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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN C. LACOURSE and MORTEZA ZANDI

Appeal 2011-010545
Application 12/419,162
Technology Center 1700

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1-12 and 15-20. We have jurisdiction under 35 U.S.C. § 6(b).

The Examiner rejects claims 1-12 and 15-20 on two grounds:

(1) on the ground of nonstatutory obviousness-type double patenting over claims 1-20 of U.S. Patent 7,531,109 (Ans. 4); and

(2) under 35 U.S.C. §103(a) as obvious over Philips¹ (Ans. 5).

We sustain the obviousness-type double patenting rejection, but do not sustain the obviousness rejection. Therefore, the decision of the Examiner is AFFIRMED.

With regard to the rejection of claims 1-12 and 15-20 on the ground of nonstatutory obviousness-type double patenting (Ans. 4), Appellants contend that the rejection is moot because that they filed a terminal disclaimer (Br. 6). The Examiner responds that, as explained in the Advisory Action mailed January 7, 2011, the terminal disclaimer was not accepted (Ans. 5). In the Reply Brief, Appellants contend that the Examiner committed error by not entering the terminal disclaimer (Reply Br. 1).

The Examiner's refusal to enter the terminal disclaimer is not within our jurisdiction to decide. Entry of papers is a matter within the Examiner's discretion reviewable by way of petition rather than by appeal. 35 U.S.C. §§ 6(b) and 134(a) (2005); *In re Berger*, 279 F.3d 975, 984-85 (Fed. Cir. 2002). Therefore, since Appellants did not contest the merits of Examiner's rejection, we summarily affirm the obviousness-type double patenting rejection.

Turning to the rejection of claims 1-12 and 15-20 under 35 U.S.C. § 103(a) as obvious over Philips, we note that Appellants filed a declaration under 37 C.F.R. § 131 to swear behind Philips, i.e., establish that Appellants were in possession of their invention prior to the effective date of the reference (LaCourse et al. Decl.; *see* Evid. App'x. at Br. 21).

¹ Bolyasnikova et al., WO 2005/110943 A1, pub. Nov. 24, 2005. The first listed Applicant is Philips Intellectual Property & Standards GmbH. Appellants refer to this reference as "Philips," and therefore we do the same.

The Examiner determines that the Declaration is insufficient to overcome the rejection because the showing in the Declaration is not commensurate in scope with the claims (Ans. 6-9). According to the Examiner, the scope of the composition encompassed by the claims is much broader than what is shown in the Declaration (Ans. 7).

For the reasons explained in the Brief and Reply Brief, we determine that the Examiner erred (Br. 8-16; Reply Br. 3-4). The Examiner's determination appears to be based on a misreading of *In re Tanczyn*, 347 F.2d 830 (CCPA). As correctly pointed out by the Examiner, *Tanczyn* stands for the proposition that a declaration must establish possession of either the whole invention claimed or something falling within the claim. *Id.*, at 833. But that "something falling within the claim" can be a species of the invention. Appellants need not show completion or possession of the entire genus of the broadest claim. *In re Stempel*, 241 F.2d 755, 759 (CCPA 1957).

So the question under the correct interpretation of the law is: Does the Declaration show possession of at least one species of the claimed invention?

The claims are directed to a rare earth oxysulfide scintillating ceramic body including a rare earth element (M) and a dopant (Ln). Claim 1 illustrates the invention on appeal and is reproduced below:

1. A rare earth oxysulfide scintillating ceramic body having a composition $(M_{1-x}Ln_x)O_2S$, wherein M is at least one rare earth element, Ln is at least one element selected from the group consisting of Eu, Ce, Pr, Tb, Yb, Dy, Sm, Nd, and Ho, and $1 \times 10^{-6} < X < 2 \times 10^{-1}$, the body having a density not less than 99% of theoretical density, an afterglow below 1000 ppm at 5

ms, and a light output of greater than 1.75 times the light output of the CdWO₄ standard.

(App'x. 1 at Br. 17.)

LaCourse and Zandi declare that two samples of their claimed ceramic body were reduced to practice before the effective filing date of Philips (Decl. ¶¶ 4-6). One of the samples was a gadolinium oxysulfide crystal that included Pr in a range of 727 to 770 atomic ppm and Ce in a range of 21-35 atomic ppm (Decl. ¶ 6). It had a density, afterglow, and light output within the ranges of claim 1 and meets the requirements of some of the other claims (compare Decl. ¶ 8 with Claims 1, 2, 6-11, and 17-20). One of the further samples was a gadolinium oxysulfide crystal that included Pr at 570 atomic ppm, and Ce at 19 atomic ppm (Decl. ¶ 6). There is no dispute that it had a density, afterglow, and light output such that this species falls within the scope of each of Appellants' claims (Ans. 7-9 (no dispute that 2.17 rounds to 2.2 as articulated at Br. 10); also *compare* Decl. ¶¶ 8 *with* claims 1-12 and 15-20).

As pointed out by Appellants, they have shown possession, and thus reduction to practice, of two species of the claimed invention (Br. 8-13; Reply Br. 3).

Showing possession of something falling within the claimed subject matter is only the first step of the inquiry. Swearing behind a reference is in essence a showing that Appellants completed what is taught by the reference before the effective filing date of the reference. Therefore, to swear behind the reference, Appellants must establish that they possessed as much of the invention as the reference happens to show. *Stempel*, 241 F.2d at 760. That being said, "possession of what is shown carries with it possession of

variations and adaptations which would, at the same time, be obvious to one skilled in the art.” *In re Spiller*, 500 F.2d 1170, 1178 n.5 (C.C.P.A. 1974). For instance, “[w]hen that species of the generic invention which has been completed prior to the effective date of the reference would make obvious to one of ordinary skill in the art the species disclosed in the reference, the reference may be said to have been ‘indirectly antedated.’” *In re Schaub*, 537 F.2d 509, 512 (CCPA 1976).

Philips teaches gadolinium oxysulfide ceramic that can have dopants from the group of claimed dopants, including the Ce and Pr dopants, and that the amounts used were on the order of the amounts claimed (*see* Ans. 5 (finding that Philips teaches amounts of Ce and Pr falling within the claimed range)). It is unclear from Philips whether those of ordinary skill in the art understood which of the compositions would result in light outputs greater than 1. While Philips states that light output up to 2.3 can be achieved, none of the example compositions achieve light outputs above 1 and another portion of the reference confines the light output range to 0.74 to 1.00 (*compare* Philips, p. 5, ll. 6-8 *with* p. 6, ll. 1-3 and data in Tables I and II).

Appellants’ broadest claims, on the other hand, are limited to the genus of compositions having a light output of greater than 1.75.

Appellants’ Declaration shows a reduction to practice of two species having the required light output. Appellants have thus shown possession of those two species plus possession of variations and adaptations which would, at the same time, have been obvious to one skilled in the art. At best, Philips happens to show that some unnamed species have light outputs in the claimed range. Under the facts of the present case, Appellants’ showing,

which indicates possession of two species and variations and adaptations that would have been obvious from the reduction to practice of those two species, establishes that they possessed as much of the invention as the reference happens to show. This is because what Philips happens to show is not specific to any species having the light output of the claim. Appellants' two species and their obvious variations renders obvious the unnamed species of Philips. "[A]ll the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show" and "this priority need not always be shown directly." *Schaub*, at 512.

Because the Examiner reversibly erred in considering the Declaration, we do not sustain the obviousness rejection.

DECISION

While we do not sustain the obviousness rejection, we do sustain the obviousness-type double patenting rejection. The Examiner's decision is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

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