Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANG-HYUN HAN

Appeal No. 2004-0030
Application No. 09/337,492

HEARD: April 27, 2004

Before BARRETT, LEVY, and BLANKENSHIP, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 6, 7, 10, 11, 17, 18, 24, 26 and 29.

BACKGROUND

Appellants' invention relates to a semi-elastic switch covering device. An understanding of the invention can be

derived from a reading of exemplary claim 6, which is reproduced as follows:

> 6. The control panel of claim 5, said latch on said plurality of members being disposed a first distance from a surface of said main board, said first distance being adjustable by moving said plurality of members through said frame and deforming said plurality of flexible supports.

No prior art references of record have been relied upon by the examiner in rejecting the appealed claims.

Claims 6, 7, 10, 11, 17, 18, 24, 26 and 29 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 27, mailed April 16, 2003) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 25, filed August 9, 2002) and reply brief (Paper No. 28, filed June 16, 2003) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of enablement relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellant.

The examiner's position (answer, page 4) is that:

> In regard to claims 6, 7, 10, 11, 17 and 18, the first distance is not seen to be adjustable since there is no mechanism for maintaining an adjusted distance. Contrary to claims 6, 10 and 17, the distance between the main board and the latch is not affected by movement of the members in reference to the frame. Contrary to claims 7, 11 and 18, the first distance cannot be adjusted. Contrary to claims 24, 26 and 29, the present device does not comprise structure to maintain a gap H" between the frame and the latch member.

Appellant asserts (brief, pages 15-17) that flexible supports 15 maintain the desired spacing between components of the device. It is argued that H" is adjustable because flexible supports 15

permit movement of latching member 5 through frame 11', and that adjustment of H" maintains the second and third distances H and H' at desired intervals. It is additionally argued that flexible supports 15 provide a structure for maintaining a gap between frame 11 and latching member 5.

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 nonenablement 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.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in

the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement[1] against evidence that the specification is not enabling.

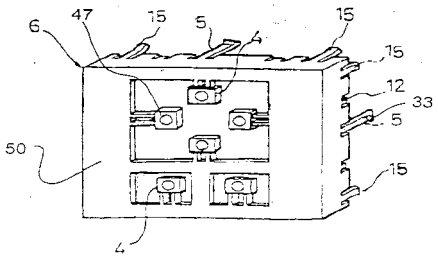
Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth, supra, is to determine whether the examiner has met his/her burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done. As set forth in the specification (page 2) the invention relates to a control apparatus in which malfunction is prevented by locating a gap-maintaining member between a control

[1] The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

knob and a tactile switch so as to maintain a constant gap between the control knob and the tactile switch.

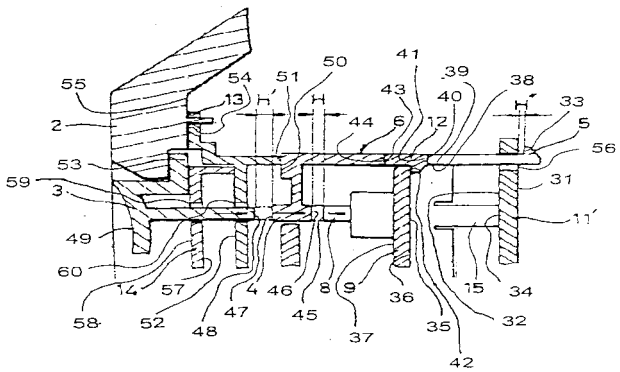
This is best seen in renumbered figure 2 (original figure 3).

FIG. 3



As shown in the figure, the gap maintaining member is illustrated as semi-elastic switch cover 6, which includes switch covers 4. As stated in the specification (page 8), switch cover 6 is braced by a combination of flexible supports 15 and latching members 5. As illustrated in renumbered figure 1,

FIG. 2



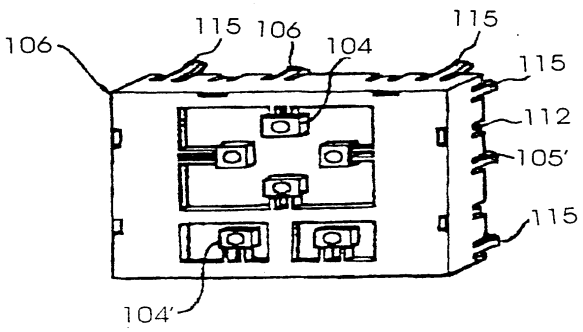
the latching members 5 are inserted through holes 56 in frame 11'. Surface 33 of latching members 5 engage surface 31 of frame 11' (as shown in renumbered figure 1).

As further described on page 8 of the specification, the engagement of latching member 5 with surface 31 of frame 11', prevents the semi-elastic switch structure from moving away from frame 11'. In addition (id.) the specification discloses (page 8) that "[f]lexible supports 15 (only one is shown) brace the switch structure 6 in place by abutting surface 34 of flexible supports 15 against surface 32 of frame 11'. Once switch structure 6 is braced, an interval H is formed between surface 46 of switch cover 4 and surface 45 of pressure switch 8." As shown in renumbered figure 1, opposite sides of switch cover 4 create spacings H and H' between surface 45 of switch 8 and surface 47 of push-button 3. As is clear from renumbered figures 1 and 2, we find that when latch 15 is moved horizontally in either a forward or backward direction, spacing H" is adjusted. Because 4, 5, 6, and 15 form a single unit, movement of latch 5 will cause the entire switch cover 6 to move, resulting in a change in the spacings H and H'. We find this to be supported by the

language set forth on page 9 of the specification, which discloses that "[s]hould there be a slight discrepancy in the intended spacing of intervals H and H' after initial assembly, they can be corrected by adjusting the space between surface 33 of latching members 5 and surface 31 of frame 11. This additional interval is labeled H" in Fig. 1. This is possible because the flexibility of the flexible supports 15 allows for the position of switch structure 6 to be adjusted. As such, the intervals H and H' can be precisely controlled by altering the surplus interval H". The ability to adjust intervals H and H' helps prevent the malfunction of pressure switch 8."

In addition, the specification discloses a second embodiment of the invention. As shown in renumbered figure 6 (originaly filed figure 7):

FIG. 7



The specification discloses (pages 12 and 13) that:

> Furthermore, a plurality of tactile switches
>
> 108 is disposed on the main board 109, which is fixed onto the gap-maintaining member 106 at the portion 112 (circled in Fig. 5) of the arrangement. A plurality of latch members 105 and 105', a plurality of flexible supporters 115, and a plurality of board holders (snap-type) 112 are formed on the gap-maintaining member 106. The latch members 105 and 105' are inserted into a latch holder (not shown) in order to fix the gap-maintaining member 106 to frame 111. Flexible supporters 115 are used for supporting the gap-maintaining member 106 in connective relationship to frame 111.. . . As seen in Fig. 7, latch member 105 of gap-maintaining member 106 is inserted into a latch holder 111a of frame 111 so as to maintain a gap H" between an interior surface of latch member 105 and an opposing surface of frame 111. Elastic tactile member 104 of gap-maintaining member 106 maintains a gap H' with a protrusion 103a of control knob 103, and also maintains a gap H with the tactile switch 108 of main board 109.

Turning to the examiner's assertions that the first distance is not seen to be adjustable, we find that the first distance H" is adjustable because flexible members 15 constitute a mechanism for maintaining an adjusted distance, when latch 105 is moved.

With respect to the examiner's second assertion that the distance between the main board and the latch is not affected by movement of the members in reference to the frame, we find that the distance between the main board 9 and the latch is affected by movement of the latch with respect to frame 11'. As is clear from our description of the device, supra, as latch 5 is adjusted

with respect to frame 11', the distance between board 9 and the surface 33 of latch 5 changes.

With respect to the third assertion presented by the examiner, that the first distance cannot be adjusted, we find that first distance H" is adjusted by moving latch 5 in either a forward or backward direction.

Turning to the fourth assertion made by the examiner, that the device does not contain structure to maintain a gap H" between the frame and the latch member, we find that as disclosed on page 9 of the specification, that flexible members 15 allow the position of switch cover 6 to be adjusted. As such, the intervals H and H' can be adjusted by altering the surplus interval H". From this disclosure of the specification, we find that adjustments to gap H" is maintained by flexible members 15.

From all of the above, we find enablement for the claim language asserted to be non-enabled by the examiner. We are not persuaded by the examiner's assertion (answer, page 5) that "[s]upports 15, being flexible, merely urge frame 11' away from the board 9 and toward the latch member 5....[B]ecause the supports 15 are flexible, the first distance H" cannot be maintained; due to the urging of the supports, upon completion of the assembly, frame 11' will be pushed against the latching member 5 and distance H" will always be 0." From our review of the specification, we agree with appellant (reply brief, page 5) that:

> The attention of the Board is directed to page 8, lines 4-7 of the specification, which describes that the flexible supports 15 merely 'brace' the switch structure 6 in place by abutting surface 34 of supports 15 against surface 32 of frame 11'. In this context, 'bracing' does not indicate 'urging' as asserted by the Examiner. Rather, the term 'bracing' indicates a supporting function, as evidenced by Webster's New Collegiate Dictionary (1977), page 132, which defines 'bracing' as 'to furnish or support with a brace' and 'to give strength'. Furthermore, as stated in the specification, element 15 is described as 'flexible supports'. Thus, the supports 15 are 'flexible' as defined in the specification, which is to say that they are constructed designed and arranged (see renumbered Figure 1 and the corresponding description in the specification) to be movable.

From the examiner's incorrect characterization of flexible members 15 "urging" the frame 11' against the latch 5, we find that the examiner has misconstrued the disclosure described in appellant's specification.

From all of the above, we find that the examiner has failed to establish a prima facie case of non-enablement. Accordingly, the rejection of claims 6, 7, 10, 11, 17, 18, 24, 26 and 29 under 35 U.S.C. § 112, first paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6, 7, 10, 11, 17, 18, 24, 26 and 29 under 35 U.S.C. § 112, first paragraph is reversed.

REVERSED

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