

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte R. RICHARD STEINER  
and  
SHIUH-KAO CHIANG

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Appeal No. 2004-0283  
Application No. 09/132,638

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ON BRIEF

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Before KIMLIN, PAK and DELMENDO, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 61 and 62. Claims 53, 56 and 63-66 have been allowed by the examiner. Claim 61 is illustrative:<sup>1</sup>

61. A component as defined in claim 53, wherein copper foil sheets are provided on each side of a metallic substrate to form a copper-metal-copper laminated component.

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<sup>1</sup> Claim 61 is incorrectly reproduced in appellants' brief.

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In the rejection of the appealed claims, the examiner does not rely upon prior art.

Appellants' claimed invention is directed to a component for use in manufacturing printed circuit boards. The component comprises a sheet of copper foil in contact with a metal support and having provided on its other surface a partially cured, preformed adhesive epoxy resin film. Allowed claim 53 specifies only one sheet of copper foil in contact with the metal support. Appealed claims 61 and 62, which depend upon allowed claim 53, further define copper sheets on each side of the metal substrate.

Appealed claims 61 and 62 stand rejected under 35 U.S.C. § 112, first paragraph, description requirement.

Appellants submit at page 3 of the principal brief that "[c]laims 61 and 62 stand or fall together."

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find ourselves in agreement with appellants that claims 61 and 62 do not run afoul of the description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, we will not sustain the examiner's rejection.

According to the examiner, since the appealed claims "would encompass laminates having one coated copper foil sheet and one

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uncoated copper foil sheet as well as laminates having both copper foil sheets coated" (page 3 of Answer), and appellants' specification only discloses and depicts both copper sheets being coated with epoxy resin film, the appealed claims lack descriptive support in the specification.

As our reviewing court stated in In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089 1096 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

It is well settled that the claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the written description requirement, i.e., it may be implicit from the original specification that the inventor had possession of the claimed subject matter at the time of filing the application. An explicit description is not required.

In the present case, while we are fully appreciative and cognizant of the effort made by the examiner in advancing a rationale in support of the rejection, we are persuaded that the facts of this case support the conclusion that the present inventors, at the time of filing the application, had in their

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possession a component that has copper sheets on each side of a metallic substrate wherein only one of the copper sheets is in contact with the epoxy resin film. We come to this conclusion because allowed claim 53, upon which claims 61 and 62 are dependent, broadly encompasses a metallic substrate having a copper sheet and epoxy resin on only one side of the substrate, and other, non-defined coatings or layers on the other side of the substrate, including a copper sheet without a coating of an epoxy resin. Since the specification discloses that "it has been known to adhere to the shiny side of the copper foil a protective polymeric film that may be removed during the assembly of the copper sheet onto a circuit board or onto another copper sheet" (page 2, lines 5-7), we are satisfied that one of ordinary skill in the art would understand that appellants had in their possession an embodiment wherein the metallic substrate has a copper sheet in contact with each of the opposite surfaces of the substrate, with one of the copper sheets having a coating of partially cured epoxy resin and the other copper sheet having a coating of the protective polymeric film of the prior art. As stated by appellants in the Reply Brief, "[i]t should be appreciated that other means are known in the prior art that serve this function, including, but not limited to, an uncured

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resin coating," which may be applied by conventional spraying and blade wiping techniques (page 2 of Reply Brief, paragraph four). Hence, based upon the genus embraced by allowed claim 53, which has original descriptive support, and the acknowledged prior art found in appellants' specification, we are of the opinion that the subject matter defined by appealed claims 61 and 62 finds descriptive support in the original specification within the meaning of 35 U.S.C. § 112, first paragraph.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
CHUNG K. PAK	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

ECK:clm

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