

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MING-YI LEE and YING-HSIANG CHENG

Appeal No. 2002-0431
Application 09/309,057

ON BRIEF

Before KIMLIN, OWENS and POTEATE, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-17, which are all of the claims remaining in the application.

THE INVENTION

The appellants claim a cleaning apparatus for removing chemical substances from an inside wall of a conduit. Claim 1 is illustrative:

1. An apparatus for removing chemical substances deposited on an inside wall of a conduit in a cleaning process comprising:

a movable shaft having an upper portion and a lower portion,

a plurality of scraping elements attached to said upper portion of the shaft,

drive means attached to said lower portion of the shaft for providing both vertical and circumferential motions of said shaft,

a housing adapted for receiving said shaft and said plurality of scraping elements, and

a controller for controlling said cleaning process by a plurality of scraping elements driven by said movable shaft to scrape said chemical substances deposited on the inside wall of said conduit.^[1]

THE REJECTION

Claims 1-17 stand rejected under 35 U.S.C. § 112, first paragraph, enablement requirement.

¹ The amendment in which this form of claim 1 was introduced (amendment filed November 2, 2000, paper no. 9) has been approved for entry by the examiner (advisory action mailed November 16, 2000, paper no. 10), but has not been clerically entered. The examiner should have this amendment entered.

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OPINION

We reverse the aforementioned rejection.

Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the 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 in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . it 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.

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The examiner argues (final rejection mailed September 22, 2000, paper no. 7, pages 2-3)²:

The specification fails to set forth how the two motors cause the shaft to be extended up into the conduit (page 10, line 11), to turn the shaft in a "radial" direction, or to oscillate it back and forth, with or without simultaneously vertical moving. Merely showing two "motors" without giving any indication as to how they are connected to the shaft by transmissions of a nature that imparts a specific motion while allowing a separate or concurrent motion in the other of the two disclosed modes is insufficient to enable one skilled in the art to make the device. Although it could be said that transmissions for connecting a motor to a shaft to impart axial reciprocating motion are old and well-known, and that transmissions for connecting a motor to a shaft to impart rotary reciprocating motion are old and well-known, connecting two motors (either directly or indirectly) to the same shaft to at the same time apply their own type of motion while being simultaneously constructed and connected not to interfere with the application of the other type of motion is an entirely different proposition.

The portions of the appellants' original specification which describe the mechanism for providing vertical and circumferential motions to the shaft and describe the operation of that mechanism are the following:

The lower portion 68 of shaft 64 is mounted to a drive means, e.g., a motor 76 for driving the shaft 64 for movement in both the vertical and the radial directions. The drive means 76 may be provided such that the shaft 64 is capable of oscillating

² The explanation of the rejection set forth in the final rejection is relied upon in the examiner's answer (page 2).

alternatingly in a clockwise and counter-clockwise direction or in a vertical (up and down) direction. A controller (not shown) may be provided to control the drive means 76 such that it may provide both the vertical and the radially oscillating motions simultaneously for more effective cleaning. The drive means 76 may further be provided such that the shaft 64 rotates in a uniform direction if such movement is more advantageous than the oscillating movement for achieving a high cleaning efficiency. The frequency of the oscillating motion or the rotational speed of the shaft 64 can be suitably controlled to achieve such high cleaning efficiency. It has been observed that an oscillating clockwise and counter-clockwise motion provides one of the more efficient methods for cleaning chemical deposits on the inside wall 46.^[3]

. . .

A controller (not shown) first instruct [sic, instructs] the drive means 76 to extend the shaft 64 fully or to a proper height inside the exhaust conduit 54 depending on the location of the chemical substances on the interior wall 46, the shaft 64 is then activated by the drive means 76 to either turn in a radial direction or oscillates [sic, oscillate] in a clockwise/counter-clockwise direction such that the scraping elements 72 frictionally engaging [sic, engage] the inside wall 46 for removing the chemical substances. The shaft 64 may also be moved in a vertical direction simultaneously with the rotational or oscillating motion to enhance the cleaning efficiency.^[4]

³ Specification, page 8, line 16 - page 9, line 6.

⁴ Specification, page 10, lines 11-17.

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As these excerpts indicate, the disclosure regarding two motors discussed throughout the examiner's argument was not part of the appellants' original specification. The "two motor" disclosure (i.e., describing drive means 76 as an up/down motor and adding rotary motor 74) and a new figure (3A) which shows the two motors were added by amendment (filed August 14, 2000, paper no. 6). The examiner has stated that the added structure has no basis in the original disclosure (final rejection, page 2; answer, page 3), and has required that figure 3A and the related descriptive subject matter be canceled (final rejection, page 2). The appellants should cancel the alleged new matter or petition the examiner's requirement that it be canceled. *See Manual of Patent Examining Procedure* § 1002.02(c)(3)(c) (8th ed. August 2001).

Regardless of whether the appellants' specification is considered to disclose only drive means 76 or a combination of up/down drive means 76 and rotary motor 74, the examiner's mere assertion that the appellants' disclosure is not sufficient to enable one of ordinary skill in the art to make the device for providing vertical and circumferential motions to the shaft is not adequate for establishing a *prima facie* case of nonenablement. The examiner must back up the assertion with

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evidence or reasoning, and the examiner has not done so.
Accordingly, we reverse the examiner's rejection.

DECISION

The rejection of claims 1-17 under 35 U.S.C. § 112, first paragraph, enablement requirement, is reversed.

REVERSED

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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	
Administrative Patent Judge)	APPEALS AND
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LINDA R. POTEATE)	
Administrative Patent Judge)	

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