

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLLI P. TUOMINEN, CAROL W. MORGAN,
DOMINICK A. BURLONE, and KEITH V. BLANKENSHIP

Appeal No. 1997-4287
Application No. 08/275,864

ON BRIEF

Before KIMLIN, GARRIS, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 8, 10 and 11 which are all of the claims pending in the application.

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The subject matter on appeal relates to a process for dry spinning filaments which contain potentially superconducting material. The process comprises extruding a solution of polymer and a suspension of potentially superconducting powder particles from a spinneret as bicomponent filaments wherein, prior to the extruding, the suspension is forced through a hyperbolic spinning capillary thereby mechanically aligning particles of the potentially superconducting powder along an axis of electrical conduction. Further details of this appealed subject matter are set forth in representative independent claim 1 which reads as follows:

1. A process for dry spinning filaments which contain potentially superconducting material, the process comprising:

preparing a suspension of potentially superconducting powder, particles of which have a length to diameter ratio above 1, in a thickened solvent;

preparing a solution of fiber-forming polymer;

supplying the suspension and the solution to a spinning apparatus;

in the spinning apparatus, arranging the solution and the suspension in a bicomponent arrangement;

extruding the arranged solution and suspension from a spinneret as bicomponent filaments;

in the spinning apparatus and prior to said extruding, forcing the suspension through a hyperbolic spinning capillary

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thereby mechanically aligning particles of the potentially superconducting powder along an axis of electrical conduction; and

removing the solvent from the bicomponent filaments.
The references relied upon by the examiner as evidence of

obviousness are:

Johnson	4,988,671	Jan. 29, 1991
Kloucek	5,037,801	Aug. 6, 1991

All of the appealed claims stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

All of the appealed claims also stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a disclosure which would not enable practice of the here claimed invention.

Finally, all of the appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Kloucek.

We cannot sustain any of the above noted rejections.

Concerning the section 112, second paragraph, rejection, the examiner contends that "[t]he claims are indefinite in that claim 1 recites that the powder or particles are aligned

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. . . [whereas] it is not clear as to what is meant by aligned" (answer, page 4). Like the appellants, we perceive no merit in the examiner's position. When the criticized claim language is analyzed in light of the appellants' disclosure (e.g., see page 11 of the specification and Figure 3 of the drawing) as it must be (In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971)), there is ample basis for concluding that the bounds of the here claimed subject matter are distinct. In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975).

Under these circumstances, we cannot sustain the examiner's section 112, second paragraph, rejection of the appealed claims.

As for the section 112, first paragraph, rejection, it is the examiner's position that "the [appellants'] disclosure is enabling only for claims limited to particles having a particular shape and crystal structure oriented with respect to said shape" (answer, page 4). It is well settled that it is the examiner's burden to advance acceptable reasoning inconsistent with enablement (as correctly observed by the appellants in their brief). In re Strahilevitz, 668 F.2d

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1229, 1232, 212 USPQ 561, 563 (CCPA 1982). On the record of this appeal, the examiner has provided no acceptable reasoning and no evidence at all which supports his aforementioned enablement viewpoint.

It follows that we also cannot sustain the examiner's section 112, first paragraph, rejection of the appealed claims.

The pivotal consideration in assessing the propriety of the section 103 rejection before us relates to whether the examiner has properly interpreted the "bicomponent filaments" feature of independent claim 1 and the "sheath around a core" feature of separately argued dependent claims 6 through 8. As a consequence, it is appropriate to emphasize that in proceedings before the Patent and Trademark Office, claims in an application are to be given their broadest reasonable interpretation consistent with the specification and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). As thoroughly explained by the appellants in their brief, the examiner's interpretation of the previously

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mentioned claim features is not reasonable and is not consistent with the subject specification (e.g., see lines 3 and 4 on specification page 3). Likewise, the claim language under review would not be interpreted by one of ordinary skill in the art in the manner urged by the examiner as evinced, for example, by the "Dictionary of Fiber & Textile Technology" copy which is attached to the appellants' brief as Appendix B.

Because the record before us plainly reveals that the examiner's claim interpretation is improper, we cannot sustain his section 103 rejection of the appealed claims as being unpatentable over Johnson in view of Kloucek.

The decision of the examiner is reversed.

REVERSED

	Edward C. Kimlin)	
	Administrative Patent Judge)	
)	
)	
)	
	Bradley R. Garris)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Beverly A. Pawlikowski))
	Administrative Patent Judge)	

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BRG:tdl

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