

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. McGEARY
and HERMAN J. BOEGLIN

Appeal No. 94-3976
Application 07/891,484¹

HEARD: April 7, 1997

Before JOHN D. SMITH, GARRIS² and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

We reverse the examiner's rejection of appealed claims 1 through 8 under 35 U.S.C. ' 103 as being unpatentable over Ghandhi or Wolf taken with either Morris or Ellingboe. We agree with appellants that one of ordinary skill would not have been motivated by Morris (oxalyl chloride is selected over HCl as a "chloride-containing substance" used for simultaneous "removal of a majority of the molybdenum and chloriding of the alumina-

¹ Application for patent filed May 29, 1992.

² Judge McFarlane, who participated in the oral hearing, has resigned from the Board. Pursuant to 35 U.S.C. § 7, Judge Garris has been designated as a substitute to decide this appeal. *Cf. In*

molybdenum-oxide mixture" to be used as a catalyst; see Col. 3) or Ellingboe (oxalyl chloride is an organic acid chloride which "approaches in activity as a chlorinating or dehydrating agent, inorganic chlorides as thionyl chloride or phosphorous trichloride;" see col. 1) to substitute oxalyl chloride for Cl₂, HCl (anhydrous) or a trichlorinated C₂ hydrocarbon used as a chlorinating agent in the processes of Gandhi and Wolf. Indeed, the examiner has failed to explain why one of ordinary skill in this art would have combined these references, see, e.g., *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)("[T]he test [for obviousness] is what the combined references would have suggested to those of ordinary skill in the art."), or to provide any scientific reasoning which would explain the motivation of one of ordinary skill in the art to select oxalyl chloride, which is only functionally related to the chlorinating agents taught in Gandhi and Wolf, for use in the particular processes of these references. *In re Dow Chemical*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988).

We also reverse the examiner's rejection of appealed claims 1 through 9 under 35 U.S.C. ' 103 as being unpatentable over Blum taken with Morris. With respect to appealed claims 1 through 8, we point out that one of ordinary skill in this art would not find teachings relevant to processes of forming a chlorine-doped silicon dioxide layer in Blum. Thus, the invention encompassed by these appealed claims would not have been reasonably suggested to one of ordinary skill in this art by this combination of references. See *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)

With respect to appealed claim 9, even though the references may be reasonably pertinent to the problem addressed by

re Bose Corp., 772 F.2d 866, 868-70, 227 USPQ 1, 2-4 (Fed. Cir. 1985); MPEP § 1203.

appellants, *Clay*, supra, the combined teachings thereof must still have suggested the claimed invention to one of ordinary skill in this art. *Keller*, supra. We observe that in Blum, the "halogen containing ambient" is applied in the outer cylinder wall portion of the apparatus in Blum (numeral 4 in fig.) at a temperature of "about 800EC to about 1100EC" to react with contaminate metals to form metal halides (col. 3). There is no teaching in Morris which would have reasonably motivated one of ordinary skill in the art to use oxalyl chloride in place of hydrogen chloride or chlorinated hydrocarbons disclosed in Blum to be useful in the "gas mixture suitable of providing halogen at the required temperature" in the process of that reference. Indeed, Morris does not disclose that oxalyl chloride is useful at temperatures over 550EC (col. 3, lines 68-71), which temperature range is below the temperature range specified by Blum. We find no other evidence or scientific reasoning in the record which supports the examiner's allegation that since Morris discloses that oxalyl chloride forms "volatile metal chlorides at even lower temperatures than those of Blum, ... confidence is high it will be at least as effective a chlorinating agent at the higher temperatures of Blum" (answer, page 5). *Dow Chemical*, supra.

Accordingly, the record before us supports the inference that the examiner relied on information gleaned from appellants' disclosure in formulating the grounds of rejection on appeal. See *Dow Chemical*, 837 F.2d at 473, 5 USPQ2d at 1532.

The examiner's decision is reversed.

Reversed

Appeal No. 94-3976
Application 07/891,484

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHARLES F. WARREN)	
Administrative Patent Judge)	

Wiggin & Dana
One Century Tower
New Haven, CT 06508-1832