

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(2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD E. CAMPBELL, JR.

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Appeal No. 94-3878  
Application 07/740,529<sup>1</sup>

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ON BRIEF

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Before SOFOCLEOUS, GARRIS and OWENS, Administrative Patent Judges.  
SOFOCLEOUS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 to 12,  
all the claims remaining is the application.

Claim 1 is illustrative and reads as follows:

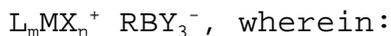
1. A process for preparing polymers of vinyl aromatic  
monomers having a high degree of syndiotacticity comprising  
contacting at least one polymerizable vinyl aromatic monomer

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<sup>1</sup> Application for patent filed August 5, 1991.

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under polymerization conditions with a catalyst comprising a metal complex corresponding to the formula:



L is a delocalized **B**-bonding group or substituted group containing up to 50 nonhydrogen atoms;

m is 0 or 1;

M is a metal of Group 4 of the Periodic Table;

X each occurrence is an inert, anionic ligand containing up to 20 nonhydrogen atoms;

n is an integer greater than or equal to 1 and the sum of m and n is one less than the valence of M;

R is hydrocarbyl, silyl, a combination thereof or a substituted derivative thereof having up to 20 nonhydrogen atoms;

B is boron; and

Y is an inert covalently bound group having up to 40 atoms and  $BY_3$  is a stable borane compound able to abstract an R group from a compound of the formula  $L_mMX_nR$ .

Claims 1 to 12 stand rejected under 35 U.S.C. § 112, first paragraph, as being broader than the enabling disclosure.

We will not sustain this rejection.

An application disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken in compliance with the enabling requirement of the first paragraph of 35 U.S.C.

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§ 112 unless there is reason to doubt the objective truth of statements contained therein. Fiers v. Revel, 984 F.2d 1164, 1171-72, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993). It is incumbent upon the examiner to explain why he doubts the truth or accuracy of any statement in a supporting disclosure and to back up his assertions with acceptable evidence or reasoning which is inconsistent with the contested statement. In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). That some experimentation is necessary does not preclude enablement; the amount of experimentation, however, must not be unduly extensive. Atlas Powder Co. v. E.I. Du Pont de Nemours & Co, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1989). The fact that a claim embraces some combinations which are inoperative does not necessarily make the claim inoperative so long as the number of inoperative embodiments does not become significant. Atlas Powder Co. v. E.I. Du Pont de Nemours & Co, supra.

Here, the examiner contends that the disclosure is enabled only for claims limited to metal complexes substituted with a delocalized **B**-bonding group, i.e., where  $m = 1$  in the formula depicted in claim 1. The examiner urges that it would require undue experimentation to ascertain which of appellant's metal complexes lacking a delocalized **B**-bonding group, i.e., where

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m = 0 in the formula, would be operative in the claimed process, and that from a structural and steric standpoint, those complexes within the claimed formula where m = 0 are so different from those complexes where m = 1 (the cyclopentadienyl metal complexes disclosed in the examples of the appellant's disclosure) as to preclude any reasonable prediction concerning their activity in the claimed process. Referring to the limited disclosure of metallocyclopentadienyl catalyst precursors, the examiner urges that the notoriously high level of unpredictability and empiricism associated with catalytic phenomena would render the disclosure enabling only for those catalysts where m = 1.

The examiner, however, has failed to substantiate his position with persuasive objective evidence or scientific reasoning. He has not cited any evidence to show that one skilled in the art would not have been enabled by the disclosure coupled with information known in the art to practice the claimed invention without undue experimentation. The examiner has not explained how those complexes where m = 0 are so different from those where m = 1 such that one skilled in the art, armed with the supporting disclosure, would not be able to practice the claimed invention.

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Accordingly, the examiner's rejection of the appealed claims  
is reversed.

REVERSED

MICHAEL SOFOCLEOUS	)	
Administrative Patent Judge	)	
	)	
	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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