Paper No. 25

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY BLOOM

Appeal No. 1995-4243
Application 07/924,591[1]

ON BRIEF

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

WALTZ, **Administrative Patent Judge.**

ON REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 1.197(b)(amended Dec. 1, 1997), appellant has submitted a request for

[1] Application for patent filed August 8, 1992. According to applicant, this application is a continuation of Application 07/650,960, filed February 5, 1991.

reconsideration[2] of our decision dated August 24, 1998, affirming the rejection of claims 2-4, 9-11, and 13-14 under the first paragraph of 35 U.S.C. § 112 for lack of descriptive support.[3]

Appellant requests rehearing based on two issues only with respect to claim 11 (Request, page 3). Specifically, appellant requests that the Board reconsider its decision that there is insufficient support in the originally filed disclosure for the subject matter of claim 11. Appellant also requests that the Board reconsider its decision to affirm the rejection of claim 11 since the rejection of claim 12 was reversed and both claims are “subsets of the table on page 8" of the specification (**Id.**).

Both issues are related and will be addressed together. The ratios of silicon to boron in independent claim 14 were held to lack descriptive support in the originally filed

[2] A request for reconsideration is now denominated as a request for rehearing. See 37 CFR § 1.197(b), amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997).

[3] All other rejections on appeal were reversed.

specification (Decision, pages 9-10). As noted by appellant on page 2 of the Request, claim 11 depends from claim 3, which in turn depends from independent claim 14. Claim 11 recites weight % ranges for a glass frit of lead monoxide, boron oxide, and silica. As also noted by appellant on page 4 of the Request, claim 11 recites
the transitional term “comprising” regarding the glass frit composition. The transitional term “comprising” permits the inclusion of other materials. **In re Baxter**, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

Conversely, claim 12 recites a specific composition of the glass frit which “consists of” lead monoxide, boron oxide and silica. The transitional term “consists of” closes the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith (see footnote 4 on page 11 of the Decision). Accordingly, there is basis in the originally filed disclosure for the composition “consisting of” the three ingredients recited in claim 12 on appeal with the attendant boron to silica ratio which is within the scope of claim 14. However, we have determined

that there is no basis in the originally filed disclosure for the composition “comprising” the three ingredients recited in claim 11 on appeal since the boron to silica ratios are inherent to the composition only when three ingredients are present, i.e., when the claim is closed to other ingredients.

Appellant argues that the basis for claim 11 on appeal is evident from the specification at page 8. However, the ranges recited in claim 11 on appeal, derived from the examples in the table on page 8 of the specification, possess an inherent boron to silica ratio **only** when the composition is limited to “consisting of” language, i.e., the three ingredients recited in the table. As previously noted on pages 9-10 of the decision, there is no other basis for the boron to silica ratios recited in independent claim 14.

We do not find in the Request any argument convincing us of error in the conclusions we reached in our decision. Accordingly, appellant’s Request for Rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Appeal No. 1995-4243
Application 07/924,591

DENIED

BRADLEY R. GARRIS Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
THOMAS A. WALTZ Administrative Patent Judge	)	

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