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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ARTHUR P. WEIDNER

Appeal 2010-006422
Application 10/974,088
Technology Center 2800

Before DENISE M. POTHIER, BRUCE W. WINSOR, and
TRENTON A. WARD, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 2, 12-15, 26-30, 33-37, 41, and 42. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Appellant's invention involves improved electrochromic devices that provide an electrolyte comprising γ -butyrolactone (gamma-butyrolactone or GBL). *See* Spec. ¶ 8. Claim 12 is illustrative with certain limitations emphasized:

12. An electrochromic device comprising:
 - a first electrode sheet, the first electrode sheet being substantially transparent;
 - a second electrode sheet, the second electrode sheet being substantially transparent;
 - an electrochromic polymer layer disposed between the first electrode sheet and the second electrode sheet; and
 - a gel electrolyte disposed between the electrochromic polymer layer and one of the first electrode sheet and the second electrode sheet, the gel electrolyte including 60% to 90% by weight of gammabutyrolactone.*

THE REJECTION

The Examiner rejected claims 2, 12-15, 26-30, 33-37, 41, and 42 under 35 U.S.C. § 102(e) as anticipated by Liu (US 7,256,923 B2; issued Aug. 14, 2007) ("Liu '923"). Ans. 3-6.¹

CONTENTIONS

CLAIM 12

¹ Throughout this opinion, we refer to (1) the Appeal Brief ("App. Br.") filed Nov. 16, 2009 and (2) the Examiner's Answer ("Ans.") mailed Dec. 28, 2009.

The Examiner finds that Liu '923 discloses every recited feature of independent claim 12 including a gel electrolyte including 60% to 90% by weight of gamma-butyrolactone. Ans. 4-5.

Appellant argues that Liu '923 is not prior art because the Rule 131 (37 C.F.R. § 1.131) Declarations submitted by the Appellant establish the invention prior to March 12, 2004, the priority date of Liu '923. App. Br. 5-6 (citing Appendices A-C). Specifically, Appellant argues that the Rule 131 Declarations, submitted by the Appellant, establish conception of claim 12 prior to the March 12, 2004 effective date of Liu '923, followed by diligence in a constructive reduction to practice. App. Br. 5-7.

Separately, Appellant argues that the rejection of base claim 12 should be withdrawn for the additional reason that the percentage by weight of gamma-butyrolactone allegedly shown by Liu '923 has a priority date after the filing date of the present application. App. Br. 9-10.

ISSUES

1. Has the Examiner erred in rejecting claim 12 by failing to withdraw Liu '923 as antedated by Appellant's Declarations?
2. Has the Examiner erred in rejecting claim 12 by finding that Liu '923 teaches the recited percentage by weight of gamma-butyrolactone

ANALYSIS

Issue (1)

According to Appellant, the Rule 131 Declaration by Kylie Thompson includes a redacted invention disclosure entitled "LOW VAPOR PRESSURE SOLVENT FOR ELECTROCHROMIC DEVICES" (the

“Invention Disclosure”), which clearly supports claim 12. App. Br. 5 (citing Appendix B). Appellant further contends that this Invention Disclosure was received by the Boeing Company on Jan. 14, 2004, which establishes conception prior to Mar. 12, 2004. App. Br. 6.

Contrary to Appellant’s arguments, the Examiner finds that Appellant’s Declarations are insufficient to establish conception prior to the priority date of Liu ’923 because “there is no evidence or proof within this declaration that the electrolyte comprises two transparent electrodes with a cathodic polymer and a gel electrolyte formed therebetween as required by independent claim 12 (and thereby claims dependent therefrom).” Ans. 8.

On this record, we are not persuaded of error in the Examiner’s findings because Appellant’s Invention Disclosure lacks sufficient disclosure to establish the elements of claim 12. “It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception.” *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985) (citations omitted); *see also* MPEP § 2138.04. Appellant’s claim 12 recites that the “gel electrolyte” be “disposed between the electrochromic polymer layer and one of the first electrode sheet and the second electrode sheet” and that the “gel electrolyte” include “60% to 90% by weight of gammabutyrolactone.”

These requirements with respect to the GBL layer, recited in claim 12, are not contained in Appellant’s Invention Disclosure. The Invention Disclosure simply states the following: “[g]amma-butyrolactone (C₄H₆O₂) can be used as a solvent with the proper electrolyte and mixed with a thixotropic compound to provide electrical isolation, ion transfer and

physical separation between the device layers.” App. Br. 8 (citing Appendix B, Ex. B). Appellant’s Invention Disclosure makes no mention of weight percentages or the placement of the GBL layer as recited in claim 12. *See id.* Accordingly, we are not persuaded of error in the Examiner’s findings that Appellant’s Declarations fail to establish conception prior to March 12, 2004.

Issue (2)

With respect to claim 12, Appellant additionally argues that the rejection of claim 12 is improper because Liu ’923 fails to teach or suggest the recited percentage by weight of GBL required by claim 12. App. Br. 10. While the cited Liu ’923 reference does disclose a “ γ -butyrolactone (GBL)” solvent (*see* Col. 20, ll. 11-12), Liu does not provide an example of a solvent that includes 60 to 90% by weight of GBL as recited. *See* col. 6, ll. 6-30. Also, the parent application, US 6,747,780 (“’780 Patent”) relied upon the Examiner as providing the percent by weight of GBL disclosure (Ans. 8-9), does not disclose GBL. Specifically, the ’780 Patent fails to mention GBL. *See* ’780 Patent (Col. 10, ll. 45-58) (“Another useful gel electrolyte can be prepared from 3% LiClO₄, 7% PMMA, 20% PC and 70% acetonitrile (ACN) (% by weight)”). Therefore, the ’780 Patent fails to provide support for the disclosure of GBL based limitations of claim 12. Accordingly, based on the record before us, we find error in the Examiner’s anticipation rejection of claim 12. The extent to which this feature would have been obvious to an ordinary skilled artisan based on Liu ’923’s teaching, however, is a question that is not before us: nor will we speculate in that regard here in the first instance on appeal.

We are therefore persuaded that the Examiner erred in finding that Liu '923 teaches the recited percentage by weight of gamma-butyrolactone and in rejecting claim 12, and claims 13-15, 34, and 41 dependent therefrom, under § 102.

THE REMAINING CLAIMS

Independent claims 2 and 26 also recite an electrolyte including 60% to 90% by weight of gamma-butyrolactone. Appellant's arguments regarding claims 2 and 26 are substantially the same as the second argument for claim 12 above. *See* App. Br. 1-12. . App. Br. 11-12. We will not sustain the anticipation rejections of claims 2 and 26, and claims 27-30, 33, 35-37, and 42 dependent therefrom, for the same reasons provided above for claim 12.

CONCLUSION

The Examiner erred in rejecting claims 2, 12-15, 26-30, 33-37, and 41-42 under § 102.

ORDER

The Examiner's decision rejecting claims 2, 12-15, 26-30, 33-37, and 41-42 is reversed.

REVERSED

gvw