Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE I. ARNO

Appeal No. 2004-1937
Application No. 09/086,033

ON BRIEF

Before GARRIS, WALTZ, and DELMENDO, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to a request, filed October 14, 2004, for rehearing of our decision, mailed September 16, 2004, wherein we affirmed the examiner's written description rejection of all appealed claims under the first paragraph of 35 U.S.C. 112.

In our decision, we agreed with the examiner that the written description requirement was violated by the independent claim limitation involving the maintenance of a pH level of about

4.5 to about 6.5 in a scrubber unit aqueous medium containing sodium thiosulfate or potassium iodide. In response to the appellant's argument that Figure 4 of his drawing shows effective abatement of fluorine containing compounds and fluorine in the aforenoted pH range, the decision emphasized that Figure 4 is based on Test 4 in Table 2 on specification page 13 and that Test 4 does not involve use of either sodium thiosulfate or potassium iodide as required by the independent claims on appeal. As a consequence, it was our determination that "the appellant's disclosure does not convey possession of the here claimed feature wherein the recited pH range is maintained in an aqueous medium which contains sodium thiosulfate or potassium iodide and certainly does not convey the here claimed feature of injecting sodium thiosulfate or potassium iodide in an amount to maintain the pH range" (decision, page 6).

In the subject request, the appellant "agrees that Test 4 and the results shown in Figure 4 do not reflect an aqueous solution with an enhancer [i.e., sodium thiosulfate or potassium iodide]" (request, page 3). Nevertheless, the appellant argues that "using the results of Test 4, one skilled in the art can determine an effective pH range and subsequently determine what necessary enhancers are required to maintain this pH range for

optimal abatement [of fluorine gas]" (request, page 4). Whether one skilled in the art can make these determinations relates to the issue of enablement which is irrelevant to the written description issue raised by the examiner's rejection and resolved in our decision. This is because conclusive evidence of a claim's enablement is not equally conclusive of a claim's compliance with written description. In re Curtis, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004).

The appellant further argues that possession of the claimed subject matter under consideration would have been conveyed by his Figure 4/Test 4 disclosure in combination with the specification disclosure on lines 1-18 of page 8. This specification disclosure relates to the use of a reducing agent such as sodium thiosulfate or potassium iodide to increase fluorine gas abatement and to inhibit formation of OF_2 wherein the reducing agent is added to the water scrubber unit in response to a monitoring means such as a pH monitoring device whereby the reducing agent is introduced at a rate and in an amount correlated to the sensed pH value. However, neither the specification nor the drawing contains any teaching which relates this page 8 disclosure to the Figure 4/Test 4 disclosure concerning pH range. Indeed, the absence of a relationship

between the reducing agent disclosure on lines 1-18 of page 8 and the pH range disclosure of Figure 4/Test 4 is highlighted by the disclosure on lines 20-23 of specification page 8 wherein the appellant teaches an alternative embodiment wherein the amount and rate by which the reducing agent is introduced may be based on the concentration of fluorocompound sensed by an exhaust gas monitor rather than the sensed pH value of the scrubbing unit aqueous medium.

Thus, the appellant's disclosed use of sodium thiosulfate or potassium iodide to increase fluorine abatement and to inhibit OF_2 formation is seemingly unrelated to the particular pH range disclosed in Figure 4/Test 4 which does not involve use of these or any other reducing agents. In fact, for all that can be determined based on the appellant's original disclosure, the particular pH range under consideration is not well suited for achieving the fluorine abatement and OF_2 inhibition functions of these agents. Under these circumstances, we continue to believe that the appellant's original disclosure would not convey possession of the appealed independent claim feature wherein the recited pH range is maintained in an aqueous medium which contains sodium thiosulfate or potassium iodide. Further, our continued belief is even more well founded with respect to the

here claimed feature wherein sodium thiosulfate or potassium iodide is injected in an amount to maintain the recited pH range. In this last mentioned regard, it is appropriate to stress that the appellant's disclosure contains no teaching or even suggestion that these agents perform a pH-affecting function.

In light of the foregoing, the appellant's request for rehearing is hereby denied.

REHEARING-DENIED

Bradley R. Garris Administrative Patent Judge	)	
Thomas A. Waltz Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Romulo H. Delmendo Administrative Patent Judge	)	

BRG/tdl

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