

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID A. DEBLOCK, RONALD L. SITZEMA JR. and GWEN H. BARBER

Appeal No. 2002-0033
Application No. 09/372,020¹

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 6, mailed September 14, 2000) of claims 18 to 34 under 35 U.S.C. § 112, first paragraph.²

We REVERSE.

¹ Application filed August 10, 1999, for reissue of U.S. Patent No. 5,655,339 (Application No. 08/694,558, filed August 9, 1996), which patent issued on August 12, 1997.

² Claims 1 to 17, the only other claims pending in this application, have been allowed.

BACKGROUND

The appellants' invention relates to skylights (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 18 to 34 stand rejected under 35 U.S.C. 112, first paragraph, as based on an inadequate written description and disclosure which is not enabling. The basis for this rejection is set forth on page 4 of the final rejection as follows:

The prismatic portion being provided on the exterior surface is considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The claims have been broadened by the omission of the limitation that the prismatic portion is provided on the exterior surface. The specification fails to satisfy the written description requirement and is not enabling for the prismatic portion being provided anywhere other than the exterior surface. One skilled in the art would not be taught by the written description of the invention in the specification that the prismatic portion may be provided anywhere other than the exterior surface. A claim which omits matter disclosed to be essential to the invention as described in the specification is subject to rejection under 35 U.S.C. 112, first paragraph as not enabling. **See Gentry Gallery, Inc. V. Berkline Corp.**, 134 F. 3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998). **See In re Mayhew**, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); **In re Venezia**, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); and **In re Collier**, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). **See also Reiffin v. Microsoft Corp.**, 48 USPQ2d 1274, 1277 (N.D. Cal. 1998). and MPEP 2172.01.

The rejection of claims 18 to 34 under 35 U.S.C. § 251 based upon a defective reissue declaration as set forth on page 2 of the final rejection is **not** under appeal as

set forth on 3 of the brief (Paper No. 9, filed January 2, 2001). The rejection of claims 18 to 34 under 35 U.S.C. § 251 based on recapture as set forth on page 3 of the final rejection is **not** under appeal since this rejection has been withdrawn by the examiner as set forth on page 4 of the answer³ mailed May 3, 2002 (Paper No. 15).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the rejection under 35 U.S.C. § 112 under appeal, we make reference to the above-noted final rejection and answer for the examiner's complete reasoning in support of that rejection, and to the brief, reply brief (Paper No. 11, filed March 29, 2001) and supplemental reply brief (Paper No. 16, filed June 28, 2002) for the appellants' arguments thereagainst.

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 18 to 34 under 35 U.S.C. § 112, first paragraph, for the reasons which follow.

³ This answer appears to have replaced the answer mailed February 13, 2001 (Paper No. 10).

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). Since the rejection under appeal appears to be based upon both the description and enablement requirements we will review each requirement separately.

The written description requirement

As set forth above, the examiner determined that the written description requirement had not been complied with since the claims under appeal have been broadened by the omission of the limitation that the prismatic portion is provided on the exterior surface. The examiner, citing Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998) and other cases, stated that a claim which omits matter disclosed to be essential to the invention as described in the specification is subject to rejection under 35 U.S.C. 112, first paragraph.

The appellants argue (brief, pp. 4-5; reply brief, pp. 1-3) that the examiner has misapplied Gentry Gallery and the other cited cases since a claim may be broader than the specific embodiment disclosed in the specification and the specification of the

instant application does not in any way teach or suggest that the location of the prismatic portion on the exterior surface is critical, essential, required or necessary. We agree.

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).

The decision in Gentry Gallery cited as authority for this rejection by the examiner does not create a new requirement of claim content. In Gentry Gallery the issue was whether the written description, which described a specific location of a control console on a reclining sofa, adequately supported broad claims that were not limited to this location of the console; these broad claims were asserted by the patentee against a reclining sofa having the control console in a different location. The Federal Circuit held that the broad claims were not supported by the written description, and were invalid. As explained in Johnson Worldwide Assoc. v. Zebco Corp., 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999), "this court's determination [in Gentry Gallery] that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element . . . as 'the only possible location' and that variations were 'outside the stated purpose of the invention.'" Thus Gentry Gallery⁴ is simply one of many decisions holding that "claims in an application which are broader than the applicant's disclosure are not allowable." See e.g., In re Sus, 306 F.2d 494, 505, 134 USPQ 301, 310 (CCPA 1962) (citations omitted).

⁴ Gentry Gallery is a situation where the patent's disclosure made crystal clear that a particular (i.e., narrow) understanding of a claim term is an "essential element of [the inventor's] invention."

The original specification provided the following:

- (1) the dome of a tubular skylight includes an exterior surface having a prismatic portion to reflect light downwardly into the tube (specification, p. 2);
- (2) the generally hemispherical dome portion 60 includes an interior surface 70 and an exterior surface 72 wherein the exterior surface includes a prismatic surface or portion 68 and a nonprismatic surface or portion 69 (specification, p. 5);
- (3) the prismatic portion 68 includes a plurality of grooves 71 that are molded, cut, or otherwise formed in the exterior surface 74 (specification, p. 5); and
- (4) the above description is that of a preferred embodiment of the invention (specification, p. 9).

In our view, the above-noted portions of the original specification provide sufficient written description support for claims 18 to 34 which omit the limitation that the prismatic portion is provided on the exterior surface. In that regard, the original disclosure does not establish the prismatic portion being provided on the exterior surface as an "essential element" of the invention that must be included in the claims. The examiner's apparent position that a disclosure of only one embodiment of the invention makes that embodiment critical or essential is without merit. That position would appear to prohibit all claims in all applications that are broader than the original claims.

For the reasons set forth above, claims 18 to 34 comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

The enablement requirement

The examiner also determined that the enablement requirement had not been complied with since the claims under appeal have been broadened by the omission of the limitation that the prismatic portion is provided on the exterior surface.

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). 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).

Thus, the dispositive issue 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. This the examiner has not done. In fact, the subject matter of claims 18 to 34 can be made and used by making the embodiment shown in Figures 1-4 of the application. The examiner has implicitly found that the subject matter of claims 1 to 17 comply with enablement requirement of 35 U.S.C. § 112, first paragraph. Thus, if the more specific claims 1 to 17 are enabled, we see no

reason why, and the examiner has not provided any explanation, broader claims 18 to 34 are not likewise enabled.

For the reasons set forth above, claims 18 to 34 comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

CONCLUSION

To summarize, the decision of the examiner to reject claims 18 to 34 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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