

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte DONN REYNOLDS ARMSTRONG,  
STANLEY S. BORYS and  
RICHARD PAUL ANDERSON

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Appeal No. 2006-0902  
Application No. 10/125,942

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ON BRIEF

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Before CAROFF, OWENS, and WALTZ, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 49 and 84.<sup>1</sup> In the final rejection, the examiner indicated that, of the remaining claims pending in appellants' application, claims 25, 27-35, 38-

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<sup>1</sup> We note that appellants have included a request for an oral hearing in their Brief (page 6). However, a request for an oral hearing must be filed as a separate paper. 37 CFR § 41.47 (b). Since appellants have not satisfied this requirement, the decision in this case is made "on the briefs" without an oral hearing in accordance with 37 CFR § 41.47(c).

45, 47, 54-56, 58, 64-68, 72, 74-76, 78, 79, 81, 82, 89, 91, 92, and 95-99 are allowed.

The two claims on appeal are dependent claims, each depending on a previously allowed claim. The appealed claims read as follows:

Claim 49. The titanium powder of claim 44, wherein said Ti powder has a packing fraction in the range of from about 4% to about 11%.

Claim 84. The titanium powder of claim 81, wherein said Ti powder has a packing fraction in the range of from about 4% to about 11%.

The following rejection is before us for review:

Claims 49 and 84 stand rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement of the statute.

We have fully evaluated the positions taken by the examiner and the appellants on appeal. Having done so, we find the examiner's position more persuasive. Accordingly, we affirm the rejection at issue.

More particularly, we note that the sole issue before us is essentially identical to the issue we decided in related application 10/125,988, Appeal No. 2005-1905, concerning appellants' failure to satisfy the written description requirement for the recitation in their claims of a "packing fraction" within a range of "from about 4% to about 11%". There, as here, we found no literal support

in the respective specification for the specific packing fraction range recited in the subject claims.

In our prior decision, we also found that the appellants did not establish that a packing fraction value within the recited range would inevitably result by practicing the disclosed invention, considering that the original specification contemplates a wide variety of starting materials and a broad range of process parameters.

The only evidence before us now, which was not before us when we rendered our prior decision, is in the form of a declaration by Lance Jacobsen.

We have carefully considered the Jacobsen Declaration. Having done so, we agree with the examiner that the Jacobsen Declaration fails to establish that a packing fraction of 4-11% is an inherent feature of the titanium powder produced according to the process described in appellants' disclosure.

Jacobsen reports that "[I]n over 200 runs of the Armstrong Process, the packing fraction of the powder has been in the range of from 4 percent to 11 percent." (Declaration, paragraph 7). We presume that Jacobson, in referring to "200 runs of the Armstrong Process", is referring to the process which is the subject of

appellants' instant specification and, also, is alluding to the 200 runs described in paragraph 5 of the Jacobsen Declaration. Those 200 runs are said to have been runs of titanium tetrachloride and liquid sodium to make titanium or titanium alloy powder.

As noted by the examiner, the Jacobsen Declaration presents no evidence respecting any halide other than titanium tetrachloride; no evidence respecting any alkali or alkaline earth metal other than sodium; and no data showing actual packing fractions obtained in any of the over 200 runs.

Neither in their Brief, nor in their Reply Brief, do appellants directly address the examiner's findings that the evidence presented in the Jacobsen Declaration relates only to chlorides and liquid sodium as reactants; whereas the instantly claimed titanium powder is the product of more broadly disclosed and claimed starting materials. Based on these findings, it logically follows that the evidence adduced by the appellants fails to establish that titanium powder made from a titanium halide other than the chloride, and an alkali metal or alkaline earth metal other than sodium, would necessarily have a packing fraction in the claimed range of 4-11%.

In view of the foregoing, appellants have failed to convince us that a packing fraction within the claimed range is an inherent feature of the titanium powder which results from practicing appellants' disclosed process or, in other words, that obtaining a titanium powder having such a packing fraction value is an inevitable consequence of practicing the disclosed process, which embraces a variety of starting materials and processing conditions.

To support their position, appellants primarily rely upon Kennecott Corp. v. Kyocera International, Inc., 835 F.2d 1419, 5 USPQ 2d 1194 (Fed. Cir. 1987); Schering Corp. v. Geneva Pharmaceuticals, Inc., 339 F.3d 1373, 67 USPQ 2d 1664 (Fed. Cir. 2003); and Smithkline Beecham Corp. v. Apotex Corp., 74 USPQ 2d 1398, 403 F.3d 1331, (Fed. Cir. 2005).

As we noted in our prior decision, Kennecott is of limited precedential value inasmuch as resolution of issues relating to the written description requirement depends upon the particular facts of each case. In re Edwards, 568 F.2d 1349, 1355, 196 USPQ 465, 470 (CCPA 1978). Kennecott can be distinguished on its facts since, in Kennecott, specific working examples in the original disclosure apparently provided an adequate basis for additional

pictures and description of the existing physical structure of the disclosed product. Here, we find no comparable basis in the original disclosure to support appellants' assertions of inherency regarding the claimed packing fraction range.

Both Schering and Smithkline relate to the doctrine of "inherent anticipation". This doctrine is not applicable here since the question before us is not whether a prior art reference inherently anticipates a claimed feature but, rather, whether appellants have adduced sufficient evidence to support their assertion that the packing fraction range at issue is an inherent characteristic of titanium powders made by the process broadly disclosed in the instant specification. In other words, the issue before us is a question of fact which must be established by the appellants. Generally, the standard of proof regarding inherency issues is applied more rigorously where applicants must satisfy the standard, as distinguished from situations where the PTO relies upon an assertion of inherency, e.g. "inherent anticipation". Cf. In re Best, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433-34 (CCPA 1977).

For the foregoing reasons, the decision of the examiner is affirmed.

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

AFFIRMED

MARC L. CAROFF )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
TERRY J. OWENS ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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THOMAS A. WALTZ )  
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