

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANUEL TORRES

Appeal No. 1999-2726
Application No. 09/020,635¹

ON BRIEF

Before CALVERT, MCQUADE, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 9, 1998. According to appellant this application is a continuation-in-part of Application No. 08/714,628, filed September 16, 1996, now U.S. patent 5,716,040.

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This is an appeal from the final rejection of claims 1 to 9, all the claims in the application.

The claims on appeal are drawn to a safety vehicle lift, and are reproduced in the appendix of appellant's brief.

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Claims 1 to 9 stand finally rejected on the grounds that:

(1) They contain subject matter which is not described in the specification in such terms as to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph;

(2) They are not in compliance with 35 U.S.C. § 112, second paragraph.

Rejection (2)

Considering first the question of compliance with the second paragraph of § 112, the examiner states on page 3 of the final rejection (Paper No. 6) that:

The phrase "opposite ends secured to the axially shiftable ends of the crosslinkage" in claim 1, line 23 appears to be inaccurate since only one end of the cross brace is apparently connected to the crosslinkage. Similarly, the phrase "the opposite ends of the cross brace being coupled to guide rollers" in claim 1, line 26 appears to be inaccurate since only one end of the cross brace is apparently connected to the guide rollers.

We do not consider this rejection to be well taken. A claim complies with the second paragraph of § 112 if its language, when read by one of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject

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matter are distinct. In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975). In the present case, as appellant points out on page 9 of the brief, cross brace 49 is disclosed on pages 5 and 6 of the specification as having "opposite ends" 52 which are secured to axially shiftable ends of the cross linkage elements, and guide roller supports are attached to each end of the cross brace. The correspondence between this disclosure and the claim language in question is such that we consider that, when read by one of ordinary skill in light of this disclosure, claim 1 would be sufficiently precise to comply with the second paragraph of § 112.

Accordingly, rejection (2) will not be sustained.

Rejection (1)

It is fundamental that "[i]n order to satisfy the enablement requirement of § 112, paragraph 1, the specification must enable one of ordinary skill in the art to practice the *claimed* invention without undue experimentation."

National Recovery Technologies Inc. v. Magnetic Separation Sys. Inc., 166 F.3d 1190, 1196, 49 USPQ2d 1671, 1676 (Fed. Cir. 1999). In the present case, the examiner specifies a

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number of inconsistencies between drawing figures, unclear depictions of parts in the drawings, etc., as items forming the basis for rejection (1). However, none of these reasons concern the claimed subject matter, and we consider that one of ordinary skill would not have to engage in undue experimentation in order to make and use what is recited in the appealed claims.

Rejection (1) therefore will not be sustained.

This is not to say, however, that we do not consider that the items enumerated by the examiner do not have merit and need not be corrected. For example, since the tongue and groove structure 43, 44 shown in Fig. 8 is an alternative to the hinge 15 shown in Fig. 2 (as disclosed on page 4, lines 3 to 5), Fig. 8 should be described on page 3 as showing a second embodiment of the invention. However, these items constitute a basis for objecting to the specification and/or drawings, rather than for rejecting the claims under § 112. Cf. Ex parte Milner, 21 USPQ 589, 590 (Bd. Apps. 1933).

An additional potential basis for objection which we have noted concerns Fig. 7. In that Figure, the element which extends from pivot 32 to end 38 is shown as being nearer to

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edge 14 of the base 12 than the element which extends from pivot 34 to end 36, while in Figs. 1 and 2 the position of these two elements is reversed. Also, on page 5, last three lines, it is stated that the ends 52 of cross brace 49 "are secured to the axially shiftable ends 36[,] 38 of the cross linkage elements 28 within the lower portion 22," but although only ends 36 are "within the lower portion 22," Fig. 7 seems to show ends 52 of the cross brace 49 as being connected only to ends 38.

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Conclusion

The examiner's decision to reject claims 1 to 9 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

SLD

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Richard L. Huff
Law Offices of Richard L. Huff
19304 Olney Mill Road
Olney, MD 20832

Shereece

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APJ CALVERT

APJ NASE

APJ MCQUDE

REVERSED

Prepared: May 31, 2000