

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

Appeal 2006-2490
Application 10/238,791
Technology Center 1700

Decided: December 11, 2006

Before WALTZ, JEFFREY T. SMITH, and GAUDETTE, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Primary Examiner's Final Rejection of claims 95 through 128 (see also the "Amendment" dated July 26, 2005, considered as per the Advisory Action dated Aug. 17, 2005). Claims 1 through 20 are the only other claims pending in this application and stand withdrawn from consideration as directed to a non-elected

invention (Final Office Action dated Apr. 29, 2005, page 1). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to Appellants, the invention is directed to a gel formed during the process described in the parent application, now U.S. Patent No. 5,779,761, and a solid formed from the gel (Br. 2). Independent claim 95 and dependent claim 107 are illustrative of the invention and are reproduced below:

95. A gel of a powder elemental material or a powder alloy thereof and a halide salt and liquid alkali metal or liquid alkaline earth metal or mixtures thereof produced by the method of submerging a halide vapor of the elemental material or mixtures of halide vapors into a flowing liquid alkali metal or liquid alkaline earth metal or mixtures thereof to produce powder elemental material or a powder alloy thereof and a halide salt in the presence of excess liquid alkali metal or liquid alkaline earth metal or mixtures thereof and separating excess liquid metal to form the gel.

107. The gel of claim 95 cooled to a solid.

Claims 95-128 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Answer 3). This is the only rejection in this appeal (Br. 2).¹

Based on the totality of the record, including due consideration of Appellants' arguments and the Jacobsen Declaration (Exhibit A attached to the Brief), we AFFIRM the rejection on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

¹ We note similar rejections and issues have been the subject of Appeal No. 2005-1905 (Application No. 10/125,988) and Appeal No. 2006-0902 (Application No. 10/125,942), with Decisions mailed in these Appeals on Oct. 21, 2005, and June 23, 2006, respectively. We also note an appeal in related Application No. 10/238,297, and we have considered abandoned Application No. 08/283,358 (filed Aug. 1, 1994) and related U.S. Patent Nos. 5,779,761; 5,958,106; and 6,409,797.

OPINION

The Examiner finds that the claims contain subject matter which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention (Answer 3). The Examiner further finds that, for purposes of this rejection, “the time the application was filed” is considered to be the filing date of related Application No. 08/283,358, i.e., Aug. 1, 1994 (*id.*). Appellants do not dispute this effective filing date as found by the Examiner (see the Brief in its entirety).

The Examiner finds that the Specification as filed discloses reaction components such as titanium powder, halide salts, and liquid alkali or alkaline earth metals (Answer 3). However, the Examiner ultimately finds that nothing in the originally filed Specification would have conveyed the concept of those components together in gel form, as now claimed, to one of ordinary skill in the art (*id.*). The Examiner further finds that this gel form concept would not have been inherent in the disclosure as originally filed, and thus claims 95-128 contain “new matter” (*id.*).

The “written description” requirement of 35 U.S.C. § 112, first paragraph, requires an applicant to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, i.e., whatever is now claimed. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Whether this rejection is for “lack of support,” “new matter,” or “lack of written description,” the requirement is the same. *See Vas-Cath*, 935 F.2d at 1560, 19 USPQ2d at 1114. The initial burden of establishing a rejection, on

any ground, rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “Thus, the burden placed on the examiner varies, depending upon what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. [Citation omitted].” *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

The Examiner has found, and Appellants do not dispute, that the original disclosure does not recite the term “gel” or that the term “gel” has been applied to the reaction mixture of the powder elemental metal, halide salt, and liquid alkali or alkaline earth metal in the original disclosure (Answer 3). Therefore we determine that the Examiner has met the initial burden and has established a prima facie case of lack of written description. *See Alton, supra*. Once the Examiner carries the burden of making out a prima facie case, the burden of coming forward with evidence or argument shifts to Appellants. *See Alton, supra*, citing *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.

Accordingly, we now consider Appellants’ arguments and evidence. Appellants cite numerous case law for the holding that “a process for making a material discloses the material and any inherent property of the material irrespective of whether the language describing that inherent property is in the application or not” (Br. 4). Therefore Appellants rely on the Jacobsen Declaration to show “that a gel is always formed and that is sufficient to establish inherency, whether or not the inventors’ [sic] appreciated that a gel would form when the priority application was filed” (Br. 6).

We do not find the Jacobsen Declaration convincing. As correctly stated by the Examiner (Answer 5-6), the data presented in the Declaration is not commensurate in scope with the claims sought to be patented. Specifically, the Declarant states that “in over 200 runs of titanium tetrachloride and liquid sodium and in some cases, titanium tetrachloride with other chlorides to make titanium alloys” at temperatures of about 220 to about 700 °C., a sodium side pressure of from about 40 kpa to about 300 kpa, and a titanium tetrachloride flow rate of about 0.44 kg/m to about 5.5 kg/m” a gel is formed (¶ 5 and 8). However, the claims on appeal are not limited to these specific reactants and reaction conditions (e.g., see claim 95 on appeal which is not limited to titanium, a chloride, or liquid sodium, much less any reaction condition; see the Specification 15). Additionally, we determine that the Declarant states that “[u]pon *filtration* of the slurry produced by the Armstrong Process, a gel forms that is an inherent property of the process, as a gel always occurs” (¶ 10, italics added). Therefore the Declarant finds that a gel is always “formed *on the filter*” (¶ 8, italics added). However, the use of a filter is not recited in the claims, but only the generic step of “separating” (e.g., see claim 95 on appeal). Thus the claim is not limited to a filtration step. Appellants’ Specification teaches that the product can be removed from the bulk sodium stream by “conventional separators” such as cyclones, particulate filters, magnetic separators, or vacuum stills (Specification 7-8). Accordingly, we do not find that the Jacobsen Declaration evinces that gel formation always, or inherently, occurs in the process *as claimed*.

Finally, we find that Appellants’ Specification contradicts the Jacobsen Declaration in that there is a specific disclosure that “[i]n the third,

and preferred option for product removal, *the solid cake* of salt [sic,] Ti, and Na is vacuum distilled to remove the Na” (Specification 8, italics added). Accordingly, this is evidence that the powder elemental material (Ti), the halide salt (salt), and liquid alkali metal (sodium or Na) mixture is a solid cake, not a gel. Furthermore, there is no evidence that any gel has been formed which was subject to a cooling step to form a solid.

Therefore, based on the totality of the record, including due consideration of Appellants’ arguments and evidence, we determine that the preponderance of evidence does not support Appellants’ position that gel formation is an inherent property of the claimed process. Accordingly, we determine that Appellants have not met their burden of proof. The rejection of claims 95-128 for failing to fulfill the written description requirement of § 112, first paragraph, is therefore affirmed.

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 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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*HARRY M. LEVY
EMRICH & DITHMAR, LLC
125 SOUTH WACKER DRIVE, SUITE 2080
CHICAGO, IL 60606-4401*