

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(2) is not binding precedent of the Board.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. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENZION LANDA

Appeal No. 1996-2362
Application 08/203,596¹

HEARD: Jan. 12, 2000

Before KIMLIN, GARRIS, and PAK, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 6
through 8 and 11 through 13. The remaining claims in the

¹Application for patent filed February 28, 1994.
According to appellant, this application is a continuation of
Application 07/676,422, filed March 28, 1991, now abandoned.

Appeal No. 1996-2362
Application No. 08/203,596

application, which are claims 9, 10, 14 and 15, have been indicated by the examiner as either allowed or allowable.

The subject matter on appeal relates to a liquid toner and to a process for the use thereof. The toner comprises a polymer blend having certain characteristics associated with temperature and viscosity. This appealed subject matter is adequately illustrated by independent claim 6, a copy of which taken from the supplemental appendix of the appellant's reply brief is appended to this decision.

No references are relied upon by the examiner in the rejection set forth below which is the sole rejection remaining on this appeal.

Claims 6 through 8 and 11 through 13 are rejected under the first paragraph of 35 U.S.C. § 112 for being based upon an original disclosure which would not enable one having an ordinary level of skill in this art to practice the here claimed invention.

We refer to the brief and reply brief and to the answer and supplemental answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejection.

Appeal No. 1996-2362
Application No. 08/203,596

We will not sustain this rejection for the reasons fully detailed by the appellant in the brief and reply brief. We add the following comments for emphasis.

In support of his nonenablement position regarding the here claimed polymers, the examiner argues that "[t]here is no way of determining, without individually testing every single one of these polymers, whether it would be suitable as a liquid toner and whether it meets the limitations of Appellant's claim" (answer, page 8). However, even if this argument is factually sound, it does not militate against enablement. This is because the enablement criteria of section 112 simply does not require the capability of determining suitability in the absence of testing. As the appellant has repeatedly explained, such a requirement would render all "experimentation" "undue", since "experimentation" implies that the success of a particular activity is uncertain. In re Angstadt, 537 F.2d 498, 503, 190 USPQ 214, 218-219 (CCPA 1976). Furthermore, it is well settled that some experimentation is permissible under the enablement requirement of section 112. Fields v. Conover, 443 F.2d 1386, 1390-1391, 170 USPQ 276, 279 (CCPA 1971).

Appeal No. 1996-2362
Application No. 08/203,596

In addition, contrary to the examiner's view, nonenablement is not established simply because there may be a large "number of tests required to determine which polymer blends meet the claimed limitations" (answer, page 9). Such a number is not the criteria or test for assessing whether a disclosure is nonenabling because the "experimentation" required is "undue". That is, "[t]he test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed". In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), citing Ex parte Jackson, 217 USPQ 804, 807 (Bd. App. 1982).

In essence, it appears to be the examiner's opinion that the appellant should be limited to claims which encompass only the specific blends of particular polymers disclosed in the subject specification examples. However, a competitor could avoid infringing such claims merely by following the appellant's disclosure to find a substitute polymer blend. In order to provide effective incentives, claims must adequately

Appeal No. 1996-2362
Application No. 08/203,596

protect inventors. To demand that the first to disclose shall limit his claims to the specific materials he has found will work would not serve the constitutional purpose of promoting progress in the useful arts. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

The decision of the examiner is reversed.

REVERSED

	Edward C. Kimlin)	
	Administrative Patent Judge)	
)	
)	
)	
	Bradley R. Garris)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Chung K. Pak)	
	Administrative Patent Judge)	

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Appeal No. 1996-2362
Application No. 08/203,596

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APPENDIX

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