

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH A. GULOTTA
and LARRY J. SHELESTAK

Appeal No. 2000-0099
Application 08/742,426

ON BRIEF

Before STONER, Chief Administrative Patent Judge, and WARREN and PAWLIKOWSKI,
Administrative Patent Judges.

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the rejection of appealed claims 18 through 26, 28, 30 and 32,¹ all of the claims in the application, under 35 U.S.C. § 102(b) based upon a public use or sale of the invention based upon evidence in the specification.² We must agree with appellants that the examiner has failed to establish that an embodiment of the claimed invention encompassed

¹ See the amendments of October 30, 1996 (Paper No. 3) and January 9, 1998 (Paper No. 10).

² Answer, page 3.

by one or more of the appealed claims was in public use or on-sale within the meaning of § 102(b).

The appealed claims are adequately represented by independent claim 18:

18. A green tinted, ultraviolet absorbing, soda lime silica glass composition comprising, on a weight percent basis, 66 to 75% SiO₂, 10 to 20 % Na₂O, 5 to 15% CaO, 0 to 5% MgO, 0 to 5% Al₂O₃, 0 to 5% K₂O and a colorant portion consisting essentially of greater than 0.6% total iron (expressed as Fe₂O₃) with a ratio of FeO/total iron from 0.275 to less than 0.35 and exhibiting ultraviolet transmittance no greater than 38 percent (300 to 400 nanometers) and luminous transmittance (illuminant A) of at least 70 percent at thicknesses ranging from 0.154 to 0.189 inches.

Independent claims 19, 20 and 23 differ from claim 18 in the ranges of the ingredients, and dependent claims 21 and 22, dependent on claim 20, and dependent claims 24 and 25 dependent on claim 23, add the excitation purity property. Claims 26, 28, 30 and 32 are sequentially dependent on claims 18 to 20 and 23, respectively, and each encompass a “flat glass formed by the float process from the glass composition of” the specified independent claim.

In order to demonstrate that the claimed product encompassed by one or more of the appealed claims was, *prima facie*, on-sale within the meaning of § 102 (b), the examiner must first establish that the claimed product was “the subject of a commercial offer for sale” and was “ready for patenting” more than one year before the critical date. *Pfaff v. Wells Elect., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646 (1998). This burden can be carried by showing that there was a definite sale or offer to sell a process which fully anticipated the claimed product or would have rendered the claimed product obvious to one of ordinary skill in this art by its addition to the prior art. *See Tec Air, Inc. v. Denso Mfg. Michigan, Inc.*, 192 F.3d 1353, 1358, 52 USPQ2d 1294, 1296-97 (Fed. Cir. 1999). Thus, “the first determination in the § 102 (b) analysis must be whether the subject of the barring activity met each of the limitations of the claims, and thus was an embodiment of the claimed invention.” *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1383, 51 USPQ2d 1055, 1058-59 (Fed. Cir. 1999). In similar manner, in order to demonstrate that the claimed product encompassed by one or more of the appealed claims was, *prima facie*, in public use within the meaning of § 102 (b), the examiner must establish that the claimed product was used for any purpose “by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor.” *See, e.g., Lough v. Brunswick*

Corp., 86 F.3d 1113, 1120, 39 USPQ2d 1100, 1105 (Fed. Cir. 1996), quoting *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983).

“Whether something is ‘in public use or on sale’ within the meaning of section 102(b), and thus properly considered prior art, is a question of law with subsidiary issues of fact.” *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994). The activities of third parties can establish the public use and on sale bars. *Id.* The standard of proof that must be met by the examiner in making a rejection of the appealed claims under the public use and on-sale bars of § 102(b) is a preponderance of the evidence. *Id.*, quoting *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985);³ see also Manual of Patent Examining Procedure (MPEP) § 706, “Uniform Application of the Patentability Standards” (7th ed., Rev. 1, Feb. 2000; 700-8). In establishing the factual foundation for a ground of rejection in an *ex parte* proceeding, the PTO is “not bound by the rules of evidence that govern judicial proceedings.” *Epstein*, 32 F.3d at 1565-66, 31 USPQ2d at 1821; see also *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 1347, 53 USPQ2d 1580, 1585 (Fed. Cir. 2000) (“In an interference, unlike an *ex parte* proceeding, the Federal Rules of Evidence apply. See 37 C.F.R. §1.671(b) (1998).”). However, while the hearsay rules may not apply in an *ex parte* proceeding, testimonial and documentary evidence ordinarily excluded by such rules is nonetheless carefully considered with respect to the risk of inaccuracy and trustworthiness. See *Epstein*, 32 F.3d at 1565-66, 31 USPQ2d at 1821-22.

³ In *Caveney*, our reviewing court discussed the applicability of the different standards of proof required with respect to the prosecution of patent applications before the United States Patent and Trademark Office and invalidating a patent claim:

[A]lthough patents are entitled to a presumption of validity under 35 U.S.C. § 282, and the party asserting patent invalidity under 35 U.S.C. § 102(b) must support the assertion by facts constituting clear and convincing evidence, . . . patent applications are not entitled to the procedural advantages of 35 U.S.C. § 282. From *In re Etter*, [756] F.2d [852,] 225 USPQ 1 (Fed. Cir. 1984) (en banc), it is apparent that, due to 35 U.S.C. § 282, the standard of proof required to properly reject the claims of a patent application is necessarily lower than that required to invalidate patent claims. The three standards of proof generally recognized are proof by a preponderance of the evidence, proof by clear and convincing evidence, and proof beyond a reasonable doubt. . . . Because it is the only standard of proof lower than clear and convincing, preponderance of the evidence is the standard that must be met by the PTO in making

The evidence of record relied on by the examiner is the letter of August 2, 1994, with attachments, from the Ford Motor Company (Ford letter) to appellants' assignee, PPG Industries, Inc. (PPG), alleging that two separate sales of "high-iron soda-lime-silica glass to Ford in the U.S. more than a year prior to the filing date of . . . pending patent application Ser. No. 07/976,059" ('059 application) (Ford letter, page 1).⁴ According to appellants, the present application is a division of the '059 application, filed November 13, 1992, now United States Patent 5,593,929 ('929 patent), issued January 14, 1997, which application is a continuation-in-part of application 07/857,903, filed March 26, 1992, now United States Patent 5,385,872 ('872 patent), issued January 31, 1995, which application is a continuation-in-part of application 07/559,915, filed July 30, 1990, now United States Patent 5,240,886, ('886 patent) issued August 31, 1993.

The evidence of the "sale of glass to Ford by Saint Gobain-Vitrag International ("SGV")" (St. Gobain glass) is alleged in the Ford letter (pages 1-2) to be found in the purchase order dated "02-13-89" (Attachment A), the invoice dated "09/11/88" (Attachment B), a lab report dated "1/22/90," and a report on "solar transmittance," circa "Jan 90," although it appears from a hand written note to have been "measured 01/19/90" (attachment D). A further report on, e.g., "% transmittance," circa "Jan 90" (Attachment D-1) is not referred to.

The invoice lists five sizes of apparently the same "experimental low transmission green tint glass purchased from Saint Gobain for special fabrication project at PR&D" with hand written sequential descriptors and the common name "parsol green," and references "your order: from 28/10/88" and the price of "US\$ 17835.32." The address on the invoice is "FORD GLASS DIVISION PRODUCT RESEARCH + DEVELOPMENT . . . USA-48120 DEARBARN." The purchase "notification" to buyer "EUROGLASS," with the hand notation "(Vegla SGV U.S. rep)," for the same sizes, sequential descriptors and common name "parsol green," appears to indicate a delivery date of "09/30/88" and an order date of "02/13/89" and shows the total price of "\$ 17835.32." The address on the purchase "notification," to the best that it can be determined

rejections . . . [761 F.2d at 674, 226 USPQ at 2-3; internal citations and footnote omitted.]

⁴ The Ford letter and attachments were submitted by appellants in the information disclosure statement of February 13, 1997 (Paper No. 5).

from the poor quality reproduction, is “. . .SS DIVISION – PR&D OFFICE . . . RBARN, MI. 48120.” The lab report shows a “Part/Material Description: SGV Solar tint rec’d 1/90” in a quantity of “2” from “Supplier SGV” with the notation “latest SGV composition,” and a “date submitted 1/19/90.” The two samples were designated “SGV1” and “SVG2” with the latter hand circled and hand annotated “used in Arizona.” The “Purpose of Investigation,” to the extent it can be determined from the poor quality reproduction, is “Analyze for colorant level of – Fe₂O₃, . . . CeO₂, TiO₂.” The “solar transmittance” report is titled “SGV2 - SGV-2 Solar Green – Jan 90” and tests “Illuminant ‘A’ ” and “ ‘C’ . ” The further, undiscussed report has the same title and samples.

It is further alleged (Ford letter, page 2) that the “original purchase of 1988 SGV glass was followed by others,” which “others” apparently includes that shown by the “purchase notification” having a typed “date of order 6-12-89” and a handwritten “delivery date 7-12-89” (Attachment E). This purchase order was for 5 different sizes of “super green tint glass” from seller “Vegla Glaswerke . . . Aachen, West Germany,” and shipped to the “. . . Glass Tech Center . . . Lincoln Park, MI.” No invoice corresponding to this purchase notification is of record.

It is stated in the Ford Letter (pages 1-2) that the purchase order was prepared, “[a]s is often the case,” “after the actual delivery of the glass to Ford in 1998” as seen from the date on the invoice; that there was enough glass for “one hundred to two hundred cars;” that “the glass was tested and evaluated by Ford, some . . . formed into windows actually installed by Ford on Taurus vehicles,” and “[a] number of those vehicles remained in use as ‘pool cars’ at Glass Division until a year or two ago;” that the “composition of the 1988 SGV glass is shown in the” lab report; that reference in the lab report “to ‘SGV Solar tint received 1/90’ . . . is the date the test sample piece was sent for analysis;” that the “glass sample identified in the report as ‘SVG2’ was a piece of the 1988 SGV glass received” under the purchase notification of “02-13-89;” that the “light transmittance properties of the SVG glass are shown in” the report titled “SVG – SVG-2 Solar Green” and has the identifier “Illuminant ‘A’ ;” and that among the other purchases of glass from “SGV’s German subsidiary, Vegla Glaswerke” was that identified in the purchase

notification of “6-12-89” as “500 pieces of ‘super green tint glass’ . . . [that] was substantially the same glass composition discussed above.”

We refer to the Ford letter for the discussion at page 2 of the “UV transmittance” and the “weight percent of ferrous oxide.”

The evidence of the second alleged sale of glass is stated in the Ford letter (page 2) to be found in the one “rear door glass” of a “1987 Scorpio vehicle” (Scorpio glass) that Ford purchased from “Earnie’s [sic, Ernie’s] Auto Parts,” “an automobile recycling yard,” as shown by an invoice dated “3/24/94” which “incorrectly identifies the Scorpio as a 1988 model year vehicle” (Attachment F). We observe that the invoice also lists one “front door glass” for a “88 Scorpio” having the same VIN and “yard” numbers. A “copy of the identifying information etched at the lower corner of the glass,” such etchings said to be common in vehicle and architectural glass, “shows the glass to have been made by Sekurit, an SVG affiliated company, in March of 1987” (Attachment G), but no explanation of the manner in which the date information is determined from the etched information is set forth. The VIN number appears on two pages stated to be “Ford records . . . showing that the vehicle arrived in the United States in May 1987 (Attachment H).”

It is stated in the Ford letter that the “1987 Scorpio glass is typical high-iron soda-lime-silica green glass” and that chemical and optical analysis are reported for samples “SGV 87A” and “SGV 87 B” of “SGV 1987 Scorpio doors” as obtained, at least with respect to the chemical analysis, on June 16, 1994 (Attachments I and J). The Ford letter provides a comparison of the reported properties for the tested glass with “Claims [sic] 18 and Claim 21” of the “PPG ‘059 Application” (page 3).

The examiner rejects all of the appealed claims under § 102(b) “based upon a public use or sale of the invention,” relying on the evidence in the Ford letter attachments “A-J” as evidence that the claimed glass was “on sale” before the critical date (answer, page 3). The examiner submits that “Attachments F-H establish the ‘on sale’ date of the Scorpio glass,” because the “composition of the Scorpio glass is shown at page 3 of the [Ford] letter and attachment I, anticipates the instant claims” (*id.*). The examiner does not consider the “process limitations in the dependent claims . . . to distinguish the claimed product or composition” (*id.*).

Appellants submit that the examiner's rejection cannot stand because the Ford letter and the attachments do not constitute evidence on which the examiner can rely, and the data in the attachments do not establish that the St. Gobain and Scorpio glasses have the properties of the claimed glass. They argue that the Ford letter "is hearsay written by a biased party several years after the alleged events for the purpose of attempting to escape a claim of infringement," does not meet the "clear and convincing standard of evidence" and thus does not meet the requirement that a rejection can be made only where the evidence establishes that it is "more likely than not that the claim is unpatentable," citing MPEP § 706 (brief, pages 4-7; emphasis in the original deleted). Appellants contend that the evidence does not establish that the "SGV Solar tint rec'd 1/90" is the "same glass that was the subject of the November 1988 invoice" (*id.*, page 4), and, similarly with respect to the Scorpio glass, that there is no evidence that the "glass for which compositional and spectral results are allegedly reported is the same glass that was the subject of the alleged sale in the U.S." (*id.*, page 6).

Appellants submit that even if the St. Gobain glass is prior art, it does not anticipate the glass compositions of claims 18-25 or the flat glass of claims 26, 28, 30 and 32. Appellants contend that the St. Gobain glass does not anticipate "redox ratio of the glass, i.e., the amount of iron in the ferrous state, expressed as FeO, divided by the total amount of iron, expressed as Fe₂O₃, is 0.195, which is outside of the redox range recited in independent claims 18 and 20 of the instant application of 0.275 to less than 0.35" (*id.*, page 7).

Appellants further contend that the St. Gobain glass, which contains "517 . . . [ppm] of cerium oxide," "a well-known UV absorbing material," is excluded from "independent claims 18, 19, 20 and 23 [which] have a colorant portion consisting essentially of iron" because the inclusion of this amount of cerium oxide "would significantly change the spectral properties of the glass" (*id.*, pages 7-8).

Appellants contend that "based on the information provided in Attachments I and J, the Scorpio glass has a redox ratio of 0.206, which is outside of the redox range recited in claims 18 and 20," and generally question the calculations used to derive values reported in the Ford letter (page 3) and the completeness of the analysis reported in the attachments (brief, page 8).

Appellants submit that the Scorpio glass as described in the Ford letter does not meet the claim requirement for ultraviolet transmittance for two reasons. Appellants first contend that there is no evidence that the “Scorpio glass had the claimed optical properties over the entire range of thicknesses recited in the claims,” that is, “ultraviolet transmittance no greater than 38 percent (300 to 400 nm) for glass thicknesses ranging from 0.154 to 0.189 inches,” on the basis that “[u]ltraviolet transmittance increases as glass thickness decreases,” citing United States Patent 4,792,536 (‘536 patent) (*id.*). Appellants extrapolate the data in the Ford letter, stating that if “the Scorpio glass had an ultraviolet transmittance of 38.0% at a thickness of 0.156 inches, then the glass would have had an ultraviolet transmittance greater than 38.0% at a glass thickness of 0.154” (*id.*, pages 8-9). Appellants submit that the Scorpio glass is thus outside the claims because “the specification, as originally filed, requires the glass compositions to have the recited optical properties over the entire range of thicknesses recited in the claims, including a glass thickness of 0.154 inches” (*id.*, page 9).

Secondly, appellants contend that the Ford letter “incorrectly reports the ultraviolet transmittance for the Scorpio glass” as “38.3% (280 to 400 nm) for the glass thickness of 0.1575 inches” while a calculation according to the method of the ‘536 patent, is “an ultraviolet transmittance of 39.05% at a glass thickness of 0.154 inches,” which “is consistent” with the value determined with the Thickness-Transmittance Nomograph in the *Glass Engineering Handbook*⁵ (brief, page 9).

The examiner is not persuaded by appellants’ arguments that the evidence is unreliable, “because appellants have not supplied any evidence to cast sufficient doubt on the authenticity of the letter” (answer, page 4). It appears that the examiner responds to appellants’ arguments that the St. Gobain glass does not anticipate the claims in the context of addressing appellants’ with respect to the Scorpio glass, because the examiner states, with respect to the Scorpio glass, that attachment “D” shows “a redox of .279” and that the “amounts of cerium oxide determined in the attachments and in the letter are zero or at most trace amounts” and ““consisting essentially of” does not exclude trace amounts of components” (*id.*). We note here that “attachment D” is

⁵ We find that a copy of pertinent part of the *Glass Engineering Handbook* was submitted with the amendment of August 7, 1998 (Paper No. 13).

directed to St. Gobain glass and does not disclose the content of this glass as does Attachment C; that the examiner does not discuss the appellants' calculations of the redox range for St. Gobain glass; and that Attachment C reports the amount of cerium oxide stated by appellants, upon which matter the Ford letter makes no statement.

With respect to the Scorpio glass, the examiner does not respond to appellants' arguments with respect to the manner in which the redox values were reported in the Ford letter or with respect to the interpretation to be made of the appealed claims with respect to the ultraviolet transmittance over a range of thicknesses or the calculation of the ultraviolet transmittance (answer, page 4). Indeed, the examiner merely states that "in reference to the UV transmittance, sufficient evidence has not been presented by appellants that the Scorpio glass has a UV transmittance outside the claimed range" and that a "sheet thickness of .156 inches and a UV transmittance of 38% is considered to anticipate the instant claims even if it is presumed that there are different properties at different thicknesses;" and that appellants have not shown the entire range in the claims, that is, "0.35 inch," or that the difference "would not be attributed to experimental error or testing calibration" (*id.*, Pages 4-5).

We first consider appellants' arguments that the Ford letter cannot be relied upon by the examiner to reject the claims. It is clear from the authority that we cite above that the hearsay rule and the standard of proof based on clear and convincing evidence do not apply to *ex parte* cases involving the issues of public use and on-sale under § 102(b). It is also clear that we are to carefully consider such evidence as the Ford letter and its attachments with respect to the accuracy and trustworthiness thereof. In this respect, we bear in mind the relationship with respect to the '059 application and the '886 patent between Ford and PPG, and thus Ford's interest in the outcome of the examination of the '059 application, as pointed out by appellants.⁶ *See, e.g., Finnigan Corp. v. ITC*, 180 F.3d 1354, 1367, 51 USPQ2d 1001, 1011 (Fed. Cir. 1999),

⁶ Indeed, the Ford letter "is in response to [PPG's] request . . . for copies of our documentation showing the sale of high-iron soda-lime-silica glass to Ford in the U.S. more than one year prior to the filing date of [PPG's] pending" '059 application (page 1), and Ford "tried to provide clear copies of the documents, since . . . [PPG would] want to present them to the USPTO in connection with" the '059 application (page 4).

citing *Stevenson v. International Trade Comm'n*, 612 F.2d 546, 550, 204 USPQ 276, 280 (CCPA 1979).

It seems to us that, as argued by appellants, the documents presented in the Ford letter do not evidence that the “parsol green” glass listed in the invoice of 9/11/88 and the purchase notification of 2/13/89, shipped to Ford Glass Division R&D and stated to be used in windows in Taurus cars at the Glass Division, is the source of the “SVG2” sample of “SGV Solar tint rec’d 1/90” and hand annotated to be “used in Arizona.” We further note in this respect, the use, in a number of the Attachments, of the “SVG” identifier with respect to glass obtained from different subsidiaries of Saint Gobain-Vitrag International (“SGV”) and that Ford states that this group of vendors provided other samples of glass after the 1988 purchase, including the purchase of “super green tint glass” from Vegla Glaswerke, a Saint Gobain-Vitrag International subsidiary, in 1989, shipped to the Glass Tech Center. Thus, there is reasonable basis in the record as established by the Ford letter, to support our determination that the “SVG2” sample tested has not been established as part of the glass purchased by Ford in 1988 by a preponderance of the evidence.

Accordingly, the evidence in the Ford letter with respect to the St Gobain glass establishes only that Ford was in possession of at least the “SVG2” sample of “SGV Solar tint rec’d 1/90” obtained from St. Gobain or one of its subsidiaries as of “Jan 90,” the date of Attachments C, D and D-1, which glass has the chemical and optical analysis reported in these documents.

There are, however, a number of issues that arise with respect to whether this limited evidence is sufficient to establish that a glass composition and a glass made therewith falling within the appealed claims was in public use or on-sale within the meaning of § 102(b). First, as the record now stands, there is no credible evidence establishing the circumstances under which Ford obtained the “SVG2” sample of “SGV Solar tint rec’d 1/90.” See *Epstein*, 32 F.3d at 1565-66, 31 USPQ2d at 1821-22. We are mindful of appellants’ arguments with respect to the inaccuracies and trustworthiness of this evidence. However, as the court pointed out in *Epstein*, “appellants are free to investigate hearsay assertions relied upon by an examiner.” 32 F.3d at

1565-66, 31 USPQ2d at 1821; *see also* 32 F.3d at 1507-71, 31 USPQ2d at 1824-25 (Plager, J., joined by Cowen, J., concurring).

Indeed, the evidence relevant to whether a claimed invention may have been on-sale before the critical date is ordinarily placed in the record by an applicant, either on his or her own volition or pursuant to a request for information by the examiner. See generally, MPEP § 706.02(c), “Rejection Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale” (7th ed., Rev. 1, Feb. 2000; 700-12). Thus, the development of the record in a patent application with respect to whether the claimed invention was in public use or on-sale within the meaning of § 102(b) before the critical date is generally to a large extent the responsibility of appellants. Here, on the basis of the evidence in the Ford letter, the examiner has not inquired and appellants have not stated whether the present assignee has investigated the auto glass that St. Gobain and its subsidiaries offered for sale more than one year prior to the effective filing date of the claimed composition and glass in the present application.

Second, the evidence in the Ford letter places a St Gobain glass in the possession of Ford as of “Jan 90,” which date is within a year of the filing date of the great grandparent ‘915 application. We fail to find in the record that the examiner has established the effective filing date of the claimed composition and glass encompassed by the appealed claims. We note that appellants have not claimed the benefit of even the immediate parent application under 35 U.S.C. § 120, even though we find that the claims of each of the ‘886, ‘872 and ‘929 patents appear to adjoin, encompass or fall within the appealed claims.⁷

And, third, the relevance of the evidence with respect to the sample “SVG2” in Attachments C, D and D-1 to the claimed invention encompassed by the appealed claims is apparent from the following. With respect to the amount of cerium oxide, 517 ppm amounts to about 0.05 weight percent of the glass composition. We agree with the examiner that this amount of cerium oxide can be contained by the claimed glass compositions encompassed by the

⁷ There is no indication in the record that the examiner considered the issues of double patenting that are apparent in comparing the appealed claims with those of the patents in the lineage of this application. Thus, it is suggested that these issues be considered by the examiner upon further consideration of the appealed claims. To the extent that consideration of the issues of double

appealed claims even in view of the claim language “consisting essentially of” because we find no disclosure in the written description in appellants’ present specification which establishes that this amount of this component would adversely affect the basic and novel characteristics of the claimed glass compositions. *See, e.g., PPG Industries, Inc. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354-57, 48 USPQ2d 1351, 1353-56 (Fed. Cir. 1998). Furthermore, appellants have calculated the “ratio of FeO/total iron” in the sample to be 0.195, and the appellants findings must stand until the examiner places rebuttal evidence in the record. We further note that appellants argue that claims 18 and 20 are thus not anticipated, which argument affects *only* claims 18, 20 through 22, 26 and 30, as independent claims 19 and 23, and thus claims 24, 25, 28 and 32, each specify a “ratio of FeO/total iron less than 0.35,” which, of course, encompasses “0.195.”

Accordingly, *on this record*, the examiner has failed to demonstrate that the evidence in the Ford letter with respect to the St. Gobain glass establishes that a glass composition and a glass made therewith falling within the appealed claims was in public use or on-sale within the meaning of § 102(b) by a preponderance of the evidence.

The evidence in the Ford letter with respect to the Scorpio glass establishes that Ford had possession of the glass in a 1987 Scorpio car that was sold in the United States more than one year prior to the effective filing date of the ‘886 application by a preponderance of the evidence. Indeed, the identification of the rear door glass of a 1987 Scorpio obtain from “Ernie’s Auto Parts” on “3/24/94” was tested on June 16, 1994, and the whole car, traced by its VIN number, was shown to have been in the possession of and sold by Ford. However, we found above that the examiner has not rebutted appellants’ arguments with respect to the reported values for redox ratio and ultraviolet transmittance. With respect to the redox ratio, we observe that appellants’ arguments are made only with respect to appealed claims 18 and 20, and thus also with respect to appealed claims 21, 22, 26 and 30, and would not apply to claims 19 and 23 through 25, 28 and 32, which latter claims require a “ratio of FeO/total iron less than 0.35” and thus encompass a redox ratio of “0.206.” With respect to the ultraviolet transmittance, we agree with appellants

patenting include revisiting a requirement for restriction under 35 U.S.C. § 121, see MPEP §§ 804.01 and 804.04 (7th ed., Rev. 1, Feb. 2000; 800-24, 800-25 and 800-30).

that the written description in the specification as it now stands⁸ supports the interpretation of the phrase “at thicknesses ranging from 0.154 to 0.189 inches” as requiring the optical properties to be exhibited over the entire range, not at just one point in the range as the examiner contends. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Accordingly, *on this record*, the examiner has failed to demonstrate that the evidence in the Ford letter with respect to the Scorpio glass establishes that a glass composition and a glass made therewith falling within the appealed claims was in public use or on-sale within the meaning of § 102(b) by a preponderance of the evidence.

The examiner’s decision is reversed.

Reversed

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
)	
)	
)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

Intellectual Property Department

⁸ In the preliminary amendment of January 8, 1997 (Paper No. 4), appellants replaced the last full paragraph on page 5 and the first full paragraph on page 6 of the specification with a single paragraph and further amended that paragraph in the amendment of August 7, 1998 (Paper No. 13; see pages 2-3), in response to which the examiner, in the Office action of October 23, 1998 (Paper No. 14), did not maintain the objection to the specification under 35 U.S.C. § 132, placed in the record in the Office action of April 10, 1998 (Paper No. 11).

Appeal No. 2000-009
Application 08/742,426

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