

INSUFFICIENCY: Disclosure to Support claims, Rule 25.

The disclosure of five radicals held sufficient to support unlimited generic terms in the claims provided other parameters are stated as to use, in this case as necessary to produce the electrophoretic pigment specified in claims 3 to 12 under rejection; but not specified in claims 1 and 2 in respect of which the rejection is affirmed.

FINAL ACTION: Overruled in part.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated September 22, 1971 on application 963,998. This application was filed in the name of Lester Weinberger et al and refers to "Electrically Photosensitive Particles Useful In Electrophotographic Imaging Processes". The Patent Appeal Board conducted a hearing on November 2, 1972, Mr. W. Mace represented the applicant.

In the prosecution terminated by the Final Action the examiner refused the claims in that the definition of R as being "selected from the group consisting of aromatic, heterocyclic, substituted aromatic and substituted heterocyclic radicals" lacks support in the disclosure.

The action of the examiner reads in part:

In order to sustain such unlimited generic terms as "aromatic", "heterocyclic" and their substituted counterparts covering such a multitude of varying radicals, the specification must show with reasonable certainty that the many different radicals permit the process to be operative and that the products all have the same desired utility. The applicant has failed to meet this requirement. The disclosure of the five aforementioned radicals is not sufficient to support claims containing these unlimited generic terms. It cannot be ascertained from the limited disclosure whether the process is operative because of the characteristics shared by these disclosed radicals; or whether the process is operative because of the characteristics of the unlimited genera for the definition of R. Similarly, the disclosure fails to show that the resultants of the process wherein R is other than disclosed but falling within the generic definition for R, all have the same utility, that of a pigment having an intense magenta colour.

The response of the applicant dated December 22, 1971 reads in part:

The Examiner in the Official Action has raised the objection that the definition of R as being selected from the group consisting of aromatic, heterocyclic, substituted aromatic and substituted heterocyclic radicals lacks sufficient support in the disclosure. Such allegation is most strenuously traversed

and Applicant respectfully submits that the disclosure and the specific examples provide a proper definition with respect to the substituted aromatic radical in outlining the species 2'-methyl phenyl, 4'-methoxy phenyl, 3'-cyano phenyl and 5'-cyano phenyl and as noted by the Examiner presumably the phenyl radical. Furthermore, Applicant in the disclosure has provided a proper definition with respect to the heterocyclic and substituted heterocyclic radicals in outlining the species the pyridyl radicals and 3-methoxy pyridyl radical. Applicant in providing examples of both the radicals and substituted radicals respectfully submits that in the absence of any prior art to the contrary he should be entitled to claim his invention broadly. This is in concert with Section 36 of the Patent Act in that the disclosure clearly sets forth the process for using the compounds contemplated and claims such process in what Applicant considers in distinct and explicit terms.

As previously drawn to the Examiner's attention, that to provide more examples, (how many more would be required is debatable,) with respect to the various compounds to meet the Examiner's requirement would result in an unwieldy and bulky disclosure. Applicant submits that the disclosure contains sufficient examples as required by Section 36(1) in order to be entitled to include in the Claims the broad definition with respect to R. The Claims in Applicant's opinion comply fully with the provisions of Rule 25, and meet the requirements of Section 36(2).

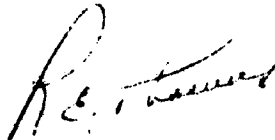
Having studied the application the Board finds that claims 1 and 2 are directed to a chemical process for preparing a pigment without any restrictions or qualifying parameters whatsoever, while claims 3 to 12 inclusive are limited to the use of pigments in the field of electrophoretic imaging. Therefore, considerations concerning the definition of "R" in claims 1 and 2 are different than that of claims 3 to 12. Thus, claims 1 and 2 appear to relate to a different invention than the remainder of the claims.

The disclosure on page 9 states that the reaction produces a composition which is useful as photosensitive pigment particles. However, claims 1 and 2 attempt to extend the monopoly beyond the invention disclosed by failing to define the ingredients employed in the process which are necessary to produce an electrophoretic pigment. Therefore, the Board finds that the pigment of claims 1 and 2 must be restricted to the specific use of electrophoretic imaging processes as in the remainder of the claims, for this is the only purpose of the pigment that the applicant has in mind as no other use is disclosed.

Claims 3 to 12 are limited to pigments in the field of electrophoretic imaging where "R" is not the sole limitation and does not purport to define a compound per se, but is merely a substituent of an extremely large complex nucleus. The composition has common characteristics as noted on page 7 of the disclosure: "The compositions produced by the above reaction have common characteristics of brilliant, intense, magenta colour; of insolubility in water and the common organic solvents, example, benzene ..., and of unusually high photosensitive response." These characteristics limit the compounds to reasonably well defined parameters.

The Board is satisfied that while the field of compounds has been defined generally, it is readily within the scope of one skilled in the art to determine by simple tests, without further invention, what additional species of compounds will produce the required photosensitive response as amply exemplified in the disclosure. The Board is also satisfied that the process and products claimed in claims 3 to 12 satisfy Section 36(2) of the Patent Act and are fairly based on the compounds and the processes using the compounds disclosed.

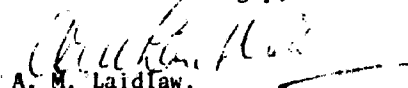
Therefore, the Board recommends that the Final Action be affirmed with respect to claims 1 and 2, and reversed with respect to claims 3 to 12 inclusive.



R. E. Thomas,
Chairman, Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and refuse to grant a patent with respect to claims 1 and 2. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.

Decision accordingly,



A. M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 17th day of November, 1972.

Agent for Applicant
Messrs. Gowling & Henderson