

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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GIUSEPPE COCITO and GIORGIO GREGO

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Appeal No. 1999-2193  
Application No. 08/975,338

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ON BRIEF

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Before CALVERT, NASE, and GROSS, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 5 and 6, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of fabricating a polarization-maintaining silica optical fiber. A substantially correct copy of the claims under appeal is set forth in the appendix to the brief.<sup>1</sup>

Claims 5 and 6, the only claims pending in this application, stand rejected solely 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.

The conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection are set forth in the examiner's answer (Paper No. 23, mailed February 23, 1999) and the appellants' brief (Paper No. 22, filed December 18, 1998).

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<sup>1</sup> A minor error in claim 5 is noted on page 3 of the answer.

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OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain the rejection of claims 5 and 6 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 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.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellants 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

enablement<sup>2</sup> against evidence that the specification is not enabling.

Thus, the dispositive issue on appeal is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' 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.

In our opinion the examiner has not met his burden of proof by advancing acceptable reasoning inconsistent with enablement for the following reasons.

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<sup>2</sup> The appellants may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellants 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.

Factors which must 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).

Our review of the record reveals that the examiner has not applied the above-noted factors to determine that undue experimentation would be required to practice the invention or provided an explanation that clearly supports such a determination. While both the examiner and the appellants agree that Figures 2 and 3 are incorrect (answer, pp. 4-5; brief, p. 4), this fact alone does not, in our view, warrant an enablement rejection.

In this case, the examiner appears to have focused on the lack of any working examples (only one of the above-noted eight factors) and the errors in Figures 2 and 3, as the basis that led the examiner to conclude that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. Since the examiner has not weighed all the factors, the examiner's conclusion of nonenablement cannot be sustained. As stated in the Manual of Patent Examining Procedure (MPEP) § 2164.02 (Seventh Edition, Rev. 1, Feb. 2000)

When considering the factors relating to a determination of non-enablement, if all the other factors point toward enablement, then the absence of working examples will not by itself render the invention non-enabled. In other words, lack of working examples or lack of evidence that the claimed invention works as described should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement.

. . .

Furthermore, it is our view that it would not require undue experimentation to practice the invention as set forth in the claims under appeal. In that regard, we note that the

appellants provide guidance on page 2, line 37, to page 3, line 38, of the specification that an ultraviolet beam is collimated within the core of a silica optical fiber by differences in refractive index between the core and the cladding of the fiber and between the cladding and the external environment (e.g., air). In our opinion, this teaching would enable an artisan to practice the claimed invention with any core-cladding silica optical fiber by reverse calculation, using known optical principles (e.g., Snell's Law), of what the appropriate incoming ultraviolet beam should be to produce a collimated beam in the fiber's core. That is, one knowing the properties of the fiber and desiring a collimated beam in the core would be able to calculate what the divergence/convergence of the beam would have to be in the cladding, and from that one could calculate what the divergence/convergence of the beam would have to be in the external environment (e.g., air). Thus, we conclude that the 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.<sup>3</sup>

For the reasons set forth above, the decision of the examiner to reject claims 5 and 6 under 35 U.S.C. § 112, first paragraph, is reversed.

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<sup>3</sup> Our decision in the case should not be taken as supporting the proposition that Figures 2 and 3 should not be corrected to remove the inaccuracies therefrom. In fact, it may be that Figures 2 and 3 are not required and could be deleted.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 and 6 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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