

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND AUDENAERT, ALBAN HENNEN,
JOSEF SCHMOLL and HEINZ GOLLER

Appeal No. 1997-1218
Application 08/268,687

HEARD: October 11, 2000

Before JOHN D. SMITH, KRATZ and TIMM, *Administrative Patent Judges*.

JOHN D. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 5 through 7 and 14, all of the claims remaining in the application.

The subject matter on appeal relates to a method for producing milled glass fibers which are distinguished by high apparent densities coupled with correspondingly large average

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lengths. As described in the specification at page 3, lines 24 through 33, glass fibers, obtained at the spinning stage, are cut directly and, without previous drying, are ground to milled glass fibers in a mixer defined as having a Froude number much greater than 1, with the addition of liquids, such as water and then dried. The formula for calculation of the Froude number is given at page 4, line 15 of the specification and appears in appealed claim 14, which representative claim is reproduced below:

14. A process for the manufacture of milled glass fibers having an average length of about 100 to 400 Fm, an apparent density of about 1 to 0.2 g/cm³ and a diameter of 10 to 14 Fm comprising spinning glass fibers into bundles, cooling said bundles with water to form wet bundles, directly cutting such wet bundles, without previous drying, grinding said cut wet bundles to milled glass fibers in a solid mixer with a Froude number Fr of

$$Fr = \frac{R W^2}{g} \gg 1$$

where R = radius of the mixing elements in the mixer,
W = angular velocity of the mixing elements, and
g = gravitational acceleration

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with the addition of a liquid, and then drying to get the milled glass fibers.

No prior art references have been relied upon by the examiner, and no prior art rejections are before us. Instead, the appealed claims stand rejected under 35 U.S.C. § 112, first paragraph, as well as under 35 U.S.C. § 112, second paragraph.

We do not sustain the stated rejections of the appealed claims.

Although the examiner indicates in his answer at page 2 that the stated rejection under 35 U.S.C. § 112, first paragraph, "has little to do with enablement", at page 3 of his answer, the examiner explains that there does not appear to be a "written description of the claim limitation of how to grind fibers with a mixer to produce milled fibers, in the application as filed." (emphasis added). Thus, it appears that the examiner's real concern is with the enablement requirement of 35 U.S.C. § 112, first paragraph, not the written description requirement.

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In appellants' specification at page 4, lines 21 through 26, appellants indicate that glass fibers, without previous drying, "are ground to milled fibers in a high-efficiency mixer, with the addition of, e.g., water."

In reviewing the issues generated by the stated rejection, we initially point out that the burden is on the examiner to

establish a reasonable basis to question the adequacy of an appellant's disclosure. In re Marzocchi, 439 F.2d 220, 223-224, 169 USPQ 367, 370 (CCPA 1971). Further, as instructed by the court in In re Marzocchi, 439 F.2d at 223, 169 USPQ at 369:

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. (emphasis added)

Basically, it is the examiner's position that the mixers described in appellants' specification are incapable of

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providing

sufficient friction to produce a milled fiber. However, the examiner has provided no objective evidence to support his argument. In short, the examiner has provided no reason to doubt the objective truth of the statements contained in appellants' specification referred to above which clearly indicate that high-efficiency mixers are capable and do, in fact grind fibers to produce a milled fiber. Accordingly, the examiner's stated rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, is reversed.

The examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph, is also reversed, essentially for the reasons set forth in appellants' brief. The examiner should be aware that the purpose of the second paragraph of § 112 is to basically ensure with a reasonable degree of particularity an adequate notification of the metes and bounds of what is being claimed. See, In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). As the court stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA

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1971), whether the claims of an application satisfy the requirements of the second paragraph of § 112 depends on a determination as to

whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. (emphasis added)

Basically, the examiner has overlooked these fundamental principles of law in setting forth his stated rejection of the appealed claims herein under 35 U.S.C. § 112, second paragraph. As an example, the examiner contends that in appealed claim 14, line 9, the expression ">>" is indefinite as to its meaning.

However, as appellants point out in their brief at page 6, this term ">>" is a recognized scientific symbol which means "much greater". Indeed, in context, what the claimed invention requires and defines is the use of a solid mixer having a Froude number as defined by the equation in claim 14. The examiner has simply not met his initial burden of

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explaining why one of ordinary skill in the art would not understand what mixers are within or without the scope of the claimed invention. Accordingly, the examiner's stated rejection of the appealed claims under 35 U.S.C. § 112, second paragraph, must also be reversed.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
PETER F. KRATZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CATHERINE TIMM)	
Administrative Patent Judge)	

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