

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CLAUS A. BOLZA-SCHUNEMANN

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Appeal No. 97-1437  
Application 08/356,227<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, McQUADE and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed December 19, 1994. According to appellant, the application is a National stage application under 35 U.S.C. § 371 of PCT/DE93/00525, filed June 18, 1993.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 18, the only claim remaining in this application. Claims 1 through 17 have been canceled.

The subject matter on appeal is directed to a drive for a multi-color, web-fed, rotary printing press. As noted on page 2 of appellant's brief, the printing press and drive therefore are "shown in somewhat schematic fashion in Figs. 1 and 2 of the drawings." A copy of claim 18 can be found in Appendix A of appellant's brief.

On page 3 of the examiner's answer (Paper No. 12), it is noted that "[t]he rejection of the claims [sic, claim 18] on prior art as set forth in the final rejection is withdrawn." Accordingly, there are currently no prior art references relied upon by the examiner in rejecting the appealed claim.

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The sole rejection presented for our review is that of claim 18 under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an enabling disclosure,

i.e., which fails to adequately teach one skilled in the art how to make and use the claimed invention. On pages 4 through 11 of the answer, the examiner presents a commentary of why he considers the present disclosure to be "indefinite and insufficient."

Rather than reiterate the details of the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed October 24, 1996) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 11, filed August 5, 1996) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claim 18,

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and to the respective positions articulated by appellant and the examiner. As a consequence of our review we have reached the determination which follows.

Looking to the examiner's rejection of claim 18 on appeal, we observe that the first paragraph of 35 U.S.C. § 112

requires, inter alia, that the specification of a patent (or an application for patent) enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those skilled in the art to make and use the invention without "undue experimentation." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is "undue." Id. at 736-37, 8 USPQ2d at 1404.

Moreover, in rejecting a claim for lack of enablement, it is well settled that the examiner has the initial burden of producing reasons that substantiate the rejection. See In re

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Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Once this is done, the burden shifts to the appellant to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), cert. denied, 416 U.S. 935 (1974); In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

In the case before us, we believe the examiner has not met his burden of advancing acceptable reasons inconsistent with enablement. While we appreciate the examiner's discomfiture over the somewhat schematic illustration of the invention in appellant's drawings, and the paucity of details concerning the various gearing connections and the connections for the drive motors (26) of the individual printing units, we nonetheless do not find that these issues individually or collectively rise to the level of non-enablement.

In this regard, it is our opinion that the level of skill in this art (i.e, the multi-color, web-fed, rotary printing press art) is sufficiently high that the ordinarily skilled

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artisan would have been able to fashion a printing press drive arrangement of the type defined in appellant's claim 18 on appeal based on appellant's disclosure, without the exercise of undue experimentation, and that such printing press drive would be capable of operation in the manner claimed and generally disclosed by appellant. More particularly, we point to, and note our agreement with appellant's arguments on pages 5 through 11 of the brief. Further, in evaluating the level of skill in the pertinent art, we have reviewed the prior art made of record in the application by appellant in several Information Disclosure Statements (Paper Nos. 1½, 5 and 13). Like appellant, we find that these prior art references are particularly relevant to understanding the level of knowledge in the art at the time of filing of the present application and to whether one skilled in the art would have been able to make and use the invention claimed herein without undue experimentation. Note particularly, the patent to Hajek (U.S. Patent No. 5,341,735). The mere fact that material extraneous to the originally filed disclosure, but known to those of ordinary skill in the art at the time of filing of the application, might be relied upon by the artisan in making and using the disclosed printing press drive is not fatal. As the Court made clear in In re Gaubert, 524 F.2d 1222, 1226,

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187 USPQ 664, 667 (CCPA 1975), citing Martin v. Johnson,  
454 F.2d 746, 751, 59 CCPA 769, 775, 172 USPQ 391, 395 (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.

For the above reasons, we will not sustain the  
examiner's rejection of claim 18 under 35 U.S.C. § 112, first  
paragraph, as being directed to a non-enabling disclosure.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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MURRIEL E. CRAWFORD )  
Administrative Patent Judge )

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