

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONNIE L. SATZLER

Appeal No. 2001-2118
Application No. 08/987,977

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 6 and 13. Claims 7 through 12 stand withdrawn from consideration pursuant to an election of species requirement. These claims constitute all of the claims in the application.

Appellant's invention pertains to a method for synchronizing the steering in a machine between a first steering arrangement having steerable wheels and a second steering arrangement having non-steerable drive units. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a

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copy of which appears in 'APPENDIX A-1" of the "SUPPLEMENT TO BRIEF ON APPEAL" (Paper No. 21).

The following rejection is the sole rejection before us for review.

Claims 1 through 6 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement in the underlying specification.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the final rejection and the answer (Paper Nos. 15 and 18), while the complete statement of appellant's argument can be found in the main brief (Paper No. 17).

OPINION

In reaching our conclusion on the enablement issue raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

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We do not sustain the examiner's rejection. Our reasons follow.

At the outset, we keep in mind that the test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. ***In re Wands***, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and ***In re Scarbrough***, 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 the examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. ***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. ***In re Doyle***, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973),

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cert. denied, 416 U.S. 935 (1974) and **In re Eynde**, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

Turning now to the circumstances before us, the examiner has particularly focused upon the "calculating" step of appellant's method claims in asserting that the claimed invention is not enabled by the application disclosure. However, nowhere within the rejection has the examiner addressed the critical matter of establishing that appellant's teaching would require undue experimentation to make and use the invention now claimed. Thus, the readily apparent deficiency of the examiner's enablement rejection is its failure to satisfy the test for enablement; a test, which as set forth earlier, mandates a showing of undue experimentation. Since the rejection on appeal lacks the requisite showing of undue experimentation, we cannot sustain the rejection of appellant's claims under 35 U.S.C. § 112.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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