

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARK HODOWANEC

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Appeal 2007-3788  
Application 10/901,332  
Technology Center 3700

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Decided: January 24, 2008

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Before TERRY J. OWENS, HUBERT C. LORIN and JOHN C. KERINS,  
*Administrative Patent Judges.*

KERINS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Mark Hodowanec (Appellant) seeks our review under 35 U.S.C.  
§ 134 of the final rejection of all of Claims 1-20 pending in the application.  
We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

## THE INVENTION

Appellant's claimed invention is to a system and method for securing a device, such as a cooling fan, to a shaft. The system includes the device to be secured, a mount securable to that device, and a shaft having an axial and a radial groove, into which first and second portions of the mount may be inserted, to secure the device to the shaft and to substantially prevent movement of the device relative to the shaft. Claims 1 and 10, reproduced below, are representative of the subject matter on appeal:

1. A system for securing a device to a shaft comprising:

a device;

a mount securable to the device; and

a shaft including an axial groove and a radial groove, a first portion of the mount insertable within the axial groove and a second portion of the mount insertable within the radial groove, said mount adapted to secure and substantially prevent movement of the device relative to the shaft, the second portion of the mount adapted to extend less than 180 degrees around the shaft.

10. A method for securing a device to a shaft comprising:

providing a device;

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positioning a mount adjacent to the device;  
securing the mount to the device; and inserting a  
first portion of the mount within an axial groove  
and a second portion of the mount within a radial  
groove of a shaft, the mount adapted to secure the  
device to substantially prevent axial and radial  
movement of the device relative to the shaft, the  
second portion adapted to extend less than 180  
degrees around the shaft.

#### THE REJECTION

The Examiner relies upon the following as evidence of  
unpatentability:

Mazzucato	US 5,741,124	April 21, 1998
Bieri	DE G 72 42 559.3	September 5, 1974

The following rejections are before us for review:

1. Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement therein.
2. Claims 1, 4, 7, 10, 13, 16, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the German Bieri reference (hereafter, “Bieri”).
3. Claims 1, 3, 10, and 12 stand rejected under 35 U.S.C. § 103(a) as being obvious, and therefore unpatentable, over Mazzucato in view of Bieri.
4. Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious, and therefore unpatentable, over Bieri.

## ISSUES

A first issue before us is whether Appellant has demonstrated that the rejection of Claims 1-20, as failing to meet the written description requirement of 35 U.S.C. § 112, is in error. The remaining issues before us involve whether Appellant has shown the rejections of various claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) to be in error.

## 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. Independent Claims 1, 10, and 19 were each amended in an Amendment filed May 10, 2006, to include an element setting forth that, “the second portion of the mount [is] adapted to extend less than 180 degrees around the shaft.” (Amendment filed May 10, 2006). Prior to that time, no claim pending in the application contained that element or limitation.

2. Appellant’s Specification and claims as filed make no reference to or mention of a value or range of values, in degrees of arc or otherwise, that the claimed second portion of the mount may span or occupy relative to the shaft or the device to be secured to the shaft.

3. The Specification discloses that two mounts may be provided “at opposing 180 degree positions” along an inner disk portion of a fan

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(Specification, p. 4, ll. 8-9), or “in a 180 degrees opposing portion [sic., position] from the other”. (Specification, p. 4, ll. 21-23).

4. The Specification describes, in written terms, that the claimed second portion of the mount is made up of two “wedges” which flank the first portion of the mount, referred to in the specification as a “median”. (Specification, p. 4, ll. 26-27; p. 5, ll. 1-2; p. 5, ll. 9-25).

5. Figure 3 of the drawings accompanying the Specification illustrates, in a reasonably precise manner, the use of two opposing mounts 306, each of which comprises two wedges 308 with a median 310 disposed between the wedges. As depicted, the combined span of each pair of wedges with the median interposed is approximately 30° around the shaft. (Fig. 3).

6. The remaining drawing figures illustrating Appellant’s invention show the use of mounts that are substantially identical in size and shape to those illustrated in Figure 3. (*See*, Figs. 4-8).

7. Appellant’s disclosure as a whole, and particularly the drawings as relied on by Appellant, does not convey to a person of ordinary skill in the art that Appellant was in possession of an invention in which the second portion of the mount could span or extend around the shaft all the way up to (but not including) 180 degrees around a shaft, nor does it convey that Appellant was in possession of an invention in which the second portion of the mount could span or extend around the shaft down to (but not including) zero degrees.

8. The use of the term “wedges” in describing the principal components of the second portion of the mount in all of the embodiments set forth in the specification, in combination with all of the illustrated embodiments, conveys to a person of ordinary skill in the art that Appellant was in possession of an invention in which the second portion of the mount would span or extend only a short distance (or arc) around the shaft.

#### PRINCIPLES OF LAW

Compliance with the written description requirement is a question of fact. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). In order to comply with the written description requirement, the applicant’s disclosure must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the [claimed] invention.” *Vas-Cath, Inc.* at 1563-64.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The written description standard in § 112 does not require that every claim element find literal support in the application. *Fujikawa v. Wattanasin*, 93 F3d 1559, 1570 (Fed. Cir. 1996). Drawing figures alone *may* provide a written description of an invention in meeting the requirements of § 112. *Vas-Cath, Inc.* at 1564.

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That a person skilled in the art might realize from reading the disclosure that such a feature is possible is not a sufficient indication that the feature is a part of the invention. *In re Barker and Pehl*, 559 F.2d 588 (CCPA 1977). If the applicant claims embodiments of an invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996); *In re Wertheim*, 541 F.2d 257 (CCPA 1976).

Precisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case by case basis. *See, e.g., In re Smith*, 458 F.2d 1389, 1395 (CCPA 1972); *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320 (Fed. Cir. 2000).

Anticipation of a claim exists when each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Spada*, 911 F.2d at 708-09.

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, (1966), the Supreme Court set out a framework for applying the statutory

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language of § 103:

[T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.* at 17-18.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid or unpatentable under § 103. *See KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

## ANALYSIS

*Rejection under 35 U.S.C. § 112, first paragraph--written description*

Each of the claims on appeal contains an element requiring that a second portion of a mount, which is securable to a device that is, in turn, to be secured to a shaft, is “*adapted to extend less than 180 degrees around the shaft*”. (Appeal Br., Claims Appendix)(emphasis added). This claim element was introduced into independent Claims 1, 10 and 19 in an Amendment filed May 10, 2006. (Finding of Fact 1). These claims, and all claims depending therefrom, stand rejected under 35 U.S.C. § 112, first

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paragraph, as failing to meet the written description requirement set forth in that paragraph, based on the presence of this element in the claims.

Appellant contends that the Examiner has not established a prima facie showing that the claim limitation does not find adequate descriptive support in the application as filed. Specifically, Appellant argues that the Examiner has cited no evidence or provided any reasoning in support of the rejection. We disagree.

The evidence relied upon by the Examiner in making the rejection is Appellant's application itself, in particular, pointing to the absence in the original disclosure of any mention that the second portion of the mount is to extend less than 180 degrees around the shaft. (Final Rejection 3, Answer 4). The reasoning presented by the Examiner based on this evidence is, in essence, that because Appellant *nowhere* addresses a possible range of sizes or spans of the second portion of the mount, the application does not convey to persons of ordinary skill in the art that Appellant was in possession of the concept that the second portion of the mount should have a span or extent falling within a particular range as claimed. The Examiner expressed this, for example, in stating that the specification does not provide any criticality or preference in having the second portion extend less than 180 degrees around the shaft.<sup>1</sup>

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<sup>1</sup> Appellant is correct in noting that he is not required to show criticality of a feature in order to meet the written description requirement. We view the Examiner's statement, which also points to the lack of any discussion regarding *preferences* directed to this feature, as a presentation of reasoning

The Examiner further notes that the actual written disclosure discusses that the mounts are to be located at opposing 180 degree positions (Final Rejection 4; Finding of Fact 3), but nothing about how far around the shaft the second portion of the mount would preferably extend. Finally, the Examiner correctly notes that the drawings accompanying the written disclosure show only one example or single embodiment of the second portion of the mount (while conceding that this embodiment happens to fall within the scope of the claims on appeal).

We find this to be a case similar to the *Vas-Cath, Inc.*, case, in which very similar evidence and reasoning was all that was required in order for Vas-Cath to initially establish the absence of genuine issues of material fact on the issue of written description, and to shift the burden to the Patentee to present evidence tending to establish the presence of adequate support.<sup>2</sup>

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as to why persons of ordinary skill in the art would have no reason to expect that Appellant was in possession of an invention which included a mount having a second portion that could extend around the shaft to any span up to (but not including) 180 degrees.

<sup>2</sup> In the *Vas-Cath, Inc.*, case, the written description issue was procedurally on review at the Federal Circuit on the propriety of the grant of a Motion for Partial Summary Judgment. The movant and accused infringer, Vas-Cath, Inc., relied *solely* on the contention that the drawings in a design patent application (on which a claim for priority was based) did not adequately support claims in a later utility patent in which “ranges of variation” were present. The Patentee, Mahurkar, presented rebuttal evidence in an affidavit attempting to establish that drawings from Mahurkar’s design patent provided adequate written description for the claims at issue. The Court

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Accordingly, we conclude that the Examiner has successfully discharged his obligation to establish a prima facie case that the claims fail to meet the written description requirement.

Appellant does not dispute the Examiner's finding that the original written disclosure fails to specify that the second portion of the mount is to extend less than 180 degrees around the shaft. Indeed, the specification makes no mention of any particular value or range of values that are regarded by Appellant as suitable for the claimed second portion of the mount. (Finding of Fact 2).

Appellant's position is instead that the claim element at issue, "is illustrated [*sic*, in] at least each of FIGS. 3, 4, 5, 6, 7 and 8", and, based solely on that statement, Appellant asserts that, "each of FIGS. 3, 4, 5, 6, 7, and 8 illustrate [*sic*] and provide [*sic*] a sufficient 'written description' of a

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held that a grant of Summary Judgment was not appropriate under these circumstances, in that the evidence relied on by each party created genuine issues of material fact. *Vas-Cath, Inc.*, at 1567 (declaration submitted by Mahurkar and non-refutation by Vas-Cath gave rise to genuine issue of material fact, summary disposition not appropriate). Of greatest significance to the present case, the "evidence" presented and relied upon by Vas-Cath, *i.e.*, that the design application drawings did not show that certain claimed elements were to have particular ranges or have particular relationships with other elements, was implicitly found to be sufficient to establish a prima facie case of lack of written description. *See, L&W Inc. v. Shertec, Inc.*, 471 F.3d 1311 (Fed. Cir. 2006)(movant in summary judgment motion must make prima facie showing in order to shift burden to opponent to present evidence, as well as to survive adverse ruling). The Examiner here presents essentially the same type and quality of evidence as did Vas-Cath.

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mount ‘adapted to extend less than 180 degrees around the shaft.’ (Appeal Br. 15). No other evidence or reasoning is advanced tending to establish that the illustrated embodiment would convey to a person of ordinary skill in the art that Appellant contemplated and had possession of using a mount that could extend anywhere between zero and 180 degrees around the shaft. We will therefore look to the drawings to determine the persuasiveness of Appellant’s position.

Figure 3 of the drawings depicts the device and the mount in a reasonably precise rendition of that embodiment. (Finding of Fact 5). In that Figure, the second portion of each mount is shown as extending or spanning approximately 30 degrees around the shaft (less the span of the median, or first portion of the mount). *Id.* The other drawing figures (Figs. 4-8) appear to show the second portion of the mount to be effectively the same size and to have the same span. (Finding of Fact 6).

The claims, in contrast, recite that the second portion of the mount is adapted to extend less than 180 degrees around the shaft, which means that the second portion can extend around the shaft from as little as nearly 0° to as much as nearly 180°. <sup>3</sup> If this particular range was envisioned by and in

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<sup>3</sup> Appellant contends that, “a range from 0 to 180 degrees is not claimed.” (Reply Br. 2). These exact words are not used, however, that is the practical effect of, and a reasonable interpretation of, the scope of the claim at issue.

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possession of Appellant, it is not evident in Figure 3 nor in the other drawings. (Finding of Fact 7).<sup>4</sup>

Although not relied upon or cited by Appellant, the Specification does provide some descriptive text, terse as it may be, which describes the second portion of the mount. Appellant refers repeatedly and consistently to the mounts as being made up of two “wedges”. (Finding of Fact 4). While not appearing to follow precisely a dictionary definition of the term wedge<sup>5</sup>, in that the tapering faces or edges are truncated and do not meet or intersect, Appellant establishes through the use of this terminology, which is consistent with the illustrations in the drawings, that the mounts formed by pairs of the wedges are to have a narrow span. (Finding of Fact 8).

In contrast, a pair of “wedges” that would form a mount that extends nearly 180 degrees around the shaft (as would be within the scope of the claim limitation) would not have their principal faces tapering toward

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<sup>4</sup> What may be evident in the drawings, and possibly considered as having adequate descriptive support, would be a claim limitation stating that the second portion of the mount is adapted to extend about 30 degrees around the shaft. *Accord, In re Heinle*, 342 F.2d 1001 (CCPA 1965)(adequate written description found where claimed apertures in a toilet paper core were to be “approximately one-fourth of the circumference of said core”, and the drawings were found to conform to the one-fourth circumference limitation almost exactly). This issue is not directly before us.

<sup>5</sup> “wedge: 1. a piece of hard material with two principal faces meeting in a sharply acute angle”, *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. <http://dictionary.reference.com/browse/wedge> (accessed: January 04, 2008).

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meeting “in a sharply acute angle”. (*See*, fn. 4). Those elements would instead take on the form of two arcuate members that combine to form nearly a semi-circle, and would not resemble wedges, as disclosed. Appellant has pointed to nothing in the Specification or drawings that suggests that persons of ordinary skill in the art would recognize that Appellant was in possession of such a construction of the mount.

We are not persuaded, based upon the evidence and reasoning before us, that error was committed in rejecting Claims 1-20 under 35 U.S.C. § 112, first paragraph, on the basis that the claims fail to meet the written description requirement. We will thus affirm this rejection.

*Rejections of Claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a)*

Claims 1, 4, 7, 10, 13, 16, and 19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bieri. Claims 1, 3, 10, and 12 have been rejected under 35 U.S.C. § 103(a) as being obvious in view of Mazzucato and Bieri. Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Bieri. As discussed below, we cannot sustain these rejections.

The Examiner, in taking the position that the claim limitation directed to, “the second portion of the mount adapted to extend less than 180 degrees around the shaft”, does not meet the written description requirement of

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§ 112, also expressly treated the claims as though they did not contain that element or limitation.<sup>6</sup> In doing so, the Examiner failed to establish a prima facie case of anticipation as to the claims rejected under 35 U.S.C. § 102(b) and of obviousness as to the claims rejected under 35 U.S.C. § 103(a).

Appellant appropriately pointed out that this claim element was not established as being present in, or established to be an obvious variation of, the prior art, and particularly the Bieri reference. We agree, and will reverse the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

#### CONCLUSIONS OF LAW

We are not persuaded that error was committed in rejecting Claims 1-20 under 35 U.S.C. § 112, first paragraph, as failing to meet the written description requirement, and will sustain that rejection.

We are persuaded that the rejection of Claims 1, 4, 7, 10, 13, 16, and 19 under 35 U.S.C. § 102(b) is in error, and will reverse that rejection.

We are persuaded that the rejection of Claims 1, 3, 10, and 12 under 35 U.S.C. § 103(a) is in error, and will reverse that rejection.

We are persuaded that the rejection of Claims 9 and 18 under 35 U.S.C. § 103(a) is in error, and will reverse that rejection.

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<sup>6</sup> Each of the grounds of rejection treated the claims “as far as they are supported by the original disclosure”, and did not attempt to apply the cited prior art against the claim limitation at issue. (Answer 4, 5, 6).

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ORDER

The decision of the Examiner to reject Claims 1-20 as failing to meet the written description requirement set forth in 35 U.S.C. § 112, is AFFIRMED.

The decision of the Examiner to reject Claims 1, 4, 7, 10, 13, 16, and 19 under 35 U.S.C. § 102(b) is REVERSED.

The decision of the Examiner to reject Claims 1, 3, 10, and 12 under 35 U.S.C. § 103(a) is REVERSED.

The decision of the Examiner to reject Claims 9 and 18 under 35 U.S.C. § 103(a) is REVERSED.

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

AFFIRMED

JRG

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