

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAO SHI GAO

Appeal No. 2004-2355
Application No. 09/935,721

ON BRIEF

Before PAK, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6 and 10-15 , which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a magnetic dispersion medium. According to appellant, the medium is useful in magnetic writing screen toys wherein the medium is encased between top and bottom sheets. During use, a pen with a magnetic tip can be employed to attract the magnetic powder (iron) within the medium to the underside of a top transparent sheet leaving a visible

pattern of the pen movement. The iron particles remain until removed via another mechanism, such as by way of a sliding mechanism that erases the tracing made with the pen. A further understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A magnetic dispersion medium, comprising:
a bulk material,
a first colorant, wherein said first colorant is titanium dioxide,
a second colorant, wherein said second colorant is benzo oxazole fluorescent whitener,
a thickener, and
a magnetic material.

Claims 1-6 and 12-15 stand rejected under 35 U.S.C. § 112, first paragraph as being based on a non-enabling disclosure. Claims 10 and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure. Claims 1-6 and 10-14 stand rejected under 35 U.S.C. § 112, first paragraph as lacking written descriptive support in the application, as filed.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Having considered the entire record of this application, including the arguments advanced by both the examiner and appellant in support of their respective positions, we agree with appellant that the examiner has not met the burden to show that the claimed subject matter is not enabled by, or described and supported by the original disclosure of the application. Accordingly, we will not sustain the examiner's rejections. Our reasoning follows.

The Rejections for Lack of Enablement

According to the examiner with respect to both of the stated enablement rejections, the specification is non-enabling since the "limited disclosure does not support the breadth of the instant claims" (answer, pages 3 and 4). The examiner appears to be concerned that appellant's detailed disclosure of a magnetic dispersion medium composition with specified percentages of a particular bulk material, particular colorant(s), a particular thickener and a particular magnetic material "does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make an invention commensurate in scope with these [rejected] claims" (answer, pages 3 and 4). Furthermore, the examiner urges that "the specification is not

directed to all magnetic dispersion mediums..." and "[t]he fact one of ordinary skill in the art could determine what compounds that can be used in the claimed dispersion does not mean the specification enables the claimed composition, since the specification only enables the production of non-toxic magnetic writing screen dispersion mediums of a non-toxic dispersion liquid having a viscosity sufficient to prevent the magnetic particles from settling out, thickener, a white pigment, a fluorescent whitener and black or dark colored magnetic particles" (answer, page 5).

With respect to enablement, a predecessor of our appellate reviewing court stated in In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the 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 in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . 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 our view, the examiner has not carried the initial burden of setting forth evidence or sound technical reasoning which indicates that one of ordinary skill in the art would not have been enabled by appellant's specification to form a magnetic dispersion medium including a bulk material, a first colorant, a second colorant, a thickener and a magnetic material as specified in original claim 1 wherein the colorants are as specified in original claims 7 and 9 (see, e.g., appealed claim 1). Nor has the examiner fairly established that one of ordinary skill in the art would not have been enabled by appellant's specification to form a magnetic dispersion medium including a bulk material, a first colorant comprising a benzo oxazole fluorescent whitener, a thickener and a magnetic material as set forth in original claim 10 as now required by appealed claim 10.¹

Whether making and using the invention would have required undue experimentation, and thus whether the disclosure is enabling, is a legal conclusion based upon several underlying

¹ It is well-settled that the original claims are part of the original application disclosure.

factual inquiries. See In re Wands, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Here, the examiner has not presented sufficient factual determinations to support the legal conclusion that undue experimentation is required to practice the invention as claimed. We note that compliance with the enablement provision of 35 U.S.C. § 112, first paragraph does not require appellant to actually have reduced the claimed invention to practice.

Accordingly, based on the present record, the rejection of claims 1-6 and 12-15 and the rejection of claims 10 and 11, each under 35 U.S.C. § 112, first paragraph, for lack of enablement cannot be sustained.

The Rejection for Lack of Descriptive Support

The examiner has rejected claims 1-6 and 10-14 as not being "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 4).

The examiner has stated that descriptive support in the original disclosure could not be found because the teaching in the detailed portion of the specification "does not support the claimed materials, where the amounts are not given and the

composition is not limited to that disclosed in the specification" (answer, page 5).

Insofar as the written description requirement is concerned, the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. See In re Alton, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). The examiner's finding of lack of descriptive support for the appealed claims is without merit. This is so because the original claims provide literal support for themselves See In re Anderson, 471 F.2d 1237, 1238-39, 176 USPQ 331, 332 (CCPA 1973)(unamended original claim is a part of the original disclosure). The examiner has not persuasively explained how appellant's presentation of a detailed description of the invention wherein specific amounts of particular magnetic dispersion medium ingredients are furnished establishes a lack of descriptive support under 35 U.S.C. § 112, first paragraph for those broader appealed claims that are supported by the originally presented claims.

"[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."

In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

"Precisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

Here, the examiner simply has not made the case as to why the so rejected claims would have been construed as describing possession of a new concept or invention not conveyed by the original disclosure for the reasons set forth above. Consequently, on the present record, we find ourselves in agreement with appellant's basic position that the original disclosure reasonably conveys to the ordinarily skilled artisan that appellant had possession of the claimed subject matter, a position that the examiner has not effectively challenged by presenting a persuasive rationale for the stated rejection.² Therefore, the rejection under § 112, first paragraph, with regard to the alleged lack of descriptive support for the claims on appeal cannot be sustained.

² Because the examiner has not furnished a prima facie case of a lack of descriptive support under § 112, first paragraph, we need not address the two patents referred to by appellant in rebuttal at page 5 of the brief.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 and 12-15 under 35 U.S.C. § 112, first paragraph as being based on a non-enabling disclosure; to reject claims 10 and 11 under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure; and to reject claims 1-6 and 10-14 under 35 U.S.C. § 112, first paragraph as lacking written descriptive support in the application, as filed is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CATHERINE TIMM)	
Administrative Patent Judge)	

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