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 AFSHIN FALSAFI, MARK S. KONINGS,
JOEL D. OXMAN, RICHARD P. RUSIN,
and EDWARD J. WINTERS

Appeal No. 2003-1755
Application No. 09/838,950

ON BRIEF

Before WARREN, TIMM, and DELMENDO, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Claims 1-24 are pending in the application. Claims 1-6, 9, 11, and 14-21 have been allowed by the Examiner. Claims 22-24 have been withdrawn from consideration as being directed to a non-elected invention. The only claims which remain subject to rejection and thus, subject to appeal, are claims 7, 8, 10, 12, and 13. The sole remaining basis for rejection of these

claims is under 35 U.S.C. § 112, ¶ 1 for lack of enablement.[1] We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We reverse.

OPINION

Claim 1 is directed to a dental composition and each of the rejected claims places a further limit on the composition of claim 1. Claim 1 reads as follows:

> 1. A dental composition comprising:
>
> (a) a part A comprising discrete, solid particles of a polymer comprising acid functionality dispersed in a polymerizable component; and
>
> (b) a part B comprising water;
>
> wherein the composition further comprises an oxidizing agent, a reducing agent, and a reactive filler in at least one of part A and part B.

The further limits at issue in the rejected claims are in the form of concentration ranges for particular components of the dental composition of claim 1. Claim 7 is illustrative:

> 7. The dental composition of claim 1 comprising about 5 to about 75 parts polymerizable component, based on the total weight of the composition.

What the Examiner focuses on is the "about" before the upper limit of the range in each of the rejected claims. This "about" was not present in the original claims. For instance, claim 7, which previously read "about 5 to 75 parts" now reads "about 5 to *about* 75 parts" (emphasis

[1]The rejections maintained in the Final Rejection, but not reproduced in the Answer are treated as having been withdrawn by the Examiner.

added). The specification, like the initial claims, uses only the initial "about" when discussing concentration ranges for the composition components. The Examiner's rejection is on the basis that insertion of "about" broadened the ranges in a manner such that one of ordinary skill in the art would not be enabled to make and use the full scope of the dental composition of the claims. The entirety of the Examiner's rejection is as follows:

> Claims 7, 8, 10, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "about" the lower limit of the claims, does not reasonably provide enablement for "about" the upper limit of the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Extending the claimed range beyond the range described in the specification is not enabling and is new matter.

(Answer, pp. 3-4).

We cannot say that the Examiner has met the required burden of proof for a rejection based on lack of enablement. To meet the burden of proof, the Examiner must advance acceptable reasoning inconsistent with enablement. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). The Examiner has not met that burden.

First, the addition of "about" in claims 8, 12, and 13 does not extend the claimed range beyond what is described in the specification, the claimed ranges are entirely within a broader disclosure of concentrations set forth in the specification. For instance, the range of claim 12, i.e., "about 25 to about 65 parts reactive filler," is completely within the broader range of "less than about 90%" set forth in the specification (p. 7, l. 11). Moreover, the range of claim 13, i.e.,

"about 0.05 about 3.0 parts" is completely within the broad range of about 0.05 to 5 parts recited in the specification (specification, p. 9, ll. 1-2). With respect to claim 8 and, additionally, claim 13, the useful concentrations of oxidizing and reducing agents are discussed in the specification in a broad manner (specification, p. 8, ll. 30-32) and the ranges are only example ranges (specification, p. 8, l. 32 to p. 9, l. 3). The first paragraph of § 112 requires nothing more than objective enablement. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The general discussions and wider ranges provide objective enablement for the claimed ranges. Therefore, the burden is on the examiner to provide sufficient reasons for doubting any assertions in the specification as to the scope of enablement. No such convincing reasons are advanced on this record.

With respect to those claims with no corresponding broader disclosure in the specification, there may be times when a slight difference in scope will support a rejection for lack of enablement, but this is not such a case. The claims are directed to a dental composition and nothing in the specification indicates that minor differences in concentration render the composition unsuitable. The Examiner simply has provided no basis for the conclusion that one of ordinary skill in the art would not have been able to make the dental compositions at the slightly higher levels of the claims, if, indeed, the upper levels are outside the ranges discussed in the specification.

It is also reasonable to read the specification as using "about" to modify both the lower and upper ends of the ranges in recitations such as "about 5 to 75 parts." After all, "parts" would

apply to both the lower and upper ends of the ranges even though it is only present at the end of the phrase: That is basic grammar. Likewise, “about” reasonably applies to both endpoints. In such an interpretation, there is no difference in scope between “about X to Y parts” and “about X to about Y parts.” The Examiner provides no evidence that one of ordinary skill in the art would not read the specification in accordance with commonly understood English grammar. Note that claims as well must be so read. *See In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir.1983) ("A claim must be read in accordance with the precepts of English grammar.").

We also find the reference to “new matter” in the context of the rejection for lack of enablement confusing. The Examiner fails to explain how this discussion of “new matter” applies to the rejection for lack of enablement. Nor, since the reference to “new matter” is contained in the enablement rejection, has the Examiner provided the Appellants with proper notice that a rejection on the basis of new matter is being maintained. We, therefore, will not address this issue.

We conclude that the Examiner has failed to establish a *prima facie* case of lack of enablement with respect to the subject matter of claims.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 7, 8, 10, 12, and 13 under 35 U.S.C. § 112, ¶ 1 is reversed.

REVERSED

CHARLES F. WARREN Administrative Patent Judge	)
CATHERINE TIMM Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ROMULO H. DELMENDO Administrative Patent Judge	)

CT/dpv

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