

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE TASH

Appeal No. 2001-0342
Application No. 08/677,707

ON BRIEF

Before ABRAMS, 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 to 20, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a drain plunger for creating a suction force within a drain. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Schacht 1915	1,152,981	Sep. 7,
Reeves 1915	1,154,055	Sep. 21,
Tomlinson 12, 1958	2,846,698	Aug.
Tash 24, 1988	4,745,641	May

Claims 11 and 14 to 20 stand rejected 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 art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 to 3, 6, 10 and 12 stand rejected under 35 U.S.C.

§ 102(b) as being anticipated by Tash.

Claims 2, 4, 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tash.

Claims 8 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tash in view of Schacht.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tash, Reeves and Tomlinson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed June 5, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed April 24, 2000) and reply brief (Paper No. 22, filed August 7, 2000) 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, to the applied prior art references, and to the respective positions articulated by the appellant 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 sustain the rejection of claims 11 and 14 to 20 under 35 U.S.C. § 112, first paragraph.

It is well settled that the description and enablement requirements are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971). However, from our reading of this rejection (answer, pp. 4-5) it is unclear to us if this rejection is based on the written description requirement or

the enablement requirement or both. Accordingly, we will treat this rejection as being based on each requirement.

The written description requirement

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the

original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

It is our determination that the originally filed disclosure does not provide written description support for the subject matter of claims 11 and 14 to 20. The originally filed application (p. 9, lines 7-10) states that

[p]lunger 10 may include a one-way flap valve or the like (not shown) in handle 14 to provide easy escape of air from bellows 20 during compression of bellows 20 or can depend on the special configuration of rim 30 for such air escape.

From this disclosure and the appellant's use of the word "or" in the above-quoted sentence, it is our determination that persons of ordinary skill in the art would recognize the originally filed application as disclosing two separate and distinct embodiments of the drain plunger 10. The first embodiment is where the drain plunger 10 includes a one-way flap valve or the like in handle 14 to provide easy escape of

air from bellows 20 during compression of bellows 20. The second embodiment is where the drain plunger 10 depends on the special configuration of rim 30 for air escape from bellows 20 during compression of bellows 20.

From our review of the original disclosure, we fail to find any explicit or implicit disclosure of a drain plunger having both a one-way flap valve coupled to the handle 14 **and** a sealing rim to release air from within the bellows during compression of bellows as recited in claims 11 and 14 to 20. Accordingly, the decision of the examiner to reject claims 11 and 14 to 20 under 35 U.S.C. § 112, first paragraph, is affirmed with respect to the written description requirement.

The enablement requirement

An analysis of whether claims 11 and 14 to 20 are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of claims 11 and 14 to 20 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 nonenablement 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).

Thus, the first issue in an enablement rejection 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.

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

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. Since the examiner has not weighed the factors, a conclusion of nonenablement cannot be reached. Accordingly, the rejection of claims 11 and 14 to 20 under 35 U.S.C. § 112, first paragraph, based on the enablement requirement cannot be sustained.

The anticipation rejection

We will not sustain the rejection of claims 1 to 3, 6, 10 and 12 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Independent claim 1 reads as follows:

A drain plunger for creating a suction force within a drain, said plunger comprising:

- a) a handle;
- b) a bellows coupled to the handle; and
- c) a flexible annular sealing rim coupled to the base of the bellows, the sealing rim defining a central space which opens to the interior of the bellows, and wherein the sealing rim is capable of allowing air to escape from the interior of the bellows during compression of the bellows.

This rejection is based upon Figure 8 of Tash and the examiner's determination that (answer, pp. 5-6) Tash's sealing rim 45 is capable of allowing air to escape when sufficient pressure is created in the bellows to overcome the sealing effect of the rim around a drain opening.

The appellant's argue (brief, p. 10) that Tash does not describe the claimed sealing rim (i.e., a sealing rim which is capable of allowing air to escape from the interior of the bellows during compression of the bellows). We agree. In that regard, it is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Tash teaches (column 5) that his sealing rim 45 provides a seal during compression of the bellows. Tash does not teach that his sealing rim 45 is capable of allowing air to escape from the interior of the bellows during compression of the bellows. Thus, the examiner's position that Tash's sealing rim 45 is capable of allowing air to escape when sufficient pressure is created in the bellows to overcome the sealing

effect of the rim around a drain opening is based on sheer speculation, not the disclosure of Tash.

Since all the limitations of claim 1 are not found in Tash for the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2, 3, 6, 10 and 12 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of dependent claims 2, 4, 5, 7 to 9 and 13 under 35 U.S.C. § 103 since the combined teachings of the applied prior art would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified Tash's sealing rim to be capable of allowing air to escape from the interior of the bellows during compression of the bellows.

CONCLUSION

To summarize, the decision of the examiner to reject claims 11 and 14 to 20 under 35 U.S.C. § 112, first paragraph, is affirmed; the decision of the examiner to reject claims 1

to 3, 6, 10 and 12 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claims 2, 4, 5, 7 to 9 and 13 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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Administrative Patent Judge)	AND
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