

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID T. FLOYD

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Appeal No. 95-4477  
Application 08/006,350<sup>1</sup>

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ON BRIEF<sup>2</sup>

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Before: WILLIAM F. SMITH, Administrative Patent Judge, and  
McKELVEY, Senior Administrative Patent Judge and SCHAFER,  
Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

The appeal is from a decision of the Primary Examiner rejecting claims 1-14, 21 and 23-25. We vacate the examiner's rejection, and enter a new ground of rejection.

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<sup>1</sup> Application for patent filed January 19, 1993. The real party in interest is believed to be Th. Goldschmidt AG.

<sup>2</sup> Applicant requested oral argument. We are informed, however, that applicant orally waived oral argument during a telephone conversation with Administrator Amalia Santiago. Accordingly, the appeal is being decided on brief without oral argument.

**A. Findings of fact**

The record supports the following findings by a preponderance of the evidence.

The claims

1. Claims 1-14, 21<sup>3</sup> and 23-25 are on appeal.
2. Claim 1 reads as follows (some indentation and paragraph numbering added; portions in bold added by an amendment filed March 25, 1994 (Amendment B, Paper 6)):

Claim 1: A **cellulosic** nonwoven material comprising an organosilicone compound, the improvement which comprises that the organosilicone compound comprises<sup>[4]</sup>

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<sup>3</sup> In reproducing claim 21 in the Appendix to the Appeal Brief, applicant omitted the limitation "**provided the ratio of polysiloxanes A:B is between about >10:1 and 15:1.**" Although another error (the absence of the word "cellulosic") was noted by the examiner (Examiner's Answer, page 2), he did not note the absence of the portion in bold.

<sup>4</sup> The use of three "comprises" has complicated our efforts to understand the precise scope of claim 1. We fail to understand why claim 1 cannot be written in plainer English and, if there is further prosecution, we recommend that claim 1 be re-written to read: "In a combination of a cellulosic nonwoven material and a medium, the improvement wherein the medium comprises [A] \*\*\*."

[A] 45 to 98% by weight of a water soluble or water dispersible polyether polysiloxane A [containing ether groups and polysiloxane blocks<sup>5</sup>],

[1] the polyether groups of which consist of

[a] 30 to 100 mole percent of oxyethylene units,

[b] the remainder being oxypropylene units, and

[2] the polysiloxane block of which has 10 to 100 siloxane units;

[B] 1 to 20% by weight of a water soluble or water dispersible organopolysiloxane B with at least one ammonium group linked over a carbon atom; and

[C] 1 to 20% by weight of

[1] water or

[2] a water soluble alkylene glycol,

**provided the ratio of polysiloxanes A:B is between about >10:1 and 15:1.**

#### Object of the invention

3. An object of the invention is to make a "cellulosic nonwoven material" which is "soft" (specification, page 4).

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<sup>5</sup> There is no antecedent in claim 1 for the following two subsequent limitations which appear in claim 1: (1) "the polyether groups of which" and (2) "the polysiloxane block of which". If there is further prosecution, applicant may wish to amend the language "polyether polysiloxane A" to read "polyether polysiloxane A containing ether groups and polysiloxane blocks".

4. According to applicant, the cellulosic nonwoven material may be made soft when a "medium" is "sprayed, imprinted or printed on the nonwoven material" (specification, page 5).

5. The medium is said to contain at least

- a. a polysiloxane A,
- b. a polysiloxane B and
- c. a water soluble alkylene glycol.

(specification, page 5).

6. The medium preferably is dissolved in water before it is used (specification, 5).

7. Alternatively, polysiloxanes A and B may be used in "water or a water soluble alkylene glycol" (specification, page 11). According to applicant, the preferred alkylene glycol is "propylene glycol" (specification, page 11).

The examiner's rejection

8. The examiner has rejected all the claims as being unpatentable under 35 U.S.C. § 103(a) over

- a. Schaefer, U.S. Patent 4,921,895 (1990) and
- b. Ampulski, U.S. Patent 5,059,282 (1991).<sup>6</sup>

Schaefer

9. Schaefer describes woven, knitted and non-woven fabrics (col. 1, line 11).

10. One fabric described is a cotton/polyester knitted fabric.

11. Cotton is a cellulosic material.

12. According to Schaefer, the fabric is treated with a "medium" comprising (col. 2, lines 5-29):

- a. a polysiloxane described as polysiloxane A<sup>7</sup>  
(col. 3, lines 3-29);
- b. a polysiloxane described as polysiloxane B<sup>8</sup>  
(col. 3, lines 41 through col. 4, line 30);  
and
- c. water and/or a water-miscible organic  
solvent (col. 2, lines 28-29).

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<sup>6</sup> Both patents are prior art under 35 U.S.C. § 102(b).

<sup>7</sup> Polysiloxane A of Schaefer is apparently the same as, or very similar to, applicant's polysiloxane A.

<sup>8</sup> Polysiloxane B of Schaefer is apparently the same as, or very similar to, applicant's polysiloxane B.

13. A suitable water-miscible organic solvent would be 1,2-propylene glycol (col. 7, about line 47--see formulation 4).

14. According to Schaefer, the "weight ratio" of polysiloxane A to polysiloxane B is from 10:1 to 1:1 (col. 2, lines 7-9).

The basis in the specification for applicant's A:B ratio

15. In his first action, the examiner rejected claim 1 as being anticipated by Schaefer (Paper 4, pages 2-3).

16. In response to the examiner's anticipation rejection, the former practitioner for applicant<sup>9</sup> made two amendments to claim 1 (Amendment B, Paper 4).

a. A first amendment was addition of "cellulosic" before nonwoven.

b. A second amendment was addition of the language "provided the ratio of polysiloxanes A:B is between about >10:1 and 15:1."

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<sup>9</sup> The practitioner listed on the last page of this opinion was appointed after entry of the Examiner's Answer. All prosecution errors mentioned in this opinion are the responsibility of applicant's former practitioner--not the current counsel of record.

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17. In Amendment B, applicant states (page 2--which we note is not numbered):

Furthermore, the amended claims are directed to a mixture of modified organopolysilixanes [sic-- organopolysiloxanes] A & B in a weight ratio of A:B of >10:1 to 15:1. By contrast, the Schaefer patent is restricted to the ratio of from 10:1 to 1:1.<sup>[10]</sup>

18. At the time Amendment B was filed, applicant's former practitioner did not state the basis in the specification, as filed, for the A:B ratio inserted into claims 1 and 23.

19. The amendment was entered, but the examiner rejected the claims finding that "[t]he specification does not provide support for the claimed range of polysiloxanes A:B ratio (>10:1 - 15:1)." Accordingly, the examiner entered a rejection of the claims for failure to comply with the description requirement of the first paragraph of 35 U.S.C. § 112. See Final Rejection entered September 26, 1994 (Paper 9, page 2). The examiner also made an obviousness rejection based, inter alia, on the Schaefer patent.

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<sup>10</sup> Applicant's former practitioner's argument is totally disingenuous. It ignores the word "about" in the phrase "about >10:1" inserted into claim 1 by Amendment B.

20. In response to the examiner's rejection, applicant did not point to an explicit reference in the specification, as filed, to an A:B ratio of "about >10:1 to 15:1."

21. However, applicant stated (Amendment C, filed December 27, 1994, page 2)

On page 16 of the specification, the chart discloses a polysiloxane A:B ratio of as small as 4.3 (Formula 4) and as high as 19.25 (Formula 5). The claimed range of > 10:1<sup>[11]</sup> and 15:1 lies between the disclosed ranges and hence, the specification fully complies with the requirement of § 112 first paragraph. If the Examiner, however, has any other suggestions regarding the aforementioned, he is invited to offer the same.

22. In an Advisory Action (Paper 12), the examiner withdrew the § 112 rejection.

23. The examiner did not require, however, that applicant amend the specification to make reference to new A:B ratio. See 37 CFR § 1.75(d)(1).

24. There is a chart in the specification (page 16) describing "examples of the inventive medium \*\*\*". The chart,

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<sup>11</sup> We note that applicant's former practitioner again leaves out any reference to "about" with respect to the ratio >10:1.

which we believe is the chart to which applicant's former practitioner referred in Amendment C, is the following (to which has been added the A:B ratio of organopolysiloxane A to organopolysiloxane B (obtained by dividing the amount of A by the amount of B and rounding to the nearest unit)):

**Chart**

F O R M U L A								
I N G R E D I E N T S	1	2	3	4	5	6	7	8
Organopolysiloxane A	85	80	81	65	77	80	81	75
Organopolysiloxane B	5	10	7	15	4	5	5	10
Propylene glycol	10	5	10	20	15	10	8	5
Butylene glycol		5						5
Nonionic surfactant			2		1	3	4	
PA, PE Polysiloxane C					3			5
PA Polysiloxane D						2		
DA Polysiloxane E							2	
Ratio A:B	17	8	12	4	19	16	16	7

PA means polyalkyl  
 PE means polyether  
 DA means dialkoxy

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25. The chart demonstrates that only medium 3 has an organopolysiloxane A to polysiloxane B ratio within the claimed range of >10:1 to 15:1, i.e., an A:B range of 11.57, which when rounded to the nearest unit is 12.

26. Accordingly, it is not clear how applicant arrived at an A:B ratio of polysiloxane A to polysiloxane B of about >10:1 to 15:1. Nor is it entirely clear why applicant limited the upper range to 15:1, when the chart describes an A:B ratio of about 19:1.

## **B. Discussion**

### 1. New ground of rejection

A claim which contains a limitation not described in the specification is properly rejected for failure to comply with the description requirement of the first paragraph of 35 U.S.C. § 112. In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981) (the proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure is the first paragraph of § 112).

Guidance on evaluation of whether a claim added to an application after its filing date is set out by our appellate

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reviewing court in Eiselstein v. Frank, 52 F.3d 1035, 1038-39, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995):

"Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (quoting In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 623-24 (CCPA 1973)). In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. Id. at 1563, 19 USPQ2d at 1116; see In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("Lack of literal support . . . is not enough . . . to support a rejection under § 112."). The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.

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Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).  
"Precisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis."  
Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116.)

We have not been able to find anything in the specification, as filed, which expressly describes the now claimed A:B ratio of "about >10:1 to 15:1."<sup>12</sup> As Eiselstein v. Frank notes, however, subsequent claim language need not appear in the specification in exactly the same words. Under the precise facts of this case, however, we have not been able to find anything which would constitute a description of the ratio "about >10:1 to 15:1."

It is true, as applicant maintained in response to the final rejection, that "the claimed range of >10:1 and 15:1" falls within the A:B ratio of the formulations described in the chart on page 16 of the specification.

Applicant's argument is similar to an argument which was accepted by the CCPA in In re Wertheim, 541 F.2d 257, 265, 191

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<sup>12</sup> Applicant's former practitioner failed to explain how the limitation actually inserted in the claim avoided the A:B ratio of Schaefer.

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USPQ 90, 98 (CCPA 1976). Thus, "on the facts" (emphasis added) the Wertheim court found that a range of "between 35% to 60%" was described in a specification explicitly describing a range of 25% to 60%. However, the CCPA noted that it was not creating a per se rule: "[w]e wish to make it clear that we are not creating a rule applicable to all description requirement cases involving ranges." 541 F.2d at 264, 191 USPQ at 98. Rather, the CCPA noted (id.):

Where it is clear, for instance, that the broad described range pertains to a different invention than the narrower (and subsumed) claimed range, then the broader range does not describe the narrower range.

In support of its observation, the CCPA referred to In re Baird, 348 F.2d 974, 146 USPQ 579 (CCPA 1965). In Baird, the CCPA found that a claimed temperature range of "from about 40°F to at least as low as about 60°F" was not described by a range of "between 0°C and 80°C. (32°F and 176°F.)" and an example describing a temperature of 7°C (44.6°F). 348 F.2d at 982, 146 USPQ at 585. Baird had indicated that the lowest practical temperature was 40°F. Thus, in Baird, the new range

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was held to be directed to a different invention than the original range.

The same is true in the case before us. But for the newly added A:B range, applicant would not have been able to distinguish in any patentable sense (anticipation and/or obviousness) the claimed invention from that described by Schaefer.<sup>13</sup> Hence, applicant would have us believe that there is a patentable difference between the Schaefer range of 10:1 to 1:1 and his range of "about >10:1 to 15:1." Thus, applicant apparently believes that he described two separate inventions, possibly three separate inventions, in the specification, as filed, viz., (1) all A:B ratios which otherwise fall within the scope of claim 1, (2) an A:B ratio of about 4:1 to about 19:1 and (3) about >10:1 to about 19:1.

For the reasons given, we find that this case is more like Baird than it is like Wertheim. We also note that the "about >10:1 to 15:1" limitation appears in all the claims on appeal. Accordingly, we enter a new rejection of claims 1-14, 21 and 23-25, all the claims on appeal, pursuant 37 CFR

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<sup>13</sup> The Schaefer range of 10:1 to 1:1 describes a range which overlaps with the range of "about >10:1 to 15:1." The language >10:1 does not overlap with 10:1. However, addition of the language "about" broadens >10:1 which necessarily means "about >10:1 reads on 10:1."

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§ 1.196(b), on the ground that those claims fail to comply with the description requirement of the first paragraph of 35 U.S.C. § 112 with respect to the A:B ratio recited in claim 1.

We recognize that there is a rejection based on obviousness presented by the appeal. However, we are unable to determine the weight, if any, which applicant and the examiner gave to the limitation "about >10:1 to 15:1." The limitation is not mentioned in the Examiner's Answer and/or the argument portion of applicant's brief on appeal. Hence, we will vacate the examiner's § 103 rejection, without prejudice to the examiner making another rejection based, inter alia, on Schaefer, in the event applicant files an amendment in response to our new ground of rejection.<sup>14</sup>

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<sup>14</sup> We have noted several deficiencies in the brief on appeal (Paper 15) and the Examiner's Answer (Paper 16). It was not sufficient when the appeal brief was filed (37 CFR § 1.192(c)(6)(iv) (1994)), and it is not sufficient now (37 CFR § 1.192(c)(8)(iv) (1998)), to simply point out that a prior art reference does not describe all limitations. An applicant is further obligated to point out why the rejection is wrong and why the invention is patentable notwithstanding the failure of a reference to describe a particular limitation. Claims stand or fall together unless separate argument is presented indicating why a claim is considered to be patentable. Hence, in this case before us, had we reached the merits of the prior art rejection, all claims would have stood or fallen with claim 1. The examiner failed to appreciate the requirements of Rule 192. On his view of the rules, the examiner nevertheless failed to address various limitations, e.g., the claims calling for organopolysiloxanes C, D and E.

2. Statement under 37 CFR § 1.196(c)

The rules authorize the board to make a suggestion on how a rejection might be overcome. With respect to our new ground of rejection under 37 CFR § 1.196(b), we suggest that applicant may wish to consider the following claim, which if presented in place of current claim 1, would overcome our new ground of rejection and all of our other observations about the deficiency of claim 1:

Suggested claim: In a combination of a cellulosic nonwoven material and a medium, the improvement wherein the medium comprises:

[A] 45 to 98% by weight of a water soluble or water dispersible polyether polysiloxane A containing ether groups and polysiloxane blocks,

[1] the polyether groups of which consist of

[a] 30 to 100 mole percent of oxyethylene units,

[b] the remainder being oxypropylene units, and

[2] the polysiloxane block of which has 10 to 100 siloxane units;

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[B] 1 to 20% by weight of a water soluble or water dispersible organopolysiloxane B with at least one ammonium group linked over a carbon atom; and

[C] 1 to 20% by weight of

[1] water or

[2] a water soluble alkylene glycol,

provided the ratio of polysiloxanes A:B is between about 12:1 and about 19:1.

Descriptive support for "about 12:1" is medium 3 in the chart on page 16 of the specification. "About" has been included given that the actual A:B ratio of medium 3 is 11.57. Descriptive support for "about 19:1" is medium 5. "About" has been included given that the actual A:B ratio of medium 5 is 19.25.

Likewise, applicant should amend the specification to make reference to the A:B ratio. See 37 CFR § 1.75(d)(1).

### 3. Other observations

We regret that the Patent and Trademark Office did not earlier fully analyze whether the A:B ratio inserted into claim 1 was described in the specification, as filed.

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However, the fact is that the A:B ratio now claimed is not described in the specification, as filed. Unfortunately, a delay in finding a basis for unpatentability is not a ground on which claims in an application can, or should, be allowed.

In the course of our review of the application and the examiner's rejection, we have uncovered another matter which may warrant examination should applicant elect to respond to our new ground of rejection. On page 6 of the specification it is said that R<sup>2</sup> can be "an alkyl group with 1 to 12 carbon atoms or a polyether group  $(C_nH_{2n}O)_xR^3$ , wherein R<sup>3</sup> is hydrogen, hydroxyl, alkyl or acyl \*\*\*." When R<sup>3</sup> is hydroxy the terminal moiety on the R<sup>2</sup> would be a peroxy group, i.e., C<sub>n</sub>H<sub>2n</sub>O)OH. The examiner may wish to look into whether an enabling disclosure has been provided by applicant insofar as organopolysiloxane A can have a peroxy group.

### **C. Decision**

The decision of the examiner rejecting the claims as being unpatentable over the prior art is vacated.

All claims on appeal have been rejected, pursuant to 37 CFR § 1.196(b), for failure to comply with the written

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description requirement of the first paragraph of 35 U.S.C. § 112.

**D. Time for taking action**

This opinion contains a new ground of rejection pursuant to Rule 196(b) (37 CFR § 1.196(b), amended effective Dec. 1, 1997). See Notice of Final Rule, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), reprinted in 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)).

Rule 196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

Rule 196(b) also provides that the applicant, **WITHIN TWO MONTHS FROM THE DATE OF ENTRY OF THIS DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**VACATED**

(New grounds of rejection 37 CFR § 1.196(b))

_____	)	
WILLIAM F. SMITH,	)	
Administrative Patent Judge	)	
	)	
	)	
_____	)	
FRED E. McKELVEY, Senior	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
_____	)	
RICHARD E. SCHAFER,	)	
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