

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULF WEISSENBERGER
and ANDREAS WEISSENBERGER

Appeal No. 97-1224
Application 08/445,866¹

ON BRIEF

Before ABRAMS, STAAB and CRAWFORD, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally
rejecting claims 2, 4, 5, 7-9 and 11-13, which constituted all of

¹ Application for patent filed May 22, 1995. According to appellants,
this application is a continuation of Application 08/151,804, filed November
15, 1993.

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the claims remaining of record in the application. Subsequently, claims 5 and 11 were canceled, leaving claims 2, 4, 7-9, 12 and 13 before us on appeal.

The appellants' invention is directed to an apparatus for cutting cardboard blanks to produce picture mounts having framing cut outs with beveled interior apertures. The subject matter before us on appeal is illustrated by reference to claim 13, which has been reproduced in an appendix to the Amended Brief on Appeal.

THE REJECTION

Claims 2, 4, 7-9, 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which "does not provide support for the invention as now claimed" (Answer, page 2).²

The rejection is explained in the Examiner's Answer and Supplemental Answer.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

²Rejections of claim 11 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(e) became moot when claim 11 was canceled after the final rejection.

OPINION

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that the rejection should not be sustained. Our reasons for this decision follow.

The appellants' invention requires that a cutting blade move in first and second longitudinal directions which are transverse of one another in order to cut out a rectangular opening in a cardboard blank, and that the blade be oblique to the blank to create a beveled edge. The blade must smoothly enter and exit the blank, and must be reoriented with respect to the blank in order to make the transverse cuts. This rejection is based upon the examiner's belief that the specification does not enable one of ordinary skill in the art to make and use the invention, in that no structure is disclosed for performing these two tasks. According to the examiner, "there is no structure set forth for the blade performing a penetration movement obliquely downwardly into the cardboard and a return or retraction movement," or for "raising the blade and reorienting the knife at a new oblique angle to perform a transverse cut" (Answer, pages 2 and 3).

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The appellants' argument which we find to be dispositive of the issue of enablement is that providing structures for accomplishing these tasks would have been within the skill of the artisan, without undue experimentation, and therefore the enablement rejection is not well taken. The appellants have provided evidence in support of this position in the form of several patents.

It is well established case law that the test regarding the enablement requirement of 35 U.S.C. § 112, first paragraph, is whether the disclosure, as filed, is sufficiently complete as to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See ***Atlas Powder Co. v. E.I. du Pont de Nemours & Co.***, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984). In the present case, we appreciate the examiner's discomfiture over the lack of information and illustration regarding the two features to which objection was taken. However, we share the appellants' opinion that the level of skill in this art is such that one of ordinary skill in the art would have been able, without undue experimentation, to fashion mechanisms which would permit the blade

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to enter and exit the blank in a suitable manner, and provide for reorienting the blade with respect to the blank so that second cuts transverse to the first cuts could be accomplished. This conclusion is supported by evidence in the form of the patent to Mood (cutting blade entry and exit) and to Schnetzer (rotatable cutting blades), which were noted by the appellants. As our reviewing court made clear in *In re Gaubert*, 524 F.2d 1222, 1226, 187 USPQ 664, 667 (CCPA 1975), citing *Martin v. Johnson*, 454 F.2d 746, 172 USPQ 391 (CCPA 1972),

[e]nablement is the criterion, and every detail need not be set forth in the written specification if the skill in the art is such that the disclosure enables one to make the invention.

It would appear that the examiner's basis for the rejection is premised on the mistaken belief that only material set forth in the appellants' disclosure is available to demonstrate enablement. As the case law cited above indicates, that belief is in error.

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The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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