



IN RE PAUL LEW and JASON SCHIERS

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2007-1196 DECIDED: November 29, 2007

JUDGES: Before NEWMAN, GAJARSA, and LINN

OPINION BY: GAJARSA

Procedural Posture:

Paul Lew and Jason Schiers (collectively “Lew”) appealed a decision of the BPAI (“Board”) sustaining a final rejection of claim 19 of Patent Application No. 10/658,143 (“the ‘143 application”).

Overview:

Is your firm doing all it can to support broad patent protection? Applicant Paul Lew was denied patent protection for a “curved member” for lack of specification support. Applicant Lew argued that the original specification disclosed “ball bearings,” which are inherently curved. However, the Court of Appeals for the Federal Circuit was not persuaded by the Applicant’s argument, reasoning that the phrase “curved member” was broader than the phrase “ball bearings” and, therefore, not supported thereby. Patent practitioners must draft disclosures in the broadest terms possible – narrow specificity should remain in the dependent claims.

Facts:

- The ‘143 application relates to a “wheel hub with clutch,” primarily intended for bicycles, which allows the wheel connected to the hub to “free wheel” when no torque is applied (e.g., the bicyclist is not pedaling), but which nearly instantly engages when torque is applied (e.g., the bicyclist is pedaling). According to Lew’s original specification, this torque transfer is facilitated “through a multitude of ball bearings.”
- During prosecution, Lew deleted all the original claims 1-18 and added a new claim 19 and submitted a substitute specification to overcome a statutory double patenting rejection. The substitute specification was substantially the same as the original specification, except that the term “ball bearings” was replaced with “curved members,” and the term “pockets” were replaced with “slots.” Notably, the term “curved members” was not previously used anywhere in the application. The Examiner concluded that the amendments introduced new matter into the

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application that was not supported by the initial disclosure. Lew argued that, because a “ball bearing” is inherently a curved object, he was entitled to claim the entire broader category of “curved objects.”

Issue: Whether the disclosure of only “ball bearings” in the original ‘143 application is sufficient for a person of ordinary skill in the art to have determined that Lew was in possession, as of the initial filing date, of using any “curved member” in place of the ball bearing.

Held: The Federal Circuit affirmed the decision, finding that substantial evidence supported the Board’s determination that Lew’s amendments to replace the term “ball bearing” with the broader term “curved member” were not supported by the initial disclosure.

Analysis: There was no language in the original written description that would suggest that using “ball bearings” was only one specific embodiment of Lew’s invention. Each time the phrase “the invention” was described, including in the summary of the invention and the abstract, the invention was stated to include “ball bearings.” The court viewed such language as “strong evidence” that the inventor intended his invention to be limited to embodiments containing such an element.

Under 35 U.S.C. §132 (no new matter) and §112 1st paragraph (written description requirement), a new claim or other amendments to a specification after the original filing date must find support in the original specification. The Federal Circuit reiterated the long-held rule that an application is required to “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.”

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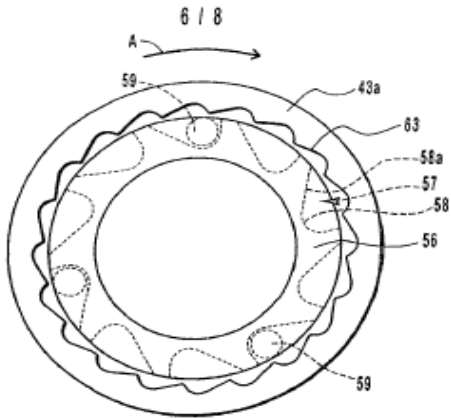


FIG. 6A

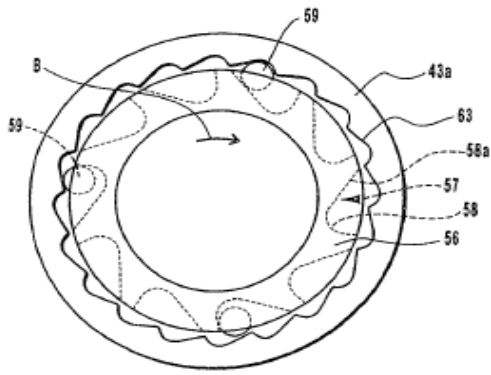


FIG. 6B