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11/995,818	01/15/2008	Masaaki Muroi	SHIGA7.124APC	1066
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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* MASA AKI MUROI and HIROKAZU OZAKI

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Appeal 2018-009047  
Application 11/995,818  
Technology Center 1700

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Before KAREN M. HASTINGS, MICHAEL P. COLAIANNI, and  
LILAN REN, *Administrative Patent Judges*.

*PER CURIAM*.

DECISION ON APPEAL<sup>1</sup>

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant,<sup>2</sup> Masaaki Muroi et al.,  
appeal from the Examiner's decision to reject claims 1, 3, and 5. Final Act.  
2, 3. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> The record on appeal includes the Specification of January 15, 2008 as well as the subsequent amendments ("Spec."), the Examiner's Final Office Action of October 16, 2017 ("Final Act."), Appeal Brief of March 16, 2018 ("Appeal Br.") and the Examiner's Answer of July 10, 2018 ("Ans."). No Reply Brief was filed.

<sup>2</sup> We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Tokyo Ohka Kogyo Co., Ltd. Appeal Br. 3.

### CLAIMED SUBJECT MATTER

The claims are directed to a process for producing a resist composition, a filtering apparatus, a resist composition applicator, and a resist composition. Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A process for producing a filtered resist composition, comprising:
  - a step (I) in which a resist composition is passed through a filter (f2) equipped with a nylon membrane; and
  - a step (II) in which the resist composition is passed through a filter (f1) equipped with a plurality of polyethylene hollow fiber membranes consisting of polyethylene, which are bundled together and housed inside a container, said plurality of polyethylene hollow fiber membrane having a pore size of less than or equal to 0.04 $\mu$ m, wherein the resist composition comprises:
    - a resin component (A) that displays changed alkali solubility at a pH of less than 7;
    - an acid generator component (B) that generates acid upon exposure; and
    - an organic solvent (S).

### REFERENCES

The prior art references relied upon by the Examiner are:

Uenishi	US 6,379,796 B1	Apr. 30, 2002
Muroi	JP 2004-212975	July 29, 2004

### REJECTIONS

The Examiner rejects claims 1, 3, and 5 under 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. Final Act. 2.

The Examiner rejects claim 1, 3, and 5 under 35 U.S.C. § 103(a) (pre-AIA) as being unpatentable over Muroi and Uenishi. Final Act. 3.

## OPINION

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Cf. Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”)). After having considered the evidence presented in this Appeal and each of Appellant’s contentions, we are not persuaded that Appellant has identified reversible error, and we affirm the Examiner’s written description and obviousness rejections for the reasons expressed in the Final Office Action and the Answer. We add the following primarily for emphasis.

### *Written Description*

The Examiner rejects claim 1<sup>3</sup> under 35 U.S.C. § 112 (pre-AIA), first paragraph, because the Specification does not describe “a plurality of polyethylene hollow fiber membranes consisting of polyethylene” as recited. Final Act. 3. The Examiner finds that to the extent the Specification describes a filter equipped with “a polyethylene hollow thread membrane”

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<sup>3</sup> Appellant’s arguments for the written description rejection are directed to claims 1, 3, and 5 collectively. *See, e.g.*, Appeal Br. 7–8. Independent claim 3 is similar to claim 1 and claim 5 depends from claim 3. We select claim 1 as representative for the written description rejection. *See id.*; *see also* 37 C.F.R. § 41.37(c)(1)(iv).

and that “the plural hollow thread membranes housed in a container is described as consisting of the material polyethylene,” the Specification describes no more than “a polyethylene hollow thread membrane.” *Id.* (citing various portions of the Specification).

Appellant, on the other hand, argues that a skilled artisan would have understood the Specification to describe “that a plurality of polyethylene hollow fiber membranes are able to be produced only by polyethylene” based on the Specification stating “because the filter is made from polyethylene, the foreign matter removal performance is superior to filters made from other materials (such as polypropylene).” Appeal Br. 7. Appellant also argues that Specification shows a comparison between the results of using the filters made from polyethylene with those made from polypropylene which support the claim limitation at issue. *Id.*

We are, however, not persuaded that reversible error has been identified because Appellant does not respond to the Examiner’s finding that the Specification describes no more than “a polyethylene hollow thread membrane” and not the claim limitation “a plurality of polyethylene hollow fiber membranes . . . , which are bundled together and housed inside a container,” e.g., “two or three or four or plural polyethylene hollow thread membranes bundled together and housed in a container[.]” Ans. 7, 8 (finding that the Specification does not describes that “the hollow thread membrane should be plural hollow thread membranes i.e., more than one hollow thread membrane, but conveys to a skilled artisan a filter made from polyethylene”), 10 (finding that the portions of the Specification cited by Appellant describe only that the filter is equipped with “a polyethylene hollow thread membrane”).

By statute, this board functions as a board of review, not a de novo examination tribunal. 35 U.S.C. § 6(b) (“The [board] shall . . . review adverse decisions of examiners upon applications for patents . . .”). To prevail in an appeal to this Board, Appellant must adequately explain or identify reversible error in the Examiner’s rejection. *See* 37 C.F.R. § 41.37(c)(1) (iv) (2012); *see also In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011). Given that Appellant does not respond to, and therefore does not dispute, at least some of the Examiner’s findings in support of the written description rejection, we discern no reversible error and sustain the rejection as a result.

*Obviousness*

The Examiner rejects claim 1<sup>4</sup> under 35 U.S.C. § 103(a) (pre-AIA) based on Muroi and Uenishi. Final Act. 3. More specifically, the Examiner finds that Muroi teaches all the recited limitations other than “a plurality of hollow fiber membranes bundled together and housed inside a container” for which the Examiner cites Uenishi. *Id.* at 4.

Appellant, on the other hand, argues that “Uenishi neither teach[es] nor suggest[s] that the intermediate layer is composed of polyethylene.” Appeal Br. 10 (emphasis removed). This argument is not persuasive for multiple reasons. First and foremost, claim 1 does not recite an intermediate layer and Appellant’s argument is unpersuasive as it is not based on the claim language. *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998)

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<sup>4</sup> Appellant does not present separate arguments for the obviousness rejection of claims 3 and 5. *See, e.g.*, Appeal Br. 8–13. The obviousness rejection of claims 1, 3, and 5 therefore stands or falls together. *See id.*; *see also* 37 C.F.R. § 41.37(c)(1)(iv).

(holding unclaimed features cannot impart patentability to claims). Second, other than the general statement that “Muroi fails to teach ‘the polyethylene hollow fiber membranes consisting of polyethylene’ recited in presently pending Claim 1 as well” (Appeal Br. 9), Appellant does not address the Examiner’s finding with regard to Muroi. “[M]ere statements of disagreement . . . do not amount to a developed argument.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006). Third, Appellant’s argument attacks Uenishi individually and alone, rather than considering what the combined references would have suggested to the person of ordinary skill in the art. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). Fourth, Appellant’s arguments do not address the Examiner’s findings in support of the rejection. For example, Appellant argues that “Uenishi neither teach[es] nor suggest[s] that the hollow fiber membranes are able to be composed of only polyethylene” (Appeal Br. 11) but does not respond to the Examiner’s finding that “Uenishi is not relied upon to disclose a hollow fiber membrane composed only of polyethylene” (Ans. 16). We are therefore not persuaded that reversible error has been identified in the Examiner’s findings with regard to Muroi and Uenishi.

## CONCLUSION

The Examiner’s rejections are affirmed.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3, and 5	35 U.S.C. § 112 (pre-AIA), first paragraph	1, 3, and 5	
1, 3, and 5	35 U.S.C. § 103(a) (pre-AIA) Muroi and Uenishi	1, 3, and 5	
<b>Overall Outcome</b>		1, 3, and 5	

FINALITY AND 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED