

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RONALD BRUCE HOWES, JR.,  
ROBERT EUGENE MAY, and DAVID HOWLAND

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Appeal 2007-2046  
Application 10/328,497  
Technology Center 1700

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Decided: June 8, 2007

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Before EDWARD C. KIMLIN, CHUNG K. PAK, and  
JEFFREY T. SMITH, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants state that “[t]his is an appeal from the final rejection of claims 17-25 and 28-36 (Br. 1). The Examiner, however, states at page 2 of the Answer that “the status of the claims is as follows: claims 18, 24-25 and 28-36 are objected” (Answer, third para.), and that “[t]here is an objection to both the specification and claims 18, 21, 23-25 and 28-36 . . . [which]

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[o]bjections are not reviewable on appeal" (Answer, para. (6)).<sup>1</sup> In the Examiner's final rejection it is stated that "[t]he specification is objected to as not containing 'a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same'" (Final Rejection 2, penultimate para.).

The Examiner errs in *objecting* to the *claims* on the basis that the Specification is non-enabling to one of ordinary skill in the art. While a non-enabling specification is objected to, the *claims* correlating to the non-enabling aspect of the Specification are *rejected* under 35 U.S.C. § 112, first paragraph (*see MPEP* § 706.03(c)). As a result, Appellants are afforded the opportunity to rebut the rejection of the claims under § 112, first paragraph.

Accordingly, this Application is remanded to the Examiner for consideration of rejecting claims that were improperly objected to. The Examiner should bear in mind that he/she has the initial burden of establishing, by compelling reasoning or objective evidence, that one of ordinary skill in the art would be unable to practice the claimed invention without undue experimentation. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971); *In re Armbruster*, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975). The Examiner should also be aware that it is not the function of the claims to specifically exclude every possible

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<sup>1</sup> It can be seen that the Examiner makes inconsistent statements with respect to the status of claims 21 and 23.

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inoperative embodiment that a creative mind can imagine. *In re Dinh-Nguyen*, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974). See also *In re Kamal*, 398 F.2d 867, 872, 158 USPQ 320, 324 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 1019, 140 USPQ 474, 486 (CCPA 1964).

Also, upon return of this Application to the Examiner, the Examiner should reevaluate all the criticisms lodged against Appellants' claim language with the understanding that it is well settled that claim language is not to be read in a vacuum but in light of the specification as it would be reasonably interpreted by one of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this Remand by the Board.

REMANDED

clj

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