

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NOBUAKI MATSUDA and KESANAO KOBAYASHI

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Appeal No. 95-3623  
Application 07/714,407<sup>1</sup>

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HEARD: October 15, 1997

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Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.  
OWENS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1, 5, 9, 10, 12 and 13 as amended after final rejection. Claim 14, which is the only other claim remaining in the application, has been withdrawn from consideration by the examiner as being directed toward a nonelected invention.

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<sup>1</sup> Application for patent filed May 29, 1991.

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Claim 1 is illustrative and is appended to this decision.

*THE REJECTION*

Claims 1, 5, 9, 10, 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph on the ground that the specification, as originally filed, does not provide adequate written descriptive support for the invention as now claimed.

*OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, this rejection will be reversed.

Appellants' claimed invention is a developing solution for a colored photopolymerizable composition. The developing solution includes, among other components, at least one acetylenic alcohol surface active agent and at least one quaternary ammonium salt surface active agent. Appellants' claim 1 recites that "said acetylenic alcohol surface active agent and quaternary ammonium salt surface active agent are collectively present in an amount of 0.01 to 5.0% by weight". This limitation was added to the claim during prosecution (paper no. 12, filed April 7, 1993). Appellants' claims 9 and 10 were amended to recite that these two components collectively are present in amounts of, respectively,

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0.03 to 3 wt% and 0.05 to 2 wt% (paper no. 15, filed November 29, 1993).

The examiner argues (answer, page 5):

The specification at page 10, lines 8-11 recites "the surface active agent may be used in an amount of from 0.01 to 5.0% by weight, more preferably from 0.03 to 3% by weight, most preferably from 0.05 to 2% by weight"; but does not recite that an acetylenic alcohol based surface active agent and a quaternary ammonium based surface active agent are "collectively present" in the amounts, as recited in the instant claims.

The limitation "said acetylenic alcohol surface active agent and quaternary ammonium salt surface active agent are *collectively* present in an amount ..." (emphasis added) did not appear in the specification as filed and therefore introduces a new concept and violates the description requirement of the first paragraph of 35 USC 112. (*Ex parte Grasselli*, 231 USPQ 393.)

The examiner acknowledges that appellants' specification at pages 5 to 6 provides written descriptive support for a combination of an acetylenic alcohol surface active agent and a quaternary ammonium salt surface active agent, but argues that the specification does not provide a written description of a developing solution wherein these two surface active agents collectively are present in an amount of 0.01 to 5 wt% (answer, page 7). The examiner also argues (answer, page 8) that

the criticality recited at page 10, lines 11-14 [of appellants' specification, i.e., that "[a]n amount of the [surface active] agent smaller than 0.01% by weight

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would result in insufficient wettability or defoamability and an amount larger than 5% by weight would spoil smoothness of pattern shapes."] is neither recited nor exemplified by the specification with respect to the combination of an acetylenic surface active agent and a quaternary ammonium surface active agent. Therefore, it would not be readily apparent from the disclosure to persons of ordinary skill in the art to interpret the recitation "the surface active agent may be used in an amount of from 0.01 to 5% by weight" at page 10, lines 8-9 as reciting that the acetylenic alcohol surface active agent and a quaternary ammonium salt surface active agents [sic, agent] are "collectively present in an amount of 0.01 to 5.0% by weight" (emphasis added).

In order for appellants' specification to provide written descriptive support for the invention presently claimed, all that is required is that it reasonably convey to one of ordinary skill in the art that as of the filing date of the application, appellants were in possession of the presently-claimed invention; how the specification accomplishes this is not material. See *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351-2, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). It is not necessary that the application describe the presently-claimed invention exactly, but only sufficiently clearly that one of ordinary skill in the art would recognize from the disclosure that appellants invented it. See *Edwards*, 568 F.2d at 1351-2, 196 USPQ at 467; *Wertheim*, 541 F.2d at 262,

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191 USPQ at 96. "[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. Precisely how close the original description must come to comply with the § 112 written description requirement must be determined on a case-by-case basis. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

As stated by the examiner (answer, page 7), appellants' specification provides written descriptive support for use of an acetylenic alcohol surface active agent in combination with a quaternary ammonium salt surface active agent. The specification discloses (pages 7-9) that each of the acetylenic alcohol surface active agent and quaternary ammonium salt surface active agent can be used in combination with other types of surface active agents, and states (page 5): "Preferably, the developing solution comprises an acetylenic alcohol based surface active agent. Also preferably, the developing solution comprises a quaternary ammonium salt based surface active agent." These teachings, taken together, reasonably convey to one of ordinary skill in the art that appellants were in possession as of their filing date of

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a developing solution containing a combination of an acetylenic alcohol surface active agent and a quaternary ammonium salt surface active agent.

Regarding the amount of the surface active agent, appellants' specification states (page 10):

The surface active agent may be used preferably in an amount of from 0.01 to 5% by weight, more preferably from 0.03 to 3% by weight, most preferably from 0.05 to 2% by weight. An amount of the agent smaller than 0.01% by weight would result in insufficient wettability or defoamability and an amount larger than 5% by weight would spoil smoothness of pattern shapes.

The teaching that wettability or defoamability would be insufficient if the amount of surface active agent is below 0.01 wt% would not make sense if the surface active agent referred to is one component of a surface active agent combination and one or more other surface active agent components are present which could provide sufficient wettability and foamability. Thus, the specification reasonably conveys that the 0.01 wt% lower limit of the amount of surface active agent and, accordingly, the preferred range, are those of the total surface active agent. For this reason and because, as discussed above, appellants' specification reasonably conveys that appellants had possession as of their filing date of the presently-recited combination of an acetylenic alcohol surface active agent and a

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quaternary ammonium salt surface active agent, we find that appellants' specification provides written descriptive support for a developing solution containing 0.01 to 5 wt% of a surface active agent which is a combination of an acetylenic alcohol surface active agent and a quaternary ammonium salt surface active agent.

*DECISION*

The rejection of claims 1, 5, 9, 10, 12 and 13 under 35 U.S.C. § 112, first paragraph on the ground that the specification, as originally filed, does not provide adequate written descriptive support for the invention as now claimed, is reversed.

*REVERSED*

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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TERRY J. OWENS	)	
Administrative Patent Judge	)	

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