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32692	7590	10/11/2019	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			PIZIALI, ANDREW T	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ULRICH E. KUNZE, LAHOUSSAINE LALOUCHE,  
CLAUS MIDDENDORF, and HARALD H. KRIEG

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Appeal 2018-006273  
Application 14/134,538  
Technology Center 1700

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Before LINDA M. GAUDETTE, KAREN M. HASTINGS, and  
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> requests our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 4–6, 9, 11, 15, and 17 under 35 U.S.C. § 103 as unpatentable over at least the combined prior art of Hornbak ( WO 2007/047273 A2, published Apr. 26, 2007) and Andersen (US

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<sup>1</sup> We use the word “Appellant” to refer to the “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant is 3M Innovative Properties Company, which is also identified as a real party in interest (Appeal Br. 2).

2005/0098910 A1, published May 12, 2005).<sup>2</sup> The Examiner also rejected claims 4–6 under 35 USC § 112(a) as lacking written description support. A hearing was held on October 1, 2019. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Claim 15 is illustrative of the subject matter on appeal (emphasis added to highlight key disputed limitation):

15. A method of making mounting mats for use in a pollution control device, said method comprising:
- (i) *heat-treating glass fibers comprising  $Al_2O_3$  in an amount of 10 to 30% by weight and  $SiO_2$  in an amount of 52 to 65% by weight based on the total weight of the glass fibers* with a temperature of between 300°C and about 50°C below the softening point of the glass;
  - (ii) supplying the heat treated glass fibers through an inlet of a forming box having an open bottom positioned over a forming wire to form a mat of fibers on the forming wire, the forming box having a plurality of fiber separating rollers provided in at least one row in the housing between the inlet and housing bottom for breaking apart clumps of fibers and an endless belt screen;
  - (iii) capturing clumps of fibers on a lower run of the endless belt beneath fiber separating rollers and above the forming wire;
  - (iv) conveying captured clumps of fibers on the endless belt above fiber separating rollers to enable captured clumps to release from the belt and to contact and be broken apart by the rollers;
  - (v) transporting the mat of fibers out of the forming box by the forming wire; and

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<sup>2</sup> The Examiner applied an additional reference, Kaneko (WO 2005/021945 A1, published Mar., 10, 2005), to dependent claim 11 as well as all the other claims (Ans. 4). A discussion of this reference is not needed for disposition of this appeal.

(vi) compressing the mat of fibers and restraining the mat of fibers in its compressed state thereby obtaining a mounting mat having a desired thickness suitable for mounting a pollution control element in the housing of a catalytic converter.

### ANALYSIS

Upon consideration of the evidence of record and each of Appellant's contentions as set forth in the Appeal Brief, as well as the Reply Brief, we determine that Appellant has not demonstrated reversible error in the Examiner's rejections (*e.g., generally Ans.*). *In re Jung*, 637 F.3d 1356, 1365–66 (Fed. Cir. 2011) (explaining the Board's long-held practice of requiring Appellant(s) to identify the alleged error in the Examiner's rejection.). We sustain the rejections for the reasons expressed by the Examiner in the Final Office Action and the Answer.

We add the following primarily for emphasis.

#### *Rejection under 35 U.S.C. § 112(a)*

Dependent claims 4–6 each recite the use of “unleached fibers.” The Examiner finds the originally-filed application does not contain written description support for this limitation. Final Act. 2.

The written description “must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (citation and quotations omitted, alteration in the original). The test is whether the disclosure “conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.*

Appellant contends that paragraph 11 of the originally-filed application describes that leached fibers are expensive and therefore one of

ordinary skill in the art would have recognized that the invention uses only unleached fibers to save money. Appeal Br. 10–11; Reply Br. 1, 2.

Contrary to Appellant’s position that one of ordinary skill in the art would understand that the present invention “would not include leached fibers” (Reply Br. 1), the leached glass fibers of WO 2004/031544 (WO ’544), relied upon by Appellant and discussed in paragraph 11 of the Specification, may include any glass fibers that “contain more silica than any other compositional ingredient in the fibers” (*see* WO ’544 at p. 10:6-9). By this definition, the recited glass fibers of claim 15 which include a range of silica from 52 to 65% by weight appear to be leached fibers, as opposed to unleached fibers. *Cf.*, *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1350–51 (Fed. Cir. 2012) (“Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation.” In *Santarus*, the court found that claims reciting the negative limitation “wherein the composition contains no sucralfate” satisfied the written description requirement, because the specification described sucralfate as having adverse effects and described omeprazole as an advantageous alternative.).

We do not find, however, nor does Appellant identify, a disclosure in the Specification that properly describes using unleached fibers.

Appellant’s remarks regarding the obviousness of using leached or unleached fibers is not persuasive (Reply Br. 2). The test is not whether one of ordinary skill in the art would find the invention obvious after reading the disclosure, it is whether the disclosure itself conveys that Appellant had possession of the later-claimed subject matter. A disclosure that merely renders the later-claimed subject matter obvious is not sufficient to meet the

written description requirement; the disclosure must describe the claimed invention with all its limitations. *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). “That a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that the step is part of appellants’ invention.” *In re Barker*, 559 F.2d 588, 593 (CCPA 1977) (quoting *In re Winkhaus*, 527 F.2d 637, 640 (CCPA 1975)).

In sum, Appellant has not persuaded us of reversible error in the Examiner’s determination that the originally-filed application does not provide written description support for the use of “unleached fibers” as recited in claims 4–6, and/or excluding the use of leached fibers as urged by Appellant (Reply Br. 1). Accordingly, we sustain the rejection of claims 4–6 under 35 U.S.C. § 112(a).

*Rejections under 35 U.S.C. § 103*

Appellant’s arguments in support of patentability as to all appealed claims are based on limitations found in claims 15.

It has been established that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *see also In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992) (a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom).

Appellant's arguments all focus on the alleged failure of Hornback to teach or suggest heat treating "glass fibers" as recited in claim 15 (*e.g.*, Appeal Br. 5–7; Reply Br. 3-5). Appellant admits that glass is a ceramic. Appellant's claims recite ranges for the amount of silica and alumina for its glass fibers that overlap the ranges Hornback describes for the disclosed heat treated ceramic fibers (Hornbach pg 27, ll. 1–8). Thus, the broadest reasonable interpretation of "glass fibers" as used in claim 15 encompasses Hornback's refractory ceramic fibers. Appellant has not directed our attention to any persuasive reasoning or credible evidence to establish that the use of Hornback's ceramic fibers is not within the scope of Appellant's "glass fibers." *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (it is well established that "the PTO must give claims their broadest reasonable construction consistent with the specification" and if the specification does not provide a definition for claim terms, the PTO applies a broad interpretation).

In any event, we also agree with the Examiner's position that it would have been obvious to treat glass fibers as recited in claim 15 (*see, e.g.*, ¶¶ 92–95, Fig. 23). One of ordinary skill in the art would have immediately inferred, using no more than ordinary creativity, that the use of Hornback's heat treatment would encompass glass fibers having the compositional make up as recited in claim 15. An attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

In summary, Appellant has not directed our attention to any persuasive reasoning or credible evidence to establish that the Examiner's interpretation that the claim encompasses the method described in the Hornback/Andersen combination is unreasonable. *ICON*, 496 F.3d at 1379.

Appellant has not adequately explained why one skilled in the art would not have combined the teachings of the applied prior art as set forth by the Examiner. Thus, on this record, Appellant has not shown error in the Examiner’s obviousness determination. *See KSR*, 550 U.S. at 417 (the predictable use of known prior art elements or steps performing the same functions they have been known to perform is normally obvious; the combination of familiar elements/steps is likely to be obvious when it does no more than yield predictable results); *Ball Aerosol and Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (under the flexible inquiry set forth by the Supreme Court, the PTO must take account of the “inferences and creative steps,” as well as routine steps, that an ordinary artisan would employ).

Accordingly, we sustain the Examiner’s prior art rejections under 35 U.S.C. § 103 of all the claims on appeal for the reasons given above and presented by the Examiner.

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
4-6	§ 112(a)		4-6	
4-6, 9, 15, 17	§ 103(a)	Hornback, Andersen	4-6, 9, 15, 17	
4-6, 9, 11, 15, 17	§ 103(a)	Hornback, Andersen, Kaneko	4-6, 9, 11, 15, 17	

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<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
<b>Overall Outcome</b>			4-6, 9, 11, 15, 17	

**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**