

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHINORI MORIZANE

Appeal No. 1999-0461
Application 08/815,682

HEARD: October 11, 2001

Before PAK, WARREN, and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 4-6, which are all of the claims remaining in the application.

THE INVENTION

The appellant's claimed invention is directed toward a method for forming metal oxide micro-spherules. Claim 4 is illustrative:

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Raytheon Co. v. Roper Corp., 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983), *cert denied*, 469 U.S. 835 (1984).

The claimed invention is a method for making metal oxide micro-spherules by subjecting a hydrolyzable organic metal compound to hydrolysis in a recited reaction solution while maintaining the reaction solution pH at 8-10 followed by dehydration and condensation to obtain micro-spherules, rinsing the micro-spherules with water to separate the micro-spherules from the reaction solution, and maintaining the micro-spherules at a temperature of 200°C or below.¹

The examiner argues that the appellant's claims, when read in light of the specification, are limited to a method for making metal oxide glass micro-spherules by vitrifying a reaction product at 200°C or below (answer, pages 3-4 and 6). It reasonably appears that "metal oxide micro-spherules" in the appellant's claims and "metal oxide glass micro-spherules" in the appellant's specification have the same meaning. Each term refers to the micro-spherules formed by the appellant's

¹ The metal oxide micro-spherules are disclosed as being useful in coatings for materials such as metals, pressurized cooking utensils, paper and film (specification, page 1).

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method. Similarly, "maintaining ... at a temperature" reasonably appears to be the same as "vitrifying ... at a temperature", both meaning holding the metal oxide micro-spherules at a particular temperature.

Regarding utility, a predecessor of our appellate reviewing court stated in *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974):

[A] specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented *must* be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter *unless* there is reason for one skilled in the art to question the objective truth of the statement of utility or its scope.

The examiner argues that the appellant's claimed method cannot work because glass cannot be vitrified at temperatures as low as 200°C or below (answer, page 4).² In support of this argument the examiner relies upon Kondo, which discloses making a porous silica gel plate by a sol-gel method and then calcining the plate at a temperature of as least 900°C to

² "Vitrification" is "[t]he conversion of a material into a glass or glasslike substance, of increased hardness and brittleness." *Hackh's Chemical Dictionary* 716 (Julius Grant ed., McGraw-Hill 4th ed. 1969). The examiner provides no evidence that the appellant's metal oxide micro-spherules are not glasslike or of increased hardness and brittleness.

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render it nonporous and suitable for use as a base for a planar optical waveguide (col. 3, line 67 - col. 4, line 11; col. 8, lines 49-59).

The appellant, however, distinguishes the claimed method over the sol-gel method which, the appellant states, requires heat treatment at 1,100°C or higher (specification, page 2). The appellant states that the appellant's method permits metal oxide micro-spherules to be produced at 200°C or below (specification, pages 3 and 18), and provides an example wherein metal oxide micro-spherules are produced at 25°C (specification, pages 16-18). The examiner has provided no evidence that if the appellant's claimed method rather than Kondo's sol-gel method is used, metal oxide micro-spherules cannot be formed at a temperature of 200°C or below. Consequently, we are not persuaded by the examiner's argument that the appellant's claimed method lacks utility.

In the rejection under 35 U.S.C. § 112, first paragraph, enable requirement, the examiner relies upon the same rationale used in the rejection under 35 U.S.C. § 101 (answer,

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page 5).³ We are not convinced by the examiner's argument for the reasons set forth above regarding that rejection.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of lack of

utility or of nonenablement. Accordingly, we reverse the rejections under 35 U.S.C. §§ 101 and 112, first paragraph, enablement requirement.

*Rejection under 35 U.S.C. § 112,
written description requirement*

A specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In*

³ Absence of utility can be the basis of a rejection under both 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, see *In re Brana*, 51 F.3d 1560, 1564 n. 12, 34 USPQ2d 1436, 1439 n.12 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971).

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re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

The examiner argues that the specification does not provide adequate written descriptive support for the term "maintaining" in claim 1 (answer, page 5).

As stated above regarding the rejection under 35 U.S.C. § 101, the maintaining at 200°C or below in claim 1 reasonably appears to be the vitrifying at 200°C or below described in the specification (page 3). This maintaining or vitrifying necessarily must last for some time period. Hence, the specification would have conveyed with reasonable clarity to those skilled in the art that the appellant was in possession of a method in which metal oxide micro-spherules are maintained at 200°C or below. Accordingly, we reverse the rejection under 35 U.S.C. § 112, first paragraph, written description requirement.

DECISION

The rejections of claims 4-6 under 35 U.S.C. § 101 and under 35 U.S.C. § 112, enablement and written description

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requirements, are reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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