

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** DENNIS BROCK

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Appeal No. 2001-1739  
Application 08/892,903

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ON BRIEF

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Before HAIRSTON, FLEMING, and GROSS, **Administrative Patent Judges**.

Fleming, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 through 8, 20, 22, 23, 25 and 26. Claims 9 through 19 and 21 have been withdrawn from consideration because of being directed to non-elected claims. In the Examiner's answer, the Examiner has withdrawn the rejection of claims 3, 20 and 22, leaving only claims 1, 2, 4 through 8, 23, 25 and 26 before us for our consideration.

The invention relates generally to microscopes. See page 1 of Appellant's specification. Appellant's figure 1 shows an isometric view of the present invention of a microscope having a camera mounted thereon. See page 5 of Appellant's specification. Appellant's figure 3 shows a preferred focus adjusting apparatus for the upper rim of cylindrical sleeve 8. Cylindrical sleeve 8 has a slope 50, which works in combination with a rivet or nub 51 on the optical tube 9 to enable fine focus adjustment by rotating the optical tube 9 to cause nub 51 to travel along the slope 50 of the cylindrical sleeve 8. See pages 6 and 7 of Appellant's specification. The sleeve 8 does not completely encircle the tube 9, thus providing a channel 52, through which the nub 51 can pass to enable gross focus adjustment. See page 7 of Appellant's specification.

Independent claim 23, the only independent claim before us, is reproduced as follows:

23. A microscope comprising:

an optical tube for magnifying an image of a specimen to be viewed, said optical tube having an optical tube optical axis along which said optical tube is selectively moveable to alter said image; and

an optical tube sleeve in which said optical tube is rotatably and slideably retained;

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wherein the optical tube sleeve includes an upper sloping surface and said optical tube includes a radial projection for overlying and engaging said sloping surface whereby rotation imparted to the optical tube causes said optical tube to move axially along said optical tube optical axis through the cooperation of the sloping surface with the radial projection to make a fine focus adjustment, and wherein said optical tube sleeve only partially encircles the optical tube and includes spaced-apart side edges defining a generally vertically oriented channel in said optical tube sleeve, said radial projection being dimensioned to slide within said channel along said optical tube optical axis when aligned therewith, whereby a gross focus adjustment can be made.

#### **References**

The references relied on by the Examiner are as follows:

|                              |           |                |
|------------------------------|-----------|----------------|
| Brock                        | 5,071,241 | Dec. 10, 1991  |
| Deutsche Akademie (Akademie) | 1,274,833 | Sept. 18, 1961 |

#### **Rejections at Issue**

Claims 5 through 8 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to have an enabling disclosure. Claims 1, 2, 4, 5, 23, 25 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brock in view of Akademie.<sup>1</sup>

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<sup>1</sup> The Examiner has withdrawn the objection to the drawings under 37 CFR 1.83(a). See page 4 of the Examiner's answer. The Examiner has withdrawn the rejection of claims 1 through 8, 20 and 22 under 35 U.S.C. § 112, second paragraph. See page 8 of the Examiner's answer.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs<sup>2</sup> and the answer for the respective details thereof.

**OPINION**

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of Appellant and Examiner, for the reasons stated *infra*, we will not sustain the Examiner's rejection of claims 5 through 8 under 35 U.S.C. § 112, first paragraph, and we will not sustain the Examiner's rejection of claims 1, 2, 4, 5, 23, 25 and 26 under 35 U.S.C. § 103.

**Rejection under 35 U.S.C. § 112, first paragraph**

The Examiner has rejected claims 5 through 8 because the specification does not teach beam 14 has a perforation in which the coupling rod is selectably rotationable. In particular, the Examiner is relying on Appellant's figure 1 which shows beam 10 having a perforation, slot 12, for receiving a threaded coupling

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<sup>2</sup>Appellant filed an appeal brief on February 15, 2000. Appellant was notified on April 13, 2000, that the brief was defective. Appellant filed a supplemental appeal brief on May 2, 2000. We will simply refer to the supplemental brief as the brief. Appellant filed a reply brief on September 20, 2000. The Examiner mailed an office communication on September 29, 2000, stating that the reply brief has been entered and considered.

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rod 13, but beam 14 does not show the coupling rod 13 being received by slot 15. The Examiner argues that claim 5 recites "the coupling rod is selectively rotatable in a perforation in at least one of said first and second beams." It is not supported by an enabling disclosure. Furthermore, the Examiner argues that claim 6 language, "the coupling rod is slidable along a length of a slot in at least one of said first and second beams" is not supported by an enabling disclosure as well.

Appellant argues that the Examiner has not met the initial burden of making a **prima facie** showing of nonenablement.

Appellant argues that the Examiner has not shown that one of ordinary skill in the art could not make or use the invention from the disclosures coupled with information known in the art without undue experimentation. See pages 5 and 6 of the brief.

As noted by our reviewing court in **Enzo v. Calgene**, 188 F.3d 1362, 1371, 52 USPQ2d 1129, 1135 "[t]he statutory basis for the enablement requirement is found in Section 112, Para. 1, which provides in relevant part that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

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35 U.S.C. § 112, Para. 1 (1994).” “To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation’.” **Genetech, Inc. v. Novo Nordisk**, A/S 108 F.3d 136, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting **In re Wright**, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, **see Hybritech, Inc. v. Monoclonal Antibodies, Inc.**, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), . . . We have held that a patent specification complies with the statute even if a “reasonable” amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be “undue.” **See, e.g., In re Wands**, 858 F.2d at 736-37, 8 USPQ2d at 1404 (“Enablement is not precluded by the necessity for some experimentation . . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is ‘undue,’ not ‘experimentation’.”) (footnotes, citations, and internal quotation marks omitted). In **Wands**, we set forth a number of factors which a court may consider in

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determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (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. **Id.** at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. **See, Amgen, Inc. v. Chugai Pharm. Co., Ltd.**, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the **Wands** factors "are illustrative, not mandatory. What is relevant depends on the facts.").

We note for the record that the language found in claims 5 and 6 in contention before us was the original claim language filed in the application. Thus, the claim language itself must be considered as part of the original enabling disclosure. Furthermore, we also note that the Appellant has provided us with a working example of how to modify beam 14. In particular, structure 10 shows a way in which beam 14 would be able to be

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modified to those skilled in art. Therefore, we find one of ordinary skill in the art would readily appreciate from the original disclosure that the embodiment depicted in figure 1 could be routinely modified so that the coupling rod 13 could be selectively rotatable in a perforation or a slot through rotatable beam 14 by simply providing coupling rod nub 17 and coupling rod washer 18 on a rotatable beam end of coupling rod 13 in addition to providing nuts and washers on the upright beam end of coupling rod 13, and inserting coupling rod 13 into rotatable beam slot 15. Therefore, we will not sustain the Examiner's rejection of the claims under 35 U.S.C. § 112, first paragraph.

**Rejection under 35 U.S.C. § 103**

Claims 1, 2, 4, 5, 23, 25, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brock in view of Akademie. Appellant points out that independent claim 23 recites

wherein said optical tube sleeve only partially encircles the optical tube and includes spaced-apart side edges defining a generally vertically oriented channel in which said optical tube sleeve, said radial projection being dimensioned to slide within said channel along said optical tube optical axis when aligned therewith, whereby a gross focus adjustment can be made.

Appellant argues that neither Brock nor Akademie or the combination teaches or suggests the above limitation. Appellant argues that the Examiner has failed to show that one of ordinary

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skill in the art would have been motivated to modify the prior art to obtain the Appellant's claimed invention. See pages 9 and 10 of Appellant's brief.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only

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assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir.. 2002).

When determining obviousness, "the [[E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references'." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), **citing In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, **citing McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

We find that Brock does teach a sleeve 38 shown in figure 1 used for slideably forming the optical tube 16. See column 4, lines 51 through 64, of Brock. Furthermore, we find that

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Akademie teaches in the figure, a wedge 10 and pen 11 where the wedge 10 has a slope engaging pen 11 for fine focus. However, we fail to find that Brock or Akademie provides any evidence that one of ordinary skill in the art would have known to use the slot provided by cylindrical sleeve 38 of Brock to allow the pen 10 of Akademie to pass through to provide gross adjustment. In particular, Brock is silent as to why cylindrical sleeve 38 is shown as only partially surrounding the optical tube 16. Brock only teaches that the cylindrical sleeve 38 should provide sufficient friction engagement between the engaging surfaces to retain the optical tube in its various adjusted positions. Akademie on the other hand, shows the wedge 10 completely surrounding the tube and teaches other means for gross adjustment. Therefore, there is no suggestion of modifying the Akademie wedge to provide a slot so that the pen 11 may pass through to provide gross adjustment. Therefore, we will not sustain the Examiner's rejection of the claims under 35 U.S.C. § 103.

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In view of the foregoing, we have not sustained the Examiner's rejection of claims 5 through 8 under 35 U.S.C. § 112, first paragraph. Furthermore, we have not sustained the Examiner's rejection of claims 1, 2, 4, 5, 23, 25 and 26 under 35 U.S.C. § 103.

**REVERSED**

|                             |   |                 |
|-----------------------------|---|-----------------|
| KENNETH W. HAIRSTON         | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| MICHAEL R. FLEMING          | ) |                 |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) |                 |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
| ANITA PELLMAN GROSS         | ) |                 |
| Administrative Patent Judge | ) |                 |

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Caesar Rivise Bernstein  
Cohen & Pokotilow  
12th Floor Seven Penn Center  
1635 Market Street  
Philadelphia, PA 19103-2212