

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANSPETER HAUSER,
WERNER H. GERBER,
ABUL IQBAL and PIERRE MAURER

Appeal No. 97-0840
Application 08/159,405¹

ON BRIEF

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

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the examiner's final rejection of claims 2 through 9, which are the only claims remaining in this application.

Appellants' invention is directed to a method of producing forgery-proof colored printed articles which cannot

¹ Application for patent filed November 30, 1993.

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be reproduced in their true colors using color copiers (Brief, page 2). According to appellants, the method comprises formulating a printing ink from a single dye or a mixture of at least two dyes so that the formulation results in the greatest degree of metamerism between the formulated printing ink and a reference ink on the basis of two defined types of illumination (*Id.* at page 3). Independent claim 5 is illustrative of the subject matter on appeal and is reproduced below:

5. A method of producing a colored printed article which is clearly visually different from color copies produced therefrom, which method comprises the steps of

- a) formulating a printing ink from a single dye or a mixture of at least two dyes so that the formulation results in the greatest possible degree of metamerism between the formulated printing ink and a reference ink on the basis of two defined types of illumination, which reference ink is of a type typically used in color copiers; and
- b) printing at least one characteristic area of said article with said formulated printing ink.

Claims 2 through 9 stand rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite and incomplete."

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(Answer, page 2).² We reverse this rejection for reasons which follow.

OPINION

The examiner's rejection of claims 2-9 "as being indefinite and incomplete" states that the "claims are considered to recite a process by only describing the desired effect wanted, i.e. using a [sic, an] ink formulated to result in the greatest possible degree of metamerism between a reference ink and the formulated ink." (Answer, page 2). The examiner further states that there are no parameters of how the ink is formulated and it would take an "inventive step" to formulate the ink and determine that the ink has the "greatest possible degree of metamerism" from the reference ink (*Id.*).

² The examiner's Answer does not specify what paragraph of § 112 is relied upon as the statutory basis for the rejection (see the Answer, page 2). Since no new ground of rejection has been made in the Answer (Answer, page 2, paragraph (12)) and the final rejection contains only a rejection of claims 2-9 under § 112, paragraph two, we consider the rejection in the Answer as based on paragraph two of § 112. However, note our discussion of 35 U.S.C. § 112, first paragraph, *infra*.

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Therefore the examiner concludes that the claims are
"incomplete and indefinite" (*Id.*).

"The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The definiteness of language employed in a claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and the particular specification disclosure. *In re Angstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976).

The cited prior art attached to appellants' brief, as well as previously cited British Patent No. 1 407 065 to Beck, clearly shows the determination and calculation of various degrees of metamerism. Appellants' specification, at pages 2-6 (see the Brief, pages 5-7), describes in detail how the printing ink with the desired properties is formulated. The burden is on the examiner to show why one of ordinary skill in the art would *not* be apprised of the scope of the claims on appeal. *See generally In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We determine that the examiner has not met this burden by failing to show why one of

ordinary skill in the art, in light of the knowledge in the art and appellants' specification, would not be apprised of the scope of the claims on appeal.

The language of the examiner's rejection is couched in terms more suitable for a rejection under the first paragraph of § 112, for lack of enablement (e.g., "inventive step", "how to determine", "how the ink is formulated", see the Answer, page 2).³ However, if the rejection was meant to be under the first paragraph of § 112, the examiner bears the initial burden of setting forth a "reasonable explanation as to why [the examiner] believes that the scope of protection provided by that claim is not adequately enabled" by the specification disclosure, i.e., "providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). This reasoning usually would include a discussion of the factors showing that "undue experimentation" is required to make and use the full scope of

³ Note also that appellants' Brief presents arguments regarding "undue experimentation" which falls in under the requirements of the first paragraph of § 112 (Brief, pages 4 and 5). A claim may be definite even if it is so broad that the enabling disclosure is not commensurate in scope with the subject matter encompassed by the claims. *In re Ehrreich*, 590 F.2d 902, 906-07, 200 USPQ 504, 508 (CCPA 1979).

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the claimed invention. *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Therefore, even assuming that the examiner's rejection was based on lack of enablement under the first paragraph of § 112, the examiner has provided no reasoning to support the rejection and thus fails to meet the initial burden of proof.

For the foregoing reasons, the examiner's rejection of claims 2 through 9 under the second paragraph of 35 U.S.C. § 112 is reversed.

The decision of the examiner is reversed.

REVERSED

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CHUNG K. PAK)	
Administrative Patent Judge)	
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THOMAS A. WALTZ)	
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CAROL A. SPIEGEL)	
Administrative Patent Judge)	

TAW/kis

CIBA SPECIALTY CHEMICALS
CORPORATION
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005

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