

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. COOKE

Appeal No. 1998-1176
Application No. 08/553,072

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5 through 10, 12, 19, 21 and 22.¹ These are the only claims remaining in this application.

¹ The amendment dated Jan. 14, 1997, Paper No. 8, subsequent to the final rejection, was entered by the examiner as per the Advisory Action dated Jan. 31, 1997, Paper No. 9. See the Brief, page 2.

Appeal No. 1998-1176
Application No. 08/553,072

According to appellant, the invention is directed to an ultraviolet (UV) light absorber composition which is spontaneously dilutable in water to allow its use in conventional textile dyeing and is based on the synergistic combination of the UV light absorber and a suitable solvent (Brief, page 2). Appellant states that the claims do not stand or fall together and have presented specific, substantive reasons for the separate patentability of each claim rejected in view of prior art (Brief, pages 5 and 8-10). Pursuant to the provisions of 37 CFR § 1.192(c)(7)(1995), we decide this appeal as to the ground of rejection under section 112 on the basis of claims 12 and 19, with claims 5-10, 21 and 22 standing or falling with claim 19. With respect to the rejections based on prior art, we consider each claim separately to the extent argued by appellant.

Illustrative claims 12 and 19 are reproduced below:²

12. A UV light absorber composition for improving the lightfastness of dyed synthetic textiles, consisting essentially of:

² We note that claims 12 and 19 are not correctly reproduced in the Appendix attached to appellant's Brief (see the Answer, page 3).

Appeal No. 1998-1176
Application No. 08/553,072

(a) from about 10-45% by weight of 2-(2-hydroxy-5-tert-octylphenyl) benzotriazole;

(b) from about 55-90% by weight of N-methyl-pyrrolidone solvent; and

(c) wherein the benzotriazole of (a) is applied to the textiles in a concentration sufficient to result in an add-on in the range of between 0.4-4.0% by weight of the textiles when dry.

Appeal No. 1998-1176
Application No. 08/553,072

19. A UV light absorber composition for improving the lightfastness of dyed synthetic textiles, consisting essentially of:

(a) 5-25% by weight of a substituted benzotriazole UV light absorbing agent; and

(b) 75-95% by weight of a miscible organic solvent suitable for dissolving said benzotriazole, wherein said benzotriazole is applied to the textiles in a concentration sufficient to result in an add-on in the range of between 0.4-4.0% by weight of the textiles when dry and optionally a surfactant, an additional light stabilizer, antioxidant and a water immiscible solvent.

The examiner has relied upon the following references in support of the rejections:

Kintopf et al. (Kintopf)	4,230,867	Oct. 28, 1980
DesLauriers et al. (DesLauriers)	5,268,450	Dec. 7, 1993

All of the claims on appeal stand rejected under 35 U.S.C.

§ 112, ¶1, as being based on a specification which contains new matter (Answer, page 4). Claims 9, 19 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over Kintopf (Answer, page 5). Claims 10 and 19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Deslauriers (Answer, page 6). We *affirm* the rejections based on prior art essentially for the reasons in the Answer but *reverse* the rejection under

Appeal No. 1998-1176
Application No. 08/553,072

the first paragraph of section 112 for reasons which follow.

Accordingly, the decision of the examiner is *affirmed-in-part*.

OPINION

A. The Rejection under 35 U.S.C. § 112, ¶1

The examiner finds that there is no basis or support in the original disclosure for the newly created ranges of components (a) and (b) in claims 12 and 19 (Answer, pages 4 and 7-9). The examiner also finds that the range of claim 12 is not supported by the disclosure of Example 12 in the specification, which the examiner finds to disclose that the entire ranges now claimed in claim 12 will not result in component (a) being soluble in component (b)(Answer, page 4).

The initial burden rests with the examiner of presenting evidence or reasoning why persons of ordinary skill in the art would not recognize in the original disclosure a description of the invention as now defined by the claims. *In re Wertheim*, 541 F.2d 257, 264, 191 USPQ 90, 97 (CCPA 1976). As stated in *Wertheim*, "the question is whether, on the facts, the PTO has presented sufficient reason to doubt that the broader described range also describes the somewhat narrower claimed range." *Wertheim*, 541 F. 2d at 264, 191 USPQ at 98. As quoted by the examiner (Answer, page 8), *Wertheim* states

Appeal No. 1998-1176
Application No. 08/553,072

"[w]here it is clear, for instance, that the broad described range pertains to a different invention than the narrower (and subsumed) claimed range, then the broader range does not describe the narrower range. [Citations omitted]." *Wertheim*, 541 F.2d at 265, 191 USPQ at 98. We determine that the examiner has not met this initial burden merely by pointing out that the ranges now claimed are subsumed within the originally disclosed ranges but some endpoints do not have literal basis in the original disclosure (see the Answer, pages 4 and 7-9). The examiner has not shown that the different ranges pertain to different inventions or that the new endpoints are alleged to be critical. Appellant has amended the original ranges, not in an attempt to avoid prior art³ or allege criticality by a showing of unexpected results, but apparently only to make the ranges of the required components (a) and (b) equal 100% by weight.⁴

³ See *In re Johnson*, 558 F.2d 1008, 1018-19, 194 USPQ 187, 196 (CCPA 1977).

⁴ For example, the upper limit of the UV agent in claim 12 is 45% by weight while the lower limit of the NMP solvent is 55% by weight. We note that original claim 12 contained the transitional term "comprising" leaving the claims open to unrecited ingredients while claims 12 and 19 now recite

Appeal No. 1998-1176
Application No. 08/553,072

The examiner's reliance on Example 12 from appellant's specification is misplaced since, as correctly argued by appellant (Brief, page 7), Example 12 is only one of twenty examples and need not support the entire claimed range. Contrary to the examiner's belief, any particular solvent must only be capable of dissolving at least 5% of the UV agent and at least 2% of any emulsifier used (see the specification, page 8, ll. 21-23).

For the foregoing reasons, we determine that the examiner has not presented sufficient facts or reasoning to meet the initial burden of proof. Accordingly, the examiner's rejection of the claims on appeal under 35 U.S.C. § 112, ¶1, is reversed. *B. The Rejection under 35 U.S.C. § 102(b)*

Claims 10 and 19 stand rejected under section 102(b) as anticipated by col. 23, ll. 25-29, of DesLauriers, which the examiner finds to disclose the addition of 5.89 grams of a substituted benzotriazole UV light absorbing agent in 70 grams

"consisting essentially of" which excludes components which would materially affect the basic and novel characteristics. We also note that claims 12 and 19 now require no additional surfactant or emulsifier.

Appeal No. 1998-1176
Application No. 08/553,072

of NMP (N-methyl-2-pyrrolidone solvent, see Example 1 in col. 15 of this reference; Answer, page 6) to an autoclave.⁵

Appellant argues that "the mere fact that such benzotriazole UV absorber compounds can be dissolved in NMP does [sic,not?] anticipate their use in making water-dilutable UV absorber solutions for treating textiles" (Brief, page 9). Appellant submits that this reference "in no way teaches or anticipates the end-use or invention of this application" (*id.*).

Appellant's arguments are not well taken since the end use of the invention is not claimed. Claim 19 on appeal is directed to a UV light absorber *composition* which consists essentially of components (a) and (b). Appellant does not contest that DesLauriers discloses the two claimed components in amounts within the scope of claim 19 on appeal (see the Brief, pages 9-10). The preamble language of claim 19 and the language following component (b) both are directed to the intended use of the UV light absorber composition and do not

⁵ Although not contested by appellant, the amount of UV agent in this composition is about 7.7% by weight (5.89/(70+5.89)), with the remainder (92.3% by weight) being the NMP solvent.

Appeal No. 1998-1176
Application No. 08/553,072

differentiate the claimed composition from the composition of DesLauriers. This language directed to the intended use does not give meaning and scope to the claim. See *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673-74 (Fed. Cir. 1994); and *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

Accordingly, for the foregoing reasons and those set forth in the Answer, the examiner's rejection of claim 19 on appeal, and claim 10 which depends on claim 19 and recites the use of NMP as the solvent, under 35 U.S.C. § 102(b) as anticipated by DesLauriers is affirmed.

C. The Rejection under 35 U.S.C. § 103

The examiner finds that Kintopf discloses the production of various substituted benzotriazole UV light absorbers in an organic solvent (Answer, page 5). The examiner concludes that the amounts of each component would have been obvious since Kintopf clearly teaches that the amount of solvent must dissolve the benzotriazole UV agent (Answer, page 6).

Appellant argues that the percentages of components recited in claim 19 on appeal are not disclosed by Kintopf

Appeal No. 1998-1176
Application No. 08/553,072

(Brief, page 8). Appellant also argues that the specific benzotriazole of claim 9 is not taught or suggested by Kintopf (*id.*). Finally, appellant argues that Kintopf does not disclose or suggest the use of a water immiscible solvent as recited in claim 22 on appeal.

Appellant's arguments are not persuasive. The examiner concludes that the amounts of each component would have been well within the ordinary skill in the art since Kintopf teaches that the amount of solvent should completely dissolve the particular benzotriazole used (see Kintopf, col. 4, ll. 28-39; col. 5, l. 64-col. 6, l. 1; Answer, pages 9-10). Appellant has not specifically rebutted the examiner's finding regarding the teaching of Kintopf. Furthermore, it is noted that the law is replete with cases in which the difference between the claimed invention and the prior art is some range within the claims and it has been consistently held that in such situations that appellant must show that the particular range is critical. See *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). The specific benzotriazole of claim 9 on appeal is disclosed by Kintopf in

Appeal No. 1998-1176
Application No. 08/553,072

Example 6 at col. 14. Water-immiscible solvents are taught as co-solvents by Kintopf (see the Answer, page 9; Kintopf, col. 5, ll. 2-6; and Example 1).

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has presented a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, giving due consideration to appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103. Accordingly, the examiner's rejection of claims 9, 19 and 22 under 35 U.S.C. § 103 as unpatentable over Kintopf is affirmed.

Appeal No. 1998-1176
Application No. 08/553,072

D. Summary

The examiner's rejection of claims 5-10, 12, 19 and 21-22 under the first paragraph of 35 U.S.C. § 112 is reversed. The examiner's rejection of claims 10 and 19 under 35 U.S.C. § 102(b) over DesLauriers is affirmed. The examiner's rejection of claims 9, 19 and 22 under 35 U.S.C. § 103 over Kintopf is affirmed. Accordingly, the decision of the examiner is affirmed-in-part.

Appeal No. 1998-1176
Application No. 08/553,072

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

AFFIRMED-IN-PART

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
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Appeal No. 1998-1176
Application No. 08/553,072

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