

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG BRAUER, WOLFGANG KAUFHOLD,
FRIEDEMANN MULLER, JURGEN WINKLER, HERBERT HEIDINGSFELD,
WOLFGANG ROHRIG, and HANS-GEORG HOPPE

Appeal No. 2005-0020
Application No. 09/572,225

ON BRIEF

Before KRATZ, TIMM, and DELMENDO, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-9, which are all of the claims pending in this application.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The invention relates to a process for the continuous preparation of thermoplastically processable polyurethanes in a tubular mixer (stirred tubular reactor)(specification, p. 1, ll. 4-5 and p. 2, ll. 22-24). In the process, specified reactants are reacted in a tubular reactor equipped with a stirrer. The stirrer is a monoaxially rotating stirrer having as mixing elements a member selected from the group consisting of beams, rods, anchors, grids, blades and propellers.

Claim 1 is illustrative:

1. A continuous process for the preparation of thermoplastic, homogeneous polyurethane having improved softening properties comprising reacting substantially to completion, in a tubular reactor equipped with a stirrer at least one diisocyanate (A) with a mixture (B) containing

B1) 1 to 85 equivalent %, based on the isocyanate groups in (A) of at least one compound having on average at least 1.8 and at most 2.2 Zerewitinoff-active hydrogen atoms per molecule and a number average molecular weight of 450 to 5000 g/mol, and

B2) 15 to 99 equivalent %, based on the isocyanate groups in (A) of at least one chain lengthening agent having on average at least 1.8 and at most 2.2 Zerewitinoff-active hydrogen atoms per molecule and a molecular weight of 60 to 400 g/mol,

wherein (A) and (B) are employed in a NCO:OH ratio of 0.9:1 to 1.1:1, said tubular reactor characterized in the absence of positively controlled conveyance therefrom and in that the ratio between the circumferential speed of said stirrer expressed in terms of meter/second and the throughput expressed in terms of g/second is greater than 0.03 meter/g, said reacting substantially to completion amounting to conversion greater than 90%, based on starting component (A) the said absence of positively controlled conveyance restricting said stirrer to a monoaxially rotating stirrer having as mixing elements a member selected from the group consisting of beams, rods, anchors, grids, blades and propellers.

Claims 1-9 stand rejected under 35 U.S.C. § 112, ¶ 1 as lacking written descriptive support in the specification. Specifically, the Examiner concludes that there is no support in the original specification for “the said absence of positively controlled conveyance restricting said

stirrer to a monoaxially rotating stirrer having as mixing elements a member selected from the group consisting of beams, rods, anchors, grids, blades and propellers.” (Answer, p. 3). The Examiner also concludes that “positively controlled conveyance” is ambiguous to the extent that one of ordinary skill would not envisage what types of equipment are encompassed or excluded by the language (Answer, p. 4).

While the terminology of the claims differs from that of the original specification, we cannot agree with the Examiner that the claims run afoul of the written description requirement of 35 U.S.C. § 112, ¶ 1. We, therefore, reverse. Our reasons follow.

OPINION

35 U.S.C. § 112, ¶ 1 (2003) states in relevant part that “[t]he specification shall contain a written description of the invention.” Our reviewing court and its predecessors have construed the statute to require that the original written description reasonably convey to one of ordinary skill in the art that the applicant had possession, at the time of filing, of what is now claimed. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The claim need not use the same words as the specification, it is enough that one of ordinary skill in the art would recognize that the inventor invented what is claimed. *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000). “Adequate description of the invention guards against the inventor’s overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original

creation.” See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991).

We turn first to the phrase “the said absence of positively controlled conveyance restricting said stirrer to a monoaxially rotating stirrer having as mixing elements a member selected from the group consisting of beams, rods, anchors, grids, blades and propellers.” In rejecting the claims in view of this phrase, the Examiner looks to page 8, lines 23-25 of the specification. According to the Examiner, page 8, lines 23-25 does not provide “support for the condition that the absence of positively controlled conveyance **restricts** the stirrer to the specified stirrer.” (Answer, p. 3). According to the Examiner, the amended language of the claim introduces a new concept into the claim (*Id.*).

The problem we see with the Examiner’s analysis is that the concept is not “new” in the sense that it brings the claimed subject matter outside the scope of the description of the invention presented in the original written description. It is true that the specification does not define “absence of positively controlled conveyance” such that it restricts the stirrer to the monoaxially rotating stirrers of the claim. However, the difference is merely linguistic. The bottomline is that the claim is limited to the use of monoaxially rotating stirrers having the specified mixing elements and those stirrers are precisely the stirrers disclosed on page 8, lines 23-25 as being useful in the invention. There is written descriptive support in the original written description as required by 35 U.S.C. § 112, ¶ 1.

The Examiner separately rejects the claims in view of the phrase “positively controlled conveyance” on the basis that Appellants have not provided a clear definition within the specification and there is not even a suggestion that the terminology is art recognized (Answer, p. 4). The Examiner maintains that the terminology is ambiguous to the extent that one of ordinary skill would not envisage what types of equipment are encompassed or excluded by the language (Answer, p. 4).

The question of whether one of ordinary skill in the art would understand what is encompassed or excluded by the claim language is more relevant to the question of definiteness under 35 U.S.C. § 112, ¶2 than to the question of written descriptive support under 35 U.S.C. § 112, ¶ 1. For the issue of written descriptive support under 35 U.S.C. § 112, ¶ 1, the relevant question is whether the language of the original written description reasonably conveys to those of ordinary skill in the art that Appellants had possession of the claimed invention at the time of filing the application. When the appropriate inquiry is made, it becomes clear that the claims are sufficiently supported as required. In the present case, the disclosure of specific mixer apparatus, such as the stirrer fitted with rods disclosed in Example 2, indicates that Appellants had possession of tubular reactors without positively controlled conveyance therefrom as claimed (specification, p. 8, ll. 23-25 and Examples 2-5).

We conclude that the Examiner has failed to establish that the subject matter of claims 1-9 runs afoul of the written description requirement of 35 U.S.C. § 112, ¶ 1.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-9 under 35 U.S.C. § 112,
¶ 1 is reversed.

REVERSED

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

Appeal No. 2005-0020
Application No. 09/572,225

Page 7

Bayer Corporation
Patent Department
100 Bayer Road
Pittsburgh, PA 15205-9741