

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESTER CORNELIUS

Appeal No. 2003-0757
Application No. 09/849,884

ON BRIEF

Before GARRIS, WALTZ, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellant has submitted a Request for Rehearing dated July 22, 2003, Paper No. 21 (hereafter the "Request"). Appellant requests a rehearing under 37 CFR § 1.197(b) of our decision dated June 26, 2003, Paper No. 20 (hereafter the "Decision"). In the Decision, we affirmed the examiner's rejection of claims 9 through 13, the only claims remaining in this application, under the first paragraph of 35 U.S.C. § 112, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

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the inventor(s), at the time the application was filed, had possession of the claimed invention" (Decision, page 3).

Appellant requests rehearing based on several issues. First, appellant submits that the Board has a "problem" with the definition of "concentration" and "approximately" (Request, page 1). Appellant argues that these are "dictionary defined words" that are readily understood (Request, paragraph bridging pages 1-2). Appellant requests the Board to indicate whether or not it understands the terms "approximate" and "concentration" (Request, sentence bridging pages 3-4).

Appellant's arguments are not well taken. The question is not whether this merits panel of the Board has a "problem" with the claimed words "approximately" and "concentration" but whether appellant's specification, at the time the application was filed, would have reasonably conveyed to one of ordinary skill in this art that appellant was in possession of the subject matter in question. See *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The subject matter in question includes the words "approximately" and "concentration" since the examiner questions the original support or written description for the claimed phrase "and a second layer overlying said first layer having an ultraviolet absorber of approximately one-fifth the

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concentration of the ultraviolet absorber in said first layer” (see claim 9; the Answer, page 4; and the Decision, paragraph bridging pages 3-4).

Appellant only relies on the Examples as support for the subject matter in question (Brief, page 4; Decision, page 4). Example 2, as pointed out by the examiner, discloses the same amount of the ultraviolet absorber in the inner and outer layer, and therefore fails to provide basis or support for the claimed one-fifth ratio (Answer, page 3; specification, pages 10-12). Calculations for Example 3, as also pointed out by the examiner, cannot be determined due to lack of disclosure regarding the amount of solvent in the polysiloxane SHC 4000 (Decision, page 6). Accordingly, appellant's alleged support for the subject matter in question is only based on Example 1, where the amount of ultraviolet absorber in the outer coating is in the ratio of 0.187 of the concentration of the ultraviolet absorber in the inner coating, if we assume that “concentration” is based on solids amount (i.e., 1.5 parts/8% based on solids = 0.187). However, the subject matter in question is the ratio “approximately one-fifth” (0.2) of the concentration. Thus, even assuming *arguendo* that appellant is correct regarding calculations for the “concentration,” we determine that appellant

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has not reasonably conveyed to one of ordinary skill in this art that he was in possession of the claimed phrase where the amount of ultraviolet absorber in the second layer was "approximately one-fifth" the amount in the first layer. As noted in our Decision (page 5), the examiner has met his initial burden and the burden has now shifted to appellant. Appellant has failed to establish that the Example(s) of the specification, directed to a ratio of 0.187, reasonably convey to one of ordinary skill in this art that appellant was in possession of ratios both closely above and below 0.2, i.e., "approximately one-fifth."

Additionally, as noted by the examiner (Answer, pages 3 and 6; Decision, pages 5-6), appellant has not established what the claimed word "concentration" means, i.e., does "concentration" refer to parts per 100 total parts or parts per parts of solids. In other words, are the solvents included in the calculations of "concentration"? Appellant states that *his* calculations do not include the presence or absence of a solvent (Request, page 2) but the examiner presents different calculations based on the amount of solids (Answer, pages 3 and 6). Thus, even knowing that "concentration" means "strength or density" (Request, sentence bridging pages 1-2), the examiner has established that this term could be calculated by at least two methods. Contrary

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to appellant's request for the Board to indicate why it considers the ratio calculation must include the presence of a solvent (Request, page 4), we determine that the ratio calculation may be calculated in the presence or absence of a solvent, thus yielding two different ratios. The specific basis for any calculations has not been established in the original disclosure.

Appellant submits that on page 6 of the Decision the Board states that different thicknesses of the two layers could produce varying required concentrations of absorbers different than the claimed one-fifth ratio (Request, page 2). Appellant argues that such concentrations would be outside the scope of the invention as presently claimed and the Board's conclusion is entirely speculative (Request, page 3). Appellant also argues that the Board has misconstrued the invention as applying to broad classes of absorbers (*id.*).

Appellant's arguments are not persuasive. This merits panel of the Board is not speculating on ratios of absorbers that would be operative. The Decision was merely establishing that appellant's support for the claimed ratio was limited to examples which are directed to specific ultraviolet absorbers with a specific film thickness (Decision, page 6). Example 1 on page 10 of the specification is limited to Tinuvin 328 as the ultraviolet

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absorber in both layers while the inner coating is 9-10 microns in thickness and the outer coating is limited to a 3-4 micron coating thickness. These limitations are not found in the claims on appeal. Appellant has not established that the concentration of absorber used in Example 1 could be interpolated or predicted by one of ordinary skill in this art to support the scope of the claims on appeal. As noted in the Decision (page 7), appellant discloses that common classes of ultraviolet absorbers are benzophenones and benzotriazoles (specification, page 2, ll. 16-18) while we note that Example 1 is limited to Tinuvin 328.

For the foregoing reasons, we have considered appellant's Request but we do not find in the Request any argument convincing us of error in the conclusions reached in our Decision. Accordingly, appellant's Request for Rehearing is denied.

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

DENIED

Bradley R. Garris)	
Administrative Patent Judge)	
)	
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)	
)	BOARD OF PATENT
Thomas A. Waltz)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
Jeffrey T. Smith)	
Administrative Patent Judge)	

TAW/tdl

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