

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JONATHAN P. COTTER

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Appeal No. 2004-0051  
Application No. 09/746,795

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ON BRIEF

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Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.  
WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the primary examiner's final rejection of claim 18.<sup>1</sup> The remaining claims pending in this application are claims 1-10 and 17, which stand allowed by the

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<sup>1</sup>Appellant submitted an amendment subsequent to the final rejection which cancelled nonelected claims 11-16, and this amendment was indicated by the examiner as entered upon a notice of appeal. See the amendment dated Oct. 9, 2002, Paper No. 6, entered as per the Advisory Action dated Oct. 16, 2002, Paper No. 7. However, we note that, contrary to the examiner's notation on the amendment and the Advisory Action, the amendment of Paper No. 6 has not been physically entered into the file record. Upon return of this application to the jurisdiction of the examiner, the examiner should ensure that the record is correct and this amendment entered.

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examiner (Brief, page 2; Answer, page 2, ¶(3)). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a tool 10 for installing retaining rings 12 in different size cylinder bodies 14, which tool has a handle lever 18 carrying a gripper 20 that engages a groove 34 in the cylinder body 14, a relatively movable compressing lever 22 with an engaging surface 110 for compressing the retaining ring 12 and a pair of links 24 pivotally connected by pins 144, 150 to the levers to slidably displace and pivot the compressing lever 22 relative to the handle lever 18 (Brief, page 5). A copy of the sole claim on appeal is attached as an Appendix to this decision.

Claim 18 stands 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 reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Answer, page 3. We *affirm* the examiner's rejection essentially for the reasons stated in the Answer and those reasons set forth below.

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### OPINION

The examiner finds that this application was filed on Dec. 22, 2000, and appellant submitted an amendment dated July 30, 2002 (Paper No. 4) which added claim 18, now on appeal (Answer, page 3). The examiner finds that newly presented claim 18 for the first time recites that the slot 84 can be located in either the handle lever or the compressing lever (*id.*). The examiner concludes that this newly claimed subject matter is "new matter" as the descriptive portion of the specification makes no suggestion whatsoever that the "slot" can be located in either the handle lever or the compressing lever, only providing support for the slot being located in the handle lever (*id.*). We agree.

Appellant argues that claim 18 is "simply broad enough to literally encompass or cover an installation tool having a slot in either one of the levers," in short reading on a tool in which the slot is in the compression lever and the levers are connected by a pin in the slot and carried by the handle lever (Brief, page 11). Appellant argues that claim 18 is broad enough to cover a "simple reversal" of the locations of the slot 84 and the pin 120 of the preferred embodiment (Brief, page 12; Reply Brief, page 2). Appellant also argues that the written description emphasizes that it is the "relative movement" of the levers in conjunction with the

slot and pin and a link pivotally connecting the lever to advance the ring engaging surface and compress the retaining ring that constitutes the "basic approach" of the inventor's method and tool, not the location of the slot (Brief, pages 13-14; Reply Brief, page 2). Finally, appellant cites *In re Vickers* and *Gentry Gallery v. Berkline Corp.*<sup>2</sup>, arguing that the slot 84 in this appeal is not an essential element of the invention (Reply Brief, pages 2-4).<sup>3</sup>

Appellant's arguments are not persuasive. Contrary to appellant's interpretation of claim 18 as a broad generic claim, we determine that claim 18 specifically recite two species, one with the slot in the handle lever and one with the slot in the compressing lever. Since the "slot in the compressing lever" species is not disclosed in the original specification or claims, there is no compliance with the written description requirement of

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<sup>2</sup>141 F.2d 522, 61 USPQ 122 (CCPA 1944) and 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998), respectively.

<sup>3</sup>Many of appellant's arguments in the Brief are directed to the issue of enablement (e.g., see pages 12 and 16). We need not respond to these arguments other than to note that the examiner's rejection is solely directed to the written description requirement of section 112, first paragraph, and the enablement requirement is separate and distinct from the written description requirement. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)..

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the first paragraph of section 112. See *Ex parte Ohshiro*, 14 USPQ2d 1750, 1752 (Bd. Pat. App. & Int. 1990).

To satisfy the written description requirement, one skilled in the art, reading the original disclosure, must "immediately discern the limitation at issue" in the claims. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 185, 1857 (Fed. Cir. 1994). "It is 'not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure....Rather, it is a question whether the application necessarily discloses that particular device.'" *Martin v. Mayer*, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987), quoting *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963). The written description requirement is not satisfied if the disclosure would lead one to speculate as to "modifications that the inventor might have envisioned, but failed to disclose." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Contrary to appellant's discussion of *Gentry Gallery* (Reply Brief, pages 3-4), there is no new "essential element" test mandating an inquiry into what an inventor considers to be essential to his invention. See *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323, 62 USPQ2d 1846, 1850-51 (Fed. Cir. 2002). The Court in *Gentry* "applied and

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merely expounded upon the unremarkable proposition that a broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope." *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc., supra.*

For the foregoing reasons and those stated in the Answer, we determine that the originally filed disclosure does not support the two species required by claim 18 on appeal. Accordingly, we affirm the examiner's rejection of claim 18 for failure to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112.

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

**AFFIRMED**

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

TAW/jrg

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**APPENDIX**

18. A retaining ring installation tool, comprising;

a handle lever having a first end and a second end;

a gripper carried by the handle lever and engageable with a sidewall of a cylinder to locate and anchor the tool relative to the cylinder;

a compressing lever, a slot in one of the levers, the compressing lever connected to the handle lever for movement between first and second positions with a portion slidably and pivotally connected in the slot, the compressing lever having a ring engaging surface for releasably receiving a portion of a retaining ring; and

a link pivotally connected to the handle lever and operably connecting the compressing lever to the handle lever whereby when the compressing lever is moved relative to the handle lever from its first position toward its second position, the link slidably displaces the compressing lever in the slot to advance the ring engaging surface and compress the retaining ring.