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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 14/356,681 and examiner information for BUIE-HATCHER, NICOLE M.

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZAI-MING QIU and MIGUEL A. GUERRA

Appeal 2020–001512
Application 14/356,681
Technology Center 1700

Before CATHERINE Q. TIMM, KAREN M. HASTINGS, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

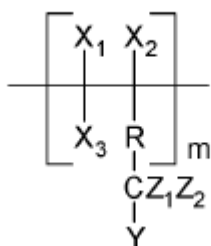
Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s rejections under 35 U.S.C. § 112 of claims 1–4, 6, 7, 11–13, and 19–24 for failing to comply with the written description requirement. Claims 5, 8–10, and 14–18 have been cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ 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 Nestec S.A. (Appeal Br. 2).

Independent claim 1 below is illustrative of the subject matter on appeal (emphasis added to highlight the disputed limitation):

1. A composition comprising a compound, wherein the compound consists of end groups R₁ and R₂ and at least m repeating segments of the following structure:



wherein Y is an anionic group selected from the group consisting of: sulfate, carboxylate, phosphate, phosphonate, and sulfonate, wherein each X₁, X₂, and X₃ are independently selected from F, Cl, H, and CF₃; R is a linking group; each Z₁ and Z₂ is independently selected from F and CF₃; m is at least 2; wherein the compound comprises substantially no other anionic pendant functional groups, except those selected from the group consisting of: sulfate, carboxylate, phosphate, phosphonate, and sulfonate, wherein the compound has a number average molecular weight of no more than 10,000 grams/mole *and an average number of anionic groups of greater than 2.*

ANALYSIS

For an applicant to comply with the 35 U.S.C. § 112, first paragraph, written description requirement, the applicant's specification must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

Claim 1 recites that the compound of claim 1 has “an average number of anionic groups of greater than 2” (Appeal Br. 12, Claims App.). There is no dispute that the Specification discloses examples wherein the average number of anionic groups range from 2.09 to 15 (*e.g.*, Spec. ¶¶ 120, 125; Appeal Br. 10, 11; Final Act. 3). The Examiner’s rejection is based on the lack of an upper limit for the range “greater than 2” recited in claim 1 (Final Act. 3).

Appellant contends that even though the upper end of the claimed range is open-ended, the Federal Circuit has held that this is not inherently improper, and that such a claim limitation may be supported (Appeal Br. 8, 9 (discussing *Anderson Corp. v. Fiber Composites, LLC*, 474 F.3d 1361 (Fed. Cir. 2007))). As stated in *Anderson*,

As we have said, “[o]pen-ended claims are not inherently improper, as for all claims their appropriateness depends on the particular facts of the invention, the disclosure, and the prior art. They may be supported if there is an inherent, albeit not precisely known, upper limit and the specification enables one of skill in the art to approach that limit.”

Id. at 1376–77, quoting *Scripps Clinic & Research Found. v. Genetech, Inc.*, 927 F.2d 1565, 1572 (Fed. Cir. 1991).

Contrary to the Examiner’s apparent belief that this principle only applies to a question of enablement (Ans. 4), *Anderson* was explicitly directed to both the written description and enablement requirements.² Thus, the Examiner has not adequately explained why the case law

² For example, *see Anderson* at 1377 (“The jury was free to credit that testimony in reaching its conclusion that the invention was adequately described and enabled. We therefore uphold the jury’s verdicts on the issues of enablement and written description.”)

discussed by Appellant in the briefs is not applicable to the question of written description presented herein.

Appellant further points out that since the claim requires an upper limit for the molecular weight of the compound, the Specification as a whole enables one of ordinary skill in the art to determine the inherent upper limit on the number of anionic groups for any particular compound circumscribed by the claimed requirements (*e.g.*, Appeal Br. 10, 11; Reply Br. *generally*).

Accordingly, we agree with Appellant that a preponderance of the evidence supports Appellant's position that one of ordinary skill in the art would have understood that Appellant was in possession of the claimed subject matter.

Accordingly, we reverse the Examiner's § 112 rejection for lack of written description.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-3, 5-8, 10-12	112	Written Description		1-3, 5-8, 10-12

REVERSED