

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte VINCENT WILMET, FRANCINE JANSSENS, and
JEAN-PAUL SCHOEBRECHTS

Appeal No. 2002-1618
Application No. 09/051,746

ON BRIEF¹

Before WINTERS, MILLS and GREEN, Administrative Patent Judges,

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 43-64 which are the claims on appeal in this application.

¹ This appeal was originally scheduled for oral hearing on January 9, 2003, but the hearing was vacated by the Board, in their discretion, finding a hearing unnecessary.

Appeal No. 2002-1618
Application No. 09/051,746

Claim 43 is representative of the claims on appeal and reads as follows:

43. In a process for the preparation of 1,1,1,3,3-pentafluoropropane comprising reaction of 1,1,1,3,3- pentachloropropane with hydrogen fluoride in the presence of a hydrofluorination catalyst, the improvement which comprises carrying out the reaction at a temperature and under a pressure at which 1,1,1,3,3-pentafluoropropane is gaseous and isolating and [sic] 1,1,1,3,3-pentafluoropropane from the reaction mixture by drawing off 1,1,1,3,3-pentafluoropropane and hydrogen chloride in a gaseous phase as each of said 1,1,1,3,3-pentafluoropropane and hydrogen chloride is being formed.

The reference relied upon by the examiner is:

Van Der Puy et al. (Van Der Puy) 5,395,997 Mar. 7, 1995

The reference relied upon by the appellants is:

M. Stacey, "The preparation of organic fluorine compounds by halogen exchange," Advances in Fluoride Chemistry, Vol. 3, pp. 180-183, 200-209 (1963)

Grounds of Rejection

Claims 43-64² stand rejected under 35 U.S.C. § 103(a) as obvious over Van Der Puy. We reverse this rejection.

² The Answer, page 3, indicates that claims 20-26, 28-36 and 44 are rejected, however, both appellants' Brief, page 2, and the final rejection (Paper No. 19) page 2, indicate that claims 43-64 are the rejected claims. We treat claims 43-64 as the rejected claims and subject matter of this appeal.

DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Examiner's Answer for the examiner's complete reasoning in support of the rejection, and to the appellants' Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103

I. Claims 43-64 stand rejected under 35 U.S.C. § 103(a) as obvious over Van Der Puy.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). An obviousness analysis requires

Appeal No. 2002-1618
Application No. 09/051,746

that the prior art both suggest the claimed subject matter and reveals a reasonable expectation of success to one reasonably skilled in the art. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

It is the examiner's position that (Answer, page 4):

Van Der Puy et al[.] disclose a process wherein a starting material such as 1,1,1,3,3,3-hexachloropropane is reacted with HF in the presence of a catalyst to produce 1,1,1,3,3,3-hexafluoropropane (Example 3). Van Der Puy et al[.] further disclose that HCl and 1,1,1,3,3,3-hexafluoropropane product are vented, in other words removed as gaseous overhead, to control the pressure (col. 3, lines 15+).

It would have been obvious to one of ordinary skill in the art to utilize 1,1,1,3,3-pentafluoropropane as starting material in the process of Van Der Puy to obtain the instant results of appellants. It is again noted that the use of 1,1,1,3,3,-pentochloropropane to produce 1,1,1,3,3-pentafluoropropane using the basic process of Van Der Puy is admitted to be well known in the art by the use of a jepson type claim by appellants. The only issue is the obviousness of using the method of gas phase recovery disclosed by Van Der Puy when substituting 1,1,1,3,3-pentachloropropane as starting material. Clearly, the same benefit of controlling the pressure would result regardless of the particular starting material used in the Van Der Puy process by recovering HCl by-product and the corresponding product by venting. Therefore, one of ordinary skill in the art would have been motivated to use 1,1,1,3,3-pentachloropropane starting material in the Van Der Puy process because it is known in the art to do so to produce the corresponding product utilizing the same chemistry, namely reaction with HF, and there would have been a reasonable expectation that the same result would be obtained by venting, namely the control of pressure.

To begin, we note that the statement of rejection indicates that the pending claims are rejected in view of a single reference, Van Der Puy. Upon review of the record, we do not find that the examiner has presented sufficient evidence to support a prima facie case of obviousness. We find Van Der Puy alone to be insufficient evidence

Appeal No. 2002-1618
Application No. 09/051,746

of obviousness of the claimed process. Van Der Puy describes a process of preparing hexafluoropropane, which is a different product from the product prepared by the claimed process and employs different starting materials. Van Der Puy alone does not enable a process for the production of 1,1,1,3,3-pentafluoropropane. In re Hoeksema, 399 F.2d 269, 274, 158 USPQ 596, 601 (CCPA 1968) [References relied upon to support a rejection under 35 U.S.C. § 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public.] See also In re Payne, 606 F.2d 303, 314, 203 USPQ 245, 255 (CCPA 1979); In re Brown, 51 CCPA 1254, 1259, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (1964). An invention is not “possessed” absent some known or obvious way to make it. Without more, in our view, Van Der Puy alone does not support a prima facie case of obviousness.

II. Although not set forth in the statement of rejection, from the analysis presented in the Examiner's Answer, the examiner appears to rely on the acknowledged state of the prior art referred to in the preamble of the Jepson-type claims as well as Van Der Puy as a basis for the rejection of the claims. A preamble is impliedly admitted to be prior art when a Jepson claim is used, unless the preamble is the inventor's own work. Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 649, 228 USPQ 1168, 1172 (Fed. Cir. 1984). Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766, 770 (CA FC 1985). Appellants' submission of the claims in Jepson format is accepted as an admission that a process for the

Appeal No. 2002-1618
Application No. 09/051,746

preparation of 1,1,1, 3,3-pentafluoropropane comprising reaction of 1,1,1,3,3-pentachloropropane with hydrogen fluoride in the presence of a hydrofluorination catalyst, can be considered "prior art" for any purpose, including use as evidence of obviousness under § 103. In re Nomiya, 509 F.2d 566, 570-571, 184 USPQ 607, 611 (CCPA 1975); In re Garfinkel, 437 F.2d 1000, 1004, 168 USPQ 659, 662 (1971); In re Hellsund, 474 F.2d 1307, 1311, 177 USPQ 170, 173 (1973).

Therefore, for a thorough and complete review of the issues before us, we also address the combination of admitted prior art in the preamble of the Jepson claim before us with Van Der Puy. Here too, however, we find the examiner's case fall short.

The crux of the examiner's position is that an "analogy" exists between (1) the process of preparing 1,1,1,3,3,3-hexafluoropropane by reacting 1,1,1,3,3,3-hexachloropropane with hydrogen fluoride in the presence of a hydrofluorination catalyst, and (2) the known process of preparing 1,1,1,3,3-pentafluoropropane by reacting 1,1,1,3,3-pentachloropropane with hydrogen fluoride in the presence of a hydrofluorination catalyst. The appellants argue that persons of ordinary skill in the art would not have employed the reaction conditions of Van Der Puy in the prior art process of preparing 1,1,1,3,3- pentafluoropropane set forth in the preamble of the claim with a reasonable expectation of success.

Appellants strenuously argue that, on the record before us, any such analogy is inexact, or, in appellants' words, "[t]he record is devoid of evidence to support the conclusion of such an analog[y]." Brief, page 9.

Appeal No. 2002-1618
Application No. 09/051,746

In our view, appellants have placed evidence of record which controverts any such "analogy" which may have been put forth by the examiner. Note, Paper No. 12, pages 4-5, where appellants provide a detailed explanation of Advances in Fluoride Chemistry, Vol. 3, p. 180-183, 200-209, previously made of record. See also, Brief, page 9. We also agree with appellants that the examiner has not come to grips with or rebutted this argument. See, Answer, page 5.

In view of the above, we find the examiner has failed to present sufficient evidence to support a prima facie case of obviousness.

After evidence or argument is submitted by the applicants in response to an obviousness rejection, "patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of the argument." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); see In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All evidence on the question of obviousness must be considered, both that supporting and that rebutting the prima facie case."). On balance, we believe that the totality of the evidence presented by the examiner and appellants weighs in favor of finding the claimed invention non-obvious. The rejection is reversed.

Appeal No. 2002-1618
Application No. 09/051,746

CONCLUSION

The rejection of Claims 43-64 under 35 U.S.C. § 103(a) as obvious over Van Der Puy alone, or Van Der Puy and the admitted prior art in the preamble of the Jepson claim are reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
DEMETRA J. MILLS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
LORA A. GREEN)	
Administrative Patent Judge)	

Appeal No. 2002-1618
Application No. 09/051,746

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