

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 VIHO NISSINEN, ELIAS RETULAINEN,
and JOHAN GRON

Appeal 2006-1543
Application 10/239,769
Technology Center 1700

Decided: November 30, 2006

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

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal the rejection of claims 15-21, 30-34, 36, and 37, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a method and apparatus for making a web of glazed paper or board. The process involves treating a base web with a high-solids content treatment agent. This is done, according to the claims, by applying the treatment agent to a heated belt of a belt dryer. When the treated belt surface contacts the web, the treatment agent is transferred from the heated belt to the web. Claim 15 is illustrative of the subject matter on appeal:

15. A method for manufacturing a web of glazed paper or board with a surface thereof treated with a treatment agent, comprising:

producing a base web;

applying a treatment agent to a surface of a heated belt, the treatment agent having a solids content of not less than 80%; and

drying the base web in a belt dryer comprising the heated belt, the surface of the heated belt to which the treatment agent is applied running against a surface of the base web to which the treatment agent is to be applied, wherein the treatment agent is transferred from the heated belt and applied to the web by the heated belt to adhere to and coat the web.

To support a rejection under 35 U.S.C. § 103(a), the Examiner relies upon the following prior art:

Söremark	US 4,857,126	Aug. 15, 1989
Lehtinen	US 5,778,555	Jul. 14, 1998

The specific matters on appeal are as follows:

1. The objection made under 35 U.S.C. § 132 to the Amendment entered July 23, 2004.^{1,2}
2. The rejection of claims 15, 21, 30-34, 36, and 37 under 35 U.S.C. § 112, ¶ 1, as lacking written descriptive support; and
3. The rejection of claims 15-20 and 30-32 under 35 U.S.C. § 103(a) as unpatentable over Lehtinen in view of Soremark.

Based on our review of the issues as presented in the Answer, Brief, Reply Brief and the evidence and arguments relied upon therein, we sustain the objection under 35 U.S.C. § 132 and the rejection under 35 U.S.C. § 112, ¶ 1. We, however, do not sustain the rejection under 35 U.S.C. § 103(a). Pursuant to our authority under 37 C.F.R. § 41.50(b), we extend the 35 U.S.C. § 112, ¶ 1 rejection to claims other than those rejected by the Examiner. Our reasons follow.

OPINION

New Matter in the Specification and Claims

As the objection under 35 U.S.C. § 132 and the rejection under 35 U.S.C. § 112, ¶ 1, are related issues and are argued together under the same heading in the Brief (Br. 3-9) we consider them together.

¹ The Amendment was originally filed on May 17, 2004 and was entered pursuant to the Request for Continued Examination filed July 23, 2004.

² Because the objection relates to new matter in the specification and is combined with a rejection of claims under 35 U.S.C. § 112, ¶ 1, written description, the objection is reviewable on appeal. *See MPEP* § 2163.06(II)(8th ed. Rev. 3, Aug. 2005).

March 28, 2001. Appellants further argue that Figure 2 merely illustrates the embodiment of the present invention that is described in the text to which the Examiner objected to as “new matter.” (Br. 4).

As a first matter, we note that the language that is the subject of the objection and rejection did not appear until the Amendment first presented on May 17, 2004 (entered July 23, 2004) and the drawing was not filed, by Appellants own admission, until February 4, 2004 (Br. 4). The relevant question is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of this newly added subject matter. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The written description inquiry is a factual one and must be assessed on a case-by-case basis. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and cases quoted therein. What is required to meet the written description requirement “depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure.” *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The Examiner has provided a factual basis supporting the finding that the original Specification would not reasonably convey to the artisan that the Appellants had possession of the concept of applying the treatment agent to the dryer belt for transfer to the web as now illustrated in Figure 2, as now described in the Specification, and as now claimed (Answer 3-6).

Appellants point to original dependent claims 7 and 8 for support of the newly added matter (Br. 4-6). However, Appellants’ interpretation of the original claims is problematic for the reasons pointed out by the Examiner in the Answer (Answer 7-9). According to Appellants’

interpretation, the reference to “a treatment agent” in claim 8 is a reference to the treatment agent recited in claim 1. But if one interprets original claim 8 in this manner, claim 8 will not further limit original claim 1 and thus claim 8 becomes improperly dependent on claim 1 in contravention of 35 U.S.C. § 112, ¶ 4. This is because original claim 1 is limited to a method comprising “passing the base web (10) to at least one applicator apparatus, wherein to the *surface of the web* is applied in at least one step at least one kind of a treatment agent” wherein “*after the application of said treatment agent, the web (10) is passed via a belt dryer comprising at least one heatable belt (2) in such a manner that the heatable belt comes to face the *treated surface of the web (10).*” (emphasis added). Claim 1 is limited to pretreatment of the web surface with the treatment agent before passing the treated web to the belt dryer in accordance with the embodiment of Figure 1, the one and only original drawing figure.*

Figure 1 with labels added thereto is reproduced below:

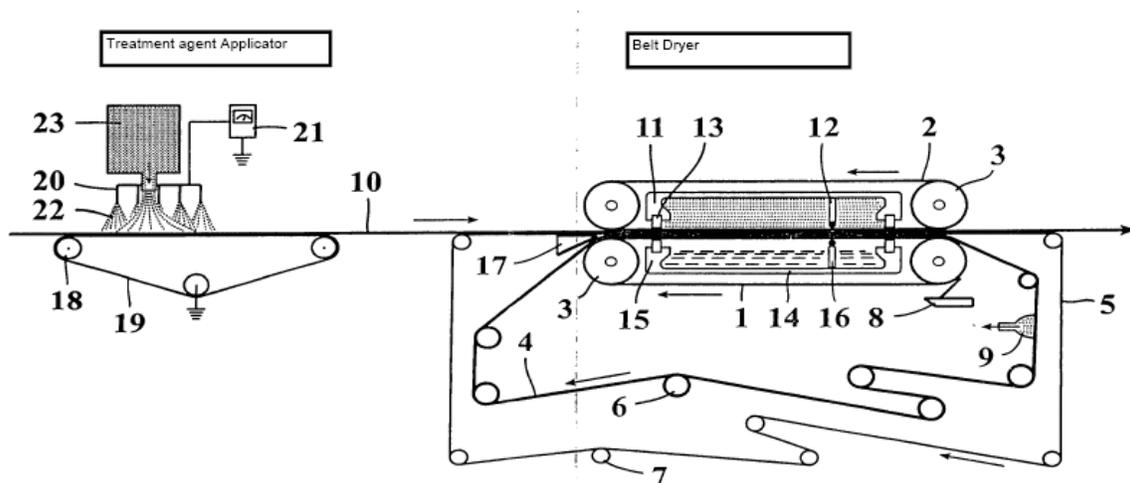


Fig. 1

Figure 1 – A diagrammatic view of an embodiment of the invention

To be in conformance with 35 U.S.C. § 112, ¶ 4, original claim 8, being dependent on original claim 1, must further limit original claim 1. However, if interpreted as proposed by Appellants, original claim 8 would be directed to applying the treatment agent referenced in original claim 1 to the surface of belt 2 of the dryer instead of to the surface of the web and the web would not be passed to the belt dryer “after the application of said treatment agent ... in such a manner that the heatable belt comes to face the treated surface of the web” as required by original claim 1. Therefore, if interpreted as suggested by Appellants, original claim 8 would be improperly dependent on original claim 1.

As pointed out by the Examiner, there is a reasonable claim interpretation that preserves original claim 8 as a properly dependent claim (Answer 8-9). As explained by the Examiner, it is reasonable to interpret “a treatment agent” as recited in original claim 8, as referring to the anti-stick material applied to the dryer belt as discussed in the Specification at page 10, lines 13-23. That treatment agent (anti-stick material), according to the Specification, is applied to prevent the earlier discussed treatment agent (web coating) from adhering to the heated dryer belt. As so interpreted, original claim 8 does not support the concept of applying the treatment agent that coats the web (web coating) to the dryer belt as shown in newly added Figure 2.

Appellants argue that the Examiner’s interpretation of original claim 8 is based on an incorrect reading of their original Specification. According to Appellants, original claim 8 refers to the same “treatment agent” as that referred to in claim 1 (Reply Br. 2). Appellants argue that page 10, lines 13-

16 of the Specification disclose the use of a film of polytetrafluoroethylene (PTFE) between the coated surface of the paper web and the “pressing steel platen” and that nowhere in the Specification is there any disclosure that the claimed method includes a step of spraying PTFE onto the coated paper web or onto the belt (Reply Br. 2).

We do not find Appellants’ argument persuasive. We agree that the original Specification does not seem to disclose spraying PTFE onto the paper web or onto the belt, but this fact is not relevant to the issue at hand. What is more relevant is that the original Specification “urges the use of suitable covering [of PTFE] . . . on the face of the steel belt of the belt dryer facing the web surface.” (original Specification 10:16-19). The language of the original Specification parallels the language of original claim 8 in that the PTFE “is applied to the surface of the belt of the belt dryer facing the web” whereas, in the embodiment of Figure 2, the treatment agent is applied to the surface of the belt not facing the web. This fact along with the fact that claim 8 recites “*a* treatment agent” rather than “said treatment agent” and that claim 1 uses the terminology “said treatment agent” when referring to the earlier recited treatment agent (web coating of claim 1) provides further evidence that original claim 8 is referring to a different agent.

With regard to claim 7, it is reasonable to interpret this claim as referring to belt or roll transfer means located upstream of the dryer belt. This reading of the claim is in conformance with the disclosure that “[a]n applicator apparatus is located in front of the belt dryer, upstream thereof in the travel direction of the web” as recited in the original Specification (original Specification 7:1-2) and the disclosure that “[t]he treatment agent may be applied directly to the web surface, as is the case in the exemplifying

embodiment, or to the surface of the belt that next meets the surface of the web.” (original Specification 8:22-24). Note that page 8 of the original Specification does not indicate that the referenced belt can be the dryer belt, rather, to one of ordinary skill in the art what is referenced is a conventional coating transfer belt. Note the further disclosure on page 13 of the original Specification that “[t]he treatment agent can be applied to the web surface in plural ways. . . . The charged particles of the powder may be applied directly to the web surface or, e.g., via a transfer roll or belt by charging the belt, then adhering the powder to this transfer means and finally transferring the powder to the web surface by way of compressing the transfer means against the web.” (original Specification 13:21-31). Again, there is no mention of using the dryer belt as the transfer means.

Given the lack of disclosure in the original Specification identifying the dryer belt as a usable transfer means and the inconsistency between the interpretation of original claim 8 as proposed by Appellants with the scope of original claim 1, the Examiner’s finding that the original Specification would not convey possession to the skilled artisan of the now recited, depicted, and claimed subject matter is reasonable.

We find that the Examiner has established that the objected to language added by the Amendment entered July 23, 2004 and the newly illustrated subject matter of new Figure 2 are impermissible new matter. We further find that the Examiner has established that claims 15, 21, 30-34, 36, and 37 violate the written description requirement of 35 U.S.C. § 112, ¶ 1. Appellants have not convinced us of a reversible error on the part of the Examiner.

The Examiner further rejects claims 21, 33, and 34 on the basis that “there is nothing that teaches, suggests, or infers that charged particles are applied to the heated belt, nor electrostatic means relative to the heatable dryer belt per claims 21, 33-34.” (Answer 6). Appellants argue that this allegation is without merit citing the original Specification at page 13, lines 21-30. This argument is not persuasive, however, because the portion of the original Specification cited by Appellants merely discloses applying the treatment agent to the web surface “via a roll or belt by charging the belt, then adhering the powder to this transfer means.” Nowhere does this portion of the original Specification mention using the dryer belt as the transfer means. We cannot agree with Appellants that this portion of the original Specification would convey to the artisan that Appellants were in possession of the concept of using the dryer belt as the transfer means.

There is some confusion on the record with regard to the rejection of claims 31 and 32. In the final rejection, the Examiner rejected these claims on the additional basis that “[n]owhere is there a disclosure of applying anti-stick material to a heatable belt of a dryer.” (Answer 4). Appellants found this to be less than clear, but argued that the language was supported (Br. 8). The rejection reproduced in the Answer does not specifically reject claims 31 and 32 on the additional basis articulated in the final rejection. In the Response to Argument section of the Answer, the Examiner responds to Appellants’ argument by stating that “[t]he teachings are for a heated belt being run against a coating on a base web (as admitted by Applicants’ own arguments on top of page 9), not on ‘the surface of the base web.’” (Answer 9-10). Appellants argue in the Reply Brief that the Examiner has made a new ground of rejection which is untimely (Reply Br. 2-3). Appellants,

however, also respond by indicating that they would be willing to change “against” to “proximate” in claim 31 to address the deficiency.

The question of whether the Examiner made an untimely new ground of rejection is not one we will address here. Appellants’ remedy was by way of petition under 37 C.F.R. § 1.181(a). No such petition having been filed, the allegation is waived. See MPEP § 1207.03(IV).

As found by the Examiner, there is no support for the heated belt running against the surface of the base web. The heated belt runs against the coating or treatment agent on the web.

New Ground of Rejection

It is unclear to us why the 35 U.S.C. § 112, ¶ 1, rejection was limited to claims 15, 21, 30-34, 36, and 37. All of the pending claims include the limitations found to violate the written description requirement. We, therefore, extend the rejection to claims 16-20. Therefore, claims 15-21, 30-34, 36, and 37 are now rejected as violating the written description requirement of 35 U.S.C. § 112, ¶1.

The Obviousness Rejection

The Examiner also maintains a rejection against claims 15-20 and 30-32 as unpatentable as obvious under 35 U.S.C. § 103(a). The Examiner relies upon Lehtinen and Soremark as evidence of obviousness.

We conclude that the Examiner has not established a prima facie case of obviousness based on Lehtinen and Soremark. As a first matter, claim 15 requires that the treatment agent have a solids content of not less than 80%. The Examiner acknowledges that the treatment layer of Söremark appears to

have a lower than claimed solids content (Answer 7). The Examiner provides no reasonable evidentiary basis for the finding that “it would have been apparent to the skilled artisan that it would have been capable of drying and smoothing a release (or other) coating with a higher solids content” (*id.*). Appellants’ Specification, on the other hand, indicates that conventional coatings in the art have solids content lower than 80% and problems were encountered with high-solids coatings (Specification 1:19 to 2:5). In light of the evidence as a whole, we cannot say that the Examiner has supported the finding by a preponderance of the evidence as required.

Furthermore, the sentence in the abstract of Soremark the Examiner relies upon for a teaching of applying a release composition to a drying roll does not seem to mean what the Examiner desires it to mean. Soremark describes an improvement to methods of applying a coating to a paper web wherein the coating is applied using a conventional roll applicator (Soremark, col. 1, ll. 14-16). The improvement involves including an additive comprising a release composition in the coating composition (Soremark, col. 2, ll. 62-64). This coating additive reduces the tendency of the coating mixture to stick to the rolls and thereby helps to maintain cleaner rolls (Soremark, col. 2, ll. 29-31). The improved composition and method allows rapid and complete separation of the wet, tacky, coated web of paper product from the coating, drying, or processing surfaces of the machine (Soremark, col. 1, ll. 8-11). While in a vacuum the sentence in the abstract might seem to teach applying the release composition directly to a drying roll for transfer to the web, when the sentence is read in the context of the entire document it becomes clear that this is not what is being taught by the reference. Therefore, the combination of art relied upon by the Examiner

does not teach applying a treatment agent to a heated drying roll as found by the Examiner and without this teaching it cannot be said that the Examiner has identified a suggestion to apply a treatment agent to the heated dryer belt of Lehtinen.

Because the references do not teach or suggest either the high-solids content or the application of a treatment agent to a heated dryer belt required by the claims, we agree with Appellants that the Examiner has failed to establish a prima facie case of obviousness.

CONCLUSION

In summary, we sustain the rejection of claims 15, 21, 30-34, 36, and 37 under 35 U.S.C. § 112, ¶ 1. We further reject claims 16-20 on the same grounds. We also sustain the objection to the Specification under 35 U.S.C. § 132. We, however, do not sustain the rejection of claims 15-20 and 30-32 under 35 U.S.C. § 103(a). Accordingly, we affirm-in-part.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a)(1)(iv)(2005).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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