THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. THOMAS

Appeal No. 95-2896
Application No. 07/977,771[1]

ON BRIEF

Before GARRIS, WARREN, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 11, which are all of the claims pending in this application.

We reverse.

[1] Application for patent filed November 17, 1992.

BACKGROUND

The appellant's invention relates to a method for the solid-state formation of diamond on a substrate. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

1. A method for solid-state formation of diamond, comprising the steps of:

(a) providing a diamond growth substrate:

(b) forming a metal-carbon alloy on said diamond growth substrate which permits carbon to exist in a metal matrix therein; and

(c) causing carbon atoms from said alloy to form diamond on said diamond growth substrate while said alloy is in a solid phase.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Prins	4,997,636	Mar. 05, 1991
Narayan	5,221,411	Jun. 22, 1993

The following references are relied upon by appellant:

Van Vlack, Elements of Material Science: An Introductory Text for Engineering Students, Addison-Wesley Publishing Company, second edition, pages 100-106, (furnished copy undated);

Ramesham et al. (Ramesham), “Selective Growth of Boron-Doped Polycrystalline Diamond Thin Films,” Proceedings of the Second International Conference: New Diamond Science and Technology,

Washington, DC Sept. 23-27, 1990, 1991 MRS Int. Conf. Proc., Editors: Messier et al., pages 943-947.

Claims 1- 11 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure and as lacking an adequate written description in the specification.

OPINION

Having considered the entire record of this application, including the arguments advanced by both the examiner and appellant in support of their respective positions, we agree with appellant that the examiner has not met his burden to show that the claimed subject matter is not described and supported by the original disclosure of the application. Accordingly, we will not sustain the examiner's rejections for essentially those reasons expressed in the appellant's brief. We add the following primarily for emphasis.

The Rejection for Lack of Descriptive Support

The examiner has rejected claims 1-11 and objected to the specification "... as failing to provide an adequate written description of the invention..." (answer, page 3). *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The examiner has stated that descriptive support in the original disclosure could not be found because of "... the failure of appellant to clearly set forth if the invention will work. The term 'believes' cannot be considered an [sic] clear and exact written description of the invnetion [sic, invention]" (answer, page 10).

Insofar as the written description requirement is concerned, the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. *See In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). The examiner’s finding of lack of descriptive support for the appealed claims is without merit for two reasons. First, the original claims provide literal support for themselves *See In re Anderson*, 471 F.2d 1237, 1238-39, 176 USPQ 331, 332 (CCPA 1973)(unamended original claim is a part of the original disclosure). Second, the examiner has not clearly explained how a lack of descriptive support under 35 U.S.C. § 112, first paragraph is established by appellant's use of the term "believe" in the specification and the examiner's concern with

whether appellant has proven that the invention will work.

Based on the present record, we find ourselves in agreement with appellant's basic position (brief, pages 19 and 20) that the original disclosure reasonably conveys to the artisan that appellant had possession of the claimed subject matter including a solid-state diamond formation method that included the steps of furnishing a substrate for diamond growth, forming a metal-carbon alloy on the substrate with carbon present in a metal matrix therein, and forming a diamond film on the substrate from the alloy carbon atoms while the alloy is in a solid phase (specification, page 2, lines 14-19). Accordingly, we determine that the subject matter of the appealed claims is adequately described in the original disclosure. Therefore, the rejection under § 112, first paragraph, with regard to the alleged lack of descriptive support for the claims on appeal cannot be sustained.

The Rejection for Lack of Enablement

According to the examiner, the specification is non-enabling since the disclosure only suggests "... that

applicant 'believes' that a diamond film will be formed..." (answer, page 3) rather than teaching that "the invention does preform [sic, perform] as expected" (answer, page 3). Furthermore, the examiner urges that the Prins and Narayan references "... both teach carbon diffuse [sic] in an upwards motion, not downwards..." (answer, page 3) as allegedly called for by the claimed invention herein.

With respect to enablement and as noted by appellant (brief, page 6), 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. . . .
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> . . . .
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> . . . 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.

In our view, the examiner has not carried his initial burden of setting forth evidence or sound technical reasoning which indicates that one of ordinary skill in the art would not have been enabled by appellants' specification to form diamond on a substrate, via a solid-state formation process, from the carbon present in a metal-carbon alloy that is deposited on the substrate.

Whether making and using the invention would have required undue experimentation, and thus whether the disclosure is enabling, is a legal conclusion based upon several underlying factual inquiries. *See In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). For the reasons expressed by appellant in the brief and reply brief, the examiner has not presented sufficient factual determinations to support the legal conclusion that undue experimentation is required to practice the invention as claimed. With regard to appellant's use of prophetic examples in the specification, we agree with appellant that such "... does not constitute a failure to enable" (brief, page 8).

Compliance with the enablement provision of 35 U.S.C. § 112, first paragraph does not require appellant to actually have reduced the claimed method to practice.

Moreover, we observe that the examiner has not convincingly explained how the teachings of the Prins and Narayan patents would support the notion that undue experimentation would have been required to practice the invention claimed herein. Indeed, we agree with appellant (brief, pages 11-14 and reply brief, page 3) that the examiner has not even fairly represented the Prins and Narayan references teachings regarding their diamond growth processes. Accordingly, based on the present record, the rejection of claims 1-11 under 35 U.S.C. § 112, first paragraph, for lack of enablement cannot be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-11 under 35 U.S.C. § 112, first paragraph for lack of descriptive support and for lack of an enabling disclosure is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

PFK/jlb

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