

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHERYLYN LEE and LARRY F. CHARBONNEAU

Appeal No. 95-2142
Application No. 07/996,423¹

ON BRIEF

Before SCHAFER, OWENS and WALTZ, Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

DECISION ON APPEAL

Applicants appeal from the final rejection of claims 21-41, all the claims in the application.

We have jurisdiction under 35 U.S.C. § 134.

The examiner entered two rejections:

¹ Application for patent filed December 23, 1992. According to appellants, this application is a division of Application 07/687,801, filed April 19, 1991, now U.S. Patent No. 5,204,443, issued April 20, 1993.

1. Claims 21-41 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Yoon,² Magagnini³ and Pielartzik;⁴ and
2. Claims 21 and 32 stand rejected under 35 U.S.C. § 112, ¶ 2, as indefinite.

We vacate and remand the § 103 rejection and reverse the rejection under § 112.

The rejection under 35 U.S.C. § 103

In general terms, the claimed subject matter is a method of producing a poly (ester-amide) fiber by preparing a specified poly (ester-amide) composition, heating the composition until it melts, and spinning the melt to form fibers. On this record, the composition and the fibers have not been asserted to lack novelty and/or to have been obvious. Indeed, the poly (ester-amide) composition and fibers are patented in U.S. Patent 5,204,403, which issued from the parent of the application involved in this appeal. On this record the steps of the process, i.e., preparing a poly (ester-amide), heating to melt the composition and spinning the melt to make fibers, is old. The difference between the old and conventional process and the claimed subject matter is the specific starting poly (ester-amide) composition and fibers made from that composition. None of the references is asserted to suggest the specific combination of ingredients making up the poly (ester-amide) composition.

Not surprisingly, the examiner's rejection is based upon In re Durden, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985). The examiner's position can be understood from the following excerpt from the Examiner's Answer:

[A]pplicants['] claims are not directed to a method of using the polymer, but are directed to the method of making a fiber from [a] starting polymer [which] is novel and unobvious which does appear to be analogous to In re Durden, i.e. a method

² U.S. Patent No. 4,562,244 issued December 31, 1985.

³ U.S. Patent No. 4,833,229 issued May 23, 1989.

⁴ U.S. Patent No. 5,030,730 issued July 9, 1991 (filed September 5, 1989).

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of making a non-obvious product (the particular fiber) from a non-obvious starting material (the polyesteramide). Note that applicants['] claims merely provide a conventional method for obtaining a fiber, i.e. melt-spinning. There is no particular novelty evident in the claimed process steps which produce a non-obvious type of fiber.

Examiner's Answer, p. 5-6.

The continued viability of a Durden-type rejection was brought into question in In re Dillon, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (Fed. Cir. 1990) (in banc), cert. denied, 500 U.S. 904 (1991).

The court therein stated:

Suffice it to say that we do not regard Durden as authority to reject as obvious every method claim reading on an old type of process, such as mixing, reacting, reducing, etc. The materials used in a claimed process as well as the result obtained therefrom, must be considered along with the specific nature of the process, and the fact that new or old, obvious or nonobvious, materials are used or result from the process are only factors to be considered, rather than conclusive indicators of the obviousness or nonobviousness of a claimed process. When any applicant properly presents and argues suitable method claims, they should be examined in light of all these relevant factors, free from any presumed controlling effect of Durden. Durden did not hold that all methods involving old process steps are obvious; the court in that case concluded that the particularly claimed process was obvious; it refused to adopt an unvarying rule that the fact that nonobvious starting materials and nonobvious products are involved ipso facto makes the process nonobvious. Such an invariant rule always leading to the opposite conclusion is also not the law.

The Court of Appeals for the Federal Circuit has most recently spoken on this issue in In re Ochiai, 71 F.3d 1565, 1569, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995). The court, in reversing a Durden-type rejection, cast out the "method of making" and "method of using" distinctions which had previously existed in patentability jurisprudence. The court emphasized that § 103 requires consideration of the invention as a whole. The court stated:

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The test of obviousness *vel non* is statutory. It requires that one compare the claim's "subject matter as a whole" with the prior art "to which said subject matter pertains." 35 U.S.C. Section 103. The inquiry is thus highly fact-specific by design. This is so "whether the invention be a process for making or a process of using, or some other process." [Citations omitted.]

Here the examiner has not compared the "subject matter as a whole," including the starting poly (ester-amide) composition, with the prior art. It appears that the examiner has not evaluated, on this record, whether the prior art would have suggested the specific poly (ester-amide) composition within the scope of applicants' claims. Accordingly, we vacate the examiner's rejection under 35 U.S.C. § 103 and remand for further examination in light of *Ochiai* and the PTO Notice titled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" published in the Federal Register at _____ Fed. Reg. _____ and republished at 1184 Official Gaz. U.S. Pat. & Tradem'k Off. 86 (March 26, 1996).

The rejection of claims 21 and 32 under 35 U.S.C. § 112, ¶ 2

The examiner also rejects claims 21 and 32 under 35 U.S.C. § 112, ¶ 2, as being indefinite. The examiner states:

In claims 21 and 32 applicants have not specified how the melt-processable poly(ester-amide) is prepared. Note, that step (b) refers to heating the resulting composition. Note also that [sic, the] method should at least recite a positive, active step [Emphasis original.]

Examiner's Answer, p. 7.

A decision as to whether a claim is invalid under § 112, ¶ 2, requires a determination whether those skilled in the art would understand what is claimed. *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d, 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991). The legal standard for definiteness is whether a claim reasonably apprises those having ordinary skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We fail to see how the lack of a

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statement as to how the poly (ester-amide) is prepared makes the scope protection applicants seek indefinite. While the claims are broad and cover any technique used to prepare the poly (ester-amide), breadth alone does not make claims indefinite. See, In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970).

The rejection of claims 21 and 32 under 35 U.S.C. § 112, ¶ 2, is reversed.

REVERSED-IN-PART, VACATED AND REMANDED

RICHARD E. SCHAFER)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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