

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

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Ex parte TETSUZI OHTA

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Appeal No. 1997-1449  
Application 08/312,036<sup>1</sup>

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ON BRIEF

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Before: McKELVEY, Senior Administrative Patent Judge, and  
LEE, and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

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<sup>1</sup> Application for patent filed September 26, 1994.

Appeal No. 97-1449  
Application 08/312,036

Upon consideration of the appellant's APPEAL BRIEF (Paper 19) and the EXAMINER'S ANSWER (Paper 20), there being no reply brief, it is

ORDERED that the decision of the examiner rejecting claims 11 and 13-18 is reversed.

The examiner believes that disclosure of four species is not an enabling disclosure commensurate in scope with the breadth of the claims. In essence, the examiner--without saying so in so many words--is concerned that undue experimentation would be necessary to determine suitable monomers which could be used in the claimed recording material. The difficulty with the examiner's position is that it is not supported by the evidence. Compare Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986) (discussion of factors to be considered in determining whether undue experimentation would be necessary to justify broad claim), which was approved by the Federal Circuit in In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), and see In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

**REVERSED**

Appeal No. 97-1449  
Application 08/312,036

_____	)	
FRED E. McKELVEY, Senior	)	
Administrative Patent Judge	)	
	)	
	)	
_____	)	
JAMESON LEE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
_____	)	
RICHARD TORCZON	)	
Administrative Patent Judge	)	

Appeal No. 97-1449  
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cc (via First Class Mail)

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