

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW M. PERRY

Appeal No. 2001-0688
Application No. 08/689,721

HEARD: May 21, 2002

Before THOMAS, GROSS, and LEVY, Administrative Patent Judges.
LEVY, 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 11-13¹, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a method of suspending a musical recorder from the neck of a user. An understanding of

¹ Appellant asserts (brief, page 3) that claims 11 and 12 are being appealed, and that claim 13 is "not a subject of this appeal." We observe that the examiner's answer only refers to claims 11 and 12. Accordingly, the appeal is dismissed as to finally rejected claim 13.

the invention can be derived from a reading of exemplary claim 11, which is reproduced as follows:

11. A method for suspending a recorder from a neck of a user using a device that comprises a strap and a ring attached to the strap, the recorder comprising a lower section and an upper section joined at a juncture point, the recorder having a distal end belonging to the lower section and a proximate end belonging to the upper section, the recorder further having a mouthpiece at the proximate end, the upper section having a diameter that increases gradually from the juncture point to the mouthpiece, the ring having an inner diameter larger than the diameter of the upper section at the juncture point, the inner diameter further being smaller than the diameter of the upper section at the mouthpiece, the method comprising the steps of:

suspending the strap from the neck of the user;

pulling the recorder apart at the juncture point, thereby separating the lower section from the upper section;

then inserting through the ring an end of the upper section that is associated with the juncture point and is opposite to the proximate end, and then sliding the ring towards the mouthpiece, the ring thereby becoming lodged; and

then reconnecting the lower and upper sections at the juncture point.

Claims 11 and 12 stand rejected² under 35 U.S.C. § 112, first paragraph, due to lack of possession,³ and lack of enablement.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 44, mailed November 20, 2000) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 40, filed May 5, 2000) and supplemental brief (Paper No. 43, filed September 12, 2000) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could

² The examiner (answer, page 2) objects to the amendment filed October 12, 1999 under 35 U.S.C. § 132 as introducing new matter into the disclosure, and refers to the objection as a ground of rejection. On page 3 of the answer, the examiner clarifies that the claims have not been rejected under 35 U.S.C. § 132. From our review of the record, we find that the examiner's rejection of claims 11 and 12 under 35 U.S.C. § 112, first paragraph, is based in part on the amendment, which the examiner considers to have introduced new matter into the disclosure. In addition, if we follow the examiner's line of reasoning, it is unclear as to why the examiner only objects to the October 12, 1999 amendment and does not object to the December 14, 1999 amendment which introduced identical language into the disclosure with respect to claim 12. In any event, the objection to the amendment, itself, is not before us on appeal. The objection is considered only to the extent that the examiner relies upon the amendment as a basis for the rejection of the claims under 35 U.S.C. § 112, first paragraph. Accordingly, the only issue before us on appeal is the rejection of claims 11 and 12 under 35 U.S.C. § 112, first paragraph, based upon the grounds of lack of written description and lack of enablement.

³ Although the examiner uses the term "possession," we consider the rejection to be based on a lack of written description, to be commensurate with the language of the statute.

have made but chose not to make in the brief and supplemental brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, and remand the application to the examiner.

We note at the outset that 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; how the specification accomplishes this is not material. See In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "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). 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 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). 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,

[I]t 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.

The examiner's position (answer, page 3) is that the originally filed disclosure does not support the order of the method steps that requires the strap to be placed on the neck of the user and then requires the recorder to be pulled apart and placed in the ring; i.e., that the original specification did not suggest that the ring be placed on the recorder after the strap was placed on the neck of the user. The examiner acknowledges that (answer, page 5) "[i]t may be true that, given the apparatus

shown in the originally filed application, one skilled in the art (admittedly not a high level of skill) could come up with all of the possible ways to maneuver the parts, thereby meeting the claimed steps." However, the examiner asserts (id.) that the disclosure is nonenabling because "finding all of the possible permutations of the steps **is** seen to be undue experimentation." In addition, the examiner acknowledges (answer, page 6) that the originally filed specification is enabling for pulling the recorder apart and then placing the ring thereon, but asserts (id.) that the specification as originally filed does not reasonably provide enablement for performing this operation after the strap has been placed on the neck of the user.

The examiner further asserts (id.) that "claimed limitations cannot be implied. The claimed subject matter must be present in the specification."

Thus, the basis of the examiner's rejection is that although the step, itself, of "suspending the strap from the neck of the user" has support in the originally filed disclosure, the order of the step as recited in method claims 11 and 12 is not supported in the originally filed disclosure, and that the order of the step is not enabled, as undue experimentation would be

required to make and use the invention, with the order of the steps, as claimed.

Appellant asserts (brief, pages 7 and 8) that the claimed sequence of steps is reasonably enabled, at least implicitly, from the disclosure. Appellant further asserts (brief, page 9) that the test for enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue, citing In re Angststadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). Appellant provides an analysis (brief, pages 9-12) of factors to be used in determining whether any necessary experimentation is undue, citing In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Appellant asserts (brief, page 10) that:

The nature of the invention is a device and a method of suspending the recorder. The device is a ring with a strap. The strap goes around the neck of a child, and the recorder goes on the ring. These two steps do not depend on each other. One does not require the other. As such, they can be done in either order, or even simultaneously.

From our review of the entire record, we find that claims 11 and 12 do not require the that step of "suspending the strap from the neck of the user" be carried out in the order listed in the claim, and that the step of "suspending the strap from the neck

of the user" can be carried out after the steps of pulling the recorder apart, inserting the ring, and reconnecting the sections of the recorder.

As set forth by our reviewing court in Interactive Gift Express Inc. v. Compuserve Inc., 59 USPQ2d 1401, 1416 (Fed. Cir. 2001) "Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one." See Loral Fairchild Corp. v. Sony Corp., 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999) (stating that "not every process claim is limited to the performance of its steps in the order written"). However, such a result can ensue when the method steps implicitly require that they be performed in the order written. See Loral, 181 F.3d at 1322, 50 USPQ2d at 1870 (stating that "the language of the claim, the specification and the prosecution history support a limiting construction[, in which the steps must be performed in the order written,] in this case"); Mantech, 152 F.3d at 1376, 47 USPQ2d at 1739 (holding that "the sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise")." We are in agreement with appellant that the invention does not require that the steps of suspending the strap from the neck of the user and placing the

recorder on the ring depend on or require each other, and they therefore can be done in any order. We observe that the originally filed specification states:

e. Operation of Invention. After a suitable strap is attached to the appropriate sized ring, the ring is attached to a recorder by slipping the ring onto the upper section of the recorder. The strap may be adjusted so the recorder hangs comfortably from the neck of the person playing the recorder.

Although the strap can be adjusted after the ring is attached to the recorder, there is no statement in the specification limiting construction of when the strap can be placed around the neck of the user. Consistent with the originally filed specification, claim 11 recites:

suspending the strap from the neck of the user;

pulling the recorder apart at the juncture point, thereby separating the lower section from the upper section;

then inserting through the ring an end of the upper section that is associated with the juncture point and is opposite to the proximate end, and then sliding the ring towards the mouthpiece, the ring thereby becoming lodged; and

then reconnecting the lower and upper sections at the juncture point.

Claim 12 recites similar language. We find that the three steps following the step of "suspending the strap from the neck of the

user" are required to be carried out in the recited order because of the presence of the term "then" between each of these three steps. Because the claimed method is not limited to the order asserted by the examiner, we find that appellant was in possession of the claimed invention as of the filing date. In addition, because the originally filed specification is enabling for "suspending the strap from the neck of the user," we find the specification to be enabled. From all of the above, we find that the examiner has failed to establish a reasonable basis for questioning the written description and enablement of the claims. Accordingly, the rejection of claims 11 and 12 under 35 U.S.C. § 112, first paragraph, is reversed.

REMAND TO THE EXAMINER

We observe that no prior art has been applied against the claims since the time that claims 11 and 12 were presented and the other claims in the application were canceled. To the extent that the examiner may have declined to apply prior art against the claims in view of their perceived lack of enablement and perceived inclusion of new matter, we remand the application to the examiner to reconsider all of the prior art in the application.

The examiner should note the statements in the admitted prior art in the specification, as currently pending (page 1), that "[p]rior art is limited to some resourceful teachers that have simply tied a string around the recorder with some sort of loop that is placed around the child's neck to suspend the recorder." The examiner should also note the statement (page 2) that "the method and apparatus of this invention consist of a ring and an attached strap." From these statements in the specification, we find that the admitted prior art teaches suspending a recorder from the neck of the user using a string around the recorder and a loop that is placed around the child's neck, and that appellant's invention consists of using a ring and an attached strap.

The examiner should consider U.S. Patent No. 4,674,298 to Wimmershoff-Caplan (Caplan), of record. Caplan discloses the use of a ring portion 20 which supports a writing instrument. The ring portion is worn around the neck of a user by a chain 30. The writing instrument is disclosed as having separable parts, 11, 12, respectively. In addition, Caplan discloses (figure 7 and col. 2, lines 13-19) that the ring portion while attached to the chain, can then be slidingly engaged on the cap of the pen, and that "[t]he body of the pen itself can then at will be

engaged in and disengaged from the cap as desired" (See also col. 4, lines 11-15). Moreover, Caplan discloses (col 4, lines 24-32) that when the assembly is worn as a necklace, the ring portion 20 need not go all the way to the top of clip 13, and may sit on a lower portion of the cap "by reason of the radius of the cap 12 being larger near its top" and that (col. 4, lines 56-58) that the clip can be omitted while the cap has a thickened portion for holding the ring in place.

The examiner should also consider U.S. Patent No. 4,841,829 to Lehmann who teaches that straps can be used to attach a musical instrument to the body of a user.

The examiner should consider these teachings, alone or in combination with other prior art, as to the patentability of claims 11 and 12 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 11 and 12 under 35 U.S.C. § 112, first paragraph, is reversed. In addition, we remand the case to the examiner for action consistent with our findings.

This application, by virtue of its "special" status, requires an immediate action, see Manual of Patent Examining Procedure (MPEP) § 708.01(d) (Eighth Edition, August 2001). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REVERSED AND REMANDED

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