

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. ZEH and JACOB D. LEVINE

Appeal No. 2004-0554
Application No. 09/612,394

ON BRIEF

Before FLEMING, BAHR, and BLANKENSHIP, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 21-40, all the claims pending in the instant application. Claims 1-20 have been canceled.

Invention

The invention relates to a shocking or testing apparatus for computer disc drives. See page 1 of Appellants' specification. Figure 1 is a block diagram of a test system 100 configured to test disc drive 102. The test system 100 includes drive tester 104 and shocker 106. Shocker 106 includes hydraulic valve 108,

Appeal No. 2004-0554
Application No. 09/612,394

valve actuator 110 and hydraulic actuator 112. See page 4 of Appellants' specification. Figures 2 and 3 are a pictorial representation of a portion of system 100, and a representation showing valve 108 in partial cross section. Figures 2 and 3 show that valve actuator 110 includes translational position generator 120, lever 122 and fulcrum assembly 138. Figures 2 and 3 also show that valve 108 includes a valve housing 124 and a valve spool 126 slidably movable within housing 124. See page 6 of Appellants' specification. When channel 204 is aligned with the inlet and outlet ports, hydraulic fluid under pressure is passed from inlet end 114 to outlet end 116 which provides hydraulic fluid under pressure to hydraulic actuator 112 which, in turn, imparts a physical shock on disc drive 102. See page 7 of Appellants' specification.

Independent claim 21 is representative of Appellants' claimed invention and is reproduced as follows:

21. An impact tester for impact testing a test specimen, comprising:

a fluid line containing a pressurized fluid;

a valve, comprising an open position and a closed position, in the fluid line defining an upstream portion of the fluid line containing the pressurized fluid and a downstream portion of the fluid line isolated from the pressurized fluid in the closed position of the valve and in fluid communication with the pressurized fluid in the open position of the valve;

Appeal No. 2004-0554
Application No. 09/612,394

an actuator momentarily moving the valve to the open position independently of an upstream portion pressurized fluid pressure, admitting a burst of pressurized fluid into the downstream portion of the fluid line; and

an impact device accelerated by the burst of pressurized fluid to impact against the test specimen.

References

The Examiner has not relied on any references.

Rejection at Issue

Claims 1-40 stand rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.¹

Throughout our opinion, we will make references to the brief and the answer for the respective details thereof.²

OPINION

With full consideration being given the subject matter on appeal, the Examiner's rejection and the arguments of Appellants

¹ The Examiner has withdrawn the art rejections in order to expedite the appeal. See page 2 of the Examiner's answer.

² Appellants filed an appeal brief on July 17, 2003. Appellants filed a reply brief on September 24, 2003. The Examiner mailed out an Office communication on October 6, 2003, stating that the reply has been entered.

Appeal No. 2004-0554
Application No. 09/612,394

and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 21-40 under 35 U.S.C. § 112, first paragraph.

The Examiner states that the ground for this rejection is that claims 21 and 31 have been amended so that an actuator momentarily moves "the valve to the open position independently of an upstream portion pressurized fluid pressure." The Examiner argues that there is no correlation between the dependence or independence of the valve movement with respect to an upstream portion pressurized fluid pressure disclosed in the application as filed. See page 3 of the Examiner's answer.

The first paragraph of 35 U.S.C. § 112 requires that "the specification shall contain the written description of the invention[.]" 35 U.S.C. § 112, ¶ 1 (1994). This requires the Appellant to "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." **Vas-Cath, Inc. v. Mahurkar**, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Thus, the inquiry 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

Appeal No. 2004-0554
Application No. 09/612,394

disclosure. . . . Rather, it is a question whether the application necessarily discloses that particular device.'"

Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997), citing **Martin v. Mayer**, 823 F.2d 500, 504, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987) (quoting **Jepson v. Coleman**, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)).

An Applicant complies with the written description requirement "by describing *the invention*, with all its claimed limitations[.]" **Id.** "One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." **Id.** "[T]he written description must include all of the limitations . . . or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed." **Hyatt v. Boone**, 146 F.3d 1348, 1354-1355, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998).

Appellants argue that Figures 1, 2 and 3, and the description in connection with these Figures, clearly show valve 108 operable solely under the control of actuator 110 to allow or prevent the flow of pressurized fluid into fluid outlet 116 from

inlet 114. Appellants argue that valve actuator 110 is neither connected directly or indirectly with the fluid line. See page 4 of Appellants' brief. Appellants further argue that as can be seen in Figures 2 and 3, to open and close valve 108, actuator 110 includes a translational movement generator 120, which includes a pair of solenoids 128 and 130, and a lever 122, pivotally connected to fulcrum 138, that has a first end 136 coupled to valve spool 126 and a second end 134 coupled to translational movement generator 120. Appellants argue that these components of the actuator, that cause valve movement, are clearly separate from the fluid line and therefore independent from the upstream fluid pressure in the fluid line. See page 2 of Appellants' reply brief.

We agree with Appellants that Figures 2 and 3 show that the pair of solenoids 128 and 130 along with the other components of the actuator causes the valve movement. However, we must look to Appellants' specification to determine how the solenoids operate. On page 5 of Appellants' specification, the specification discloses that valve actuator 110 is a hydraulic piston, an air piston, an electrical solenoid, or some other suitable mechanical, pneumatic or electro-mechanical device for creating translational movement of the spool in valve 108. Thus,

Appeal No. 2004-0554
Application No. 09/612,394

Appellants' claims are broad enough in scope to cover several of these above embodiments. For the embodiments in which the solenoids would be an air piston or an electric solenoid, we find that these components would provide an actuator for momentarily moving the valve to the open position independently of an upstream portion pressurized fluid pressure. Therefore, for these embodiments we find that the specification does reasonably convey to one skilled in the art, that the inventors at the time the application was filed, had possession of the claimed invention.

Appeal No. 2004-0554
Application No. 09/612,394

In view of the foregoing, we have not sustained the Examiner's rejection of claims 21-40 under 35 U.S.C. § 112, first paragraph.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JENNIFER D. BAHR)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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Appeal No. 2004-0554
Application No. 09/612,394

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