

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 BARRY K. SPERONELLO,
GERALD S. KOERMER,
APPADURAI THANGARAJ and
AHMAD MOINI

Appeal 2006-1705
Application 10/744,481
Technology Center 1700

DECIDED: AUGUST 24, 2006

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

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 38-48.

We REVERSE.

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The subject matter on appeal relates to a massive body comprising a metal chlorite, an acid source and a source of free halogen wherein the massive body produces a solution of chlorine dioxide and free halogen when exposed to liquid water. Further details regarding this subject matter are set forth in representative independent claim 38 which reads as follows:

38. A massive body comprising a metal chlorite, an acid source and a source of free halogen, wherein said massive body produces a solution of chlorine dioxide and free halogen and forms a low solubility porous framework when exposed to liquid water.

No references have been relied upon by the examiner in support of the sole rejection before us on this appeal which is based on the enablement requirement in the first paragraph of 35 U.S.C. § 112.¹

Claims 38-48 are rejected under 35 U.S.C. § 112, first paragraph, because the specification "does not reasonably provide enablement for the above [claimed] massive body when it is not limited to said ratio of the concentration of chlorine dioxide generated to the sum of the concentrations of chlorine dioxide generated and chlorite anion being at least 0.25:1 by weight" (Answer 3). As subsequently expressed on page 4 of the Answer, "[t]he examiner thus holds that applicant's pending independent claims 38 and 44 must be amended to require a ratio of concentration of chlorine

¹ The obviousness-type double patenting rejections set forth in the final Office action have not been advanced on this appeal (e.g., see the paragraph bridging pages 2-3 of the Answer).

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dioxide generated to the sum of the concentrations of chlorine dioxide generated and chlorite anion being at least 0.25:1 by weight."

We refer to the Brief and Reply Brief and to the Answer for a thorough exposition of the opposing viewpoints expressed by the Appellants and by the Examiner concerning the above noted rejection.

OPINION

This rejection cannot be sustained.

We apply the following well-established legal principles in assessing the Examiner's position that the scope of enablement provided by the Appellant's specification is not commensurate with the scope of the appealed claims.

First, it is the function of the specification, not the claims, to set forth the practical limits of operation of an invention. *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). One does not look to claims to find out how to practice the invention they define, but to the specification. *Id.*

Second, the specification *as a whole* must be considered in determining whether the scope of enablement provided by the specification is commensurate with the scope of the claims. *Id.*

Finally, when rejecting a claim for lack of enablement, the Patent and Trademark Office (PTO) bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided

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in the specification. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

According to the Examiner, the appealed claims would be enabled only if amended to include the ratio limitation discussed above. This limitation involves the amount of chlorine dioxide and chlorite anion products generated by the here claimed massive body. It is the essence of this limitation that chlorine dioxide constitutes at least 25% of these products. The disclosure of this limitation appears in the last paragraph on specification page 4.

Specifically, this page 4 disclosure teaches that "[t]he massive body is such that when it is added to liquid water, it will produce a solution of chlorine dioxide and free halogen, ... the ratio of the concentration of chlorine dioxide to the sum of the concentrations of chlorine dioxide and chlorite anion in the solution is at least 0.25:1 by weight." *Id.* Importantly, neither this disclosure of page 4 nor the remaining disclosure of the subject specification teaches that the massive body disclosed and claimed by Appellants would not perform the desired biocidal function if it produces a solution containing less than 25% by weight chlorine dioxide. To the contrary, the first paragraph on specification page 3 teaches that it would be merely "desirable" to produce a chlorine dioxide solution "that did not also contain excessive amounts of chlorine." Similarly, the disclosure in the first full paragraph on specification page 8 teaches that, in certain situations, "the presence of a relatively high concentration of chlorine or other free halogen in solution may be acceptable."

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In light of the foregoing, we cannot agree with the Examiner that the subject specification limits the Appellants' invention to a massive body which, in operation, produces a solution containing at least 25% by weight chlorine dioxide. The Examiner's enablement position would not be well-taken even if a solution of at least 25% by weight chlorine dioxide were considered to be the practical limit of operation for the Appellants' disclosed and claimed massive body. This is because it is improper to require the claims to set forth the practical limits of operation for an invention.

Johnson, 558 F.2d at 1017, 194 USPQ at 195. As explained in *Johnson*, *id.* (citing *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976)):

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.
[citation and footnote omitted.]

For the above stated reasons, it is our determination that the Examiner has failed to carry his initial burden of setting forth a reasonable explanation as to why he believes that the scope of protection provided by the appealed claims is not adequately enabled by the description of the invention provided in the specification of this application. *Wright*, 999 F.2d at 1561, 27 USPQ

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at 1513. We cannot sustain, therefore, the Examiner's § 112, first paragraph, rejection of claims 38-48 for lack of enablement.

The decision of the Examiner is reversed.

REVERSED

Bradley R. Garris)
Administrative Patent Judge)
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Charles F. Warren) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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