

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TETSUYUKI MIWA

Appeal No. 1999-0445
Application No. 08/351,583

ON BRIEF¹

Before CALVERT, FRANKFORT and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6 and 8-12, which are all of the claims pending in this application.²

¹ An oral hearing on this appeal was set for October 26, 2000. However, the appellant's counsel waived this hearing in a telephone conference with Craig Feinberg, Program and Resources Administrator, Board of Patent Appeals and Interferences, on October 26, 2000.

² In an entered amendment (Paper No. 20) filed subsequent to the final rejection, claims 7, 13, 14 and 19 were canceled.

BACKGROUND

The appellant's invention relates to a noncontact type tonometer. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.³

The following rejection is before us for review.

Claims 1-6 and 8-12 stand rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification fails to (1) provide an adequate written description of the invention and (2) teach how to make and/or use the invention.⁴

Reference is made to the brief⁵ and reply brief (Paper Nos. 24 and 27) and the answer (Paper No. 25) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

OPINION

³ The reproductions of claims 2 and 4 contained in the appellant's appendix contain minor typographical errors. In particular, claim 2 of record depends from "claim 1" (not "claim I"). The text "t," in line 3 of claim 4 as reproduced in the appendix is not found in the claim of record.

⁴ While the examiner does not explicitly re-state the ground of rejection in the answer (Paper No. 25), it is apparent from the examiner's statement of the issues on page 2 of the answer that the claims stand rejected under the first paragraph of 35 U.S.C. § 112 for the reasons set forth in the objection to the specification on pages 3-6 of the answer.

⁵ All references in this decision to "the brief" allude to the corrected brief filed May 28, 1998.

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In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we shall not sustain the examiner's rejection.

The examiner's position in rejecting the claims appears⁶ to be that the appellant's specification fails to comply with both the written description and enablement requirements of the first paragraph of 35 U.S.C. § 112 in regard to the claimed subject matter. Accordingly, this panel has reviewed the appellant's claims and underlying disclosure to determine whether each of these requirements has been met.

The enablement requirement

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

⁶ In the first rejection (Paper No. 4, page 4), the examiner indicated that, in addition to failing to provide an adequate written description of the invention and failing to teach how to make and/or use the invention, the appellant's specification as originally filed did not provide support for the invention as claimed. This third basis appears to us to have been a clear articulation of a lack of written description rejection. It is not clear whether the examiner's withdrawal of this third basis of rejection in the final rejection (Paper No. 10, page 2), after the appellant amended the specification to indicate its continuation-in-part status and filed a declaration for a continuation-in-part application, stems from a recognition that the third basis was simply repetitive of the lack of written description basis or from a determination that the specification as originally filed does provide support for the claimed subject matter.

The examiner urges that the appellant's specification fails to provide an enabling disclosure of a tonometer comprising a processing means for "determining an amended time based on the time detected by the time detection means when the result of the pressure comparison indicates that the pressure change is different than the standard pressure characteristic" as recited in claim 1. As explained in the appellant's specification, from page 11, line 24, to page 12, line 13, the microcomputer circuit 6, which corresponds to the recited processing means, behaves as follows:

- a) If the rate of change $X(t)$ is equal to 1 (i.e., no difference between the pressure change and the standard pressure characteristic), the actual curve is used to determine intraocular pressure (IOP). In this case, time is not amended.
- b) If the rate of change is not equal to 1 (i.e., a difference is detected between the pressure change and standard pressure characteristic), then time t is amended to t' wherein $t' = t \cdot X(t)$ and the IOP is calculated using the amended time.
- c) If the rate of change is greater than 1.3, a stop signal is input to the solenoid driving circuit 9 to prevent the applied air pressure from rising abnormally. In this instance, an amended time may not be determined.

The examiner does not contend that one of ordinary skill in the art would not have been able to make and use a microprocessor which operates as set forth in situations a) through c) above

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from the appellant's disclosure. Rather, the sole basis of the examiner's rejection, as we understand it, is that the disclosed processing means does not amend time, in all instances (note situation c)), when the result of the pressure comparison indicates that the pressure change is different than the standard characteristic.

We share the appellant's opinion, as expressed on page 2 of the reply brief, that the claims do not require that time is always amended when the pressure comparison indicates the pressure change is different from the standard, as urged by the examiner on page 3 of the answer. The processing means as disclosed in the appellant's specification amends time, once cornea flattening has been detected, when the pressure comparison indicates the pressure change is different from the standard (i.e., when $X(t) \dots 1$) and the language in the last paragraph of claim 1 requires no more than this. Another disclosed feature of the appellant's invention is a safety routine which stops the compressing means (perhaps before cornea flattening is detected) when the pressure appears to be rising too rapidly (e.g., when $X(t) > 1.3$). That this additional feature is not also recited in independent claim 1 does not render claim 1 inconsistent with the underlying disclosure. In this regard, we note that claim 10, which depends indirectly from claim 1, further recites that the processing means stops the

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operation of the compressing means when the value of the calculated rate of change is larger than a predetermined value (i.e., situation c) described above).⁷

In light of the foregoing, we conclude that the examiner has not met the initial burden of advancing acceptable reasoning inconsistent with enablement of the claimed subject matter. Accordingly, we cannot sustain the examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112 on the basis that the specification fails to teach one of ordinary skill in the art how to make and use the invention.

The Written Description Requirement

The description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also 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 invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*.

⁷ It is of some interest that the examiner, appropriately in our opinion, has not asserted that the further limitation recited in claim 10 is in any way inconsistent with the language in the final paragraph of claim 1.

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. . . drawings alone *may* be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

As explained on pages 3-6 of the answer, the examiner urges that the appellant's specification fails to provide adequate written description of a noncontact tonometer comprising a processing means as recited in the last paragraph of claim 1. In light of our discussion, *supra*, it should be apparent that we consider the disclosure on pages 11 and 12 of the appellant's specification sufficient to provide written descriptive support for the features of the processing means recited in the last paragraph of claim 1.

Moreover, we note that claims 1-3, 5, 6 and 8-12 before us on appeal are identical in language to original⁸ claims 1-3, 5, 6 and 8-12 of this application. Therefore, there can be no question that the original claims provide written descriptive support for the subject matter of claims 1-3, 5, 6 and 8-12.⁹ Likewise, while claim 4 has been amended from its original presentation to clarify that the processing means, rather than the pressure detection means, monitors the gradients, we are of the opinion that the language of original claim 4, especially when read in light of the disclosure on page 10, line 31, to page 12, line 13, of the appellant's

⁸ It is important to note that the appellant has amended the specification to indicate that the instant application is a continuation-in-part of earlier application no. 07/933,303 and has filed a declaration meeting the requirement of 37 CFR § 1.63(e) for a continuation-in-part application (see Paper Nos. 8 and 9). Accordingly, it is the disclosure of the application as of the filing date of the instant application (December 7, 1994) which must be considered in determining whether the written description requirement has been met.

⁹ Where, as here, an original claim is identical in language to the subject matter now being claimed, nothing more is necessary for compliance with the description requirement of the first paragraph of § 112. See Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 938, 9 USPQ2d 1321, 1326 (Fed. Cir. 1990), In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973), and In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397 (CCPA 1973).

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specification, was sufficient to convey to one of ordinary skill in the art that the appellant was in possession of the invention now recited in claim 4, i.e., a noncontact tonometer comprising, *inter alia*, a processing means as recited in the last paragraph of claim 1 which monitors a gradient in the standard pressure curvature and a gradient in the pressure changing curvature at the time detected by the time detection means.

For the foregoing reasons, we cannot sustain the examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112 on the basis that the specification as originally filed fails to provide written descriptive support for the subject matter now claimed.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 and 8-12 under the first paragraph of 35 U.S.C. § 112 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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