

***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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** MARK G. VOSS,  
ZALMAN P. SAPERSTEIN,  
PETER C. KOTTAL,  
and GREGORY G. HUGHES

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Appeal No. 96-1677  
Application 08/144,735<sup>1</sup>

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ON BRIEF

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Before MEISTER, FRANKFORT, and PATE, ***Administrative Patent Judges***.

PATE, ***Administrative Patent Judge***.

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<sup>1</sup> Application for patent filed October 28, 1993.

Appeal No. 96-1677  
Application 08/144,735

### ***DECISION ON APPEAL***

This is an appeal from the final rejection of claims 9 through 14. The other claims remaining in the application, claims 1 through 8, are indicated as allowable.

### ***Background***

The appellants filed a Notice of Appeal on June 1, 1995. Thereafter on July 28, the appellants filed an Appeal Brief with an Examiner's Answer following on August 28, 1995. On October 30, 1995, the appellants filed a Reply Brief directed to new points raised in the Examiner's Answer. The examiner notified the appellants of non-entry of the Reply Brief on December 7, 1995. Appellants petitioned from the non-entry of the Reply Brief and the petition was granted on February 26, 1996. The examiner noted but did not otherwise respond to the Reply Brief after entry thereof. Therefore, both the Appeal Brief and the Reply Brief from appellants and the Examiner's Answer are before us for consideration on this appeal.

The claimed subject matter relates to a header and tank assembly for a heat exchanger. The header and tank assembly are concave with complementary extending flanges that are brazed together to form the tubular header/tank assembly. Elongated flattened tubes are brazed into the header and comprise the heat exchange passages of the invention. The flange of the tank has crests and valleys that correspond to the

tube slots that are in the header portion of the tank/header assembly. The crests and valleys allow full flow through the elongated flattened tubes.

Claim 9, reproduced below, is representative of the subject matter on appeal.

9. A heat exchanger comprising

a plurality of flattened tubes, each having a minor dimension and a major dimension transverse thereto, extending in spaced parallel relation;

fins between and in heat exchange relation with said tubes; and

a pair of spaced parallel elongated headers/tank assemblies between which said tubes extend, at least one of said headers/tank assemblies being a multiple piece header including a header piece and a separate tank piece, said header piece being elongated and having a plurality of slots sized to receive ends of said tubes with the tube major dimensions being generally transverse to the direction of elongation of said header piece, said header piece further including opposed elongated flanges extending along its length, said tank piece being elongated, concave and having opposed elongated flanges extending along its length and nested within the flanges of said header piece and bonded thereto to form a unitary tubular structure, the flanges of the tank piece having alternating crests and valleys, said valleys having a width greater than said tube minor dimension and being aligned with said tube ends;

whereby flow to said tubes is not obstructed by said tank flanges because of the valleys therein being aligned with said tube ends to provide reliefs therefor.

The appellants and the examiner do not agree over whether claims 9 through 14 stand or fall together.

Turning first to the appellants' Brief, the first sentence under "GROUPING OF CLAIMS" on page 5 seems to indicate that the appellants are accepting of the examiner's grouping of claims 9 through 14 together. However the next sentence

states that claim 14 is different from claims 9 through 13. However, the “ARGUMENTS” section of appellants’ Brief treats the claims together and does not include a second argument directed to claim 14. In the Reply Brief, the appellants take issue with the examiner’s statement in the Examiner’s Answer that claims 9 through 14 stand or fall together. Inasmuch as 37 CFR § 1.192(c)(7) specifically requires both a statement that the claims do not stand or fall together and arguments under paragraph (c)(8) explaining why the claims of the group are believed to be separately patentable, and since we do not find any discussion of claim 14 independent from claims 9 through 13 in the “ARGUMENT” section of the appellants’ Main and Reply Brief, we conclude that the examiner is correct and that claims 9 through 14 shall stand or fall together. We limit our analysis to claim 9.

The sole issue on appeal is the rejection by the examiner of claims 9 through 14 under 35 U.S.C. § 112, first paragraph. The examiner has objected to the specification and rejects claims 9 through 14 for the reason that the specification discloses the flanges as being peripheral. According to the examiner, there is no disclosure of the flanges being merely elongate.

***Opinion***

The examiner has some difficulty articulating the rejection. The examiner states that the rejection is a new matter rejection, not an inoperability or lack of enablement rejection in the first paragraph on page 4 of the Examiner's Answer. A new matter rejection finds its basis in the descriptive support provision of 35 U.S.C. § 112, first paragraph. In our view, the specification and particularly the drawing in Figure 2 disclose elongated flanges forming the top and bottom joining portions in plan view of the tank header. Drawings alone may provide written description as required by 35 U.S.C. § 112. ***Vas-Cath, Inc., v. Mahurkar***, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991). Therefore we will not sustain the rejection under 35 U.S.C. § 112, first paragraph, for lack of descriptive support.

Additionally however, the body of the Examiner's rejection seems to be predicated upon the fact that by merely claiming elongated flanges, the claim does not recite structure that closes off the "open ends" of the header/tank assemblies. See the third full paragraph, Examiner's Answer at page 4. We are in agreement with the appellants in the Reply Brief wherein they state that this type of rejection is actually under the enablement provision of 35 U.S.C. § 112, first paragraph. We are further in agreement with the appellants that since the claim is of the comprising or of the open ended type, it is not necessary for appellants to recite the closed end structure as long as one of ordinary skill in the art could make a header/tank assembly with elongated

flanges operable without undue experimentation. To the extent that the examiner's rejection is to be construed as based on the enablement provision of 35 U.S.C. § 112, first paragraph, we also reverse the examiner's rejection. We add the following quotations to emphasize this point.

If an invention pertains to an art where the results are predictable, e.g., mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment, *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298, 301 (CCPA 1971); *In re Vickers*, 141 F.2d 522, 527, 61 USPQ 122, 127 (CCPA 1944), and is not invalid for lack of enablement simply because it reads on another embodiment of the invention which is inadequately disclosed, *see Gould v. Mossinghoff*, 711 F.2d 396, 400, 219 USPQ 393, 396 (D.C. Cir. 1983).

*Spectra-Physics, Inc. v. Coherent Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987).

[M]any patented claims read on vast numbers of inoperative embodiments in the trivial sense that they can and do omit 'factors which must be [sic, have been] presumed to be within the level of ordinary skill in the art,' *In re Skrivan*, 427 F.2d 801, 806, 166 USPQ 85, 88 (1980), and therefore read on embodiments in which such factors may be included in such a manner as to make the embodiments inoperative. There is nothing wrong with this so long as it would be obvious to one of ordinary skill in the relevant art how to include those factors in such manner as to make the embodiment operative rather than inoperative. (Citations omitted.)

*Cook* at 735, 169 USPQ at 302 (*citing Skrivan* at 806, 166 USPQ at 88).

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**Summary**

The examiner's "new matter" rejection of claims 9 through 14 under 35 U.S.C. § 112, first paragraph, for lack of descriptive support is reversed. To the extent that the examiner's rejection can be construed as under 35 U.S.C. § 112, first paragraph, lack of enablement, the rejection is also reversed. Consideration of appellants' petition under 37 CFR §1.48 (Paper No. 8) appears to be in order.

**REVERSED**

	)	
James M. Meister	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Charles E. Frankfort	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
William F. Pate, III	)	
Administrative Patent Judge	)	

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