

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NATHAN FELDSTEIN  
and DEBORAH J. LINDSAY

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Appeal No. 1996-3535  
Application No. 08/236,006

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on an appeal which involves claims 20 through 27, 44 through 51, 58 and 61. The only other claims remaining in the application, which are claims 28 through 43, 52 through 57, 59, 60, 62 and 63 stand withdrawn from further consideration by the examiner.

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The subject matter on appeal relates to a process for electrolessly metallizing a body to provide on the surface thereof a metal coating incorporating therein particulate matter which comprises contacting the surface of the body with an electroless metallizing bath which contains a particulate matter stabilizer that shifts the Zeta potential for the particulate matter by at least 10 mv. Further details of this appealed subject matter are set forth in representative independent claim 20 which reads as follows:

20. A process for electrolessly metallizing a body to provide on the surface thereof a metal coating incorporating therein particulate matter which comprises contacting the surface of said body with an electroless metallizing bath comprising an aqueous solution of a metal salt, a reducing agent, a quantity of insoluble particulate matter and a quantity of particulate matter stabilizer, wherein said particulate matter stabilizer shifts the Zeta potential for said insoluble particulate matter by at least 10 mv in comparison to the measured Zeta potential of said insoluble particulate matter alone in water.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Metzger et al. 1971	3,617,363	Nov. 2,
Kurosaki et al. 1974	3,787,294	Jan. 22,

All of the appealed claims are rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a disclosure

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which would not enable one with ordinary skill in the art to practice the here claimed invention.

Claims 20, 21, 23 through 27, 44, 45, 47 through 51, 58 and 61 are rejected under 35 U.S.C. § 103 as being unpatentable over Metzger in view of Kurosaki.

Neither of these rejections can be sustained.

Concerning the section 112, first paragraph, rejection, the examiner argues that the appellants' disclosure is enabling only for electroless metallizing bath compositions comprising the specific particulate matter materials, the specific particulate matter stabilizers and the specific concentrations for these materials and stabilizers set forth in Table 1 of the subject specification. According to the examiner, this is because "[t]here is insufficient teaching as to what criteria might be used to suggest an appropriate particulate matter stabilizers-particulate matter pairs" (answer, page 9) and correspondingly because "one skilled in the art would have to perform undue experimentation to determine operative compositions within the bounds of the instant claims and practice the invention as it is now set forth" (answer, page 10). We cannot agree.

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It is well settled that the Patent and Trademark Office must carry its burden of questioning enablement by advancing acceptable reasoning inconsistent with enablement. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). The examiner has advanced no such reasoning. Contrary to the examiner's argument, the criteria for practicing the here claimed invention is plainly taught in the appellants' specification disclosure and further, is explicitly set forth in the appealed claims. Specifically, this criteria involves the shifting of Zeta potential by a particular amount, and the examiner has proffered no evidence or reasoning that the appellants' disclosure would not enable an artisan with ordinary skill from using this criteria of Zeta potential shift in order to practice the here claimed invention. On the other hand, the appellants have submitted evidence (e.g., see the Dumas affidavit filed December 5, 1994) which militates against the examiner's nonenablement position.

Under these circumstances, it is our determination that the examiner has failed to carry his burden of proof in calling into question the enablement of the appellants' disclosure. In essence, the examiner has demanded without

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appropriate evidence or reasoning that the appellants limit their claims to the specific materials and concentrations which have been exemplified in specification Table 1 as effecting the desired Zeta potential shift of the here claimed invention. However, to demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process would not serve the constitutional purpose of promoting progress in the useful arts. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

In light of the foregoing, the examiner's section 112, first paragraph, rejection cannot be sustained.

The examiner's section 103 rejection likewise cannot be sustained. The applied references contain no teaching, suggestion or motivation to combine the applied references in the manner proposed by the examiner based upon a reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). In this regard, it is significant that Metzger relates to a process for electroless metallizing whereas Kurosaki relates to a process

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for electroplating. The examiner's opinion that it would have been obvious to combine these disparate processes plainly lacks probative support.

Even if the electroless metallizing process of Metzger were provided with a stabilizer from Kurosaki's electroplating process, the result would not correspond to the here claimed process. This is because neither of the applied references contains any teaching or suggestion concerning particulate matter stabilizers of the type and at the concentrations necessary to effect the Zeta potential shift required by the appealed claims. It is apparent that this aspect of the examiner's rejection is impermissibly based upon pure speculation and conjecture. It has been long established, however, that a rejection based on section 103 must rest upon a factual basis rather than conjecture, speculation or assumptions. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

The decision of the examiner is reversed.

REVERSED

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	Bradley R. Garris	)	
	Administrative Patent Judge	)	
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		)	
	Terry J. Owens	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Catherine Timm	)	
	Administrative Patent Judge	)	

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