

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** DAVID S. BREED, WENDELL C. JOHNSON,  
and WILBUR E. DUVALL

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Appeal No. 2004-1433  
Application No. 09/639,303

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ON BRIEF

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Before FLEMING, GROSS, and LEVY, **Administrative Patent Judges**.  
GROSS, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1 through 5, 8, 10 through 13, 16, 28 through 32, and 35 through 39. Claims 6, 7, 9, 14, 15, 17 through 27, and 40 through 53 have been withdrawn from consideration. In the Answer at page 5, the examiner withdraws the anticipation rejection of claims 1 through 5, 8, 10 through 13, 16, 28 through 32, and 35 through 39, thereby leaving only a rejection under 35 U.S.C. § 112, first paragraph, of claims 1, 3, 4, 28, 30, and 31. Accordingly, only claims 1, 3, 4, 28, 30, and 31 are before us on appeal.

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Appellants' invention relates to a method for controlling an airbag in a vehicle based on an expected, future position of an occupant, which, in turn, is determined based on the current position and current velocity of the occupant. Thus, deployment of the airbag may be suppressed if the expected position of the occupant at the time of deployment is not within a predetermined threshold distance from the airbag. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for controlling a vehicular component based on the position and velocity of an occupant, comprising the steps of:

determining the current position of the occupant,

determining the current velocity of the occupant,

determining an expected, future position of the occupant based on the current position and current velocity of the occupant, and

controlling the component in consideration of the expected position of the occupant.

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

Claims 1, 3, 4, 28, 30, and 31 stand 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 art that the inventor(s),

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at the time the application was filed, had possession of the claimed invention."<sup>1</sup>

Reference is made to the Final Rejection (Paper No. 6, mailed June 17, 2002) and the Examiner's Answer (Paper No. 17, mailed July 15, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 16, filed April 28, 2003) for the appellants' arguments thereagainst.

#### **OPINION**

We have carefully considered the claims and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the written description rejection of claims 1, 3, 4, 28, 30, and 31.

The examiner rejects claims 1, 3, 4, 28, 30, and 31 under 35 U.S.C. § 112, first paragraph, for a lack of an adequate written description. However, the explanation that follows the statement of the rejection (Final Rejection, page 3) is more akin to a lack of enablement.

According to Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563/64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991),

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<sup>1</sup> We note that although the examiner states (Answer, page 3) that claims 1 through 5, 8, 10 through 13, 16, 28 through 32, and 35 through 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mattes (U.S. Patent No. 5,118,134), the examiner states (Answer, page 5) that appellants' arguments are persuasive and the rejection has been withdrawn. Accordingly, we consider the rejection to be withdrawn.

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35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also 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*.

The written description requirement generally comes into play after an amendment to the claims. However, the examiner has not pointed to any claim limitation that was added by amendment and considered to be new matter. In fact, all of the limitations discussed by the examiner were in the original set of claims and disclosed, for example, at page 18 of the specification.

Consequently, we find no basis for the examiner's assertion of an inadequate written description.

As to the enablement part of 35 U.S.C. § 112, first paragraph, the examiner has not met the standard set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) for determining enablement. In particular, we find that each of the eight **Wands** factors, 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention

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based on the content of the disclosure applies to this case. The examiner, at best, has only addressed the sixth factor. Therefore, the examiner has failed to establish a *prima facie* case of non-enablement. We further note that appellants do disclose (at page 18 of the specification) sensing the current position and velocity of the occupant, determining where the occupant is likely to be at the time of deployment of the airbag, and preventing deployment of the airbag based on that information. Accordingly, we cannot sustain the rejection of claims 1, 3, 4, 28, 30, and 31 under 35 U.S.C. § 112, first paragraph.

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**CONCLUSION**

The decision of the examiner rejecting claims 1, 3, 4, 28, 30, and 31 under 35 U.S.C. § 112, first paragraph, is reversed.

**REVERSED**

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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BRIAN ROFFE, ESQ  
11 SUNRISE PLAZA, SUITE 303  
VALLEY STREAM, NY 11580-6170