

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. VANDERMINDEN, SR.

Appeal 2007-2590
Application 09/895,950
Technology Center 3600

Decided: December 5, 2007

Before HUBERT C. LORIN, JENNIFER D. BAHR, and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert D. Vanderminden, Sr. (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3, 4, 9, and 11-14.¹ We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ The final rejection of claims 5-8 has been withdrawn and these claims have been allowed (Answer 3-5). Claims 15 and 17-24 have also been allowed (Final Office

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is to a tilt mechanism for an umbrella (Specification 1). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A tilt mechanism for an umbrella comprising
 - a first tubular member for securement to a first section of an umbrella pole;
 - a second tubular member for securement to a second section of an umbrella pole;
 - a catch mounted in one of said members and projecting into the other of said members, said catch having a plurality of recesses at an end projecting into said other tubular member; and
 - a pin mounted in said other of said tubular members transversely of and in one of said recesses of said catch to lock said tubular members relative to each other, at least one of said pin and said catch being movable coaxially relative to each other to release said pin from a selected one of said recesses.

Action 2). Claims 2, 10, and 16 have been canceled.

THE REJECTION

The Examiner rejected claims 1, 3, 4, 9, and 11-14 under 35 U.S.C. § 112, first paragraph.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1, 3, 4, 9, and 11-14 under 35 U.S.C. § 112, first paragraph. This issue turns on whether the Specification, as originally filed, contains a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. In particular, the issue focuses on the sufficiency in the disclosure of the Specification for the recitation in independent claims 1 and 9 of “at least one of said pin and said catch being movable coaxially relative to each other to release said pin from a selected one of said recesses.”

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Appellant’s Specification, as originally filed, stated that “[t]he pin and the catch are moveable relative to each other in order to release the

- pin from the catch to allow the umbrella pole sections to be tilted relative to each other” (Specification 1-2).
2. The originally filed claims 2 and 10 recited a tilt mechanism “wherein at least one of said pin and said catch are movable relative to each other to release said pin from a selected one of said recesses” (Specification 7, 8).
 3. The original figures depicted an embodiment in which both the pin and catch are movable relative to each other, i.e., the catch pivots relative to the pin, and the pin is coaxially movable relative to the catch to release the pin from the recess in the catch (*see e.g.*, Figs. 2 and 3 and accompanying description at Specification 4-5).
 4. The only facet of appealed claims 1 and 9 missing from this disclosure is the fact that the catch is moveable “coaxially” relative to the pin.

PRINCIPLES OF LAW

35 U.S.C. § 112, first paragraph, states,

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112, first paragraph (2002). The first paragraph of § 112 contains three requirements: (1) written description, (2) enablement, and (3) best mode.

The Federal Circuit has stated that the written description requirement is separate

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from the enablement requirement, *see e.g., Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 963 (Fed. Cir. 2002); *and Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). For the sake of completeness, and due to the inexactitude with which the Examiner framed the rejection and the Appellant presented arguments on appeal, we include a discussion of the case law of both the written description and enablement requirements and include an analysis of each requirement as it pertains to this appeal.

Written Description

The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The possession test alone, however, is not always sufficient to meet the written description requirement. *Enzo Biochem*, 323 F.3d at 969. Rather, “the written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Id.* (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)).

The claimed subject matter need not be described “*in haec verba*” in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989). Rather, “the test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed

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what is claimed in the later filed application as of the filing date of the earlier filed application.” *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004).

Enablement

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 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223-24 (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 (Fed. Cir. 1988). 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;

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- (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.

Id. 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.*

ANALYSIS

Independent claims 1 and 9 both recite "at least one of said pin and said catch being movable coaxially relative to each other to release said pin from a selected one of said recesses."

Turning first to the issue of written description, we find that the Specification, as originally filed, included words, claims, and figures that provided an adequate description of the invention as now claimed. In particular, the original Specification stated, "[t]he pin and the catch are moveable relative to each other in order to release the pin from the catch to allow the umbrella pole sections to be tilted relative to each other" (FF 1). Further, originally filed claims 2 and 10 recited a tilt mechanism "wherein at least one of said pin and said catch are movable relative to each other to release said pin from a selected one of said

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recesses” (FF 2). Further, the original figures depicted an embodiment in which both the pin and catch are movable relative to each other, i.e., the catch pivots relative to the pin, and the pin is coaxially movable relative to the catch to release the pin from the recess in the catch (FF 3). The only facet of appealed claims 1 and 9 missing from this disclosure is the fact that the catch is moveable “coaxially” relative to the pin (FF 4).

The Specification clearly describes, in reference to the preferred embodiment and the figures, that the pin is moveable “coaxially” relative to the catch (FF 3). The Specification also describes that the pin and/or catch can be movable relative to each other (FF 1-3). Those skilled in the art, reading the original description of the pin and/or catch being moveable relative to each other to release the pin from the recess, and reading the description of the pin moveable “coaxially” relative to the catch, would understand that the Appellant also invented an alternate embodiment of the invention in which the catch, instead of or in addition to the pin, is moveable “coaxially” relative to the pin to release the pin from the recess. As such, the Specification conveys with reasonable clarity that the Appellant was in possession of the claimed invention at the time of filing and it provides an adequate description to allow one skilled in the art to visualize or recognize the identity of the subject matter described.

Turning next to the issue of enablement, the Examiner has failed to meet the PTO’s initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the appealed claims is not adequately enabled by the description of the invention provided in the Specification. In particular, the

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Examiner has failed to explain why the disclosure, as filed, is not sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The rejection merely states that “[t]here is no disclosure for both the pin 48 and the catch being movable or the catch being movable” (Answer 3). As set forth *supra*, this is clearly not an accurate statement. The Specification as originally filed describes that at least one of the pin and the catch is movable relative to the other to release the pin from the recess (FF 1-3). As such, the Specification contains disclosure that envisions the catch being movable relative to the pin.

The Examiner also states that “it is clear from the specification that the catch is not a coaxially movable structure as it is fixed to one of the tubular member[s]” (Answer 3). This statement is flawed because claims 1 and 9 recite that the catch is movable coaxially relative to the *pin*, not relative to the tubular members. The fact that the catch may be fixed to one of the tubular members is of no moment. Even if the catch were fixed to, for example, the upper tubular member, the catch may still be able to move coaxially relative to a pin in the lower tubular member if the upper tubular member is able to move coaxially relative to the lower tubular member.

Further, the Examiner’s rejection has not included any discussion as to any of the *Wands* factors to provide the Appellant or the Board with an indication as to why the disclosure would require undue experimentation. Although the Examiner is not required to provide a discussion as to every *Wands* factor, it is not apparent from the Examiner’s Answer that any of these factors has been considered or that

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the Examiner has relied on any evidence whatsoever to support the conclusion of lack of enablement.

As such, we do not sustain the rejection of claims 1, 3, 4, 9, and 11-14 under 35 U.S.C. § 112, first paragraph.

CONCLUSIONS OF LAW

We conclude the Appellant has shown that the Examiner erred in rejecting claims 1, 3, 4, 9, and 11-14 under 35 U.S.C. § 112, first paragraph.

DECISION

The decision of the Examiner to reject claims 1, 3, 4, 9, and 11-14 is reversed.

REVERSED

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