

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 PHILIP J. MAZIASZ,
TIM MCGREEVY, MICHAEL JAMES POLLARD,
CHAD W. SIEBENALER and ROBERT W. SWINDEMAN

Appeal No. 2006-2061
Application 10/195,703

ON BRIEF

Before WARREN, TIMM and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the rejection of appealed claims 1 through 24 and 26 through 29, all of the claims in the application under 35 U.S.C. § 112, first paragraph, written description requirement.

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

Appealed claims independent claims 1 and 18 encompass alloys comprising at least the specified elements in the specified amounts including “less than 0.01 weight percent sulfur.” The reasonable construction of the sulfur limitation in context and in light of the written description in the specification is that the range “less than 0.01” has a lower limit of “0.0.” This

value is less than 0.01 and is reflected in the disclosure “removing . . . sulfur” in paragraphs [11] and [15], and “0” as the lower end of the ranges for sulfur in Table 1 (paragraph [09]). Thus, the claims encompasses alloys containing sulfur in the range of 0.0 to 0.01 weight percent. *See, e.g.*, *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Similarly, original claims 1 and 25, the latter dependent on claim 18, contain the language “less than about 0.03 weight percent sulfur,” thus encompassing alloys containing sulfur in the range of 0.0 to about 0.03 weight percent, which range is specifically disclosed in specification paragraph [06] and Table 1 (paragraph [09]).

The same disclosure in the written description of the specification and the original claims would have reasonably conveyed to one skilled in this art that, as a matter of fact, appellants were in possession of alloys which contain 0.0 to about 0.03 weight percent sulfur, that is, either no sulfur or any amount of sulfur up to about 0.03 weight percent, at the time the claimed invention was filed. Thus, the written description in the specification would have further reasonably conveyed that appellants were also in possession of alloys within said range containing no sulfur and any amount of sulfur up to less than 0.01 weight percent at the time the claimed invention was filed. Indeed, appellants further disclose alloy species A-H containing 0.001, 0.002 or 0.003 weight percent sulfur in Table 2 (paragraph [12]), such amounts falling within the narrower range.

In other words, on the record before us, the complete disclosure in the specification as a whole of the originally claimed genus of alloys containing 0.0 to about 0.03 weight percent sulfur provides a description of the now claimed limited genus of alloys containing 0.0 to less than 0.01 weight percent sulfur, the limited genus additionally supported by examples of alloy species falling therein, as well as of the now excluded limited genus of alloys containing 0.01 to about 0.03 weight percent sulfur. We further find that in the amendment filed September 9, 2004, appellants limited original generic claims 1 and 18 to read as they stand on appeal in response to the application of prior art under 35 U.S.C. § 102(e) (pages 2, 4 and 7-8).

Thus, we are of the opinion that, as a matter of fact, appealed claims 1 and 18 comply with 35 U.S.C. § 112, first paragraph, written description requirement. *See In re Johnson*,

558 F.2d 1008, 1017-19, 194 USPQ 187, 195-96 (CCPA 1977) (limited generic claim encompassing polymers to which appellants retreated in view of applied prior art was in fact supported by the written description in the specification which supported broader generic claim encompassing polymers “in the absence of the limitation, and that specification, having described the whole, necessarily described the parts remaining”); *cf. In re Wertheim*, 541 F.2d 257, 264-65, 191 USPQ 90, 98 (CCPA 1976) (specification supporting broad process parameter range further in fact described narrower claimed range of that parameter falling within the broad range in view of disclosure of two embodiments falling within narrower range and absence of evidence of that narrower range was a different invention than broad range).

We are not convinced otherwise by the examiner’s contention that data reported for the disclosed alloy species within the presently claimed range in specification Tables 3 and 4 establishes that alloys encompassed by the appealed claims constitute “a different invention” from the alloys encompassed only by the broader original claims. We find that the written description in the specification does not support the examiner’s position. Indeed, it is disclosed that “removing or substantially reducing the presence of sulfur alone” improves the physical properties of the disclosed alloys (paragraph [11]), which disclosure is coupled with the ranges in Table 1 (paragraph [09]), and without further describing or otherwise conveying that the “invention” based on the exemplified alloys is in fact a separate invention. The examiner has not established that the properties reported for the exemplified alloys would be considered by one skilled in this art to fall outside this disclosure. In this respect, it is the examiner’s burden to set forth evidence or reasons why, as a matter of fact, the written description in appellants’ specification would not reasonably convey to persons skilled in this art that appellants were in possession of the invention defined by the claims, including all of the limitations thereof, at the time the application was filed in order to establish a *prima facie* case of non-compliance with the statutory provision. *See generally, In re Alton*, 76 F.3d 1168, 1172, 1175-76, 37 USPQ2d 1578, 1581, 1583-84 (Fed. Cir. 1996) (citing *Wertheim*, 541 F.2d at 262-64, 191 USPQ at 96-97).

The examiner’s decision is reversed.

Reversed

CHARLES F. WARREN Administrative Patent Judge)))))
CATHERINE TIMM Administrative Patent Judge) BOARD OF PATENT) APPEALS AND) INTERFERENCES))
JEFFREY T. SMITH Administrative Patent Judge))

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001-4413