

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 54

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROAKI YOKOYA
and HIROMICHI TACHIKAWA

Appeal No. 95-0696
Application 07/335,411

HEARD: March 7, 1996

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before GOLDSTEIN, SMITH, JOHN D. and TURNER, Administrative
Patent Judges.

TURNER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the Examiner's decision rejecting claims 1-6 and 9-19 which are all of the claims remaining in the application. Illustrative claim 1 is reproduced below.

¹ Application for patent filed April 10, 1989.

Appeal No. 95-0696
Application 07/335,411

1. A printing plate for electrophotographic type plate making which is formed of at least a photoconductive layer comprising an organic photoconductive compound and a binding resin on an electrically conductive support and with which printing plates are made by removing the photoconductive layer of the non-image parts other than toner image parts after imagewise exposure and forming a toner image, wherein said binding resin of the photoconductive layer comprises a copolymer including (1) an acrylic acid ester or methacrylic acid ester containing an aromatic ring in at least one monomer component thereof and (2) a vinyl polymerizable monomer having one to three acidic functional groups and present in an amount of from 38 to 60 mol% based on total monomer content of the copolymer.

The reference of record relied upon by the Examiner is:

Horie et al. (Horie) 4,500,622 Feb. 19, 1985

Claims 1-5 and 9-16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Horie. Claims 6, 17 and 18 stand rejected under 35 U.S.C. § 103 as unpatentable over Horie.

Claims 18 and ~~19~~ stand rejected under 35 U.S.C. § 112, first paragraph, as based upon an insufficient written description of the amount of monomer.

The subject matter on appeal is directed to a printing plate for electrophotographic type plate making formed of a photoconductive layer comprising an organic compound and a binding resin on a support, the binding resin comprising 1) a copolymer of an acrylic acid ester or methacrylic acid ester and

Appeal No. 95-0696
Application 07/335,411

2) a vinyl polymerizable monomer having one to three acidic functional groups. A more detailed description can be gleaned from a reading of claim 1.

According to Appellants, the claims should be grouped as follows:

- 1) claims 1-5 and 9-16;
- 2) claims 6 and 17;
- 3) claim 18; and
- 4) claim 19

We shall observe this grouping to the extent that the claims are so argued.

OPINION

We shall not reiterate the conflicting viewpoints advanced by Appellants and the Examiner in support of their respective positions. Reference is made to the Brief and Answer for the full exposition thereof. Upon careful review of the conflicting viewpoints, we will affirm the rejections under § 102 and § 103 but will not affirm the rejection under § 112, first paragraph. Our reasons follow.

Appeal No. 95-0696
Application 07/335,411

REJECTION OF CLAIMS 1-5 AND 9-16 UNDER
35 U.S.C. § 102(b) OVER HORIE

We will affirm this rejection since it is our view that the invention is described in the Horie reference. Anticipation is a matter of fact and the necessary inquiry must focus on what subject matter is encompassed by the claims and what subject matter is described by the reference. Here, the only dispute regarding the Horie disclosure is the amount of acidic monomer described in the Horie disclosure. Appellants argue that based upon their calculations, the maximum amount of acidic monomer, based upon the total monomer in Horie, is 37.5% while the claims here on appeal specify a minimum of 38%. In our view, the disclosure in Horie of a mole ratio of y/x of acidic monomer to ester monomer of 5 to 60% (col. 14, lines 7 and 8) describes a calculated rounded-off range for the acidic monomer component of 5 to 38%. Appellants have placed significance upon the ".5%", i.e., Appellants view the Horie disclosure as 37.5 rather than 38%. However, Horie's example 1 describes a copolymer having an acidic monomer content of 32.9 mol%. Such a description indicates that Horie knew how to be precise when intended and supports the conclusion that otherwise, when a whole number was stated, a precise amount (i.e., a number with three significant digits) was not intended. See Eiselstein v. Frank, 52 F.3d 1035,

Appeal No. 95-0696
Application 07/335,411

1039, 34 USPQ2d 1467, 1471 (Fed. Cir. 1995). Thus, the lower limit of the claimed range is anticipated by the upper limit of the range calculated from the Horie disclosure. Giving the claims their broadest reasonable interpretation, consistent with Appellants' specification, we comfortably reach the conclusion that the lower limit of the claimed range (38%) touches, if not overlaps, the upper limit of Horie. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). We note, moreover, that the claims here on appeal, when read in light of the disclosure, suggest that the acidic monomer accounts for "about 38 to 60 mol%" (specification, page 13, lines 10 and 11) which hardly strengthens Appellants' argument.

We observe that alternative grounds of rejection under § 102 and 103 are conventionally relied upon by Examiners in the event that they should be found to have erred in their conclusion that the claimed invention was actually described in a single reference as required by § 102. We consider this practice to be prudent and encourage it. Ex parte Lee, 31 USPQ2d 1105 (Bd. Pat. App. & Int. 1993). The examiner has chosen not to do so in the circumstances of this application and we find no apparent reason on the record for the examiner not to follow conventional practice.

Appeal No. 95-0696
Application 07/335,411

For the reasons set forth above, we will affirm the rejection.

REJECTION OF CLAIMS 6, 17 AND 18 UNDER
35 U.S.C. § 103 OVER HORIE

We will affirm this rejection. Appellants have not separately argued claims 6 and 17. Thus, claims 6 and 17 will stand or fall with claim 18. It is uncontroverted and perhaps incontrovertible that the Horie invention is essentially identical to the claimed invention except for the amount of the acidic monomer component. Horie discloses a calculated rounded-off range of from about 5 to 38 mol% of the acidic component while claim 18 specifies a range of 40 to 60 mol% (claims 6 and 17 disclose a range of 38 to 60 mol%). The claimed range is at least rendered prima facie obvious by the range of Horie. In re Wertheim, supra. Appellants argue that there is no motivation to use amounts of the acidic component in the claimed range. It is said that Horie teaches away from a concentration as is set forth in claim 18 and that the narrower range in claim 18 is significantly above the calculated non rounded-off maximum of "37.5%" disclosed in Horie (Brief, page 12). Appellants rely upon and refer to no objective evidence of unobviousness. It is axiomatic that unobvious results must be substantiated by factual

Appeal No. 95-0696
Application 07/335,411

evidence. Arguments of counsel cannot take the place of evidence lacking in the record. In re Greenfield, 571 F.2d 1185, 197 USPQ 227 (CCPA 1978).

Accordingly, we will affirm the rejection.

**REJECTION OF CLAIMS 18 AND 19 UNDER
35 U.S.C. § 112, FIRST PARAGRAPH**

We will not affirm this rejection. It is the Examiner's position that the specification does not provide a written description of the amount of monomer of from 40-60 mol% or 50-60 mol% as specified in claims 18 and 19 respectively. The description requirement of § 112 does not require that the later added limitations be described in *ipsis verbis* in the original disclosure. In re Smith, 481 F.2d 910, 178 USPQ 620 (CCPA 1973). Rather, the original disclosure needs to reasonably convey to one of ordinary skill in the art that the inventors had in their possession, as of the filing date of the application, the later added limitation. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The burden of establishing a prima facie case with regard to lack of compliance with the written description requirement of § 112, first paragraph, rests with the Examiner in the first instance. Our

Appeal No. 95-0696
Application 07/335,411.

review of the record reveals that the Examiner has not carried the burden of establishing a prima facie case that the application as filed does not convey a description of the presently claimed monomer amounts. We are in agreement with Appellants and their comments at page 14 of the Brief that the examples at pages 14 and 15 of the specification support the ranges in claims 18 and 19. Our reviewing court stated in In re Wertheim, 191 USPQ 90 at 96 that

...It is not necessary that the application describe the claim limitations exactly, ...but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.....

Thus, the Examiner's rejection of claims 18 and 19 under § 112, first paragraph, is reversed.

Under the provisions of 37 CFR § 1.196(b), we make the following new rejection.

Claims 1-5 and 9-16 are rejected under 35 U.S.C. § 103 as unpatentable over Horie. The substance of the Horie disclosure is not disputed. The linchpin of the Appellants' argument is that there is no motivation to employ amounts of the acidic monomer of Horie in

Appeal No. 95-0696
Application 07/335,411

excess of 37.5%. Thus, since the claims here on appeal require from 38 to 60 mol% of the acidic monomer, the Horie disclosure teaches away from the claimed invention. Given its broadest reasonable interpretation, consistent with Appellants' specification, we can reach no other conclusion than that the range covered by the claims touches, if not overlaps, the range taught in Horie. The claimed range is thus at least rendered prima facie obvious by Horie. In re Wertheim, supra. We refer to our comments above in discussing the § 103 rejection as to the propriety of this rejection.

The decision of the Examiner is affirmed as to the rejections under § 102 and 103 above and is reversed as to the § 112, first paragraph rejection. Claims 1-5 and 9-16 are subject to a new ground of rejection under 37 CFR § 1.196(b). Claim 19 appears to be free of any outstanding rejection.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

Appeal No. 95-0696
Application 07/335,411

With respect to the new rejection under 37 CFR § 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

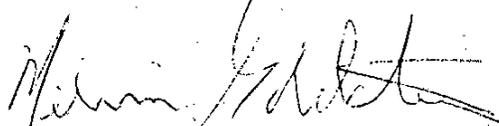
If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

Appeal No. 95-0696
Application 07/335,411

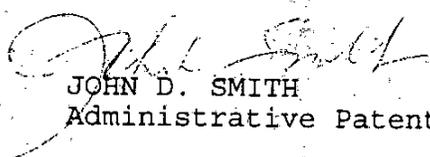
No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

37 CFR § 1.196(b)

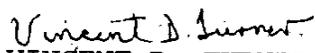


MELVIN GOLDSTEIN)
Administrative Patent Judge)



JOHN D. SMITH)
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Appeal No. 95-0696
Application 07/335,411

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