

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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS-GERD ECKEL and ANJA KUNKEL

Appeal No. 1999-0527
Application No. 08/801,837

ON BRIEF

Before CALVERT, COHEN, and FRANKFORT, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 9, all of the claims in the application.

Appellants' invention pertains to a seal arrangement for a shaft end. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the APPENDIX to the main brief (Paper No. 9).

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The following rejections are before us for review.

Claims 1 through 9 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a description in a specification which would not enable one skilled in the art to make and/or use the invention.

Claims 1 through 9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 10), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 9 and 11).

Appellants indicate that claims 1 through 9 stand or fall together. Accordingly, we select claim 1 for review, infra, and the remaining claims shall stand or fall therewith.

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OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification, drawing, and claim 1, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection under 35 U.S.C. § 112, first paragraph

We affirm this rejection.

The rejection questions the adequacy of appellants' disclosure of their invention as it pertains to the question of whether the disclosure would have enabled one skilled in the art of seal arrangements for shaft ends to make and use the invention. The test regarding enablement is whether a disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use a claimed invention without undue experimentation. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and In re Scarbrough,

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500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. See In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 218 (CCPA 1976). It is also well settled that an examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. See In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982) and In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Once this is done, the burden shifts to the appellant to rebut this conclusion by presenting evidence to prove that the disclosure is enabling. See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), **cert. denied**, 416 U.S. 935 (1974) and In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

Having fully reviewed the entirety of appellants' disclosure as filed, i.e., the content of the specification and claims 1 through 9, and the showing in Figures 1 through 3, 3a, 4, and 5, we are in basic agreement with the examiner's reasoning to the effect that the disclosure raises substantial questions concerning enablement. More specifically, we do not perceive

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that one skilled in this art would have understood from the overall disclosure what structurally constitutes the guideways 5.1 (partially and inadequately shown in Figures 1 and 5) and receptacles 1.2 (partially and inadequately depicted solely in Figure 5) and their interface. Further, we readily discern that the circumferential extent of each segment 1.1 and interface between the movable segments 1.1 are not adequately disclosed as to the claimed sleeve of segments fastened on a sensor ring nondisplaceably in an axial direction and displaceably outwardly in a radial direction.

The main and reply briefs provide a narrative explanation and argument as to why the disclosure is adequate (enabling). However, the content of these briefs simply does not persuade us that the disclosure is in fact adequate. No evidence has been submitted to prove that one skilled in this art would have been enabled by the disclosure to practice the invention. A counsel's argument in a brief simply cannot take the place of evidence. See In re DeBlauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir 1984). The necessity of having to add to Figure 1 (appellants' marked-up Figure 1 attached to the main brief) to obtain a basis for the argument made that the extent of the

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segments is understandable supports the view that the showing in Figure 1 alone is inadequate. While the specification (pages 6 and 7) may descriptively support the argued recitation of guideways delimited by punched out portions (main brief, page 6, and reply brief, page 4)), the overall disclosure, inclusive of the drawings (punched out areas 5.2 solely shown in Figure 1), fails to adequately inform as to the actual structure of the guideways, as indicated, supra.

The rejection under 35 U.S.C. § 112, second paragraph

We reverse this rejection of appellants' claims.

The examiner considers claim 1, for example, to set forth insufficient structural relationships which render the claims indefinite (answer, page 6). However, our reading of claim 1 informs us that it would reasonably apprise those having skill in the art at issue as to the metes and bounds of the claimed subject matter. Consistent with the view of appellants (reply brief, pages 3 and 4), it is apparent to us that what the examiner's concerns address relates to the breadth of claim 1 not

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its definiteness in terms of understanding just what is being claimed. Admittedly, the claim is broad, but it is not indefinite. It is for this reason that the rejection under 35 U.S.C. § 112, second paragraph, must be reversed.

In summary, this panel of the board has:

sustained the rejection of claims 1 through 9 under 35 U.S.C. § 112, first paragraph; and

not sustained the rejection of claims 1 through 9 under 35 U.S.C. § 112, second paragraph.

The decision of the examiner is affirmed.

AFFIRMED

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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APPLICATION NO. 08/801,837

APJ COHEN

APJ CALVERT

APJ FRANKFORT

DECISION: **AFFIRMED**

Prepared By:

DRAFT TYPED: 21 Jul 03

FINAL TYPED: