

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLAUS-OTTO GRIEBEL
and JUERGEN THAMS

Appeal No. 2002-1593
Application 09/091,020

HEARD: January 9, 2003

Before COHEN, STAAB, and MCQUADE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Claus-Otto Griebel et al. appeal from the final rejection (Paper No. 20) of claims 7 through 19, all of the claims pending in the application.

THE INVENTION

The invention relates to a peripheral cam for a valve-controlled internal combustion engine (claims 7 through 15), and

to a method of using same (claim 16 and presumably claims 17 through 19¹). Representative claim 7 reads as follows:²

7. Peripheral cam for a valve-controlled internal-combustion engine, comprising
an opening flank with a cam contour configured to generate at least one positive acceleration course in a valve opening area, with an opening acceleration course having first and second acceleration curves with acceleration peak values of different amounts spaced by way of an intermediate curve of positive acceleration lower than the first and second acceleration curves, wherein the first acceleration curve has a peak value of approximately 40 to 60% of a peak value of the adjacent second acceleration curve set at 100%,
an ascending curve section of the first acceleration curve and a descending curve section of the second acceleration curve form at least one projected intersection respectively with a zero acceleration line, and
a distance between respective connection points of the descending curve section of the first acceleration curve and of the ascending curve section of the second acceleration curve with the intermediate curve corresponding to an amount of about 10 to 15% of the distance of the at least one projected intersections at 100%.

¹ The preambles of claims 17 through 19 ("Peripheral cam") are inconsistent with the method recited in parent claim 16. Also, claim 11 is redundant, and the limitations in claims 7, 8, 10, 13, 15, 16 and 18 relating to the projected intersections are somewhat garbled and hard to follow. Each of these informalities is deserving of correction in the event of further prosecution before the examiner.

² Independent method claim 16 defines the peripheral cam with limitations essentially similar to, if not identical with, those in claim 7 and further recites the step of "using the peripheral cam as a cam for actuating one of an inlet valve and an outlet valve."

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THE REJECTION

Claims 7 through 19 stand rejected as being based on a specification which fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

Claims 7 through 19 also stand rejected as being based on a specification which fails to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.³

Attention is directed to the appellants' main and reply briefs (Paper Nos. 25½ and 28) and to the examiner's final rejection and answer (Paper Nos. 20 and 27) for the respective positions of the appellants and the examiner with regard to the merits of the rejection.

DISCUSSION

I. Petitionable matters

The appellants' briefs and examiner's answer touch upon various objections made by the examiner during the prosecution of the application to the drawings and to certain amendments filed by the appellants. Since none of these objections is directly connected with the merits of issues involving the above

³ The written description and enablement requirements of 35 U.S.C. § 112, first paragraph, are separate and distinct. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

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rejections of claims, they are reviewable by petition to the Commissioner rather than by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971)) and will not be further addressed in this decision.

II. The merits of the appealed rejections

Both the written description and enablement rejections rest on alleged deficiencies in the appellants' disclosure, and particularly in the drawing figure, with respect to the peripheral cam elements set forth in claims 7 through 19 (see pages 4 and 5 in the final rejection). Although the drawing figure does not show these elements as seemingly required by 37 CFR § 1.83, the appellants' disclosure as a whole does not on the record justify the examiner's written description and enablement concerns.

The test for compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors 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. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In determining that the appellants' disclosure lacks written descriptive support for the cam elements recited in the appealed claims, the examiner asserts that "on the filing date, the entire specification merely describes and the single figure merely shows a diagram of the acceleration course" (final rejection, page 4). Although the appellants' drawing figure does not illustrate the peripheral cam, the originally filed specification, including the original claims, does provide literal support for the cam limitations now contained in claims 7 through 19.⁴ Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that the appellants had possession at that time of the subject matter now recited in the appealed claims.

Accordingly, we shall not sustain the 35 U.S.C. § 112, first paragraph (written description), rejection of claims 7 through 19.

⁴ The viewpoints expressed in the briefs and answer evidence a dispute between the appellants and the examiner as to whether the original disclosure includes the unamended specification filed June 8, 1998 or the amended substitute specification filed concurrently therewith. Although this matter is deserving of resolution upon return of the application to the technology center, it is of no moment in this appeal since both the unamended and amended versions of the specification provide the requisite support for the subject matter set forth in claims 7 through 19.

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Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' 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 appellants' invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling the enablement of the appellants' disclosure into question, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The appellants' disclosure describes the claimed peripheral cam in terms of the valve acceleration course associated therewith. The examiner has failed to advance any factual support or cogent line of reasoning for the proposition that this disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would not have enabled a person of such skill to make and use the invention recited in the appealed claims without undue experimentation.

Therefore, we shall not sustain the standing 35 U.S.C. § 112, first paragraph (enablement), rejection of claims 7 through 19.

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As the examiner has failed to establish a prima facie case of lack of written description or enablement, it is not necessary to delve into the merits of the 37 CFR § 1.132 Declaration of Juergen Thams made of record by the appellants to rebut the examiner's position.⁵

SUMMARY

The decision of the examiner to reject claims 7 through 19 under 35 U.S.C. § 112, first paragraph, is reversed.

⁵ It should be noted, however, that the foreign language exhibits appended to the declaration without English translations carry little, if any, probative value before the USPTO.

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REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	
Administrative Patent Judge)	INTERFERENCES
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JOHN P. MCQUADE)	
Administrative Patent Judge)	

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