

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT E. STIEGMAN

Appeal No. 1997-1667
Application 08/226,819

ON BRIEF

Before JOHN D. SMITH, GARRIS, and DELMENDO, Administrative
Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection
of claims 6 through 12, 16 through 20 and 22 through 38. The
only other claims remaining in the application, which are

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Claims 6 through 12, 25, 27 through 33 and 36 through 38 stand rejected under the second paragraph of 35 U.S.C. § 112 as failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.

Claims 6 through 10, 16 through 20 and 25 through 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baiker; claim 12 stands correspondingly rejected as being unpatentable over Baiker in view of Ghosh; and claims 22 through 24 stand correspondingly rejected as being unpatentable over Baiker in view of Dougherty.

OPINION

For the reasons set forth below, we will sustain the examiner's section 112, second paragraph, rejection of claim 28 but will not sustain any of the other section 112 or section 103 rejections before us on this appeal.

The section 112, second paragraph, rejection

As correctly indicated by the appellant in the brief, the examiner's indefiniteness position is not well founded with respect to the claim 11 term "thin" (in addition to the appellant's comments, see page 9 of the subject specification

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regarding the meaning of this term), the expression "exhibiting . . . species" in claims 6 and 25 (in addition to the appellant's comments, see pages 6 and 7 of the subject specification regarding the meaning of this expression), or the term "oxometal" in claims 27, 33, 36 and 38. It follows that we cannot sustain the examiner's section 112, second paragraph, rejection of claims 6 through 12, 25, 27, 29 through 33 and 36 through 38.

However, we will sustain the examiner's section 112, second paragraph, rejection of claim 28 since the appellant has not contested and in fact appears to agree with the examiner's criticism of this claim (see the paragraph bridging pages 7 and 8 of the brief).¹

The section 103 rejections

Concerning the section 103 rejection based upon Baiker alone, the examiner points to nothing and we find nothing

¹In any further prosecution that may occur, the appellant and the examiner should address and resolve whether the examiner's aforementioned criticism of claim 28 is also applicable to claims 7 and 17.

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independently in this reference which would have suggested somehow modifying the teachings thereof in such a manner as to yield products of the type defined by the appealed claims.

Alternatively, we are cognizant of the examiner's statement on page 7 of the answer that, "[c]oncerning Baiker alone, the failure of the reference to explicitly discuss certain [here claimed] features is not persuasive [of patentability] since it does not mean that the materials of Baiker lack these properties." This statement reflects that the examiner regards the products/materials of Baiker as corresponding to the appellant's claimed products/materials and concomitantly that Baiker's products/materials inherently possess the properties recited in the appealed claims. However, the record before us contains utterly no evidence or rationale in support of such a position. See, for example, In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999); Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. App. Pat. & Int. 1986). On the other hand, the appellant's declaration filed June 27, 1996 under 37 CFR § 1.132 evinces that the products/materials of Baiker do not correspond to and

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do not inherently possess the properties of the here claimed products/materials.

Under the circumstances recounted above, we consider the examiner's nonobviousness conclusion based upon Baiker alone to be without support. As a result, we cannot sustain the examiner's section 103 rejection of claims 6 through 10, 16 through 20 and 25 through 38 as being unpatentable over Baiker.

Furthermore, the above discussed deficiencies of Baiker plainly are not supplied by the secondary references to Ghosh and Dougherty. Thus, even assuming it would have been obvious to combine Baiker with these secondary references, the result of this combination would not correspond to the subject matter defined by the rejected claims. It follows that we also cannot sustain the examiner's section 103 rejection of claim 12 as being unpatentable over Baiker in view of Ghosh or his corresponding rejection of claims 22 through 24 as being unpatentable over Baiker in view of Dougherty.

Summary

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We have sustained the examiner's section 112, second paragraph, rejection of claim 28. However, we have not sustained any of the other rejections advanced by the examiner on this appeal.

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The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

	John D. Smith)	
	Administrative Patent Judge)	
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)	
	Bradley R. Garris)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Romulo H. Delmendo)	
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