

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 STEVEN W. TROVINGER and AKINOBU KURAMOTO

Appeal No. 2006-0809
Application No. 10/887,631
Technology Center 3600

ON BRIEF
Decided: August 16, 2006

Before FRANKFORT, OWENS and HORNER, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 25-31, all of the claims remaining in the application. Claims 1-24 have been canceled.

We reverse.

BACKGROUND

The appellants' invention relates to an apparatus used in print media handling operations to minimize skew of the print media. The apparatus of the claims at issue specifically relates to an apparatus having at least two sensing members downstream of a de-skew mechanism. One of the sensing members is fixed near one side of the print medium, and the other sensing member is mounted for movement so as to accommodate print media of different dimensions. In one embodiment, the movable sensing member is mounted to a carriage that is movable along a carriage transport rail. Claims 25-31 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellants' brief.

The examiner has rejected claims 25-31 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In the final rejection, the examiner noted as the basis for his rejection that the specification as filed does not state how the sensing member is to be mounted, where it is to be mounted, what will move it along a rail, or how it is enabled to generate data indicative of an actual alignment of the leading edge of a print medium relative to the feedpath. (Final Office Action, pp. 3-4).

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we refer to the examiner's answer (mailed August 10, 2005) for the examiner's complete reasoning in support

of the rejection and to the appellants' replacement brief (filed July 5, 2005) and reply brief (filed October 5, 2005) for the appellants' arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellants' specification, claims 25-31, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, the examiner has failed to meet the initial burden of setting forth a reasonable explanation as to why he believes that the scope of protection provided by the claims is not adequately enabled by the description of the invention provided in the specification of the application.

The PTO bears the initial burden when rejecting claims for lack of enablement.

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.

In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971)).

It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). “Enablement is not precluded by the necessity for some experimentation However, experimentation needed to practice the invention must not be undue experimentation. The key word is ‘undue,’ not ‘experimentation.’” *In re Wands*, 858 F.2d at 736-737, 8 USPQ2d at 1404.

To evaluate whether a disclosure would require undue experimentation, the Federal Circuit has adopted the following factors to be considered:

- (1) The quantity of experimentation needed to make or use the invention based on the content of the disclosure;
- (2) The amount of direction or guidance presented;
- (3) The existence of working examples;
- (4) The nature of the invention;
- (5) The state of the prior art;
- (6) The relative skill of those in the art;

- (7) The level of predictability in the art; and
- (8) The breadth of the claims.

In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Id.*, 8 USPQ2d at 1404.

In his articulation of the rejection in both the final office action and the examiner's answer, the examiner fails to focus on the above-enumerated factors and fails to explain how the specification lacks sufficient disclosure to teach one skilled in the art to make and use the claimed invention without undue experimentation. The examiner merely poses questions to the appellants and fails to make any specific findings of fact supported by the evidence or draw conclusions based on these findings of fact.

The examiner makes note of information that is missing from the specification that he feels would have been important to teach one skilled in the art how to make and use the invention. He fails, however, to explain why one skilled in the art at the time of the invention could not have supplied this missing information without undue experimentation.

For example, the examiner asserts that the specification as filed is missing certain information including: how the sensing member is to be mounted; where it is to be mounted; what will move it along a rail; or how it is enabled to generate data indicative of an actual alignment of the leading edge of a print medium relative to the feedpath. (Examiner's Answer, p. 3). In response to the appellants'

argument accusing the examiner of failing to give proper credit to the sophistication of persons skilled in the art, the examiner responds merely by stating that the drawings do not show “a sensing member mounted for movement so as to accommodate print media of different dimensions” and that the specification does not provide enough detail for one skilled in the art to be able to make the invention of claim 25 without undue experimentation. (Examiner’s Answer, p. 4). No reasons in support of this conclusion of undue experimentation are offered. Rather, the examiner’s position reduces to a bald assertion that a person skilled in the art would require undue experimentation to mount the sensing member on a carriage or otherwise for movement so as to accommodate print media of different dimensions. Cf. *Ex parte Lemak*, 210 USPQ 306 (BPAI 1981) (reversing an examiner’s rejection for lack of enablement because the examiner failed to provide reasons in support of his assertion of undue experimentation).

We note that not everything necessary to practice the invention need be disclosed. In fact, what is well known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Nowhere in the examiner’s position do we find that he took into consideration the knowledge and skill in the art or the disclosure in paragraph [0028] of the specification where it is indicated that,

[A]n alternative embodiment in which the print media is aligned to the left hand side of the feedpath has one fixed sensor, on the left hand side, and one movable sensor that

is moved to be close to the right hand side edge of the print media, thus accommodating different print media widths. The movable sensor can be a sensor mounted on a carriage which moves along a carriage transport rail aligned to the sensor axis. Such carriages are well known in the art and are used in printers, such as the printer of Fig. 2.

Accordingly, we find that the examiner has not met his initial burden of setting forth a reasonable explanation as to why he believes that the scope of protection provided by the claims is not adequately enabled by the description of the invention provided in the specification of the application. Thus, we reverse the examiner's rejection of claims 25-31 under 35 U.S.C. § 112, first paragraph, for lack of enablement.¹

In their brief, the appellants also address the new matter objections to the amendments to the specification and Figure 2 of the drawings. As the examiner correctly noted in his answer, these issues are subject to review by petition under 37 C.F.R. § 1.181 and we decline to review them here.²

¹ With regard to claim 31, we note that the phrase "said first optical sensors" lacks antecedent basis. If appellants pursue further prosecution of this application, they should consider clarifying the scope of this claim.

² We note that the Examiner did not reject the claims for lack of written description under 35 U.S.C. § 112, first paragraph. As such, it appears that the appellants should be able to present a figure, similar to Figure 3, depicting a "movable sensor mounted on a carriage which moves along a carriage transport rail aligned to the sensor axis," as disclosed in paragraph 0028 of the specification as originally filed.

Appeal No. 2006-0809
Application No. 10/887,631

Page 8

CONCLUSION

For the reasons set forth above, we reverse the rejection of claims 25-31 under 35 U.S.C. § 112.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
)
)
)
)
)
) BOARD OF PATENT
TERRY J. OWENS) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)
)
LINDA E. HORNER)
Administrative Patent Judge)

Appeal No. 2006-0809
Application No. 10/887,631

Page 11

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CA 80527-2400

M/BM TEAM



APPEAL NO. «Appeal_No»

APPLICATION NO. «Application_No»

Copies:

 APJ «APJ1»

 APJ «APJ2»

 APJ «APJ3»

DECISION: «Outcome»

PREPARED: Aug 16, 2006

2 Person Conf. Onbrief

PALM:

3 Person Conf. Onbrief

ACTS:

3 Person Conf. Heard

DISK (FOIA):

ELPH:

BOOK:

GAU:

44C2:

IFW in Mail Room: