors, and any conclusion of nonenablement must be based on the evidence as a whole." Manual of Patent Examining Procedure § 2164.01(a), Seventh Edition, Rev. 1 (Feb. 2000).

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present invention. But rather, appellant has [sic; appellants have] relied on what one of ordinary skill in the art would have known regarding the comparison." (Answer at 17.) The Answer further indicates, in the paragraph bridging pages 17 and 18, that extrinsic evidence in support of enablement will not be considered, because "such information is not part of the original disclosure and could not be entered now for reason of new matter and new issues after final rejection."

However, an applicant need not, and preferably does not, disclose what is already well known in the art. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." U.S. v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (emphasis added) (citing Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986)). Determining what the specification fails to explicitly set forth is, at best, only a first step in demonstrating that a disclosure is not enabling. As the precedents of our reviewing court make plain, determining whether "undue experimentation" is required involves weighing factors beyond what the specification explicitly sets forth.

For example, with respect to the seventh Wands factor -- the predictability or unpredictability of the art -- the level of predictability in the mechanical and electrical arts is recognized as being relatively high. See, e.g., In re Hogan, 559 F.2d 595, 606, 194 USPQ 527, 537-38 (CCPA 1977) (taking notice of the high level of predictability in mechanical or

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electrical environments and the lower level of predictability expected in chemical reactions and physiological activity).

Upon weighing the factual considerations before us, we do not agree that the instant disclosure fails to teach the artisan how to make and use the claimed invention. At least for the reason that the rejection fails to consider the evidence as a whole, we do not sustain the rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph.³

Turning to the section 102 rejection of claims 1, 5, 9, and 13 as being anticipated by Krahe, we agree with appellants that the reference fails to meet all limitations of each of independent claims 1 and 9. In particular, the rejection (Answer at 7-10) refers to "production rule data," but does not show that Krahe discloses "production rule data including data indicating whether production is enabled or disabled," and "generating an ENABLE/DISABLE control signal by comparing the production rule data with the image control data, the image template data and the composite control data to generate the ENABLE/DISABLE control signal," as required by each of independent claims 1 and 9.

³ We are, however, somewhat puzzled by statements in the 37 CFR § 1.132 declaration submitted by appellants' expert on April 24, 1998 in support of enablement. Appellants' expert alleges (¶ 8), with respect to certain production rules set forth in the specification, "the control data for such production rules is not described sufficiently completely in the specification for me to render an opinion as to whether a program could have been written to implement these particular production rules...." The statement at least raises the question whether the full scope of the claims has been enabled. However, in predictable arts, a single embodiment may provide broad enablement. See In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Here, there are ten production rules (specification at 8-10) that appellants assert to be enabled, even though four, perhaps, are not. In any event, the examiner's rejection is not based on the question of whether the claims bear a "reasonable correlation" to the scope of enablement provided by the specification, nor does the examiner rely on the averment regarding what "is not described sufficiently completely."

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The deficiency in the section 102 rejection may be related to the indication on page 6 of the Answer that the relevant limitations are given "no weight" due to the alleged lack of enablement. If that is the case, the section 102 rejection is flawed at the outset. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

We therefore do not sustain the section 102 rejection, nor the section 103 rejection of claims 2-4, 6, 8, 10-12, 14 and 16. The section 103 rejection does not deal with all the requirements of independent claims 1 and 9, and fails at least on that basis. We note that, at page 19 of the Answer, the examiner appears to submit appellants' arguments for enablement as evidence of obviousness of the claimed subject matter. However, the enablement issue is related to implementation of the details of the invention, rather than what the prior art would have suggested to the artisan. Cf. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 941, 15 USPQ2d 1321, 1329 (Fed. Cir 1990) ("The claimed invention...is not in the details of the program writing, but in the apparatus and method whose patentability is based on the claimed combination of components or steps.")

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CONCLUSION

The rejection of claims 1-16 is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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