

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TADAHIRO YABU,  
YOSHIYUKI TAKASE,  
MASAYUKI NAMIMATSU  
and YOSHIYUKI HIRAGA

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Appeal 2008-2773  
Application 10/488,838  
Technology Center 1700

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Decided: December 15, 2008

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Before CHUNG K. PAK, CATHERINE Q. TIMM, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 3-20, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The invention is directed to a fluororesin composition (independent claims 1 and 16) and to a process for preparing a fluororesin composition (independent claim 3). Each of the independent claims includes the

limitation “said composition having a melt flow rate of at least 15 g/10 min at 372 °C” (claims 1, 3, and 16). The sole ground of rejection of claims 1 and 3-20 is under 35 U.S.C. § 112, first paragraph.

The issue presented for our review is: Have Appellants shown that a preponderance of the evidence weighs in favor of a finding that the Specification, as originally filed, described the invention in sufficient detail that one skilled in the art would clearly conclude that the unit of measure of the melt flow rate is “g/10 min”? We answer this question in the affirmative.

The Examiner contends that the claims fail to comply with the § 112 written description requirement because the Specification fails to identify “g/10 min.”, or any other unit of measure, for the melt flow rate. (Ans. 4.) According to the Examiner, one of ordinary skill in the art, upon reading the Specification, would not be able to determine the unit of measure being employed by the inventors. (Ans. 6.) The Examiner cites four U.S. patents (Ans. 3, § (8)) as evidence that melt flow rate may be expressed in a variety of units (Ans. 5, § (9), para. (a); Ans. 7, § (10), last para.)

The claims, as originally filed, did not include the units “g/10 min” (Spec. 17-18, original claims 1-15). Likewise, the Specification does not identify the units for melt flow rate, but states that “the fluororesin composition . . . has a melt flow rate measured according to ASTM D-2116 of at least 15 at 372°C” (Spec. 7, ll. 1-4). With respect to the Examples (Spec. 12, l. 20 – p. 15, l. 10), the Specification states that “Melt flow rate was measured according to ASTM D 2116 by the method of 372°C and 5 kg load” (Spec. 13, ll. 11-12). ASTM D 2116 provides that “melt flow rate is determined at  $372 \pm 1^\circ\text{C}$  using Procedure A or B described in Test Method D

1238.” The American Soc’y for Testing and Mat’ls, Annual Book of Standards, Vol. 8.01, (D 2116 - 02), *Standard Specification for FEP-Fluorocarbon Molding and Extrusion Materials*, p. 521, § 11.1.1. ASTM D 1238 identifies the units of measure for flow rate as “g/10 min.” The American Soc’y for Testing and Mat’ls, Annual Book of Standards, Vol. 8.01, (D 1238 - 99), *Standard Test Method for Melt Flow Rates of Thermoplastics by Extrusion Plastometer*, p. 261, § 1.2 p. 265, § 9.1, p. 267, § 11.1.

“When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the invention of the applicant. That is the essence of the so-called ‘description requirement’ of § 112, first paragraph.” *In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989).

Whether an applicant has complied with the written description requirement is a finding of fact, to be analyzed from the perspective of one of ordinary skill in the art as of the date of the filing of the application. . . .

The written description requirement of 35 U.S.C. § 112, ¶ 1, is straightforward: “The specification shall contain a written description of the invention. . . .” To satisfy this requirement, the specification must describe the invention in sufficient detail so “that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. . . .”

The requirement “serves a teaching function, as a ‘*quid pro quo*’ in which the public is given ‘meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.’ ”

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*In re Alonso*, No. 2008-1079, 2008 WL 4762048, at \*\*2-3 (Fed. Cir. Oct. 30, 2008) (citations omitted).

Appellants have persuasively argued that one of ordinary skill in the art would understand from the Specification that the unit of measure of melt flow rate of the inventive fluororesin composition is “g/10 min.” The Examiner has not established that one of ordinary skill in the art would not be able to ascertain the unit of measure used in the Specification merely because other references express melt flow rate using different units of measure. The Specification unequivocally states that melt flow rate is determined by ASTM D 2116 (and ASTM D 1238), which identifies the unit of measure for melt flow rate as “g/10 min.” As pointed out by Appellants, it is unclear whether the prior art references cited by the Examiner measure melt flow rate using ASTM D 2116.

In view of the foregoing, the decision of the Examiner rejecting claims 1 and 3-20 is under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

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