

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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCESCO MASI, LIA BARAZZONI, SERGIO MASINI,
CESARE FERRERO and ANGELO MOALLI

Appeal No. 1998-2451
Application No. 08/317,826

ON BRIEF

Before PAK, WARREN, and PAWLIKOWSKI, Administrative Patent Judges.
PAWLIKOWSKI, Administrative Patent Judge.

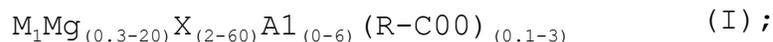
DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 2, 4-10, 13-16, 26-35, and 48-53.¹ Claims 1-17, 26-35, and 48-53 are pending in this application. Claims 18-25 and 36-47 have been canceled. Claims 3, 11, and 12 have been allowed. Claim 17 has being withdrawn from consideration.

¹ We note that the examiner indicates that minor errors exist in appellants' copy of the claims. (answer, page 2).

The subject matter on appeal is represented by the following claim 1:

1. A solid component of a catalyst for the (co)polymerization of ethylene and α -olefins, which contains magnesium-carboxylate bonds and transition metal-carboxylate bonds; which is represented by the formula



and which is prepared by the steps of:

(a) forming a solution, in an inert organic solvent, of a magnesium carboxylate or a magnesium carboxylate halogenide having the formula $MgX_n(R-COO)_{2-n}$ (II), where n ranges from 0 to 1, and at least one transition metal carboxylate or transition metal carboxylate halogenide having the formula $MX_m(R-COO)_{4-m}$ (III), where the atomic ratio between the magnesium in (II) and the transition metal in (III) is from 0.3:1 to 20:1;

(b) adding to the solution an aluminum alkyl halide (IV), where the alkyl group is a linear or branched alkyl group containing 1-20 carbon atoms and the halide group is a halide other than an iodide group, to precipitate the solid component of the catalyst, where the atomic ratio between the halide in (IV) and the total carboxyl groups in (II) and (III) is from 0.3:1 to 10:1; and

(c) recovering the solid component in a granular form; where

M in formulas (I) and (III) is at least one transition metal selected from the group consisting of titanium, vanadium, zirconium, and hafnium;

X in formulas (I), (II), (III), and (IV) is halogen other than iodine;

R in formulas (I), (II), and (III) is an aliphatic, cycloaliphatic, or aromatic radical containing at least 4 carbon atoms; and

m is from 0 to 2.

No prior art references are relied upon by the examiner.

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The rejections at issue are as follows:

I. Claims 1, 4, 5, 7-10, 13-16, 29-35, and 48-53 stand rejected under 35 U.S.C. § 112, first paragraph (written descriptions).²

II. Claims 2, 6, and 28 stand rejected under 35 U.S.C. § 112, first paragraph (written description).

On page 5 of the Brief, appellants state that the claims do not stand or fall together, and group the claims with each rejection. The examiner agrees with the grouping. Hence, we consider claims 1 and 2 (the broadest claims of each respective grouping). 37 CFR § 1.192(c)(5)(1997).

OPINION

We have carefully considered all of the arguments advanced by the appellants in the brief and reply brief, and by the examiner in the answer. Our decision based on this review is set forth below.

² We observe that the examiner's rejection on page 3 of the answer indicates that claims 20, 42, and 45 are included in this rejection. However, as indicated supra, claims 20, 42, and 45 have been canceled. Also, the examiner did not include claims 48-53 in this rejection, which contradicts the position taken in the office action of Paper No. 33. We therefore presume that claims 1, 4, 5, 7-10, 13-16, 29-35, and 48-53 stand rejected in this rejection. This coincides with PTOL-326 form of Paper No. 33.

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I. The 35 U.S.C. § 112, first paragraph (written description) rejection of claims 1, 4, 5, 7-10, 13-16, 29-35, 48-35

Firstly, we note that the examiner must establish a prima facie case that the claims do not comply with § 112, first paragraph, written description requirement, by showing that the written description in the application does not "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [applicant] was in possession of the invention . . . now claimed." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); see also In re Alton, 76 F.3d 1168, 1172, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996), In re Wertheim 541 F. 2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In this context, we provide the following determinations.

On page 3 of the answer, the examiner states that there is lack of support for the now claimed phrase "aluminum alkyl halide". This phrase is recited in step (b) of claims 1, 5, and 48. The examiner states that the specification, on page 6, at lines 6-11, indicates that the phrase "aluminum alkyl halide" is qualified by formula (IV). This formula is set forth on page 6 of the specification. The examiner concludes it should be so qualified in the claims.

Upon our review of page 6 of the specification, we observe that when p (in formula (IV)) is between the value of 1 and 2³,

³ Appellants' claim 2, for example, recites "p is between 1 and 2".

the formula on page 6 provides for an aluminum alkyl halide wherein the alkyl is linear or branched, containing from 1 to 20 carbon atoms, and the formula can have at most only two halides (when the value of p is 1).

However, we observe that appellants' claim 1 recites having multiple halides ⁴, i.e., in an amount greater than 2 to an amount less than 2. Such claimed subject matter is not supported by the aforementioned disclosure set forth on page 6 of appellants' specification.

Hence, we find that the description of the "aluminum alkyl halide" as set forth on page 6 of appellants' specification does not allow for multiple halides from more than 2 to less than 2 as now recited in the claims.

We are mindful of appellants' arguments presented on pages 6-8 of the Brief, and on pages 4-8 of the Reply Brief. However, we reiterate that the phrase "aluminum alkyl halide ... and the halide group is a ..." allows for multiple halides from more than 2 to less than 2.

Therefore, in view of the above, we affirm the rejection of claims 1, 4, 5, 7-10, 13-16, 29-35, 42, and 45 under 35 USC § 112 first paragraph (written description).

II. The 35 U.S.C. § 112, first paragraph (written description) rejection of claims 2, 6, and 28

⁴ The phrase "and the halide group" allows for multiple halide groups.

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On page 5 of the answer, the examiner rejects claims 2, 6 and 28, stating that there is no support in the specification for the phrase "P is between 1 and 2".

Appellants argue that the range of "p is between 1 and 2" is supported by 3 examples which cover the lower limit of "p is 1", the upper limit of "p is 2", and the mid point of "p is 1.5". (Brief page 8).

We refer to the case of Ex parte Jackson, 110 USPQ 561, 562, (Pat. & Trademark Office Bd. App. 1956). In this case, the claim at issue recited, *inter alia*, "from 4% to 20%, of carbon". The specification provided for 4%, 15% and 20%, for the amount of carbon. The examiner asserted that such a disclosure was not sufficient for all the values between 4% and 20%. We held that in fact such a disclosure was sufficient to support the claim range of "from 4% to 20% of carbon".

In the instant case, we have a similar situation, i.e., the examples provide for the values of 1, 1.2, and 2. In view of Ex parte Jackson, we also conclude that such a description supports the claimed range of "p is between 1 and 2".

In view of the above, we reverse the rejection of claims 2, 6, and 28 under 35 U.S.C. § 112, first paragraph (written description).

III. Conclusion

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The rejection of claims 1, 4, 5, 7-10, 13-16, 29-35, and 48-53 under 35 U.S.C. § 112, first paragraph (written description) is **affirmed**.

The rejection of claims 2, 6, and 28 under 35 U.S.C. § 112, first paragraph (written description) is **reversed**.
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

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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BEVERLY A. PAWLIKOWSKI)	
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