

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 MARK B. KNUDSON,
TIMOTHY R. CONRAD and
JERRY C. GRIFFIN

Appeal 2006-3401
Application 10/938,255
Technology Center 3700

Decided: February 26, 2007

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 2, 4, and 5. Claim 3 has been allowed. We have jurisdiction pursuant to 35 U.S.C. § 6.

We AFFIRM.

The Appellants claim a method of treating snoring by injecting a polymer into a soft palate of the patient and adding a stiffening agent to the polymer to alter the flexibility of the polymer. Further details of the claimed method under appeal are set forth in claim 1, which is the sole independent claim before us and reads as follows:

1. A method of treating snoring, comprising treating a patient's snoring by the steps of:

injecting a polymer into a soft palate of said patient in an area between a hard palate and a trailing edge of said soft palate; and

adding a stiffening agent to said polymer to alter the flexibility of said polymer with an alteration of said flexibility of said polymer due to said addition occurring after the injection of said polymer into said soft palate.

Claims 1, 2, 4, and 5 stand rejected under the first paragraph of 35 U.S.C. § 112, as failing to comply with the enablement requirement.¹ The Examiner concludes that claim 1 encompasses injecting the polymer and stiffening agent directly into the soft palate of a patient and that such direct injection is not enabled by the Appellants' disclosure (Answer 4).

For the reasons set forth in the Answer and below, this rejection will be sustained.

The first paragraph of § 112 requires that a specification must describe the manner and process of making and using a claimed invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation. *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1344-45, 76 F.2d 1724, 1731 (Fed.

¹ Because the dependent claims have not been separately argued, all claims will stand or fall with independent claim 1.

Cir. 2005). When a specification describes one inventive embodiment and a claim defines the invention generically, the specification must enable a person of ordinary skill in the art to make and use the generic invention without undue experimentation. *Id.*, 424 F.3d at 1345. Thus, an inventor cannot always satisfy the requirements of § 112, in supporting expansive claim language, merely by clearly describing one embodiment of the thing claimed. *Id.*, 414 F.3d at 1346.

According to the Appellants, "[t]he claims of the present application are directed to an embodiment illustrated in Fig. 19 of the application and described on page 10, lines 6-17, of the Specification" (Br.10). The Appellants argue that page 10, lines 6-17, of the Specification describe two different alternatives (*Id.* at 17). Lines 6-15 describe the first alternative and refer to housing 26" whereas lines 16-17 describe the second alternative and do not refer to housing 26" (*Id.*). The Appellants state that this second alternative is the subject of the present claims (*Id.* at 18).

There is no merit in the Appellants' apparent belief that the afore-noted second alternative does not include housing 26". As correctly explained by the Examiner, in describing this alternative, lines 16-17 explicitly refer to "the space 28" , " and the antecedent basis for this positively recited space 28" appears in lines 7-8 which describe "a housing 26" ... defining an interior space 28" ." Like the Examiner, therefore, we find that the second alternative described on lines 16-17 of Specification page 10 includes housing 26".

In light of the foregoing, we additionally find that the one and only embodiment disclosed by Appellants for practicing the here claimed method includes use of a housing. The Specification contains no disclosure of

practicing this claimed method without a housing. In contrast, the appealed claims define a generic method which may or may not include use of a housing.

Under these circumstances, the pivotal issue of this appeal is whether the Appellants' disclosure of a single embodiment which includes use of a housing would enable a person with ordinary skill in this art to practice, without undue experimentation, a snoring treatment method which does not include use of a housing as encompassed by the generic claims before us.

There is reasonable doubt that Appellants' disclosure provides enablement for a method which does not include use of a housing. As described in the Specification (and defined by allowed claim 3), a housing (or bladder) defines an interior space within which the polymer and stiffening agent are injected and allowed to freely commingle so as to react with one another to thereby achieve the desired alteration of flexibility. In contrast, without a housing and its interior space, the polymer and stiffening agent are not free to commingle and react with one another. As correctly indicated by the Examiner, interstitial matter such as fluids in the palate might well prevent the polymer and stiffening agent from commingling and reacting with one another and thereby prevent achievement of the desired flexibility alteration (Answer 5-6).

These considerations persuade us that the Examiner's enablement doubts are based on reasonable technical rationale. Only by undue experimentation would an artisan be able to determine whether it is possible to practice the claimed snoring treatment method without a housing and, if possible, the conditions and parameters which would enable practice of such a method. Because the generic claims on appeal encompass this method,

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they fail to comply with the enablement requirement set forth in the first paragraph of 35 U.S.C. § 112.

We hereby sustain, therefore, the Examiner's § 112, first paragraph, rejection of claims 1, 2, 4, and 5.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED

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