

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTY G. LEON

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Appeal No. 1999-2225  
Application No. 08/815,441

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ON BRIEF

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Before PAK, WARREN, and DELMENDO, Administrative Patent Judges.  
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 4, which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to a vacuuming assembly for wet and dry vacuums. Further details of this appealed subject matter are recited in representative claim 1, the sole independent claim on appeal, reproduced below:

1. An improved vacuuming assembly for wet and dry vacuums and for use inside of a vacuum canister, the assembly comprising the following: a motor chamber in connection with an induction chamber, said induction chamber having an hourglass shape having a middle section, an upper section and a lower section so as to produce a venturi effect, said upper section and said lower section of large diameter than said middle

section, said induction chamber having an upper opening and a lower opening in connection with one another so as to create a channel throughout said induction chamber, a series of apertures in said upper section, an impeller assembly fixed for rotation at a point above said induction chamber and having blades of size and shape parallel to the shape of said upper section so as to create a gap between said upper section and said spinning blades, a motor in connection with said motor chamber and in connection with a drive shaft, said drive shaft in connection with said impeller assembly so that said impeller assembly may induct air upward through said induction chamber and with sufficient speed to force air and water particles through said apertures.

The examiner has not relied on any prior art as evidence of unpatentability.

Claims 1 through 4 on appeal stand rejected under the first paragraph of 35 U.S.C. § 112. (Examiner's answer, page 3; Office action of July 2, 1998, paper 4, pages 2-3.)

We reverse this rejection.

As a preliminary matter, we note that the examiner does not identify the specific requirement (i.e., best mode, enablement, or written description) of the statutory provision being relied upon to reject the appealed claims. Nevertheless, we presume that the examiner is relying on the enablement requirement of the statutory provision because the basic thrust of the rejection is based on the allegation that the claimed invention is inoperative. (Examiner's answer, pages 3-5; Office action of July 2, 1998, pages 2-3.) In this regard, it appears to us that

the appellants have responded to the examiner's rejection with the same presumption. (Appeal brief, page 6.)

In the final Office action, the examiner held (id. at page 2):

2. The specification is objected to under 37 CFR 1.71 as being inoperative. The device would be incapable of performing either the presumed operation of vacuuming material from a work surface or of cooperating with a canister vacuum cleaner because neither an inlet nor outlet is disclosed in the outer canister of the assembly. Therefore, the device is incapable of drawing air-entrained liquid or dust into the outer housing 40, and air will merely circulate through the venturi and out through the perforations to cycle again through the inlet of the venturi.

3. The specification is further objected to for various reasons listed in the following. It is not seen what the function of the lower and middle portions of the venturi member is supposed to be. Since the inlet to the venturi is solely disclosed as placed low in the container, should any liquid or dust be somehow present in the housing, the nearness of the inlet of the fan to the dirt/liquid at the bottom would tend to pick up more dirt/liquid in the air stream than if the middle and lower sections were not present! The statement that the venturi assembly is "supported" by horn 56 is not seen to have any basis, as no means of supportive contact is described or shown between 12 and 56, and any but point contact would obstruct the inlet of the venturi. How 35 may be considered to be a "valve" to cut off flow through the venturi is not understood, as no structure of an obstructing member in the throat is set forth that would not nearly, if not completely block off the throat at all positions of the float, assuming that the double horizontal line is a solid member.

The examiner's position is without merit.

It is important to emphasize that the initial burden of

establishing a prima facie case of non-enablement under the first paragraph of 35 U.S.C. § 112 rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The predecessor of our reviewing court has stated as follows:

[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 Section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Thus, it is only upon the advancement of acceptable reasoning on the part of the examiner that the burden of proving enablement shifts to the appellants. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). Here, the examiner has not met the threshold initial burden of proof.

"Although not explicitly stated in section 112, to be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'"<sup>1</sup> In re Wright, 999

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<sup>1</sup> The question of whether making and using the invention would have required "undue experimentation" depends on several underlying factual inquiries including: (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4)

F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). As long as "undue experimentation" is not involved, a specification would comply with the enablement requirement of the statute even if a reasonable amount of routine experimentation is necessary to practice the claimed invention. Enzo Biochem Inc. v. Calgene, 188 F.3d 1362, 1371, 52 USPQ2d 1129, 1135 (Fed. Cir. 1999). Even "a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed..." Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

Here, the examiner has not undertaken the analytic framework, as set out in Wands, for determining whether one skilled in the relevant art would be subject to "undue experimentation" in making and using the claimed invention. For this reason alone, the examiner has failed to carry the initial burden of proof.

The examiner fails to understand that a rejection under 35 U.S.C. § 112, first paragraph, must take into account various

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the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. In re Wands, 858 F.2d 731, 735, 736-37, 8 USPQ2d 1400, 1402, 1404 (Fed. Cir. 1988).

factors such as the nature of the invention, the predictability of the art, and the relative skill of persons in the art. For example, the examiner argues that the claimed invention is inoperative because an inlet or outlet is not disclosed in the specification. However, the examiner has not established that any undue experimentation would be involved in providing an operative canister for the claimed vacuum assembly. While the examiner would have us believe that any knowledge in the prior art needed to establish enablement must be recited in the specification (Examiner's answer, pages 3-4), this is not the law. Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987)("A patent need not teach, and preferably omits, what is well known in the art."); Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 664, 231 USPQ 649, 653 (Fed. Cir. 1986)("A patent applicant need not include in the specification that which is already known to an available to the public."); Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986)("A patent need not teach, and preferably omits, what is well known in the art.").

Regarding the examiner's reasoning as set forth in paragraph 3 of the final Office action, we agree with the appellants' analysis as set forth in the appeal brief (pages 8-9).

Appeal No. 1999-2225  
Application No. 08/815,441

The decision of the examiner to reject appealed claims 1 through 4 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

CHUNG K. PAK	)	
Administrative Patent Judge	)	
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	)	BOARD OF
	)	PATENT
CHARLES F. WARREN	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
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ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

rhd/  
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