



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/727,644	03/27/2007	Atsuhiro Tanaka	24-052	3027
23400	7590	02/01/2013	EXAMINER	
POSZ LAW GROUP, P.L.C. 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			SHAH, SAMIR	
			ART UNIT	PAPER NUMBER
			1787	
			NOTIFICATION DATE	DELIVERY MODE
			02/01/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailbox@poszlaw.com
lwebbers@poszlaw.com
dposz@poszlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ATSUHIRO TANAKA, YOSHITOMO ONO, and
ATSUSHI TEZUNA

Appeal 2011-010577
Application 11/727,644
Technology Center 1700

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and
JAMES C. HOUSEL, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1, 2, 4, and 5 under 35 U.S.C. § 112, ¶ 1 as lacking written descriptive support. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The claims are directed to a pressure-sensitive adhesive sheet having a substrate film (claim 1), or a surface-most layer of a substrate film (claim 4), having a storage modulus within a particular range (Claims 1 and 4). Claim 1 is representative and reproduced below:

1. A pressure-sensitive adhesive sheet comprising:

a single-layer substrate film and a pressure-sensitive adhesive layer, said substrate film having a specular gloss Gs (60°) of not less than 80%, wherein

said substrate film has a storage modulus at some temperature between 70 °C and 90°C in a range of from 6.9×10^1 to 2.8×10^2 MPa, and

said substrate film comprises a polyurethane as a main component thereof.

(Claims App'x. at Br. 15.)

The Examiner finds that the Specification fails to support the 6.9×10^1 MPa lower limit of the storage modulus range (Ans. 4). The Examiner states that:

While there is support to recite storage modulus of 6.9×10^1 MPa for a specific pressure sensitive adhesive using specific polyurethane substrate and specific pressure sensitive adhesive layer (Table 1), however, there is no support to recite this value of storage modulus for the broad disclosure of pressure sensitive adhesive sheet and polyurethane as set forth in present claims.

(Ans. 4)

Appellants contend that the broader range of 1.0×10^1 to 2.8×10^2 MPa recited in the Specification supports the narrower claimed range (Br. 7, citing Spec. 6:5-19; 11:8-10). Appellants argue that the facts of the present

case are similar to those of *In re Wertheim*¹ and *In re Blaser*²; cases in which a broader range recited in the Specification was found to support claims reciting a narrower range (Br. 6-13). Appellants also point out that the Specification provides a written description of the 6.9×10^1 MPa lower limit in Example 2 at 90°C (Br. 8, citing Spec. 18-19, Table 1).

What the Specification discloses with regard to the broader range and Example 2 is not disputed, the question is: Has the Examiner presented a sufficient reason to doubt that the broader described range and example of the Specification fails to also describe the somewhat narrower range of the claims?

For the following reasons, we answer this question in the negative.

OPINION

Initially, we agree with the Examiner that the facts of *In re Wertheim* and *In re Blaser* are not as directly on point as Appellants argue (Ans. 5-6). Moreover, Appellants statement that “[t]hese cases established in the case law that the disclosure of a broad range in this specification provides a written description within the meaning of 35 U.S.C. § 112, first paragraph, for a more narrow range in the claims, even though the more narrow range is not specifically mentioned in the specification” (Br. 6) is overbroad. The facts of those cases differ somewhat from the facts before us. Those cases were concerned with support for process parameters in claimed processes. The case before us concerns support for a genus of materials defined by a property range set forth in the claims.

¹ 541 F.2d 257 (CCPA 1976).

² 556 F.2d 534 (CCPA 1977).

Wertheim was directed to a process involving a step of concentrating a coffee extract to a higher solids level. The court found that there was written descriptive support for a claimed solids content range of “between 35% and 60% because that range was completely within the 25% to 60% solids range disclosed in the Specification. *Wertheim*, at 264. The court drew “an important practical distinction between broad generic chemical compound inventions ... in which each compound within the genus is a separate embodiment of the invention, and inventions like that at bar, in which the range of solids content is but one of several process parameters.” *Id.* The court also made clear that they were “not creating a rule applicable to all description requirement cases involving ranges.” *Id.*, at 264-65.

Blaser claimed a process for manufacturing acylation products of phosphorus acid including a step of heating to 80°C to 200°C. *Blaser*, at 535-36 (Blaser’s Claim 7). The court found that this heating range was supported by the more broadly disclosed range of 60°C to 200°C disclosed in the written description. *Id.*, at 538.

The case before us is directed to a pressure sensitive adhesive sheet including a genus of substrate films partly defined by the storage modulus range of the claims. The claims encompass all substrate films, or surface-most layers of films, whose main component is polyurethane and, which have a storage modulus at some temperature between 70 °C and 90 °C within the claimed range. The property range of the claims serves to define a genus of materials rather than a process parameter in a process claim. The genus includes the polyurethanes identified in Examples 1 and 2 of the Specification, but also includes unidentified materials meeting the compositional and property limitations of the claims. The claims before us

are, therefore, more similar to claims that define a genus of materials than to claims that define a range of one of several process parameters as in *Wertheim and Blaser*.

The written descriptive support inquiry is a question of fact, and determining whether a patent complies with the written description requirement will necessarily vary depending on the context. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Specifically, the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology. *Id.* There is no per se rule that a broader range disclosed in the written description will always support a narrower range recited in a claim. That being said, when the original written description describes something more broadly than what is claimed, the burden is on the Examiner to provide convincing reasoning or evidence showing why the broader disclosure does not provide support for the narrower limitation of the claim. *See In re Wertheim*, 541 F.2d, 257, 263-65 (CCPA 1976) (holding that when the claimed range is outside the range disclosed in the original specification, the PTO need only point out that fact to support a written description rejection, but when the claimed range is subsumed within a range disclosed in the original specification, the PTO must present a sufficient reason to doubt that the broader described range does not also describe the somewhat narrower range.)

As set forth in *Ariad*, there are a number of factors for evaluating the adequacy of the disclosure when analyzing the written descriptive support question. They include “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology,

[and] the predictability of the aspect at issue.” *Ariad*, 598 F.3d at 1351 (quoting *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed.Cir.2005)). The Examiner does not discuss any of these factors. There is little evidence on this record that the broader genus of polyurethane-based materials described by the modulus range of the written description fails to reasonably convey to those of ordinary skill in the art that Appellants were in possession of the smaller genus of polyurethane-based materials required by the claims at the time the application was filed.

The Examiner has not presented a sufficient reason to doubt that the broader described range of materials does not also describe the somewhat narrower range of the claims.

CONCLUSION

We do not sustain the Examiner’s rejection.

DECISION

The Examiner’s decision is reversed.

REVERSED

cam