

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SCOTT N. PEMBER

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Appeal No. 98-0103  
Application No. 08/248,745<sup>1</sup>

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ON BRIEF

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Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7 and 10 through 22, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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<sup>1</sup> Application for patent filed May 25, 1994.

BACKGROUND

The appellant's invention relates to a license plate cover constructed to absorb laser energy. Claims 1, 10 and 16 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appendix to the appellant's brief, is attached to this decision.

The prior art of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Kluck	3,315,394	April 25, 1967
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The absorptive materials admitted on page 7 of the specification to be well known

Claims 1 through 7 and 10 through 22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure, and failing to provide a written description of the invention.

Claims 1 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kluck.

Claims 10 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kluck in view of the absorptive materials admitted on page 7 of the specification to be well known.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 and § 112 rejections, we make reference to the examiner's answer (Paper No. 18, mailed March 12, 1997), the supplemental examiner's answer (Paper No. 21, mailed June 5, 1997) and the second supplemental examiner's answer (Paper No. 23, mailed July 2, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 17, filed February 12, 1997), reply brief (Paper No. 19, filed May 9, 1997) and supplemental reply brief (Paper No. 22, filed June 24, 1997) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

**The enablement issue**

We do not sustain the rejection of claims 1 through 7 and 10 through 22 under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving

this issue is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done. While the examiner has correctly pointed out that the appellant's disclosure fails to specify the amounts of the absorbers and polymers used in the absorptive material, it is our opinion that this alone is not a sufficient basis, in this case, to meet his burden of proof. This is especially true in view of the fact that the prior art of record (e.g., U.S. Patents 4,948,922 and 5,389,434) establishes that absorptive materials of similar composition were known as of the date of the appellant's application. Thus, we conclude that appellant's disclosure would have enabled a person of ordinary skill to make and use the appellant's invention without undue experimentation.

**The written description issue**

We sustain the rejection of claims 1 through 7 and 16 through 22 under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed, but we do not sustain the rejection of claims 10 through 15 on this ground of rejection.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The language at issue in independent claim 1 is "a substantially flat piece of laser absorptive material constructed to absorb more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material." The language at issue in independent claim 16 is "the substantially flat piece of laser absorptive material absorbs more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material." The recitation in claims 1 and 16 that the laser absorptive material absorbs more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material language is not supported by the disclosure of the application as originally

filed. In our opinion, the disclosure of the application as originally filed would not have reasonably conveyed to the artisan that the disclosed laser absorptive material absorbs more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material. While the appellant's Figure 2 illustrates a graph of a particular absorptive material which may be used in the present invention, that graph would not have reasonably conveyed to an artisan that the particular absorptive material absorbs more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material. This is due to the fact that the graph shown in Figure 2 does not display the total amount of laser energy generated by a laser beam. In this regard, we note that the graph shown in Figure 2 does not display frequencies above 1200 nanometers or below 300 nanometers. Thus the graph shown in Figure 2 is silent as to the total amount of energy from a laser beam that the material absorbs.

The language at issue in dependent claims 6 and 21<sup>2</sup> is "the laser absorptive material is configured to absorb more than 60%

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<sup>2</sup> Claim 6 depends from independent claim 1 and claim 21 depends from independent claim 16.

of laser energy of a laser beam in the 900 to 1000 nanometer range." The language at issue in independent claim 10 is "laser energy of a laser beam of a predetermined wavelength is at least 60% absorbed by the material." The language at issue in dependent claim 15<sup>3</sup> is "the laser absorptive material is configured to absorb more than 90% of laser energy of a laser beam in the 900 to 1000 nanometer range." In our opinion, the disclosure of the application as originally filed would have reasonably conveyed to the artisan that the disclosed laser absorptive material absorbs more than 60%/90% of a predetermined wavelength generated by a laser beam. In this regard, we note that the graph shown in Figure 2 does display frequencies in the 900 to 1000 nanometer range wherein the absorptive material absorbs more than 90% of those wavelengths.

#### **The obviousness issue**

We do not sustain the rejections of claims 1 through 7 and claims 10 through 22 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in

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<sup>3</sup> Claim 15 depends from independent claim 10.

the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Independent claims 1 and 16, recite, inter alia, a license plate cover apparatus comprising a substantially flat piece of laser absorptive material which absorbs more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material. Independent claim 10, recites, inter alia, a license plate cover apparatus comprising a substantially flat piece of laser absorptive material which absorbs more than 60% of a predetermined wavelength generated by a laser beam.

In our opinion, the combined teachings of all the applied prior art (i.e., Kluck and the absorptive materials admitted on page 7 of the specification to be well known) would not have been suggestive of providing a license plate cover apparatus with a substantially flat piece of a laser absorptive material which absorbs either (1) more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material, or (2) more than 60% of a predetermined wavelength generated by a laser beam. Thus, we are constrained to reverse

the examiner's rejection of appealed independent claims 1, 10 and 16, and claims 2 through 7, 11 through 15 and 17 through 22 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, (1) the decision of the examiner to reject claims 1 through 7 and 10 through 22 under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure is reversed, (2) the decision of the examiner to reject claims 1 through 7 and 16 through 22 under 35 U.S.C. § 112, first

paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed is affirmed, (3) the decision of the examiner to reject claims 10 through 15 under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed is reversed, and (4) the decision of the examiner to reject claims 1 through 7 and claims 10 through 22 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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MARK S. SVAT  
FAY, SHARPE, BEALL, FAGAN,  
MINNICH & MCKEE  
1100 SUPERIOR AVENUE, SUITE 700  
CLEVELAND, OH 44114-2518

APPENDIX

1. A license plate cover apparatus for decreasing an effective range of a speed detection device using a laser beam, the license plate cover apparatus comprising:

a substantially flat piece of laser absorptive material constructed to absorb more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material, wherein the laser absorptive material is sized to cover a vehicle license plate; and

an attaching means for attaching the piece of laser absorptive material to a front face of the vehicle license plate.

10. A license plate cover apparatus for decreasing an effective range of a speed detection device using a laser beam, the license plate cover apparatus comprising:

a substantially flat piece of laser absorptive material constructed of a polymer and homogeneously dissolved additives such that substantially all of visible light passes through the material and laser energy of a laser beam of a predetermined wavelength is at least 60% absorbed by the material, wherein the material is sized to cover a vehicle license plate; and

an attaching means for attaching the substantially flat piece of laser absorptive material to a front face of the vehicle license plate.

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16. A license plate cover apparatus for decreasing an effective range of a speed detection device using a laser beam, the license plate cover apparatus comprising:

a substantially flat piece of laser absorptive material, including at least one of rubber compounding material HVA-2, NDBC-D and sebacic acid di-K salt integrated into a polymer based article, wherein the substantially flat piece of laser absorptive material absorbs more than 60% of laser energy generated by a laser beam impinging upon a surface of the laser absorptive material, and is sized to substantially a same size as a vehicle license plate; and

an attaching means for attaching the substantially flat piece of laser absorptive material to a front face of the vehicle license plate.

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APJ NASE

APJ COHEN

APJ FRANKFORT

DECISION: **AFFIRMED-IN-PART**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 05 Jan 98

**FINAL TYPED:**