

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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD GUERIN  
and GERARD JACQ

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Appeal No. 2002-1354  
Application 08/668,264

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ON BRIEF

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Before GARRIS, WARREN and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*ORDER VACATING ORAL HEARING*

On March 17, 2003, Mr. Craig R. Feinberg, a Program and Resources Administrator of the Board of Patent Appeals and Interferences, informed appellants' counsel, Mr. Keith J. McWha, that the Merits Panel assigned to this application had decided to reverse the decision of the examiner. Mr. Feinberg further informed Mr. McWha that therefore, the Oral Hearing scheduled for March 18, 2003, will be vacated.

Accordingly, as counsel was informed on March 17, 2003, it is ORDERED that the Oral Hearing scheduled for 1:00 PM on March 18, 2003, is *VACATED*.

*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 reply brief,

and based on our review, find that we cannot sustain the rejection of appealed claims 1, 3 through 8, 22 and 24 through 28,<sup>1</sup> all of the claims in the application, under 35 U.S.C. § 112, first paragraph, written description requirement.<sup>2</sup> For the reasons pointed out by appellants in the brief and reply brief, the examiner has failed to make out a *prima facie* case with respect to this ground of rejection.

In stating the ground of rejection, the examiner takes the position that the claim language “[a] friction material . . . manufactured without the use of an organic solvent,” as set forth in illustrative claim 1, “lacks written description in the specification as originally filed and addition of this phrase constitutes new matter” without further supporting the rejection (Paper No. 26, page 2; answer, page 4). Appellants point out in the brief that the written description in the specification identifies a problem with solvents and sets forth a method of making the claimed friction material without reference to a solvent (pages 4-6). The examiner responds in the answer by pointing out that “[t]he specification does not actually teach that no noxious or organic solvent is employed nor is it inherent in the specification that no such solvent is employed,” and that a solventless method “is merely one of several probabilities or possibilities . . . [and] [i]nherency may not be established by possibilities or probabilities” (answer, page 4). Appellants again point out in the reply brief that no solvent is used in the method of making the “friction material” in the specification.

It is well settled that while the written description does not have to describe the invention later claimed *in haec verba*, such written description “must . . . convey with reasonable clarity to those skilled in the art that . . . [appellant] was in possession of *the invention now claimed*.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *see also Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000); *In re Wertheim*, 541 F.2d 257, 262-65, 191 USPQ 90, 96-98 (CCPA 1976). Where the claimed invention is alleged by appellants to be based on an inherent limitation,

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<sup>1</sup> See illustrative claim 1 in the amendment of February 26, 2001 (Paper No. 25).

<sup>2</sup> In the Answer, the examiner refers to the Office action of March 29, 2001 (Paper No. 26, page 2) for a statement of the ground of rejection advanced on appeal (page 4), and withdraws the ground of rejection of all of the appealed claims under 35 U.S.C. § 103(a) over Royer (page 3).

appellants need only establish that the written description of the application “necessarily” describes the later claimed subject matter such that one skilled in the art would recognize such a disclosure therein. *See generally, Purdue Pharma*, 230 F.3d at 1327, 56 USPQ2d at 1486; *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998) (“In order for a disclosure to be inherent, . . . the missing descriptive matter must necessarily be present in the . . . specification such that one skilled in the art would recognize such a disclosure. *See Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).”); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (“Lockwood claimed a distinct invention from that disclosed in the specification. It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”).

In other words, “one skilled in the art, reading the original disclosure, must ‘immediately discern the limitation at issue’ in the claims.” *Purdue Pharma*, 230 F.3d at 1323, 56 USPQ2d at 1483, quoting *Waldemar Link, GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). Whether one skilled in the art would immediately discern in the written description of the application the limitations of the invention now claimed is a factual inquiry that is determined on a case-by-case basis. *Vas-Cath, supra*; *see also Purdue Pharma*, 230 F.3d at 1323, 56 USPQ2d at 1483. In order to make out a *prima facie* case that the appealed claims do not comply with this section of the statute, the examiner must set forth evidence or reasons why, as a matter of fact, persons skilled in this art would not reasonably recognize in the disclosure in the specification a description of the invention defined by the claims which establishes that appellant was in possession of the invention, including all of the limitations thereof, at the time the application was filed. *See generally, In re Alton*, 76 F.3d 1168, 1175-76, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996), citing *Wertheim*, 541 F.2d at 263-64, 191 USPQ at 97.

We have reviewed the passages of the specification on which appellants rely in light of the written description in the specification as a whole, and based on our review, find that we agree with the appellants that, as a matter of fact, one of ordinary skill in this art would have

immediately discerned the claim limitation at issue. Indeed, we cannot find in the written description in the specification which describes the method of preparing “friction material” any mention of “an organic solvent” and the examiner does not point to such disclosure.

Furthermore, appellants are certainly entitled to claim less than the invention originally presented where the claimed invention to which they retreat complies with this statutory provision, as is the case here. *See generally, In re Johnson*, 558 F.2d 1008, 1017-19, 194 USPQ 187, 195-96 (CCPA 1977). Thus, it follows that the examiner has failed to establish a *prima facie* case that the appealed claims do not comply with § 112, first paragraph, written description requirement, and accordingly, we reverse this ground of rejection.

The examiner’s decision is reversed.

*Reversed*

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CATHERINE TIMM	)	
Administrative Patent Judge	)	

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