

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. KOSHAK

Appeal No. 1999-0220
Application No. 08/540,323

HEARD: March 6, 2000

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

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 4, 6 to 12, 21 and 27 to 30, as amended subsequent to the final rejection.¹ These claims constitute all of the claims pending in this application.

We AFFIRM.

¹ While the examiner has approved entry of the amendment after final rejection (Paper No. 12, filed April 15, 1997), we note that this amendment has not been clerically entered.

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BACKGROUND

The appellant's invention relates to an arresting device. A copy of the claims under appeal is set forth in the appendix to the appellant's brief. Claim 1 is representative of the subject matter on appeal and reads as follows:

An arresting device for halting relative motion between a main cylinder and a second cylinder of a hydraulic elevator, wherein the second cylinder moves within the main cylinder, wherein the second cylinder has a perimeter and an external radius of curvature, said arresting device comprising:

two lever arms, each of said two lever arms having an approximately semi-cylindrical braking surface and a pivot point, said approximately semi-cylindrical braking surface having an internal radius of curvature which is smaller than the external radius of curvature of the second cylinder, and said pivot point being offset from said braking surface,

said lever arms having a first position wherein said lever arms are rotated away from the second cylinder with said braking surface out of contact with the perimeter of the second cylinder, and a second position wherein said lever arms press said braking surface against the perimeter of the second cylinder to generate a braking force.

Claims 1 to 4, 6 to 12, 21 and 27 to 30 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a

way as to enable one skilled in the art to make and/or use the invention.

Claims 1 to 4, 6 to 12, 21 and 27 to 30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed February 3, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed November 7, 1997) and reply brief (Paper No. 22, filed April 3, 1998) 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, 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 rejection

We will not sustain the rejection of claims 1 to 4, 6 to 12, 21 and 27 to 30 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. 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).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an 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 being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting

disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

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 as set forth supra is to determine whether the examiner has met the burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

The examiner's rejection (answer, pp. 3-4) states that

[t]he arguments and declaration filed January 10, 1997 and the declaration filed October 21, 1997 indicate that the critical part of the invention is that the braking surface causes deformation of the ram. The originally filed specification states that the ram is not deformed by the braking surface (page 4, lines 17-18 and page 5, line 8). The originally filed specification

appears to be fatally deficient since it incorrectly disclosed the operation of the device.

The appellant argues (brief, pp. 7-14) that the claimed invention is enabled and that deformation of the ram by the braking surfaces is not a critical feature of the claimed invention.

We agree with the appellant that the claimed invention is enabled since the claims under appeal are generic as to whether the braking surfaces cause either (1) elastic deformation of the ram (i.e., the second cylinder); (2) permanent deformation of the ram; or (3) no deformation of the ram. That, being the case, the examiner has not met his burden of proof by advancing acceptable reasoning inconsistent with enablement as to the claimed invention.

Additionally, it is our determination that one of ordinary skill in the art as of the date of the appellant's application would have taken the appellant's disclosure, as a whole, to mean that the braking surfaces cause elastic

deformation of the ram but not permanent deformation of the ram. In this regard, the appellant's specification provides that (1) the general object of the invention is to provide a mechanism for arresting an elevator "without permanently damaging any part of the elevator" (page 3, lines 20-22); (2) another object of the invention is to provide an elevator arrestor that allows the elevator to be usable within a short period of time "with little reset and repair necessary" (page 3, lines 23-25); (3) when actuated, the friction lining material of the braking surfaces contacts the ram with sufficient frictional force to stop the downward motion of the ram "without deformation of the ram" (page 4, lines 16-18); (4) annealed copper is the preferred friction lining material for the braking surfaces since it creates "the greatest braking force with the least amount of damage/deformation of the ram" (page 7, lines 13-18); and (5) in an alternative embodiment, cutting bits or teeth may be fixed to the braking surfaces in place of or in addition to the friction lining material such that braking is accomplished by the teeth biting into the ram wherein that damage to the ram can be repaired by filling and filing the gouges in the ram (page 8, lines 3-9).

From these diverse disclosures, we conclude that one of ordinary skill in the art as of the date of the appellant's application would have taken the appellant's disclosure, as a whole, to mean that the braking surfaces cause elastic deformation (i.e, no permanent damage) of the ram but not permanent deformation (i.e, permanent damage) of the ram.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 4, 6 to 12, 21 and 27 to 30 under 35 U.S.C. § 112, first paragraph, is reversed.

The indefiniteness rejection

We sustain the rejection of claims 1 to 4, 6 to 12, 21 and 27 to 30 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims 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. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, of the

claims on appeal made by the examiner. The examiner's rejection (answer, p. 4) states that

[t]he scope of claims 1-4, 6-12, 21, and 27-30 is not clear. The claims appear to be directed to an arresting device, but the claims recite structure which is outside of the device, i.e. the external radius of curvature of the second cylinder/ram, the detection system, the hydraulic ram, the hydraulic lift, the longitudinal axis of the second cylinder, etc. The claims further define the arresting device relative to the outside structure, i.e. the internal radius of curvature of the braking surface being smaller than the external radius of curvature of the second cylinder/ram, the lever arms being within 15 degrees of being perpendicular to the longitudinal axis of the second cylinder, and the lever arms being perpendicular to the longitudinal axis of the second cylinder. Therefore, it is not clear if solely the arresting device is being relied upon for patentability or if the combination of the arresting device and the outside elements are being relied upon for patentability.

The appellant argues (reply brief, pp. 3-7) that with respect to the claims under appeal there is no indefiniteness as to the scope of the claims. Specifically, the appellant asserts that the claims are directed to an apparatus having as its principal elements a pair of lever arms having semi-cylindrical braking surfaces. The appellant also asserts that the references to elements outside the claimed apparatus (e.g., the second cylinder, the ram) in the claims are

permitted references to unclaimed elements. Thus, the appellant states that the second cylinder/ram is not claimed.

Our review of the claims under appeal leads us to the conclusion that the rejection under 35 U.S.C. § 112, second paragraph, is appropriate, since the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. Our analysis of claim 1 leads us to the following determinations:

(1) in the first paragraph, the main cylinder and a second cylinder of a hydraulic elevator are recited utilizing intended use language; (2) in the second paragraph, the second cylinder is referred to without utilizing intended use language (i.e., use of the phrase "is smaller than" rather than "is intended to be smaller than"); and (3) in the third paragraph, the second cylinder is referred to without utilizing intended use language (i.e., use of the phrase "are rotated" rather than "are capable of being rotated away" and the use of the term "press" rather than "are capable of pressing"). From our review of claim 1 as a whole, it is

unclear to us whether or not the second cylinder is part of the claimed apparatus, thus rendering claim 1 indefinite. Claim 21 (the other independent claim on appeal) is likewise indefinite for reasons comparable to those set forth for claim 1.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 4, 6 to 12, 21 and 27 to 30 under 35 U.S.C. § 112, second paragraph, is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4, 6 to 12, 21 and 27 to 30 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 1 to 4, 6 to 12, 21 and 27 to 30 under 35 U.S.C. § 112, second paragraph, is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

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

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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JAMES J. LEARY
505 W. OLIVE AVENUE, SUITE 330
SUNNYVALE, CA 94086

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