

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(2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUKKA HEINO,
RAIMO KOHONEN and ERKKI SAVOLAINEN

Appeal No. 96-3181
Application 08/251,963¹

ON BRIEF

Before WARREN, ELLIS and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner rejecting for the third time claims 1 through 21 as filed in this application. The examiner has now withdrawn all of the

¹ Application for reissue patent, filed June 1, 1994. According to appellants, this application is reissue of Patent No. 5,264,138, issued November 23, 1993, maturing from application 07/663,877, filed May 1, 1991.

grounds of rejection of the appealed claims except the ground of rejection of appealed claims 16 and 18 through 20 under 35 U.S.C. § 112, first paragraph.²

While the examiner has premised his rejection of appealed claims 16 and 18 through 20 on the basis that the specification, as originally filed, does not provide “support” for the invention as is now claimed (answer, page 3, incorporating paragraphs 2-3 of the office action of November 8, 1995 (Paper No. 10) in that the term “pulsations” added to column 8, line 38, and the revised Figure 6 is new matter (answer, pages 4-5), it is apparent to us that this rejection is based on the written description requirement of § 112, first paragraph. *See, generally, Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 99 (CCPA 1976). In order to make out a *prima facie* case of failure of the *claims* to comply with this section of the statute, the examiner must set forth “evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996), quoting *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

We find that appealed claims 16 and 18 through 20 encompass methods of treating pulp utilizing a wire-surfaced filter cylinder. We construe these claims to require in “step (d)” that the pulp web is removed from the wire-surfaced filter cylinder with a flexible wiper (claims 16 and 18 through 21) wherein “pressure pulsations” are provided from the interior of the wire surface of the cylinder which cause radial movement of the tip of the wiper toward and away from the wire surface of the cylinder (claims 16, 18 and 20) and/or provided when each wall between adjacent filter compartments is rotated past the tip of said wiper (claims 18 through 20). The only contentions advanced by the examiner in support of his position that the methods defined by the appealed claims lack “support” in the specification with respect to these limitations, thus violating § 112, first paragraph, written description, is that the “specification of [the] original patent does not recite ‘pulsation’” and “a slight increase in the space 98 is not [the] same as ‘pulsation’” (answer, pages 4-5). With respect to the examiner’s first contention, it has long been settled that the examiner must provide “reasons why a description not in

² Answer (Paper No. 13; page 2, and Letter of June 12, 1998 (Paper No. 23).

ipsis verbis is insufficient.” *Wertheim*, 541 F.2d at 265, 191 USPQ at 98. Thus, the examiner’s finding that the term “pulsation” is not *per se* found in the original disclosure is insufficient to support the rejection.

Accordingly, the only substantive reason advanced by the examiner which bears on whether the appealed claims satisfy § 112, first paragraph, written description, is that “a slight increase in the space 98 is not [the] same as ‘pulsation.’” We have carefully considered the record before us with respect to whether one skilled in this art would have recognized in the patent specification a description of the claimed methods which employ “pressure pulsations” as encompassed by appealed claims 16 and 18 through 20. Based on our consideration, we find ourselves in agreement with appellants for the reasons advanced in their reply brief (pages 1-2), that one skilled in the art would have recognized in the original patent specification a disclosure of the so claimed invention. We add the following only for emphasis.

The pertinent part of the original patent specification³ reads as follows:

If the wiper 92 is produced from somewhat flexible material, the wall between filtrate compartments 20 causes, when passing the tip of the wiper [sic - “,”] a slight pressure increase in the space 98, which again causes the bending of the wiper 92 outwards from the wire surface [22], whereby, for example, an accumulation of fibers generated between the tip of the wiper 92 and the wire surface 22 is allowed to loosen and fall into the suspension. [Col. 8, lines 35-43; emphasis ours.]

The numerals in this passage are found in original “FIG. 6” (see col. 7, line 63, to col. 8, line 33). We refer to “FIG. 1” (see col. 3, line 57, to col. 4, line 35) and to “FIG. 4B” (see col. 6, lines 32-53) for a more complete understanding of the apparatus employed in the methods claimed in appealed claims 16 and 18 through 20. With respect to the filtrate compartments 20 (see “FIG. 1”), the patent specification states that “[a] great number of filtrate compartments 20, approximately 30-40, has been arranged about the [inner] rim of the [drum] cylinder” (col. 4, lines 6-8). We observe that this arrangement is depicted in amended “FIG. 6” from which it is apparent that the filtrate compartments 20 are separated

³ Appellants amended their patent specification by parenthetically inserting the term “pulsation” after the word “increase” in the quoted passage in order to “provide proper antecedent basis for terminology in the claims” (principal brief, Paper No. 12; page 5). See *In re Wright*, 343 F.2d 761, 767, 145 USPQ 182, 188 (CCPA 1965), cited by appellants (reply brief, Paper No. 19; page 2).

by walls. The rotational direction **B** of the drum cylinder is also apparent from “FIG. 6” and appellants disclose that “rim speed” can be “approximately 2m/s” (col. 7, lines 43-50).

Based on the disclosure in the original patent specification and drawings taken as a whole, we find that one of ordinary skill in this art would have recognized that the original disclosure in col. 8, lines 35-43, describes an embodiment wherein, if a flexible wiper is employed, a slight pressure increase occurs in space **98** *each time* the forward wall of one of the numerous filtrate compartment **20** passes the tip of wiper **92** as the drum cylinder rotates. Appellants have selected the term “pressure pulsations” to describe these repeated, separate increases, or pulses, in pressure in space **98** and have demonstrated (reply brief, page 2) that the activity described in the quoted passage from the original patent specification can be adequately described by the term “pulsation” when given its ordinary meaning.

Accordingly, we find that the examiner has failed to establish by evidence or reason that, *prima facie*, appealed claims 16 and 18 through 20 do not comply with § 112, first paragraph, written description requirement, because persons skilled in this art would have recognized in the disclosure a description of the methods encompassed by the appealed claims through the use of the term “pressure pulsations.”

Thus, the examiner’s ground of rejection under § 112, first paragraph, written description requirement, and his decision are reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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JOAN ELLIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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TERRY J. OWENS)	
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