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BEFORE THE PATENT TRIAL AND APPEAL BOARD

*Ex parte* ANTHONY MYERS, ALYSON MYERS, HAROLD MEHERG, and PATRICK SOON-SHIONG

> Appeal 2022-000894 Application 16/858,548 Technology Center 1700

Before ADRIENE LEPIANE HANLON, JENNIFER R. GUPTA, and JANE E. INGLESE, *Administrative Patent Judges*.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

## A. STATEMENT OF THE CASE

The Appellant<sup>1</sup> filed an appeal under 35 U.S.C. § 134(a) from an Examiner's decision finally rejecting claims 5–12, 22, and  $23.^2$  We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Independent claim 5 is reproduced below from the Claims Appendix to the Appeal Brief. The limitation at issue is italicized.

5. A composition comprising oolitic aragonite particles, wherein the oolitic aragonite particles have an average particle size of between 100 nm to 1 mm, and a median (D50) particle size distribution (PSD) of between 2.0 to 3.5  $\mu$ m, and *a Hunter brightness level greater than 90*.

Appeal Br. 8.

According to the Appellant, "Hunter brightness is a percentage scale/index that is used to measure the brightness of white materials that tend to color with age and/or degradation." Appeal Br. 5.

The Examiner maintains the following grounds of rejection on appeal:

(1) claims 5–12, 22, and 23 under 35 U.S.C. § 112(a) based on the enablement requirement; and

<sup>&</sup>lt;sup>1</sup> The word "Appellant" refers to "applicant" as defined in 37 C.F.R. § 1.42. The Appellant identifies the real parties in interest as Nant Holdings IP, LLC and Calcean Minerals and Materials, LLC. Appeal Brief dated August 4, 2021 ("Appeal Br."), at 2.

<sup>&</sup>lt;sup>2</sup> Claims 13–21 are also pending. Claims 13–20 have been withdrawn from consideration, and claim 21 is objected to as being dependent upon a rejected base claim. The Examiner indicates that claim 21 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Final Office Action dated April 5, 2021 ("Final Act."), at 2.

(2) claims 5–12, 22, and 23 under 35 U.S.C. § 112(a) based on the written description requirement.

#### B. DISCUSSION

### 1. <u>Rejection (1)</u>

The Examiner concludes that the Appellant's disclosure does not enable a composition comprising oolitic aragonite particles having *a Hunter brightness level greater than 90* as recited in claim 5. Final Act. 3. The Examiner recognizes that the Appellant discloses a single value within that range, i.e., a Hunter brightness level of 94, and enables a composition as claimed having that Hunter brightness value. Final Act. 3. However, the Examiner explains that "a single specification value within a claimed range does not reasonably provide enablement for/across the entire claimed range." Final Act. 3 (citing *In re Lukach*, 442 F.2d 967 (CCPA 1971)).

*Lukach* involves the written description requirement, not the enablement requirement. *Lukach*, 442 F.2d at 968 ("From the board's language it is apparently the description requirement, rather than the enablement provisions or best mode provision, of the first paragraph of § 112, which was considered not to have been met."); *see also* MPEP § 2163(I) (9<sup>th</sup> ed., Rev. 10.2019, June 2020) (citing *Lukach* under "GENERAL PRINCIPLES GOVERNING COMPLIANCE WITH THE 'WRITTEN DESCRIPTION' REQUIREMENT FOR APPLICATIONS").

Enablement requires that a disclosure teach one of ordinary skill in the art how to make and use the claimed invention without *undue experimentation*. *Elan Pharm., Inc. v. Mayo Found.*, 346 F.3d, 1051, 1054 (Fed. Cir. 2003).

[A] determination of whether the requisite amount of experimentation is undue may include consideration of:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id. at 1055 (citing In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988)).

On this record, the Examiner has failed to show that undue experimentation would have been required to make and use the composition recited in claim 5.

The Examiner also relies on *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970), to support the enablement rejection on appeal. Ans. 6.<sup>3</sup> In that case, the court explained that where predictable factors are involved, a *single* embodiment may provide "broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws." *Id.* However, where unpredictable factors are involved, the court explained that the scope of enablement "varies inversely with the degree of unpredictability of the factors involved." *Id.* On appeal, the Examiner has failed to show that the claimed invention involves unpredictable factors, whereby the single disclosed embodiment (i.e., a Hunter brightness level of 94) is not sufficient to enable the range recited in claim 5 (i.e., "a Hunter brightness level greater than 90"). *See* Reply Br. 1 (contending that the grinding of particles is a mechanical process likely to be enabled by the disclosure of a single embodiment).<sup>4</sup>

In sum, the Examiner has failed to show that the composition recited in claims 5–12, 22, and 23 is not enabled by the Appellant's Specification. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (the examiner bears the initial

<sup>&</sup>lt;sup>3</sup> Examiner's Answer dated September 24, 2021.

<sup>&</sup>lt;sup>4</sup> Reply Brief dated November 24, 2021.

burden of presenting a prima facie case of unpatentability). Therefore, the rejection of claims 5–12, 22, and 23 under 35 U.S.C. § 112(a), based on the enablement requirement, is not sustained.

2. <u>Rejection (2)</u>

The Examiner finds the original disclosure does not provide written description support for a composition comprising oolitic aragonite particles having *a Hunter brightness level greater than 90* as recited in claim 5. Final Act. 3–4.

There is no dispute that the original disclosure does not provide *ipsis verbis* support for the claim limitation at issue. *See* Appeal Br. 7 (stating that "the specification does not provide *ipsis verbis* support for the claimed limitation 'greater than 90"). The Appellant, however, argues that the particles described in the Appellant's Specification *inherently* have Hunter brightness values between 90 and 100. Appeal Br. 7. For support, the Appellant argues that "the specification describes the process of making particles with Hunter brightness values between 90 and 100" and teaches that particle size distributions, as well as the addition of "waxes, dyes, etc.," determine brightness. Appeal Br. 6–7.

The Appellant's arguments are not persuasive of reversible error. To satisfy the written description requirement, a patent applicant 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.*" *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). "The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed.*" *Id.* at 1564. Moreover, "[i]n order for a disclosure to be inherent . . . the missing descriptive matter must *necessarily* be present in the . . . application's specification such that one skilled in the art would recognize such a disclosure" (emphasis added). *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998).

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At the outset, we note that any process disclosed in the Appellant's Specification is not described as "making particles with Hunter brightness values *between 90 and 100.*" Appeal Br. 7 (emphasis added). Rather, the Appellant merely discloses:

[T]he size of (milled) aragonite *will also* have a substantial effect on brightness of the material. For example, when milled to a fine particle size of 2 to 8 micron, the Hunter brightness level is approximately 94, which is very bright white. Thus, by selecting a suitable particle size, brightness of the milled aragonite can be adjusted.

Spec. ¶ 81 (emphasis added).

Based on the disclosure in paragraph 81 of the Appellant's Specification, it appears that factors other than the milled particle size affect brightness. The Appellant, however, does not direct us to any portion of the original disclosure identifying other factors that affect brightness.<sup>5</sup>

Moreover, the Examiner finds that the original disclosure does not describe "any specific correlation between the particle size of [milled] aragonite . . . and the brightening degree/amount." Ans. 6–7. Thus, to the extent that the original disclosure describes a range of milled particle sizes, there is no evidence on this record that any disclosed range necessarily results in the claimed brightness range (i.e., a Hunter brightness level greater than 90).

In sum, the original disclosure does not reasonably convey that the Appellant, as of the filing date, was in possession of the composition recited in claim 5, wherein the oolitic aragonite particles have a Hunter brightness level

<sup>&</sup>lt;sup>5</sup> Paragraph 81 of the Appellant's Specification discloses that pigment, for example, brings color, not brightness, to a cosmetic. Similarly, paragraph 81 discloses that "oolitic aragonite coated with titanium or with bismuth oxychloride achieves a white pearlescence." That paragraph, however, does not discuss the effect of titanium or bismuth oxychloride on the brightness of the coating.

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greater than 90. *See Lukach*, 442 F.2d at 970 (a single embodiment might not alone be enough to provide a description of the invention for purposes of adequate disclosure). Therefore, the rejection of claims 5–12, 22, and 23 under 35 U.S.C. § 112(a), based on the written description requirement, is sustained.

C. CONCLUSION

The Examiner's decision is affirmed.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
Rejected				
5-12, 22, 23	112(a)	Enablement		5-12, 22, 23
5-12, 22, 23	112(a)	Written description	5-12, 22, 23	
Overall			5-12, 22, 23	
Outcome				

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