

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS L. DULL

Appeal No. 1998-1224
Application No. 08/465,077

ON BRIEF

Before CAROFF, KIMLIN, and PAK, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of claims 25-27. Claims 3-18 and 24, all the other pending claims in appellant's application, have been indicated by the examiner as being allowable.

The appealed claims relate to an etching method involving the use of an etching solution containing cupric chloride and NaCl; the claims requiring that the

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etch rate of the solution decrease "to less than 0.01 mil/min when the desired etch is complete." We shall refer to this rate as the terminal etch rate of the solution. Claim 25, the sole independent claim on appeal, is representative:

25. A method for etching a curved copper film to produce a patterned film with fine-line elements etched to a tolerance of about ± 0.25 mil on all lines, the patterned film being a frequency selective surface suitable for use in a radome, comprising the steps of:

(a) patterning a photolithographic mask deposited on the copper film to expose line widths approximately 1 mil narrower than the desired final width; and

(b) etching the exposed copper to create fine-line elements in the film to a tolerance of about ± 0.25 mil on all lines by immersing the masked film in a quiescent, dilute cupric chloride etching solution having at least about 125 gm/lNaCl sufficient to eliminate any migration or electrolytic effects, the etch rate of the solution declining to less than 0.01 mil/min when the desired etch is complete.

All of the claims on appeal stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of an adequate written description in the specification of appellant's invention as claimed.

After having considered the entire record in light

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of the respective positions of the examiner and the appellant, we agree with appellant that the examiner has failed to establish noncompliance with any of the provisions of 35 U.S.C. § 112, first paragraph.

Accordingly, we cannot sustain the rejection at issue.

The rejection is framed in language which appears to focus upon the written description requirement of 35 U.S.C. § 112. On the other hand, appellant interprets the rejection as translating into an issue of enablement. In either case, it is the examiner who has the burden of persuasion to establish noncompliance with the provisions of 35 U.S.C. § 112. In this regard, see In re Edwards, 568 F.2d 1349, 1354, 196 USPQ 465, 469 (CCPA 1978) as to the written description requirement; and In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971) as to the enablement requirement. We find that the examiner has failed to provide persuasive reasons to support the rejection at issue.

The examiner merely asserts that there is no written disclosure of the terminal etch rate, as claimed, in a generic sense, and that that particular terminal etch

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rate is associated in appellant's specification only with one particular etchant solution, viz., the preferred etchant composition. However, this is not dispositive as regards compliance with the provisions of 35 U.S.C. § 112.

First of all, with regard to the written description requirement, we fail to see how the specification can be found deficient inasmuch as all the relevant claim limitations apparently are described verbatim in the specification.

As for enablement, the claims appear to be limited to use of those etchant solutions which are capable of exhibiting the recited terminal etch rate, and there is no dispute that appellant has disclosed at least one particular etchant solution that satisfies this criteria, i.e., the preferred etchant composition. In other words, we read the claims as being limited to using only etchant solutions which are conducive to reaching the recited terminal etch rate, viz., the claims are limited to operable embodiments.

In this regard, it must be borne in mind that in

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general it is not the function of the claims to specifically exclude possible inoperative embodiments. In re Dinh-Nguyen, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974).

See also In re Kamal, 398 F.2d 867, 872, 158 USPQ 320, 324 (CCPA 1968); In re Anderson, 471 F.2d 1237, 1242, 176 USPQ 331, 334-35 (CCPA 1973) and In re Sarett, 327 F.2d 1005, 1019, 140 USPQ 474, 486 (CCPA 1964).

The decision of the examiner is reversed.

REVERSED

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| | MARC L. CAROFF |) | |
| | Administrative Patent Judge |) | |
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| | |) | BOARD OF PATENT |
| | EDWARD C. KIMLIN |) | APPEALS |
| AND | |) | |
| | Administrative Patent Judge |) | INTERFERENCES |
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| | CHUNG K. PAK |) | |
| | Administrative Patent Judge |) | |

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