

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(2) is not binding precedent of the Board.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. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte WAYNE L. WORREL  
and KANG N. LEE

---

Appeal No. 1996-4058  
Application 07/837,619<sup>1</sup>

---

ON BRIEF

---

Before WARREN, WALTZ, and LIEBERMAN, Administrative Patent  
Judges.

LIEBERMAN, Administrative Patent Judge.

---

<sup>1</sup>Application for patent filed February 18, 1992.  
According to appellants, this application is a continuation of  
Application 07/641,314, filed January 14, 1991, now abandoned;  
which is a continuation of Application 07/247,413, filed  
September 21, 1988, now abandoned.

Appeal No. 1996-4058  
Application No. 07/837,619

#### **DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 13, 14, 24, 28 through 33, 36 through 38, 42, 47 and 48, and refusing to allow claims 49 through 54 as amended subsequent to the final rejection which are all the claims in the application.

#### **THE INVENTION**

The invention is directed to rhenium and iridium alloys comprising silicon and aluminum wherein the alloy is resistant to oxidation at 1550EC. Other embodiments include methods for fabricating a shaped body and shaped bodies resulting therefrom containing the aforesaid alloys.

#### **THE CLAIMS**

Claim 47 is illustrative of appellants' invention and is reproduced below.

47. An alloy comprising:

rhenium;

from about 20 to about 40 atomic percent silicon; and

from about 20 to about 50 atomic percent aluminum;

said alloy being resistant to oxidation at 1550EC.

Appeal No. 1996-4058  
Application No. 07/837,619

#### **THE REJECTION**

Claims 13, 14, 24, 28 through 33, 36 through 38, 42, and 47 through 54 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not support the invention as now claimed.

#### **OPINION**

As an initial matter, appellants' Brief contains a statement that the appealed claims stand or fall together. See Brief, page 4. As each of the independent claims before us contain the limitation, "said alloy being resistant to oxidation at 1550EC," we select claim 47, an independent alloy claim, as representative of appellants' invention and limit our consideration to said claim. 37 CFR § 1.192(c)(5)(1993).

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, we will not sustain the rejection.

Appellants amended their claims by inserting the phrase, "said alloy being resistant to oxidation at 1550EC." See the Amendment executed May 16, 1994 and filed May 20, 1994 wherein

Appeal No. 1996-4058  
Application No. 07/837,619

each of the independent claims, now before us, contains the above terminology.

While the examiner has premised his rejection of the appealed claims on the basis that the specification as originally filed, does not provide "support" for the invention as now claimed in that there is no positive statement that the claimed alloys are oxidation resistant at 1550EC, it is apparent to us that the sole rejection before us is based upon the written description requirement of § 112, first paragraph. See, Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991); In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 99 (CCPA 1976). In order to make out a *prima facie* case of failure of the claims to comply with this section of the statute, the examiner must set forth "evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." In re Alton, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996), quoting Wertheim, 541 F.2d at 263, 191 USPQ at 97. The only contentions advanced by the examiner in support of his position that the claimed subject matter lacks "support" are lack of a "positive statement," Final

Appeal No. 1996-4058  
Application No. 07/837,619

Rejection, page 2, and lack of "enough data to support the claimed invention," Final Rejection, page 3, line 1.

With respect to the examiner's first contention, it has long been settled that the examiner must provide "reasons why a description not in *ipsis verbis* is insufficient." Wertheim, 541 F.2d at 265, 191 USPQ at 98. Accordingly, the examiner's finding that the term "said alloy being resistant to oxidation at 1550°C" is not *per se* found in the specification" is insufficient to support the rejection. Moreover, we find basis for the terminology in the specification at page 1, lines 6-9, Example 1, and page 12, lines 1-4. The specification at page 1 states that "[the] invention relates to materials which melt only at very high temperatures and, more specifically, to alloys which melt only at high temperatures and exhibit improved resistance to oxidation at such temperatures." Similarly at page 12 of the specification, it is concluded that "[a]s can be seen in the foregoing examples, the alloys of this invention are structurally stable at high temperatures and exhibit remarkably good resistance to harshly oxidizing environments." The aforesaid statement refers to each of the examples wherein

Appeal No. 1996-4058  
Application No. 07/837,619

a specimen "was exposed to 1.0 atmosphere oxygen at 1550EC."  
These excerpts provide ample basis for "said alloy being  
resistant to oxidation at 1550EC," at issue before us. Based  
on our considerations, we further find ourselves in agreement  
with appellants for reasons advanced in their Brief that one  
skilled in the art would have recognized in the original  
patent specification a disclosure of the now claimed subject  
matter. See Brief, page 5.

Accordingly, we find that the examiner has failed to  
establish by evidence or reason that the appealed claims do  
not comply with § 112, written description requirement,  
because one of ordinary skill in this art would have  
recognized in the disclosure a description of the alloys  
encompassed by the appealed claims through the use of the  
term, "said alloy being resistant to oxidation at 1550EC."

Appeal No. 1996-4058  
Application No. 07/837,619

**DECISION**

The rejection of claims 13, 14, 24, 28 through 33, 36 through 38, 42, and 47 through 54 under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not support the invention as now claimed is reversed.

The decision of the examiner is reversed.

**REVERSED**

	)	
Charles F. Warren	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Thomas A. Waltz	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	

Appeal No. 1996-4058  
Application No. 07/837,619

Paul Lieberman )  
Administrative Patent Judge )

WOODCOCK WASHBURN KURTZ  
MACKIEWICZ & NORRIS  
One Liberty Place - 46th Floor  
Philadelphia, PA 19103