

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUFUMI OGAWA, NORIHISA MINO and MAMORU SOGA

Appeal No. 95-4065
Application No. 07/872,185¹

HEARD: March 9, 1999

Before SOFOCLEOUS, WALTZ, and SPIEGEL, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 8, 9 and 22, which are all of the claims remaining in this application.

According to appellants, the invention is directed to a chemically adsorbed monomolecular film having a siloxane-based

¹ Application for patent filed April 22, 1992.

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The Answer refers to Paper No. 16, dated Nov. 26, 1993, for the statement of the rejection (Answer, page 3). The examiner's rejection of claims 8, 9 and 22 under the first paragraph of § 112 is for "failing to provide an adequate written description of the invention" (Paragraph 15, page 2, see also paragraph 16, page 3, of Paper No. 16). Immediately following this reason for the rejection the examiner states that "[i]t is not clear from the enabling description ..." (Paragraph 15, page 2, Paper No. 16, emphasis added).

As our reviewing Court has stated in *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), "...we hereby reaffirm, that 35 U.S.C. 112, first paragraph, requires a 'written description of the invention' which is separate and distinct from the enablement requirement." The examiner's rejection states that appellants have failed "to provide an adequate written description" (Paragraph 15, page 2, Paper No. 16) but sets forth reasoning for a lack of enablement rejection (*Id.* at pages 2-3). Since the basis for the rejection is unclear, we will discuss both

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the written description and enablement requirements with regard to the examiner's rejection.

WRITTEN DESCRIPTION

To meet the written description requirement of § 112, appellants must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, appellants were in possession of the invention as now claimed. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1117. In rejecting a claim under the first paragraph of § 112, it is incumbent upon the examiner to establish by evidence or reasoning that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that appellants had possession of the now claimed subject matter. *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

In the record before us, the examiner has not presented any evidence or reasoning to establish that an artisan would not recognize in the application disclosure a description of the now claimed subject matter. The claimed subject matter is described almost verbatim in the disclosure at page 5, lines

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5-13. Accordingly, insofar as the examiner's rejection is based on appellants' failure to meet the written description requirement of § 112, first paragraph, we determine that the examiner has failed to meet the initial burden of establishing a lack of written description of the invention as now claimed and the examiner's rejection of claims 8, 9 and 22 is reversed.

LACK OF ENABLEMENT

"[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The burden of proof is set forth by the Court in *In re Wright, supra*:

to provided the the includes, of doubting any scope of the burden	When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as why it believes that the scope of protection by that claim is not adequately enabled by description of the invention provided in specification of the application; this course, providing sufficient reasons for assertions in the specification as to the enablement. If the PTO meets this burden, then shifts to the applicant to provide
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suitable proofs indicating that the specification is
indeed enabling. [citation omitted]

The examiner has stated that it is not clear "from the enabling description" why or how only one and not both of the reactive SiCl_3 end groups react with the reactive hydroxyl groups on the substrate surface (Paper No. 16, page 2, paragraph 15). The examiner has advanced a theory that both reactive end groups will bond to the substrate surface and form loops (Paper No. 16). As evidence in support of this theory, the examiner cites Yundt "which shows formation of monomolecular polysiloxane loops" (Answer, page 3).

On this record, we find that the examiner has failed to meet the initial burden of establishing lack of enablement. Yundt does not disclose or teach the use of SiCl_3 end groups in the formation of a monomolecular film on a substrate. Yundt is limited to flexible backbone long chain polymer units which can form loops (column 2, lines 42-50; column 4, lines 15-17, 35-37), e.g., chain polymers having a length of at least about 60 Angstroms (column 5, lines 42-61). Yundt discloses an example where, with certain chain lengths, the polymer forms chains which are bonded at only one end (Example

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3, column 10). Therefore Yundt does not provide any evidence to support the examiner's reasoning for doubting the assertions in the specification as to the scope of enablement. Furthermore, the examiner has only questioned the enabling disclosure for the formulas recited on page 2, paragraph 15, of Paper No. 16, and the scope of appealed claim 22 is not limited to these siloxane chains.

For the foregoing reasons, we determine that the examiner has failed to meet the initial burden of establishing a lack of enabling disclosure. Therefore we need not discuss the sufficiency of the two Ogawa Declarations under 37 CFR § 1.132 submitted by appellants. *See In re Wright, supra.*

Accordingly, insofar as the examiner's rejection under the first paragraph of § 112 is based on the enablement requirement, the examiner's rejection of claims 8, 9 and 22 is reversed.

The decision of the examiner is reversed.

REVERSED

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MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
CAROL A. SPIEGEL)	
Administrative Patent Judge)	

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BARRY E. BRETSCHNEIDER
MORRISON & FOERSTER LLP
2000 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, D.C. 20006-1888

Leticia

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APJ WALTZ

APJ SPIEGEL

APJ SOFOCLEOUS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: December 6, 1999

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT