

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

MAILED

*dm*  
OCT 15 1996

*Ex parte* DAVID E. ALBRIGHT JR.

PATENT OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 94-2569  
Application 07/930,942<sup>1</sup>

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and THIERSTEIN, *Administrative Patent Judges*.

THIERSTEIN, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 1 and 3 through 18, all the claims remaining in the application.

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<sup>1</sup> Application for patent filed August 17, 1992. According to appellant, this application is a continuation-in-part of Application 07/685,106, filed April 15, 1991.

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Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A method of making 3,5-diaminobenzotrifluoride comprising:

- (1) preparing a solution of 4-chloro-3,5-dinitrobenzotrifluoride in a 1-alkanol
- (2) preparing a slurry which comprises
  - (a) a palladium catalyst on a suitable substrate;
  - (b) at least one equivalent of magnesium oxide per equivalent of said 4-chloro-3,5-dinitrobenzotrifluoride;
  - (c) sufficient hydrogen-donating reducing agent to reduce said 4-chloro-3,5-dinitrobenzotrifluoride to said 3,5-diaminobenzotrifluoride; and
  - (d) an amount of said alcohol sufficient to make said slurry stirrable;
- (3) adding said solution to said slurry with stirring at a rate that does not exceed the reaction rate of said 4-chloro-3,5-dinitrobenzotrifluoride.

The references relied on by the examiner are:

Spiegler	3,073,865	Jan. 15, 1963
Franz (European patent application)	0,038,465	Oct. 28, 1981

The claims stand rejected as follows:

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I. Claims 1 and 3 through 18 are rejected under 35 U.S.C. § 103 as unpatentable over Franz in view of Spiegler.

II. Claims 1 and 3 through 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Serial No. 07/685,106 now U.S. Patent 5,347,052 in view of Franz.<sup>2</sup>

We reverse the rejection under 35 U.S.C. § 103.

We affirm the rejection under the judicially created doctrine of obviousness-type double patenting noting appellant's offer to file a terminal disclaimer.

All claims stand or fall together.

First, we consider the rejection of the present claims over Franz in view of Spiegler.

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<sup>2</sup> Although the rejection of record is a provisional rejection, application Serial No. 07/685,106 issued on September 13, 1994 as U.S. Patent 5,347,052 thereby converting the examiner's "provisional" obviousness-type double patenting rejection into an obviousness-type double patenting rejection. See Manual of Patent Examining Procedure § 804(I)(B) (6th ed., rev. 1, September, 1995).

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Parent application Serial No. 07/685,106 issued as U.S. Patent 5,347,052 after a merits panel at the Board of Patent Appeals & Interferences reversed a rejection of all the claims under 35 U.S.C. § 103 as unpatentable over Franz in view of Spiegler. See Paper No. 15 of the file for U.S. Patent No. 5,347,052 (hereinafter Decision).

Claim 1 of the parent is illustrative of the invention in the issued U.S. Patent 5,347,052 and reads as follows:

1. A process for the preparation of 3,5-diaminobenzotrifluoride which comprises treating 4-chloro-3,5-dinitrobenzotrifluoride, in a methanol solvent, with hydrogen gas in the presence of magnesium oxide and in the presence of a catalyst which comprises palladium on a carbon support.

It is readily apparent that both the claims of the parent and the claims of the present application encompass the preparation of 3,5-diaminobenzo-trifluoride from 4-chloro-3,5-dinitrobenzotrifluoride in methanol using hydrogen with a palladium catalyst on carbon in the presence of magnesium oxide.

The substitution in the present claims of the terms "1-alkanol," "hydrogen-donating reducing agent" and "a palladium catalyst on a suitable substrate" for the corresponding patent terms "methanol," "hydrogen" and "palladium on a carbon support"

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respectively in the parent is noted. However, this substitution does not affect our finding here.

It is our opinion that (1) the claims here bear a close relationship to the claims of the parent and (2) the rejection is essentially the same as in the parent. Accordingly, we hold the present claims are patentable over Franz in view of Spiegler under the same rationale as set forth in the Decision.

The merits panel in that decision found the procedure described by Franz differs from the claimed method in the parent in two significant aspects. First, Franz did not involve the preparation of 3,5-diaminobenzotrifluoride, and second, Franz did not specifically disclose the use of magnesium oxide as a base in that reaction. We agree with these differences and find that each also applies to the current application's claims when compared to Franz.

There, as here, the examiner relied upon Spiegler to make up for these differences. The examiner states on page 6 of examiner's answer in the present application, that Spiegler and the present process describe dehalogenation with catalytic dehydrogenation using alkanol as a solvent and a base as acid

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binding agent. This argument is no different from that set forth by the examiner on page 5 in his answer in the parent where he states "Spiegler spells out the function of magnesium oxide as a binder of liberated hydrochloric acid. . . ." The merits panel in the Decision on page 3 found reliance by the examiner on this stated role for magnesium oxide in the Spiegler reaction contrary to the teachings of Spiegler. The panel specifically noted column 2, lines 33-37 of Spiegler "where it is made clear that Spiegler's catalyst must consist only of platinum since the presence of other catalytic metals such as palladium as used in the present invention is detrimental." The panel also found column 3, lines 31-40 of Spiegler described Spiegler's belief "that magnesium oxide functions in that invention due to its ability to interact with the platinum catalyst and modify the catalyst activity."

In the same manner, we also find examiner's reliance on Spiegler to be misplaced here. The examiner has added nothing to his rejection as to why it would have been obvious to extend the relied upon teachings of these references to encompass the procedure of the claims now on appeal. Therefore, the examiner's

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conclusion that one of ordinary skill in the art would have found it *prima facie* obvious to use magnesium oxide as the base in the reaction of Franz is not supported by reasons of record.

Consistent with the merits panel in the parent, we recognize appellant's argument here on page 5 of his brief, that the present invention reduces two nitro groups to amine groups while Franz reduces only one, and the positions of the groups in the benzene ring are completely different. Similarly, appellant argues again in his brief and reply brief in the present application that these differences are significant when two nitro groups are next a chlorine, as in appellant's starting compound.

Appellant relies in this application upon the same declaration filed under 37 CFR § 1.132 as referred to by the merit panel as "appellant's declaration" on page 4 of their Decision in the parent by entering the declaration into the present record as an attachment to Paper No. 4. The panel stated the declaration "establishes that the bases preferred by Franz, sodium hydroxide and amines, as well as calcium oxide degrade 4-chloro-3,5-dinitrobenzotrifluoride, whereas magnesium oxide does not."

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Furthermore, the panel on page 5 of their Decision found that the use of methanol and magnesium oxide in the working examples, which are also the same in the parent as in the present application "establish that the conjoint use of these two agents provides a consistently higher yield of the present compound than the use of similar components."

Thus, the merits panel's conclusion at the bottom of page 4 in their Decision is equally applicable here as follows:

After considering the record of this appeal, we conclude that to the extent the two references relied upon by the examiner would form some basis for a conclusion that the subject [matter] on appeal would have been *prima facie* obvious, the working examples and declaration provide sufficient evidence of nonobviousness to outweigh the evidence of obviousness.

The examiner's criticism of the declaration again fails to explain why appellant's position is in error.

The examiner has not provided reasons why the references disclosing the preparation of compounds different from the compound prepared here should be applied to the present claims, and finally, the examiner has not provided an explanation why

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appellant's reliance on the declaration and working examples is misplaced.

We find that the present process for the preparation of a single compound in 1-alkanol with a hydrogen donating reducing agent in the presence of magnesium oxide using a catalyst which comprises palladium on a suitable substrate is patentable over Franz in view of Spiegler for the same reasons as set out in the Decision.

In addition to the same declaration and working examples as are present in the parent application, appellant in this application relies upon three references to demonstrate that "Franz's teachings to use methanol and NaOH do not work." The three references are U.S. Patent No. 5,144,076, EP Application 0490115A1 and Crampton, J. Chem. Soc. Perkin Trans. II, 1986, pages 187-192, 1986. However, we find it unnecessary to reach this cumulative evidence.

In view of the above findings, we also need not address appellant's further arguments presented in regard to the new matter that was added to this application compared to the parent application.

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We reverse the rejection of claims 1 and 3 through 18 under 35 U.S.C. § 103 over Franz in view of Spiegler.

We now turn to the judicially created obviousness-type double patenting rejection of claims 1 and 3 through 18 as being unpatentable over the claims 1 through 10 in U.S. Patent 5,347,052 in view of Franz.

It is clear that appellant does not traverse the obviousness-type double patenting rejection.<sup>3</sup> In lines 4 and 5 of the first paragraph under the heading "Issues" in appellant's brief, appellant offers to file a terminal disclaimer to obviate this rejection "in whichever application issues last." The present application is the last to issue as compared to the parent application, now U.S. Patent 5,347,052. Appellant has thus acquiesced in the rejection in this application.

We summarily affirm the rejection of claims 1 and 3 through 18 as unpatentable under the judicially created doctrine of obviousness-type double patenting.

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<sup>3</sup> The new matter added to the parent application, now U.S. Patent 5,347,052, was argued by appellant against the rejection under 35 U.S.C. § 103 over Franz in view of Spiegler.



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