

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 76

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUILIO NATTA, PIERO PINO
and GIORGIO MAZZANTI

Appeal No. 95-2683
Application No. 07/883,912¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and WEIFFENBACH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

¹ Application for patent filed May 12, 1992. According to appellants, this application is a continuation of Application No. 07/719,666, filed June 24, 1991; which is a continuation of Application No. 07/607,215, filed October 29, 1990; which is a continuation of Application No. 06/906,600, filed September 10, 1986; which is a continuation of Application No. 06/498,699, filed May 27, 1983; which is a continuation of Application No. 04/710,840, filed January 24, 1958; which is a division of Application No. 04/514,097, filed June 8, 1955; all abandoned.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 11-17, all the claims remaining in the present application.

Claim 11 is illustrative:

11. A process which comprises interpolymerizing ethylene with an alpha olefin $\text{CHR}=\text{CH}_2$, wherein R is a saturated aliphatic radical with 2 or more carbon atoms or a cycloaliphatic radical, in the presence of a coordination catalyst, one component of which contains a Ti-Cl bond.

In the rejection of the appealed claims, the examiner relies upon the following references:

Anderson et al. (Anderson)	2,905,645	Sep. 22, 1959
Vandenberg	3,058,963	Oct. 16, 1962

Appellants' claimed invention is directed to a process for interpolymerizing ethylene and an alpha olefin of the recited formula in the presence of a coordination catalyst having a component containing a Ti-Cl bond.

Appellants submit at page 2 of the principal Brief that "[t]he claims are not grouped separately." Accordingly, all the appealed claims stand or fall together as they are grouped by the examiner in different rejections.

Claims 11 and 17 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original specification that does not provide descriptive support for the claim

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language "coordination catalyst, one component of which contains a Ti-Cl bond." Claims 11-17 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original specification that does not provide descriptive support for the claim language "interpolymerizing ethylene with an alpha olefin $\text{CHR}=\text{CH}_2$, wherein R is a saturated aliphatic radical with 2 or more carbon atoms or a cycloaliphatic radical" (claim 11) and "interpolymerizing ethylene with styrene $\text{C}_6\text{H}_5\text{CH}=\text{CH}_2$ " (claim 17). Claims 11-13 and 17 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Vandenberg. Claims 14-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vandenberg. Also, claims 11-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anderson in view of Vandenberg.

We will sustain the examiner's rejection of claims 11 and 17 under 35 U.S.C. § 112, first paragraph. The examiner has set forth an explanation that the term "coordination catalyst" is not described within the meaning of § 112, first paragraph, in appellants' original U.S. Application Serial No. 04/514,097, filed June 8, 1955 and Italian Patent Application, Serial No. 25109, filed July 27, 1954, which applications

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appellants claim priority under 35 U.S.C. § 120 and 35 U.S.C. § 119, respectively. For instance, the examiner explains that coordination catalysts "were known to be able to be formed from titanium chloride and a Group I alkyl compound or an elemental non-transition metal such as aluminum or lithium" (page 4 of Answer), and the applications upon which appellants base priority do not disclose that the catalysts of the present invention are formed from such materials. Also, the examiner points out that there is no evidence of record which establishes that the catalyst compositions described in the original applications were known by those skilled in the art as "coordination catalysts." On the other hand, our review of appellants' principal and Reply Briefs reveals that appellants have not advanced any substantive argument that rebuts the examiner's position. Indeed, appellants' principal and Reply Briefs present no argument that the claim language "coordination catalyst" is described in the applications upon which priority is based. Consequently, we will sustain the examiner's rejection.

Although appellants have presented no substantive arguments refuting the rejection discussed above, appellants

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have presented arguments of a legal nature that are applicable to all the examiner's rejections. Appellants contend that their count in an earlier interference proceeding of the present invention is of the same breadth as claim 11 presently on appeal and, therefore, since the interference count was considered allowable by Examiner Schoffer, Manual of Patent Examining Procedure (MPEP) § 706.04 warrants our reversal of the examiner's rejection. In relevant part, appellants rely upon the language of the MPEP which states "[i]n general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner . . ."

We do not subscribe to appellants' position. The MPEP provides general guidance to the Examining Corps, and such guidance is not tantamount to a proscription on an examiner's entry of a new rejection of an allowed claim. While the examiner's rejection may be a petitionable matter to the Commissioner of the U.S. Patent and Trademark Office (PTO), our scope of review does not extend to such matters. The guidance given by the relevant section of the MPEP can not serve to preclude our review of the merits of the examiner's rejection before us, or mandate our reversal of the rejection.

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Further-more, the PTO is within its statutory right to reject an application at any time before issuance.

Appellants also contend that the Board is bound by the decision in Anderson v. Natta, 480 F.2d 1392, 178 USPQ 458 (CCPA 1973), which decision awarded priority to appellants. According to appellants, we are bound "from reaching a different conclusion on the patentability of the claimed subject matter to Natta et al." (page 11 of principal Brief). However, res judicata is not applicable to the present appeal since the court in Anderson v. Natta did not address the rejection under 35 U.S.C. § 112, first paragraph, presently before us. Indeed, the court expressly refused to entertain arguments pertinent to 35 U.S.C. § 112, first paragraph, since such arguments were not at issue "at any point below, and we will not consider it for the first time on appeal." Anderson v. Natta, 480 F.2d at 1399, 178 USPQ at 463.

We are also not persuaded by appellants' argument that res judicata and collateral estoppel from the earlier interference proceeding precludes us from reviewing the examiner's rejections because a final judgment in an interference is conclusive of all matters that were

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adjudicated and might have been adjudicated. The cases cited by appellants, e.g., Ex parte Tygat, 225 USPQ 907 (Bd. App. 1985) and Ex parte Kroekel, 230 USPQ 191 (Bd. Pat. App. & Int. 1986), stand for the proposition that parties to an interference cannot reinstitute matters that were adjudicated or might have been adjudicated in a prior interference proceeding, but such cases place no prohibition on the PTO to reopen prosecution of any application before issuance, including the applications of winning parties in an interference. Appellants have cited no legal authority to support the principle that the PTO is estopped from reopening prosecution and entering a new ground of rejection in an application that prevailed in an interference, and we know of no such authority.

We will not sustain the examiner's rejection of claims 11-17 under 35 U.S.C. § 112, first paragraph, on the basis that there is no descriptive support for the claim language "interpolymerizing ethylene with an alpha olefin $\text{CHR}=\text{CH}_2$ wherein R is a saturated aliphatic radical with 2 or more carbon atoms or a cycloaliphatic radical" (claim 11) and "interpolymerizing ethylene with styrene $\text{C}_6\text{H}_5\text{CH}=\text{CH}_2$ " (claim

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17). The thrust of the examiner's rejection is that the original specification provides an upper limit of 5% ethylene, but the appealed claims encompass an unlimited range for the amount of ethylene. On this point we agree with the reasoning presented by appellants at pages 17 and 18 of the principal Brief. Fatal to the examiner's rejection is the fact that the appealed claims contain no language regarding the amount of ethylene used in the polymerization process that is not described in the original specification. For instance, the appealed claims do not recite that the amount of ethylene is in excess of 5%. While it can be argued that the appealed claims encompass amounts of ethylene greater than 5%, it is well settled that it is not the function of the claims to specifically exclude possible inoperable substances or ineffective reactant proportions. In re Dinh-Nguyen, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974); In re Anderson, 471 F.2d 1237, 1242, 176 USPQ 331, 334-35 (CCPA 1973). See also In re Kamal, 398 F.2d 867, 872, 158 USPQ 320, 324 (CCPA 1968); and In re Sarett, 327 F.2d 1005, 1019, 140 USPQ 474, 486 (CCPA 1964). In our view, the examiner's line of reasoning is more appropriate for a

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rejection under the enablement requirement of 35 U.S.C. § 112, first paragraph. However, the examiner has effectively precluded any rejection under the enablement requirement of § 112, first paragraph, by dismissing the Corradini, Giannini I and Giannini II declarations as "directed to the proposition of enablement" (page 8 of Answer).

As for the examiner's position that the original specification does not provide equivalent language for the claim language "interpolymerizing ethylene with an alpha olefin $\text{CHR}=\text{CH}_2$ wherein R is a saturated aliphatic radical with 2 or more carbon atoms or a cycloaliphatic radical" and "interpolymerizing ethylene with styrene $\text{C}_6\text{H}_5\text{CH}=\text{CH}_2$," we find that the passages in the specification cited by the examiner provide descriptive support for the criticized claim language within the meaning of § 112, first paragraph. For instance, see page 10, lines 10-14 of the original specification.

We now turn to the examiner's rejections of claims 11-13 and 17 under § 102 over Vandenberg, claims 14-16 under § 103 over Vandenberg and claims 11-17 under § 103 over Anderson in view of Vandenberg. Appellants state that the dispositive issue for these rejections is whether parent application U.S.

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Administrative Patent Judge)	APPEALS AND
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