

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte BRUCE R. CRUM, COREY G. KNUTSON, BRIAN M. NAASZ and  
JEFFREY S. SMITH

---

Appeal No.96-1315  
Application 08/293,611<sup>1</sup>

---

ON BRIEF

---

Before SOFOCLEOUS, CAROFF, and DOWNEY, Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §134 from the final rejection of claims 1-4, and 6-16. Claims 5, 17 and 18 remain in the application. The examiner has found claims 17 and 18 allowable and claim 5 objectionable.

---

<sup>1</sup> Application for patent filed August 19, 1994.

The subject matter on appeal is directed to a method for recovering a C<sub>1</sub> chlorocarbon from a gaseous mixture by use of a liquid hydrocarbon having an average molecular weight within a range of about 142 to 422 at a temperature and pressure where the C<sub>1</sub> is absorbed in the liquid hydrocarbon.

All the claims stand or fall together. Claim 1 is illustrative and reads as follows:

1. A process for recovering a C<sub>1</sub> chlorocarbon from a gaseous mixture, the process comprising: contacting a gaseous mixture comprising a C<sub>1</sub> chlorocarbon and a noncondensable gas with an absorbent comprising a liquid hydrocarbon having an average molecular weight within a range of about 142 to 422 at a temperature and pressure where the C<sub>1</sub> chlorocarbon is absorbed in the liquid hydrocarbon thereby separating the C<sub>1</sub> chlorocarbon from the noncondensable gas.

There are no references relied upon by the examiner.

Claims 1-4 and 6-16 stand rejected under 35 U.S.C. § 112, first paragraph. It is the examiner's position that appellants' specification is enabling only for claims limited to the liquid hydrocarbon having an average molecular weight of about 272, which is the weight of the liquid hydrocarbon of examples 1 and 2 in the specification. The examiner states that "[T]here are no other examples of the use of any other type of liquid hydrocarbon nor [sic: or] of molecular weights which approach the two outer limits of the 'range of about 142 to 422'" (original emphasis).

We reverse.

The first paragraph of 35 U.S.C. § 112 requires nothing more than objective enablement. How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 U.S.C. § 112 unless there is reason to doubt the objective truth of the statements relied upon for enabling support. In re Brana, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). The statute does not require that a specification convince persons skilled in the art that the assertions therein are correct. In re Robins, 429 F.2d 452, 457, 166 USPQ 552, 556 (CCPA 1970). It is necessary that the examiner supply either evidence or reasoning as to why the invention cannot be practiced as broadly as it is claimed. In re Bowen, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974).

Herein the examiner posits that the use of liquid hydrocarbons having a molecular weight of 142 to 422 does not follow from the singular example of a hydrocarbon having an average molecular weight of 272. The examiner reasons that “[T]he viscosity and therefore the flow properties of the liquid hydrocarbon changes as its molecular weight increases.” However, the examiner has not provided any evidence or reasoning to establish that (1) this is an unpredictable art and undue experimentation is required to

carry out the claimed process or (2) that one of ordinary skill in this art could not make and use liquid hydrocarbons of the molecular weight range of 142 to 422 in the claimed process. In addition, the examiner has proffered no

evidence or acceptable reasoning to establish that the viscosity of the adsorbent affects the extraction process in a fashion to doubt that the full scope of the claimed invention is not enabled.

**Reversed**

MICHAEL SOFOCLEOUS	)
Administrative Patent Judge	)
	)
	)BOARD OF PATENT
MARC L. CAROFF	)
Administrative Patent Judge	) APPEALS AND
	)
	)INTERFERENCES
MARY F. DOWNEY	)
Administrative Patent Judge	)

Appeal No. 96-1315  
Application 08/293,611

MFD/pgg  
Dow Corning Corp.  
Patent Department  
Mail CO1232  
Midland, MI 48686-0994