

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TATSUYA FUJITA, YASUHIKO NIIMI,
TAKASHI KOTOH, HIDEAKI MIZUNO,
NOBUO WATANABE, and TADAICHI MATSUMOTO

Appeal 2008-3831
Application 10/171,974
Technology Center 1700

Decided: November 21, 2008

Before EDWARD C. KIMLIN, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 14, 15, and 45-59. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Appellants' invention is directed to a power output device for, e.g., a vehicle (Spec. 1, ¶ [0002] to Spec. 2, ¶ [0005]; Spec. 5, ¶ [0030]).

Claim 14, the sole independent claim on appeal, reads as follows:

14. A power output device, comprising:
 - a fuel cell;
 - a second battery which can be charged with an output from the fuel cell;
 - an inverter for driving a motor with a supplied output from at least one of the fuel cell and the secondary battery;
 - a calculation device the calculates a parameter corresponding to the sum of a possible electric power from the fuel cell and the secondary battery;
 - a determining device that compares the calculated parameter with a predetermined value and for determining a state of a power shortage which is a shortage of the sum of the possible electric power; and
 - a notification device that provides notification of power shortage when the state of power shortage is determined through the determining device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tabata 6,672,415 Jan. 6, 2004

The Examiner rejected the claims as follows: (i) claims 14 and 15 under 35 U.S.C. § 102(e) as anticipated by Tabata; and (ii) claims 45-59 under 35 U.S.C. § 112, first paragraph "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art ... to make and/or use the invention." (Ans. 3-6).

The Examiner also made an objection to the Specification that the amendment filed April 20, 2005 "introduces new matter into the disclosure."

(Ans. 2). This objection is based on the language used in newly added claims 45-59 filed on April 20, 2005; that is, there is no amendment to the Specification *per se*.

Appellants contend that the Examiner's description of the basis for the rejection of claims 45-59 under 35 U.S.C. § 112, first paragraph makes clear that this rejection is allegedly based on a lack of written description for the claimed subject matter (versus a lack of enablement) in the original Specification (Appeal Br. 4)¹. The Examiner did not directly dispute this; however, he also continued to use the language quoted above which refers to a lack of enablement (Ans. 4)².

ISSUES

Have Appellants demonstrated error in the Examiner's determination that claim 14 is anticipated by Tabata; specifically, has the Examiner met the initial burden of establishing that the output device of Tabata includes a calculating device, a determining device and a notification device with the claimed capabilities?

Have Appellants demonstrated error in the Examiner's determination that the inventor(s) did not have possession of the claimed invention of claims 45-59 based on the Specification as originally filed and/or that these claims are not enabled by the written description in the Specification?

¹ All references herein are to the Appeal Brief filed October 19, 2006, the Examiner's Answer (Ans.) mailed Dec. 14, 2006, and the Reply Brief (Rep. Br.) filed Feb. 12, 2007.

² The Manual of Patent Examining Procedure ("MPEP") provides a specific form paragraph, 7.31.01, for failure to comply with the written description requirement and a separate specific form paragraph, 7.31.02, for failure to comply with the enablement requirement (MPEP 706.03(c)). The Examiner did not use either form paragraph.

The 35 U.S.C. § 102 Rejection

PRINCIPLES OF LAW

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

Inherent anticipation of a claim feature cannot be based on possibilities or probabilities; the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981); *see also MEHL/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

In relying upon a theory of inherency, the Examiner has the initial burden to provide a basis in fact and/or technical reasoning to reasonably support a finding that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990).

A patent applicant is free to recite features of an apparatus either structurally or functionally, i.e., by what it does. *See, e.g., Schreiber* 128 F.3d at 1477. Where an apparatus is claimed functionally rather than structurally and the PTO has reason to believe that a functional limitation is an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic. *Schreiber*, 128 F.3d at 1478.

FINDINGS OF FACT

The following findings of fact are supported by a preponderance of the evidence. Additional findings of fact as necessary appear in the Analysis portion of the opinion.

1. Tabata describes a hybrid vehicle comprising a fuel cell and a secondary battery (Abstract; col. 1, ll. 29-32).
2. Tabata describes that a CPU (central processing unit) carries out various control schemes to operate the hybrid vehicle; i.e., to drive the motor with the battery when the power from the battery is above a predetermined level, or alternatively, to drive the motor by the fuel cell if the fuel cell power is above a predetermined level (e.g., Fig. 38 of Tabata; col. 78, l. 32 to col. 79, l. 28).
3. Tabata does not explicitly state that a calculation device “calculates a parameter that correspond[s] to the sum of a possible electric power from the fuel cell and the secondary battery”, nor that a determination device “compares the calculated parameter with a predetermined value . . . for determining a state of power shortage which is a shortage of the sum of the possible electric power”, nor that a notification device “provides notification of power shortage when the state of power shortage is determined through the determining device” as recited in claim 14.

ANALYSIS

Appellants contend that Tabata does not teach a calculating device that sums the possible electric power from the fuel cell and the battery, nor a determining device and a notification device with the claimed characteristics as recited in claim 14. (App. Br. 4-5).

The Examiner, however, relies primarily upon the steps outlined in the flowchart of Fig. 38, and the accompanying Fig. 39 to establish that Tabata's central processing unit (CPU) and notification device must have the claimed capabilities. (Ans. 5-10).

The Examiner's position is not well taken. The dispositive issue is whether, as noted above, the Examiner has met the initial burden of establishing that the programmed computer (CPU) and notification device disclosed by Tabata inherently have the capabilities as set forth in claim 14. Tabata discloses various control schemes to drive the hybrid vehicle (Facts 1 and 2). The Examiner has discussed numerous passages of the Tabata reference (Ans. 7-12). However, other than concluding this to be so, the Examiner has not directed us to any evidence or persuasive technical reasoning to substantiate the assertion that Tabata's processing unit and notification device have the capabilities required by claim 14 (Fact 3).

To the contrary, Tabata describes a control device scheme wherein the comparison is to the individual power of each of the battery and fuel cell (Fact 2). Further, the notification device of Appellants' claim 14 provides "notification of power shortage when the state of power shortage is determined through the determining device", which power shortage is a shortage of "*the sum* of the possible electric power" (claim 14; emphasis provided). In contrast, Tabata's device provides notification of the change in

operation from motor-driven to engine driven, this change being in response to a determination that only the power of the fuel cell is insufficient (col. 80, ll. 5-9; Fig. 38, step S1040). The Examiner has not established that Tabata describes a power output device wherein the sum of the power from both the fuel cell and battery are computed and compared to a predetermined value, which value is then used to provide notification of a power shortage via a notification device as set out in claim 14.

Thus, we agree with Appellants that the apparatus of Tabata does not necessarily have the capabilities recited in claim 14. (App. Br. 7-12; Reply Br. 7-14). In our view the Examiner is improperly relying on the mere possibility that under certain conditions, the apparatus of Tabata would have been capable of performing the claimed functions. *Oelrich*, 666 F.2d at 581.

Accordingly, we cannot uphold the Examiner's rejection under 35 U.S.C. § 102(e) based on Tabata³.

The Objection to the Specification (based on the introduction of new matter) and the Rejection under 35 U.S.C. § 112, first paragraph

PRINCIPLES OF LAW

Written Description

The fundamental factual inquiry in determining whether a claimed invention satisfies the written description requirement of 35 U.S.C. § 112, first paragraph, is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in

³ The Examiner cannot rely on any additional references to make up for the difference between Tabata and the claimed subject matter since a statement of common ownership filed Aug. 23, 2005 disqualifies the Tabata reference under 35 U.S.C. § 103(c).

possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The claimed subject matter need not be described *in haec verba* in the specification in order for that specification to satisfy the description requirement. *In re Smith*, 481 F.2d 910, 914 (CCPA 1973). The PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976).

Enablement

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).

When the challenged subject matter deals with a computer program that implements a claimed device or method, it has been established that:

[E]nablement is determined from the viewpoint of a skilled programmer using the knowledge and skill with which such a person is charged. The amount of disclosure that will enable practice of an invention that utilizes a computer program may vary according to the nature of the invention, the role of the program in carrying it out, and the complexity of the contemplated programming, all from the viewpoint of the skilled programmer.

Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 941 (Fed. Cir. 1990) (citing *In re Sherwood*, 613 F.2d 809, 817 (CCPA 1980)).

FINDINGS OF FACT AND ANALYSIS

We will not sustain the rejection of claims 45-59 under 35 U.S.C. § 112, first paragraph, nor the objection⁴ to the Specification, for the following reasons.

The Examiner has not established that the invention claimed in dependent claims 45-59 is a different invention than that described in the written description in the Specification.

While we agree with the Examiner that there “is no discussion in the disclosure to indicate that the Qh [i.e., the sum of possible electric power] is used to compare with a ‘predetermined fuel cell value’” (Ans. 13), claim 45 does **not** require that Qh be compared with “a predetermined fuel cell power value.” The ending of claim 45 (as well as claim 46) refers to “the predetermined value”. It is clear that this term refers back to “a predetermined value” set forth in the sole independent claim 14 (e.g., step S760 as described in Fig. 14, using Ed* as described in Fig. 6, step S190). It does not refer back to any of the various *additional* “predetermined” values set out in the dependent claims that have been given more specific names (e.g., “a predetermined fuel cell power value” of dependent claim 45).

We agree with Appellants' analysis set out in the Appeal Brief and Reply Brief (App. Br. 14-16; Reply Br. 16-18). In particular, we find that the description of a CPU (central processing unit) and the related functions

⁴ Where “both the claims and the specification contain new matter either directly or indirectly, and there has been both a rejection and an objection by the Examiner, the issue becomes appealable and should not be decided by petition.” Manual of Patent Examining Procedure § 2163.06, II. Review of New Matter Objections And/Or Rejections (8th ed., Rev. 6, August 2007); *see also* § 608.04(c) (8th ed., Rev. 6, August 2007).

outlined in the flow diagram of Fig. 6 of the present application adequately convey to one of ordinary skill in the art that Appellants had possession of the calculating device and determining device being part of a processing unit (claims 55 and 59) (*see e.g.*, App. Br. 14-15).

We further find that Fig. 6 and the related description thereof adequately convey to one of ordinary skill in the art that Appellants had possession of the invention described in claim 58. The Specification teaches that the predetermined value (Ed^*) is calculated based on a required torque value (T^*) and vehicle speed value (V) (e.g., Fig. 6, Step S130; Spec. [0128], [0129]). Likewise the Specification describes that this predetermined value (Ed^*) is compared to the sum of the possible electric power of the fuel cell and the secondary battery (Q_h) (e.g., step S190 of Fig. 6).

With respect to the invention claimed in claims 45-48, we agree with the reasons set forth by Appellants that Figs. 6 and 14 and the related descriptions of these flow diagrams in the Specification adequately convey to one of ordinary skill in the art that Appellants had possession of the invention set out in these claims (*see e.g.*, App. Br. 15-16; Reply Br. 16-17).

As a final note, even if the Examiner's rejection of claims 45-59 under 35 U.S.C. § 112, first paragraph is based on lack of enablement (versus a lack of written description), we also determine that the Examiner has not presented a *prima facie* case of nonenablement.

The threshold step in resolving this issue is to determine whether the Examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.

In his articulation of the rejection in both the final office action and the Examiner's Answer, the Examiner fails to explain how the Specification

Appeal 2008-3831
Application 10/171,974

lacks sufficient disclosure to teach one skilled in the art to make and use the claimed invention without undue experimentation. Rather, the Examiner merely concludes that there is no “support for” specified recitations of claims 45, 47, 48, 55, 58, and 59 (Ans. 4).

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.

Thus, we reverse the Examiner's rejection of claims 45-59 under 35 U.S.C. § 112, first paragraph, for lack of enablement and/or for lack of written description.

CONCLUSION

For the foregoing reasons and those stated in the Appeal Brief and Reply Brief, we determine that Appellants have shown error in the Examiner's determinations that: (i) claims 14 and 15 are anticipated by Tabata; and (ii) that the inventors did not have possession of the claimed subject matter of claims 45-59 (and correspondingly that claims 45-59 introduced new matter into the disclosure), and/or that the claims were not enabled by the Specification.

DECISION

The Examiner's decision to reject the appealed claims is reversed.

REVERSED

Appeal 2008-3831
Application 10/171,974

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