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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES W. MEEKS

Appeal 2018-001955
Application 12/421,420
Technology Center 3600

Before CHARLES N. GREENHUT, MICHAEL J. FITZPATRICK, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant,² James W. Meeks, appeals from the Examiner's decision to reject claims 1–3, 6, 7, 10–14, 17, 18, 21, 22, 24 and 25. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted October 1st, 2019.

We AFFIRM and designate NEW GROUNDS OF REJECTION.

¹ A decision was rendered in a prior appeal (2014-000565) (“565 Decision”) in this application on March 16, 2016.

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real parties in interest as Quanex Homeshield and Therma-Tru Corp. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to a seal for an adjustable threshold assembly.
Claim 1, reproduced below, with emphasis added, is illustrative of the
claimed subject matter:

1. An adjustable threshold assembly for disposition below a door, said adjustable threshold assembly comprising:
 - a sill;
 - a rail spaced from said sill and configured to be vertically adjustable relative to said sill between a minimum and a maximum height; and
 - a seal comprising:
 - a first portion which is plastic and engages one of said sill and said rail;
 - a second portion which is plastic and engages the other of said sill and said rail;
 - an intermediate portion which is an elastomer and connects said first and second portions and is flexible relative to said first and second portions; and
 - said second portion including a projection defined by an upper corner, a lower corner, and a vertically extending portion extending from said upper corner to said lower corner;
 - a bulb which is an elastomer, *said bulb extending from said first portion and maintaining contact with said vertically extending portion and with at least one of said upper corner and said lower corner as said rail moves between said minimum height and said maximum height*, wherein said bulb maintains contact with said upper corner when said rail is at said minimum height, and wherein said bulb maintains contact with said lower corner when said rail is at said maximum height;
 - wherein said bulb includes a first end extending from said first portion and a second end extending from said first portion and spaced from said first end, said bulb and said first portion enclosing a cavity between said first and second ends;
 - said bulb rolling relative to said first portion of said seal as said rail moves between said minimum height and said maximum height;

said bulb being resiliently collapsed around said upper corner when said rail is at said minimum height with said upper corner deforming said bulb to match a shape of said upper corner to seal between said bulb and said projection, and said bulb being resiliently collapsed around said lower corner when said rail is at said maximum height with said lower corner deforming said bulb to match a shape of said lower corner to seal between said bulb and said projection.

REJECTION

Claims 1–3, 6, 7, 10–14, 17, 18, 21, 22, 24 and 25 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

OPINION

Claim Grouping

The claims are argued as a group for which claim 1 is representative under 37 C.F.R. § 41.37(c)(1)(iv).

Principles of Law

“The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required ‘to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.’” *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *Vas Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. *See, e.g., In re Lukach*, 442 F.2d 967 (CCPA 1971). Appellant’s specification need not describe the claimed

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invention in *ipsis verbis* to comply with the written description requirement. *In re Edwards*, 568 F.2d 1349, 1351–52 (CCPA 1978). When an explicit limitation in a claim is not present in the written description it must be shown that a person of ordinary skill would have understood that the description requires that limitation. *Hyatt v. Boone*, 146 F.3d 1348, 1353, (Fed. Cir. 1998). As is the case here, the description requirement of 35 U.S.C. § 112, first paragraph may operate to defeat the patentability of a narrower but not a broader claim. *In re Smith*, 458 F.2d 1389, 1395 (CCPA 1972). The Supreme Court has viewed with skepticism efforts to distinguish the subject matter claimed from the prior art by relying on elements or functionality notably absent in an original disclosure and appearing to be “an afterthought.” *Graham v. John Deere Co. of Kansas City*, 383 US 1, 25 (citing *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 (1938)). If the originally filed disclosure does not provide support for each claim limitation, a new or amended claim must be rejected under 35 U.S.C. § 112, paragraph 1, as lacking adequate written description.

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). The fundamental factual inquiry is whether the Specification conveys 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. *See, e.g., Vas-Cath, Inc.*, 935 F.2d at 1563-64. Facts must be established by a preponderance of the evidence by the PTO when making rejections. *In re Caveney*, 761 F.2d 671, 674, (Fed.Cir.1985).

Background and the prior appeal

In appeal number 2014-000565, we entered a new ground of rejection for claims 1–3, 6, 7, 10, 11, and 23 under 35 U.S.C. § 112, first paragraph because claims 1 and 23 had been amended to introduce the following subject matter, for which the Board determined there was insufficient written description:

maintaining contact with at least one of said upper corner and said lower corner as said rail moves between said minimum height and said maximum height

'565 Decision 6–8. The '565 Decision stated:

We understand [] paragraph [35] to describe bulb 66 contacting one of three structures: the top corner 76 (Fig. 4), the bottom corner 76 (Fig. 5) or vertically extending portion 78 (not shown). To introduce, by way of amendment, a limitation requiring the bulb to maintain contact with only two of those structures (the corners) during rail movement is, as the Examiner originally found, a violation of the written description requirement of 35 U.S.C. § 112, first paragraph.

'565 Decision at 7.

Based on the briefing and the Examiner's analysis, there appears to be two aspects of the above-quoted portion of the '565 Decision in need of clarification. First, in reinstating the rejection under 35 U.S.C. § 112, first paragraph that the Examiner had previously withdrawn, the Board did not base its holding regarding the lack of descriptive support on the Examiner's more narrow claim construction that the limitation at issue in the '565 appeal and quoted above requires maintaining contact with the *same* corner throughout rail movement. *See* Dec. 6, 2012 Final Act. 2. To the extent the Examiner relies on that claim construction again in the present appeal (Ans. 2; Reply. Br. 3), we expressly decline to adopt the Examiner's claim

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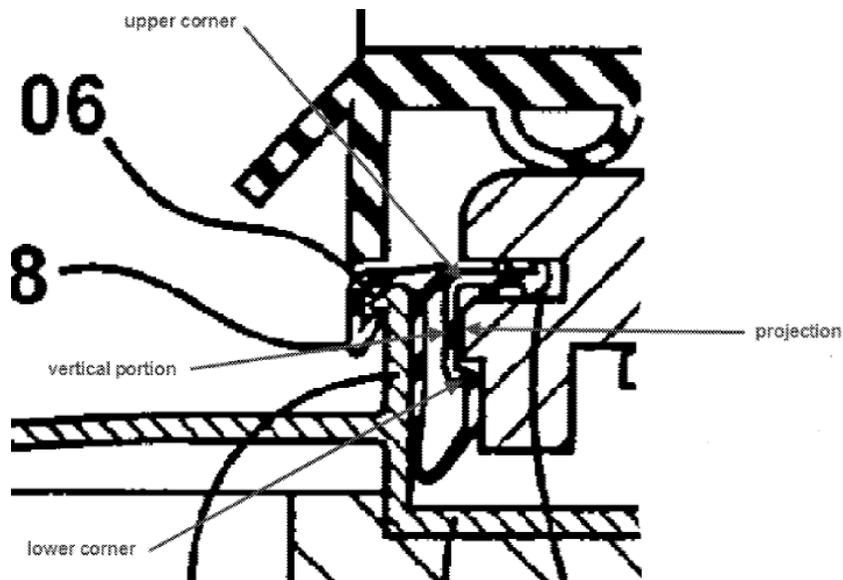
construction in this regard. The finding of inadequate written description both in the prior appeal and here was, and is, instead based on the broadest reasonable interpretation of the claim language, which allows for contact with *either* corner. This brings us to the next point of clarification.

When the Board commented that the newly added limitation required the bulb to maintain contact with “only” two of the corners the term “only” was not intended as a means by which to indicate that contact *itself* must be limited to only a corner. As Appellant argues, such an interpretation would directly contradict the “at least one of” claim language. App. Br. 23–25. The term “only” was used in the prior opinion to refer to the *list of possible* contact options being limited, inconsistently with the original disclosure, to always include a corner, thereby *precluding* the option of contact with just the vertically extending portion. Appellant devotes a substantial portion of the briefs to arguing that the bulb *can* contact *more* than one structure of the projection. *See* App. Br. 23–37; Reply. Br. 5–9. The Board never held otherwise. Rather, the Board held that there was no descriptive support for expressly *omitting* the vertically extending portion 78 from the *list of possible* structures with which the bulb may make exclusive contact during the rail’s movement between minimum and maximum positions.

Claimed Subject Matter

Appellant introduced the above-quoted limitation involved in the ’565 appeal and argued (’565 App. Br. 11) it created a distinction between the subject matter claimed in the ’565 appeal and the subject matter depicted in

Figure 2 of Pepper (U.S. 2006/0112644 A1 Pub. Jun. 1, 2006).³ Figure 2 of Pepper illustrates, without discussion, a position in which Pepper's sealing portion 88 is contacting *only* a vertical portion of the (annotated) projection of Pepper's rail 42 and neither of the upper or lower corners of that projection.



A version of Figure 2 of Pepper with the Examiner's annotations from the Examiner's Answer in the '565 appeal is reproduced above.

According to the limitations at issue introduced both in the prior appeal and the present one, the *absence of contact* with at least one of the corners *never* happens over the course of moving Appellant's rail 32 between its minimum and maximum positions. Stated differently, the possibility of seal contact with only the vertical portion of the projection, as appears to happen at at least at some moment in Pepper, is now precluded by the claim language emphasized above and reproduced below:

said bulb extending from said first portion and maintaining contact with said vertically extending portion and with at least

³ Trantina (US 3,344,271 iss. Sept. 26, 1967) was relied on by the Examiner regarding the "bulb" portion of the seal.

one of said upper corner and said lower corner as said rail moves between said minimum height and said maximum height

The limitation above included in the present form of claim 1 unambiguously requires contact with at least *two* components of the projection (74) during rail movement between its maximum and its minimum: one of the corners (76) and the vertically extending portion (78). This means that, according to claim 1, the bulb seal 66, in contrast to the seal illustrated in Pepper, *never loses contact with* at least one of the corners of the projection and also *never loses contact with* the vertically extending portion of the projection.

Written Description

According to Appellant there is an “unambiguous recitation that the bulb ‘maintains contact with at least one corner’ [in] paragraph [0035].” Reply. Br. 9. It is not clear what Appellant is quoting with this argument because the quotation matches neither the claim language nor that of paragraph 35 of Appellant’s Specification.

The Board has carefully reviewed Appellant’s arguments and has again carefully reviewed the Specification and Figures. We find that paragraph 35 does contain the *best* language, and seemingly the only language, that provides at least the possibility that there is some support for Appellant’s position. However, Appellant misquotes paragraph 35 (Reply. Br. 9) and provides hypothetical examples that do not adhere to important aspects of the express language of that paragraph (App. Br. 23–24). The actual language of paragraph 35 is, in relevant part: “the bulb 66 maintains contact with at least one of the corners 76 and the vertically extending portion 78.”

At first blush reasonable minds may differ as to precisely how to parse this phrase. It could mean, as Appellant argues, consistent with claim 1 as *presently* amended, “maintaining contact with said vertically extending portion and with at least one of said upper corner and said lower corner.” However, in stark contrast to the language of the Specification, in claim 1, Appellant clearly uses “at least one of” to qualify only the corners and also uses “and with” to indicate the maintenance of *two* contact points on the projection. Although the Specification need not contain identical language to provide adequate descriptive support for claimed subject matter, certainly language having the level of precision of the language now present in claim 1 was available to Appellant to demonstrate possession of the subject matter now claimed at the time of filing. Appellant chose to instead employ language in the Specification amenable to more than one reasonable interpretation.

An alternate, and also reasonable, reading of “at least one of the corners 76 and the vertically extending portion 78” is that contact need only be maintained with, at a minimum, *one* of the three delineated components of the projection 74. In the prior appeal, in light of the entirety of the disclosure, the Board applied this latter interpretation of paragraph 35. In doing so, the Board designated the opinion as including a “new ground of rejection” under 37 C.F.R. § 41.50(b) so that Appellant was provided with the opportunities to respond associated therewith.

Following the prior appeal decision, Appellant chose to reopen prosecution to amend the claims. Now that this case returns to the Board having substantially the same issue, Appellant has also had ample opportunity to provide additional arguments and direct the Board’s attention to any other evidence supporting Appellant’s proposed interpretation of

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paragraph 35 of the Specification. Appellant has not apprised us of error in declining to adopt Appellant's most recent proposed interpretation of paragraph 35 advanced in this appeal.

The first paragraph of 35 U.S.C. § 112 provides:

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.

Expressly stated in this paragraph is the requirement for using “full, clear, concise, and exact terms.” Indeed, our reviewing court and its predecessor have both emphasized the importance of clarity in drafting a disclosure that demonstrates an applicant has actually invented the subject matter claimed. *See* MPEP § 2163 *quoting*, inter alia, *In re Barker*, 559 F.2d 588, 592 n.4 (CCPA 1977) (“[T]he ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed.”); *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, (Fed. Cir. 2000) (“[T]he specification does not clearly disclose to the skilled artisan that the inventors. . . considered the ratio... to be part of their invention. . .”); *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (“[does] the description clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.”); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (“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.*”).

The Board is not aware, and Appellant does not apprise us, of any precedent to support the notion that a disclosure, reasonably ambiguous on its face, can be relied on, without more, as descriptive support for a later preferred one of its possible interpretations. The approach that is more consistent with the purpose of the written description requirement is to consider ambiguous statements in the Specification in the context of their surrounding disclosure to determine what meaning, if any, can be gleaned therefrom. Indeed, when it comes to the Written Description requirement “[e]ach case must be decided on its own facts in terms of what is reasonably communicated to those skilled in the art.” MPEP § 2163.05(II) (quoting *In re Wilder*, 736 F2d. 1516, 1520 (Fed. Cir. 1984).

During the oral hearing, the Board gave Appellant the opportunity to point to any *other* language in the Specification or aspect of the Figures that supported Appellant’s proposed interpretation of the sentence of paragraph 35 in question. *See* Hearing Transcript 6–17. We began, as we do here, with a discussion of the Figures. *See* Hearing Transcript 5–13.

The Figures

There is no dispute that Figure 5 shows a maximum rail position and bulb 66 contact with a lower corner 76 and the vertical portion 78 of projection 74. This is consistent with both the present claim language and *either* of the possible interpretations of the sentence in question in paragraph 35. Thus, Figure 5 neither confirms nor refutes a particular interpretation.

Figure 6 depicts a minimum rail height where there is contact between the bulb and the upper corner 76. Figure 6 does not clearly depict contact

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with the vertical portion 78 of projection 74. Figure 6, illustrating a minimum position, need not necessarily show contact with vertical portion 78 because, according to the claim language, and according to Appellant's proposed interpretation of paragraph 35, contact with the vertical portion 78 need only begin *as the rail 32 is moved between* the minimum position toward the maximum position. However, this means that, *immediately* after the rail 32 starts moving, there should be, according to Appellant's proposed interpretation of the language of paragraph 35, contact between the bulb 66 and the vertical portion 78. This is certainly much easier to envisage with regard to moving away from the *maximum* rail position illustrated in Figure 5 because there is already some contact with the vertical portion 78 at the maximum rail position.

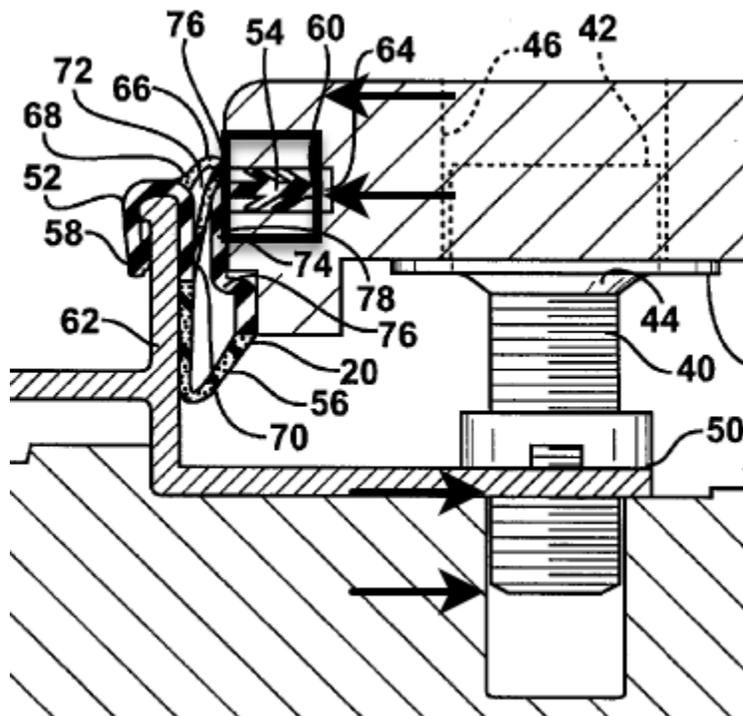
The position depicted in Figure 7 appears to, like Figure 6, exhibit an absence of contact between the bulb 66 and vertical portion 78. Figure 7 is also described as illustrating a maximum rail height, albeit after the rail has been lowered from the maximum. Spec. paras. 14, 40. Appellant was unable to provide any cogent explanation as to precisely why the bulb exhibits a different position in the maximum rail position depicted in Figure 7 versus that depicted in Figure 5. *See* Hearing Transcript 8–11. The Examiner also questioned how contact with the vertical portion 78 is always maintained during movement between the maximum and minimum when at least Figure 7 appears to illustrate the absence of contact with or immediately adjacent to, the vertical portion 78 at the maximum rail height *See* Interview Sum. p. 2 (attached to Adv. Act. of Dec. 28, 2016).

The absence of contact with the vertical portion 78 in figures 6 and 7 seems to suggest a reading of paragraph 35 that does not in all instances require contact with the vertical portion 78 during rail movement. This

would make the interpretation requiring bulb contact to be with, at a minimum, only *one* of the three delineated points more consistent with Figures 6 and 7. We must recognize, as noted above, that Figures 6 and 7 illustrate minimum and maximum positions, respectively, and not points of travel therebetween. Inferring, in Appellant's favor, that contact may be made between the bulb 66 and the vertical portion 78 as soon as the rail begins to move away from either of the maximum or minimum positions only leads us to conclude that Figures 5, 6, and 7 are not, by themselves, conclusive insofar as demonstrating how the skilled artisan would understand the language of paragraph 35.

Figure 4 is the only figure that actually depicts the rail 32 at a position between its maximum and minimum. Spec. paras. 11, 37. However, as can be observed by considering the relative positions of the threaded fastener 40 and the threaded coupling 50, the position depicted in Figure 4 is much closer to the minimum height depicted in Figure 6 than it is to either of the maximum heights depicted in Figures 5 and 7. Even with a cursory glance at Figure 4, one skilled in the art could envisage the amount of travel necessary to move from the Figure 4 position to that of either of Figures 5 or 7 because that amount of travel is equal to the amount of threaded fastener 40 exposed beneath threaded coupling 50. When one skilled in the art considers this distance (indicated as being between the lower pair of arrows we have added to Appellant's figure 4 below) one skilled in the art would also be able to easily envisage the travel of projection 74 with respect to bulb 66 (indicated as being between the upper pair arrows we have added to Appellant's figure 4 below), because these distances are necessarily the same. For these reasons, based on Figure 4, it seems highly likely that one skilled in the art would envisage at least a point, and more likely, multiple points, during the

course of the projection's travel wherein the bulb 66 makes contact with *only* the vertically extending portion 78 of the projection 74 and neither of its corners 76. Such a location is illustrated with a rectangle matching the size of the projection 74 and placed in a hypothetical position the projection would occupy between the Figure 4 position and maximum rail height positions (Figures 5 and 7) in the annotated version of Figure 4 below:



As mentioned in the Oral Hearing, we recognize that the figures in patent applications are not necessarily drawn to scale unless it is so indicated. However, in the context of considering the adequacy of a disclosure, our reviewing court has recognized that “[i]n those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340 (Fed. Cir. 2010) (en

banc). Appellant's Figure 4 supports only the interpretation that the bulb 66, at some point during the rail's travel, makes contact with *only* the vertically extending portion 78, much like the seal of Pepper. This is part of the reason why the Board was skeptical when Appellant amended claim 1 to indicate contact with the vertical portion 78 alone *never* occurs during the rail's travel.

We asked Appellant to address Figure 4 in the Oral Hearing and Appellant only reiterated that the figures were not to scale. Hearing Transcript at 8. We also confirmed that if the bulb 66 were to always maintain contact with at least one of the corners, the bulb 66 would need to exhibit a size similar to that of the projection 74 so that it may essentially or nearly contact both corners simultaneously to ensure that each corner 76 is contacted by the bulb 66 *as soon as* its opposite corner *loses* contact with the bulb 66. Hearing Transcript at 6–8. Appellant indicated Appellant was unable to file “animations” demonstrating an *absence* of contact with *just* vertical portion 78 of projection 74, or constant contact with at least one corner, during every possible position of the rail between its maximum and minimum. Hearing Transcript at 6. In most cases that may be so,⁴ but illustrating the alleged *point* at which contact occurs between the bulb and both corners, or an appropriate relative sizing between the bulb and projection, would not have required any animation and would certainly have allowed one skilled in the art to more easily envisage the arrangement Appellant now contends was part of the original disclosure. Indeed, if this were contemplated as part of the original disclosure, particularly one that might help distinguish the claimed subject matter from the prior art, there

⁴ See MPEP § 608.03 for exceptions to this policy.

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appears to be no excuse for failing to illustrate it, or with Figure 4, for illustrating something seemingly conflicting with it, because 37 C.F.R. § 1.83 requires drawings to “show every feature of the invention specified in the claims.” MPEP § 608.02(d). Appellant instead chose to illustrate, with Figure 4, only an arrangement that tends to support our interpretation of paragraph 35 over that advanced by Appellant.

Recognizing Figure 4 is not necessarily drawn to scale, at best for Appellant, Figure 4, like the other figures provides some evidence as to how paragraph 35 would be understood by the skilled artisan in light of the disclosure, but is not, by itself, dispositive as to how the language in question in paragraph 35 should ultimately be interpreted. We turn next, as we did in the Oral Hearing, to the Specification.

The Specification

One of the questions we asked Appellant at the Oral Hearing was whether there was any disclosure regarding the *reasons or purposes* for maintaining contact between the bulb 66 and *both* the vertically extending portion 78 *and* at least one corner 76 of the projection 74. Hearing Transcript 15. The presence of a discussion indicating a reason for including a particular feature, though not necessarily required, can often help inform the skilled artisan reading the Specification about the feature itself. It can also help demonstrate that the feature in question was something more than an afterthought—subject matter not found in an applied prior-art reference

but not necessarily part of Appellant's original disclosure.⁵ Appellant did not provide any cogent response to our inquiry.

The only discussion that we are aware of in the Specification regarding reasons the seal and bulb maintain contact states:

By maintaining contact with the second portion[54], the bulb [60] prevents water, dirt, etc., from collecting between the first [52] and second portions of the seal [20] thereby preventing damage, rot, unappealing appearance, etc., associated with collection of water, dirt, etc., between the first and second portions.

Spec. para. 6. This objective would seemingly be achieved so long as there is contact between the bulb and *any* portion of the elastomeric seal's second portion 54 (the portion with projection 74). There is no indication that *multiple* portions of the seal second portion 54, or projection 74, in particular *both* the vertically extending portion 78 and at least one of the corners 76, must be contacted in order to achieve the stated benefit or to provide any particular advantage. In fact, to the contrary, Appellant *repeatedly* indicates just the opposite throughout the Specification in that during rail movement contact is maintained either "between the bulb 66 *and the second portion 54*" (para. 33 (emphasis added)) or "the bulb 66. . .maintain[s] contact *with the projection 74*" (paras. 38, 39, 40 (emphasis added)). We see no reason, and when asked, Appellant offered no cogent explanation (Hearing Transcript at 16–17), why these sentences would not be interpreted by a skilled artisan to have their plain and ordinary meaning, wherein contacting the second portion of the seal 54, or contacting the projection 74, can be

⁵ Negative limitations often present issues of similar concern. *See, merely for example, Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1351 (Fed. Cir.2012).

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achieved by contacting at least any *one* element of the seal second portion 54 or projection 74. These statements strongly favor the interpretation of paragraph 35 used in the prior appeal, that contact may be between the bulb and *any one of the three elements* of the projection 74. This includes the bulb 66 possibly contacting only the vertically extending portion 78. When contacting vertically extending portion 78 without contacting a corner the bulb “maintains contact with the projection 74” as stated in each of paragraphs 38, 39, and 40. These portions of Appellant’s Specification do not sufficiently specify the subject matter now sought by claim 1. *In re Ruschig*, 379 F. 2d 990, 995 (CCPA 1967) (“It is an old custom in the woods to mark trails by making blaze marks on the trees. . .Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.”).

Originally filed claims 1, 5, 8, 9, 12, 16, and 19–21 are consistent with paragraphs 33 and 38–40 of the Specification in that they all permit contact with *any* portion of the projection during rail movement. There is no language in any of the originally filed claims, or elsewhere in the Specification, to indicate that contact between the bulb 66 and the vertical portion 78 alone, i.e., without contact between the bulb and a corner 76, *never* occurs during the rail’s movement between its minimum and maximum positions, as is *now* required by amended claim 1.

Conclusion

As noted above, ascertaining compliance with the written description requirement is a question of fact that must be determined on a case-by-case basis. Here, Appellant relies heavily on the language of paragraph 35 of the Specification read in isolation to argue the original disclosure supports the

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newly added limitation requiring “maintaining contact with [the] vertically extending portion and with at least one [corner].” The fact that the phrase of paragraph 35 in question could, at first blush, be interpreted by some as Appellant proposes may be *some* evidence to support Appellant’s position. However, all the other evidence before us, including the aspects of the Figures and Specification discussed above, taken together, outweighs any inclination that may be derived only from reading the phrase in question in isolation, and makes it more likely than not that Appellant’s disclosure does not adequately demonstrate to one skilled in the art Appellant had actual or constructive possession of the subject matter now claimed.

Appellant is the master of Appellant’s own application and, as such, was free to choose any language and supply any figures to satisfy the Written Description requirement of 35 U.S.C. § 112, first paragraph. By not clearly describing the subject matter now claimed, claim 1, in its present form, violates the Written Description requirement.

We designate this opinion as including a new ground of rejection

Although the Board addressed a very similar issue in the prior appeal, we recognize that the discussion there was brief and that portions of the Examiner’s analysis are not consistent with the previous decision or the decision here. Accordingly, to ensure Appellant has a fair opportunity to respond, the Board again designates this opinion as including a “new ground” of rejection under 37 C.F.R. § 41.50(b) so as to again afford Appellant the procedural options associated therewith.

DECISION

The Examiner's rejection is affirmed. We designate our affirmance as including a new ground of rejection.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed	New Ground
1-3, 6, 7, 10-14, 17, 18, 21, 22, 24, 25	112, first paragraph	Written description	1-3, 6, 7, 10-14, 17, 18, 21, 22, 24, 25		1-3, 6, 7, 10-14, 17, 18, 21, 22, 24, 25

FINALITY AND RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection

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and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)