The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL D. CASE and MARTIN COLEMAN

Appeal No. 2001-2177
Application No. 08/551,576

ON BRIEF

Before GARRIS, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 and 8, which are all of the claims pending in this application.[1]

We REVERSE.

[1] While the examiner has approved entry of the amendment after final rejection which cancels claims 1 and 4 (Paper No. 24, filed December 10, 1998), we note that this amendment has not been clerically entered.

BACKGROUND

The appellants' invention relates to a smoking article. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Birkholz	1,897,976	Feb. 14, 1933
Cayle et al. (Cayle)	3,966,543	June 29, 1976
Müller et al. (Müller)	4,274,428	June 23, 1981
Quame	4,547,263	Oct. 15, 1985

Claims 5 and 8 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 enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 5 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Müller in view of Quame, Cayle and Birkholz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer

(Paper No. 28, remailed April 16, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 23, filed December 10, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The enablement rejection

We will not sustain the rejection of claims 5 and 8 under 35 U.S.C. § 112, first paragraph.

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 appellants 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[2] against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to

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[2] The appellants may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellants 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.

determine whether the examiner has met the burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

The basis set forth by the examiner for this rejection (answer, p. 4) is that "the specification does not disclose the process for producing a paper having a moisture disintegration index that does not exceed 20 [sic, 10]."[3] While the specification does not specifically disclose the process for producing a paper having a moisture disintegration index that does not exceed 10, the examiner has not set forth any rationale as to why one skilled in the art could not make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation.

The appellants specifically disclose (specification, pp. 4-5) that a paper made from 100% wood pulp has a moisture disintegration index of 4. In addition, the process for making a paper from 100% wood pulp would be well known to one skilled in the art. Accordingly, it is our opinion that 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.

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[3] Claim 5 recites that the moisture disintegration index of the filter paper of a smoking article does not exceed 10. Claim 8 recites that the moisture disintegration index of the filter paper of a smoking article does not exceed 7.

For the reasons set forth above, the decision of the examiner to reject claims 5 and 8 under 35 U.S.C. § 112, first paragraph, is reversed.

The obviousness rejection

We will not sustain the rejection of claims 5 and 8 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require the moisture disintegration index of the filter paper of a smoking article to be 10 or less. However, this limitation is not suggested by the applied prior art. In that regard, while Müller does teach to use filter paper of a known type in a smoking article, none of the applied prior art teaches or suggests using either a filter paper having a moisture disintegration index that does not exceed 10 or a filter paper made from 100% wood pulp (which appears from the appellants' disclosure

to inherently have a moisture disintegration index of 4). In our view, the only suggestion for modifying Müller in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 5 and 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 and 8 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 5 and 8 under 35 U.S.C. § 103 is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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