

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL LEBLANS,
PETER WILLEMS,
LUC STRUYE,
JOHANN-MARTIN SPAETH,
and
THOMAS PAWLIK

Appeal No. 1997-2937
Application No. 08/420,562

HEARD: NOVEMBER 16, 2000

Before PAK, WALTZ, and TIERNEY, **Administrative Patent Judges**.
WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 3, 5 through 8, 11 through 13 and 15 through 18 as amended subsequent to the final rejection (see the amendment dated July 1, 1996, Paper No. 8, entered as

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per the Advisory Action dated July 12, 1996, Paper No. 9).
Claim 19, the only other claim pending in this application,
has been objected to by the examiner and is not the subject of
this appeal (see Paper No. 9 and the Brief, page 2).

According to appellants, the invention is directed to a
method for recording X-rays by exposing a recording element
comprising an X-ray intensifying screen utilizing an
elposolite phosphor having a specific formula (Brief, page 3).
Claim 1 is illustrative of the subject matter on appeal and a
copy of this claim is attached as an Appendix to this
decision.

Claims 1 through 3, 5 through 8, 11 through 13 and 15
through 18 stand rejected under 35 U.S.C. § 112, first and
second paragraphs, "as the claimed invention is not described
in such full, clear, concise and exact terms as to enable any
person skilled in the art to make and use the same, and/or for
failing to particularly point out and distinctly claim the
subject matter which applicant regards [sic, appellants

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regard] as the invention." (Answer, page 3).¹ We reverse the examiner's rejections essentially for the reasons stated by appellants on pages 4-6 of the Brief and pages 1-3 of the Reply Brief. We add the following comments for completeness.

OPINION

Since all of the claims on appeal have been rejected under the first and second paragraphs of 35 U.S.C. § 112, we begin our analysis with a determination of whether the claims satisfy the requirements of the second paragraph. *In re Angstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). It is well settled that the examiner bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

"The legal standard for definiteness [under § 112, ¶2] is

¹The final rejection of claims 3 through 5 and 13 through 15 under § 112, second paragraph, was withdrawn by the examiner in view of the amendment subsequent to the final rejection (see the Advisory Action dated July 12, 1996, Paper No. 9).

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whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In other words, the inquiry is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity, taken in view of the teachings of the prior art and the application disclosure as interpreted by one of ordinary skill in the art. *See In re Angstadt, supra; In re Moore, supra*. We note that the examiner has advanced no reasons or evidence as to why one of ordinary skill in the art would not be apprised of the scope of the claims (Answer, pages 3-4). Therefore we determine that the examiner has not met the initial burden of proof. Accordingly, the examiner's rejection of the claims on appeal under the second paragraph of 35 U.S.C. § 112 cannot be sustained.

Once having determined that the subject matter defined by the claims is particular and definite, the analysis turns to the first paragraph of § 112 to determine whether the disclosure is enabling for the scope of the claimed subject matter. *In re Angstadt, supra; In re Moore, supra*. When

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rejecting a claim under the enablement requirement of § 112, the examiner again bears the initial burden of setting forth a reasonable explanation as to why it is believed that the scope of the protection provided by the claim is not adequately enabled by the description of the invention provided in the specification, including sufficient reasons for doubting any assertions in the specification as to the scope of enablement. *In re Wright*, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

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The examiner states that

[a]ppellants have not shown all elpasolites, which have the claimed formula and where M^{3+} is any trivalent ion and D is any dopant, will act as either a prompt or a photostimulable phosphor; nor that the elpasolites will function in the claimed methods of using of claims 1 and 11. [Answer, paragraph bridging pages 3-4].

The examiner finds that appellants have only exemplified one composition as being a phosphor and also finds that the phosphor art is "unpredictable." (Answer, page 4). From these findings, the examiner concludes that "the claims fail to satisfy the requirements of 35 USC 112." (*Id.*).

We determine that the examiner has not provided sufficient and convincing reasons for doubting the assertions in the specification. The examiner refers to the "art cited" and a "few references" which show doped elpasolites with an activation wavelength outside the X-ray wavelength range but none of this evidence is presented in the Answer (Answer, page 5). The examiner states that unpredictability of a particular art area alone may provide a reasonable doubt as to the accuracy of a broad statement made in support of a broad claim (*id.*). On the facts of this case, we disagree. "[T]o be

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enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *In re Wright, supra*. Whether making and using the invention would have required undue experimentation, and thus whether the disclosure is enabling, is a legal conclusion based upon several underlying factual inquiries. *See In re Wright, supra; In re Wands*, 858 F.2d 731, 735, 736-37, 8 USPQ2d 1400, 1402, 1404 (Fed. Cir. 1988). Here the examiner has only made the underlying factual finding that the art in question is unpredictable. The examiner has failed to make the other underlying factual inquiries suggested by *In re Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404.

Furthermore, the examiner has failed to show that any experimentation necessary to practice the invention as claimed would be "undue" and not routine, i.e., would "require ingenuity beyond that to be expected of one of ordinary skill in the art." *See In re Angstadt*, 537 F.2d at 503-04, 190 USPQ at 218-19. Even in an unpredictable art, Section 112 does not require disclosure of a test with every species covered by a

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claim. *Id.* Additionally, appellants' claims on appeal are directed to *methods* for recording X-rays. Thus using elpasolite phosphors within the claimed formula which are not functional in the X-ray intensifying screen (claim 1) or the photostimulable phosphor screen (claim 11) would not record X-rays and therefore these phosphors would not be within the scope of the claimed subject matter (Brief, page 4; Reply Brief, page 2).

For the foregoing reasons, we determine that, on this record, the examiner has not met the initial burden of establishing the underlying factual inquiries to support the legal conclusion of lack of enablement under the first paragraph of Section 112.

Accordingly, we reverse the examiner's rejection of the claims on appeal under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is reversed.

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OTHER ISSUES

Although claim 19 is not before us on appeal, we note that claim 19 is an improper dependent claim (see 35 U.S.C. § 112, ¶4) since the value of x in independent claim 11 is between 0 and 0.2 while the value of x in claim 19 is 1.0. Compare the formula of the phosphor in claim 11 with the formula of the phosphor in claim 19 (see the specification, pages 4, 5 and 20). This inconsistency should be explained and/or corrected upon the return of this application to the jurisdiction of the examiner.

REVERSED

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CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
MICHAEL P. TIERNEY)	

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Administrative Patent Judge)

TAW:hh

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APPENDIX

1. A method for recording X-rays comprising the steps of
 - i. exposing a recording element comprising an X-ray intensifying screen in combination with a photosensitive material to X-rays,
 - ii. recording the light emitted by said X-ray intensifying screen in said photosensitive material, wherein said X-ray intensifying screen comprises an elpasolite phosphor corresponding to the general formula:



wherein: A is a monovalent metal ion selected from the group consisting of Cs, Rb, K and Tl ions,

B is a monovalent metal ion selected from the group consisting of Rb, K and Na ions,

A is different from B

$r_A > r_B$, r_A representing the ionic radius of monovalent metal ion A, r_B the ionic radius of monovalent metal ion B

Me^{3+} = a trivalent ion

D is a dopant

X is at least one of F, Cl, Br and I

$0 \leq y \leq 1$

$0 \leq x \leq 0.2$

and wherein said phosphor has a specific gravity (sg) ≥ 4 .

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