The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE B. LOCKWOOD

Appeal No. 2005-2411
Application No. 08/418,772

ON BRIEF

Before HAIRSTON, KRASS and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

Decision On Appeal

This is a decision on appeal from the final rejection of claims 1-17.

The invention is directed to an automatic data processing system comprising a searchable mass storage and at least one user station. Each user station relies on sounds, video images, and textual display media to assist the user in the quest for

information and/or services. Data entered by the user is automatically processed with information already stored. The processing is said to be "according to forward-chaining sequences including analyzing said data in the system in order to formulate a more focused answer or an additional inquiry to be presented to the user" (principal brief-page 4). Thus, the system automatically analyzes and interprets stored data in combination with new queries and answers in order to lead the user down a more effective search path.

Representative independent claim 8 is reproduced as follows:

8. An automated multimedia system for data processing for delivering information on request to at least one user, which comprises:

at least one computerized station;

means for accepting and processing an user's entry according to backward-chaining and forward-chaining sequences, including:

means for analyzing and for combining a user's entry with a set of stored data, and means, responsive to said means for analyzing and for combining, for formulating a query and outputting said query to said user; and

means for delivering information to said user.

No references are relied on by the examiner.

Claims 1-17 stand rejected under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that there is a prior decision by this Board relating to the instant claimed subject matter. That decision, Appeal No. 1999-0393, rendered September 25, 2000, affirmed the examiner's decision regarding a rejection of claims 1-15 under 35 U.S.C. § 103 but reversed the examiner's decision anent a rejection of claims 8-17 under 35 U.S.C. § 112, first paragraph and a rejection of claims 16 and 17 under 35 U.S.C. § 103.[1]

The rejection under 35 U.S.C. § 112, first paragraph, in that decision involved the enablement clause of that statutory section, the examiner taking the position that the disclosure supported only claims which were limited to a system for processing a loan, and not claims directed to the broader "automated multimedia data processing system."

The issue before us in the instant case is whether there is an adequate written description for the claimed "according to backward-chaining and forward-chaining sequences."

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[1]That decision referred back to still an earlier decision in Appeal No. 1991-1232, rendered July 31, 1991.

The written description requirement is separate from the enablement requirement of 35 U.S.C. 112; it is not necessary that the claimed subject matter be described identically but that the originally filed disclosure convey to those skilled in the art that appellant had invented the subject matter now claimed. Precisely how close the original description must come to comply with the description requirement must be determined on a case by case basis as a question of fact. In re Barker, 194 USPQ 470 (CCPA 1977), cert den., sub. nom., Barker v. Parker, 197 USPQ 271 (1978); In re Wilder, 222 USPQ 369 (Fed. Cir. 1984), cert den., sub. nom.; Wilder v. Mossinghoff, 105 S. Ct. 1173 (1985).

At page 4 of our decision of September 25, 2000, we noted that it was not clear whether the examiner was maintaining a rejection of claims based on the written description section of 35 U.S.C. § 112, but that, in any event, we would not sustain such a rejection because the examiner provided no reason for finding the disclosure deficient. However, the claimed "according to backward-chaining and forward-chaining sequences" was not one of the issues, regarding any rejection based on the first paragraph of 35 U.S.C. § 112, in our decision of September 25, 2000.

This cited portion of the claims was referred to by us, at pages 4-5, of that decision, but it was in reference to a rejection of claims 16 and 17 under 35 U.S.C. § 103. We indicated therein that we could not sustain the rejection under 35 U.S.C. § 103, but we noted that "according to backward-chaining and forward-chaining sequences" did not appear to be part of the original disclosure and that, perhaps, there might be an issue with regard to the written description requirement of 35 U.S.C. § 112.

With this as a background, the examiner deemed it wise to initiate a rejection of the instant claims under 35 U.S.C. § 112, first paragraph, based on an inadequate written description to support the claimed "according to backward-chaining and forward-chaining sequences," bringing us to the present issue.

Appellant asserts that there are two issues to be resolved, the first being whether it was proper for the examiner to apply this new rejection after the initial rejection was not sustained by the Board, and the second going to the merits of whether claims 1-17 do, in fact, contain subject matter which was not described in the specification.

As to the first issue, we do not agree with appellant as the examiner was well within her rights to make the rejection.

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