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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL PAUL ROWE

Appeal 2019-000905
Application 13/565,250
Technology Center 1700

Before BEVERLY A. FRANKLIN, JAMES C. HOUSEL, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–6, 10, and 11.³ We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on June 11, 2020.⁴

¹ This Decision refers to the Specification filed Aug. 2, 2012 (“Spec.”); Final Office Action dated Apr. 16, 2018 (“Final Act.”); Appeal Brief filed July 23, 2018, as amended Aug. 14, 2018 (“Appeal Br.”); Examiner’s Answer dated Sept. 14, 2018 (“Ans.”); and Reply Brief filed Nov. 14, 2018 (“Reply Brief”).

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Toyota Motor Engineering & Manufacturing NA, as the real party in interest. Appeal Br. 1.

³ Claims 7 and 9 are cancelled and claim 8 is withdrawn. Appeal Br. 16.

⁴ A written transcript of the oral hearing will be entered into the record when the transcript is made available.

We AFFIRM.

CLAIMED SUBJECT MATTER

The invention relates to a magnetic core of superparamagnetic core shell nanoparticles, wherein the core is an iron cobalt ternary alloy and the shell is a silicon oxide. Abstract; Spec. 1:12–17, 8:6–10. Independent claim 1 illustrates the subject matter on appeal and is reproduced below from the Claims Appendix to the Appeal Brief:

1. A magnetic core, comprising:
core shell nanoparticles;
wherein
the core is an iron cobalt ternary alloy and the shell is a silicon oxide,
the third component of the ternary alloy is a transition metal selected from the group consisting of scandium, titanium, vanadium, chromium, manganese, nickel, copper and zinc,
the magnetic core is a monolithic structure of superparamagnetic core grains of the iron cobalt ternary alloy having a particle size of 5 to 30 nm directly bonded by the silicon oxide shells, which form a silica matrix,
the magnetic core has a length dimension and a thickness dimension greater than 1 mm, and
the magnetic core is superparamagnetic.

Appeal Br. 15 (key disputed claim language italicized and bolded).

REJECTIONS

On appeal, the Examiner maintains (Ans. 3) the following rejections:

1. Claims 1–6, 10, and 11 are rejected under 35 U.S.C. § 112(a) or pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (“Rejection 1”). Ans. 3–4.

2. Claims 1–6, 10, and 11 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 7, 9–12, 15, and 16 of copending Application No. 13/921878 (“Rejection 2”). *Id.* at 5–6.

OPINION

Having considered the respective positions the Examiner and Appellant advance in light of this appeal record, we affirm the Examiner’s rejections based on the fact-finding and reasoning set forth in the Answer and Final Office Action, which we adopt as our own. We add the following primarily for emphasis.

Rejection 1

The Examiner rejects claims 1–6, 10, and 11 under 35 U.S.C. § 112 for lack of written description. Ans. 3–4. In response to the Examiner’s rejection, Appellant presents argument for the patentability of claims 1–6 as a group and claims 10 and 11 as a group. Appeal Br. 4, 12. However, Appellant’s argument for the patentability of claims 10 and 11 is substantially the same as the argument for the patentability of claim 1. We select claim 1 as representative and claims 2–6, 10, and 11 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The test for compliance with the written description requirement is “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

The Examiner determines that adequate written descriptive support is not provided in the originally-filed Specification for “the magnetic core has a length dimension and a thickness dimension greater than 1 mm” recitation of claim 1. Ans. 3–4. The Examiner finds that although the Specification discloses “discs were produced that were 9 mm in diameter and 2.5 mm thick” (Spec. 10:16–18), without more, such disclosure does not reasonably convey to one skilled in the art that the inventor had possession of the claimed subject matter at the time the application was filed. *Id.* at 3–4; *see also id.* at 8 (explaining “with the exception of one example (example 9) that discloses one specific diameter and one specific thickness, it cannot be concluded that appellant is in possession of the claimed monolithic structure having any length and any thickness of greater than 1 mm”).

Appellant argues the Examiner’s rejection of claim 1 should be reversed because the originally-filed Specification provides written description that fully supports the claimed subject matter, including each element recited in the claim. *See* Appeal Br. 4–12; Reply Br. 4 (“[I]t is clear that the specification as originally filed does notify one of ordinary skill in the art of all the elements now claimed and therefore, the requirement under 35 U.S.C. 112, first paragraph is fulfilled.”).

Appellant contends

an artisan of magnetic core technology readily recognizes that the subject matter and elements of Claim 1 as now

recited are fully supported by the description of the specification as originally filed.

Appeal Br. 10–11; *see also* Reply Br. 3 (same).

In particular, based principally on the disclosures at pages 1, 8, and 10 of the Specification (*see* Spec. 1:13–17, 1:25–29, 8:19–30, 10:15–20), Appellant contends one of ordinary skill would have recognized Appellant was in possession of a magnetic core structure, which adequately supports the magnetic core having “a length dimension and a thickness dimension greater than 1 mm” element of the claim. Appeal Br. 7 (arguing “that one of ordinary skill, based on the descriptions provided above recognizes that the toroid obtained in the example was obtained from a monolithic structure disc”). Relying on the Declaration under 37 C.F.R. § 1.132 of Inventor, Dr. Michael Paul Rowe filed Jan. 3, 2018 (“Rowe Decl.”), Appellant further contends

it is entirely obvious and common knowledge to anyone of ordinary skill in the art that these electronic devices are typically a few millimeters to several inches in size, with large examples of the technology measuring several feet in diameter.

Id. at 8 (quoting Rowe Decl. 2); *see also* Reply Br. 3 (same).

We do not find Appellant’s arguments persuasive of reversible error in the Examiner’s rejection based on the fact-finding and for the reasons the Examiner provides at pages 3–4 and 6–10 of the Answer and pages 2–3 and 5–6 of the Final Office Action, which a preponderance of the evidence supports.

Rather, on the record before us, we determine that “the magnetic core has a length dimension and a thickness dimension greater than 1 mm” recitation of claim 1 is not adequately supported by the originally-filed

Specification. We have reviewed the portions of the Specification Appellant relies upon, but find that the written description does not adequately describe and is not commensurate in scope with that element of the claim. In particular, as the Examiner finds and explains (Ans. 8), although page 10 of the Specification describes an example of a structure having a diameter of 9 mm and a thickness of 2.5 mm (Spec. 10:15–20), we do not find that disclosure, without more, sufficient to reasonably convey to one of ordinary skill in the art that the inventor had possession of a magnetic core encompassing a length dimension and a thickness dimension greater than 1 mm, as claimed. Likewise, none of the other portions of the originally-filed Specification Appellant cites and relies upon provide adequate written descriptive support for that element of the claim. *See, e.g.*, Spec. 1:13–17, 1:25–29, 8:19–30.

We do not find the Rowe Declaration and Appellant’s arguments regarding the Rowe Declaration (Appeal Br. 8; Reply Br. 3) persuasive because the fact that it may have been “entirely obvious” and “common knowledge” to one of ordinary skill that devices, such as the device of claim 1, are typically a few millimeters to several inches in size, without more, does not establish reversible error in the Examiner’s rejection. Contrary to what Appellant’s argument seems to suggest, as discussed above, the test for compliance with the written description requirement is not whether the claimed subject matter would have been obvious to one of ordinary skill, but whether the disclosure of the application relied upon reasonably conveys to one of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharm.*, 598 F.3d at 1351. Indeed, it is well-settled

[t]he question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.

Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997) (citations omitted).

Accordingly, we affirm the Examiner's rejection of claims 1–6, 10, and 11 under 35 U.S.C. § 112(a) or pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Rejection 2

Appellant does not present any substantive argument in response to the Examiner's provisional rejection of claims 1–6, 10, and 11 on the ground of nonstatutory double patenting as being unpatentable over claims 7, 9–12, 15, and 16 of copending Application No. 13/921878 (Ans. 5–6). *See* Appeal Br. 13 (noting “that once patentable subject matter is identified, a Terminal Disclaimer, if warranted, may be filed”).

Accordingly, because the Examiner's rejection of claims 1–6, 10, and 11 for nonstatutory double patenting has not been withdrawn (*see* Ans. 3) and is not substantively addressed by Appellant, we summarily affirm this rejection. *Cf. Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008); *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (“If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection”) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011)).

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-6, 10, 11	112	written description	1-6, 10, 11	
1-6, 10, 11		nonstatutory double patenting	1-6, 10, 11	
Overall Outcome			1-6, 10, 11	

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)(iv).

AFFIRMED