

*Ex parte Nielsen*

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* ARNOLD T. NIELSEN

Appeal No. 95-4690  
Application 07/253,106<sup>1</sup>

HEARD: February 8, 1996

Before JOHN D. SMITH, TURNER and OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from the primary examiner's rejection of claims 1-28, which are all of the claims pending in the application. Appellant's invention is 2,4,6,8,10,12-hexanitro-2,4,6,8,10,12-hexaazaisowurtzitane and a method of making it.

<sup>1</sup> Application for patent filed September 30, 1988.

95-4690

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PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*THE REFERENCE*

Nielsen, A. T. and Nissan, R. A. (Nielsen), "Polynitropolyaza Caged Explosives", Part 6, NWC Technical Publication 6788, Naval Weapons Center, China Lake, CA (August 1987).

*THE REJECTION*

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nielsen. Claims 2, 3, 5-12 and 14-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over Nielsen. Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nielsen.

*OPINION*

We have carefully considered all of the arguments advanced by appellant and the examiner and find that the examiner has not carried his burden of establishing that Nielsen was a printed publication within the meaning of 35 U.S.C. §§ 102(b) and 103 at the time appellant's application was filed. Accordingly, the aforementioned rejections will be reversed.

The Nielsen report over which appellant's claims stand rejected under 35 U.S.C. §§ 102(b) and 103 bears a United States Government "CONFIDENTIAL" stamp, over which is stamped "DECLASSIFIED BY ORIGINATING AGENCY". The date of declassification is not of record. The record indicates, however, that appellant and the examiner agree that the Nielsen

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report was classified "confidential" as of appellant's September 30, 1988 filing date.<sup>2</sup> For example, appellant states at page 5 of Paper No. 4, filed December 4, 1989, that the document is classified "confidential", and the examiner refers to the document as being classified "confidential" in his November 16, 1990 answer (page 3).

To establish a *prima facie* case of anticipation or obviousness of appellant's claimed invention on the ground that the Nielsen report is a bar to patentability under 35 U.S.C. § 102(b) or § 103, the examiner must provide evidence that the report had at least a sufficient level of public accessibility as of appellant's filing date to raise a presumption that the public concerned with the art would know of the invention. *In re Bayer*, 568 F.2d 1357, 1361, 196 USPQ 670, 674 (CCPA 1978). The mere fact that the report might have been accessible is not enough to establish that it was a publication within the meaning of the patent statute. *Aluminum Co. of America v. Reynolds Metals Co.*, 14 USPQ2d 1170, 1173 (N.D. Ill. 1989). A document can be considered to be publicly accessible if 1) it has been

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<sup>2</sup>The examiner stated in the June 14, 1989 Office action (paper no. 3) that the Nielsen document has an unclassified cover sheet attached. As correctly pointed out by appellant (December 4, 1989 amendment, paper no. 4, page 4) this cover sheet is an abstract sheet which pertains to the synthesis of the precursor to the compound claimed by appellants. The cover sheet does not disclose appellant's claimed compound or how to make it.

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distributed to that segment of the public concerned with the technology to which the document relates, *Id.*, even if it has been marked "confidential", *Crane Co. v. Goodyear Tire & Rubber Co.*, 577 F.Supp. 186, 197, 219 USPQ 1100, 1108 (N.D. Ohio 1983), — or 2) it is available to such persons merely for the asking. *Ex parte Kroenert*, 144 USPQ 133, 135 (Bd. App. 1960). The determination of whether a bar to patentability exists is a legal determination based on underlying fact issues, and therefore must be made on a case-by-case basis. *In re Hall*, 781 F.2d 897, 899, 228 USPQ 453, 455 (Fed. Cir. 1986); *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981).

The examiner's position (answer, page 5) is that the statement on the cover sheet of the Nielsen report, "Other requests for this document must be referred to the Naval Weapons Center", indicates that the report was available as of appellant's filing date to that class of persons concerned with the art to which the document relates and therefore was publicly accessible. The examiner relies upon *Boileau v. Diamond*, 659 F.2d 247, 248-49, 211 USPQ 489 (D.C. Cir. 1981), wherein the court said:

Although a publication must be available to the public to bar patentability, it is sufficient if the document is available to "that class of persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." *Garrett Corp v. United States*, 422 F.2d 874,

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878, 164 USPQ 521, 524-525 (Ct. Cl.), cert  
denied, 400 U.S. 951, 167 USPQ 705 (1970).

Appellant's position is that the classification of the Nielsen report as "confidential" by the United States Government precludes it from being a publicly accessible document (brief, page 2). Therefore, appellant argues, Nielsen cannot be cited as prior art (brief, page 4).<sup>3</sup>

Appellant, in his brief (page 9), quoted portions of Department of Defense Directive 5200.1-R which, according to appellant, the Naval Weapons Center is mandated to follow. This directive as quoted by appellant states that to obtain classified information, a person must have both a security clearance and a "need to know", and that bidders, contractors, grantees, and educational, scientific or industrial organizations have access to classified information only when the recipients have the required clearance and such access is essential to a function that is necessary in the interest of the national security (brief, pages 8-9).

Appellant did not provide a copy of the relevant portions of the Department of Defense directive. The information

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<sup>3</sup>Appellants also argues that the Nielsen reference would not have enabled one of ordinary skill in the art to make and use the claimed compound (brief, pages 12-16). Because our decision regarding whether Nielsen was a printed publication within the meaning of 35 U.S.C. §§ 102(b) and 103 as of appellant's filing date is dispositive as to this appeal, we do not reach the enablement issue.

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has been presented in the form of argument without supporting evidence, and such argument is entitled to little weight in reaching our decision. *In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979) ("Arguments of counsel unsupported by competent factual evidence of record are entitled to little weight."); *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978) ("And arguments of counsel cannot take the place of evidence.").

Under the facts of the present case, however, we find that evidence provided by appellant is not needed. The reason is that the examiner has not met his burden, as part of setting forth a *prima facie* case for denying patentability, of establishing that the Nielsen document was publicly accessible. *Ex parte Natale*, 11 USPQ2d 1222, 1226 (Bd. Pat. App. & Int. 1989); *Wyer*, 655 F.2d at 227, 210 USPQ at 795.

The notice on the front of the Nielsen report says:

Distribution limited to U.S. Government agencies and their contractors: critical technology; 21 January 1987. Other requests for this document must be referred to the Naval Weapons Center.

This wording provides no reason to believe that the notice inherently rendered the report available merely for the asking to the portion of the public concerned with the technology to which the report pertains. *Kroenert*, 144 USPQ at 135; *Ex parte Suozzi*, 125 USPQ 445, 447 (Bd. App. 1959). The examiner has provided no

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reason to believe that the initial recipients of the report comprised the portion of the public concerned with the technology to which the report is directed, that the report was available to such persons merely for the asking, *Aluminum Co. of America v. Reynolds Metals Co.*, 14 USPQ2d at 1173; *Kroenert*, 144 USPQ at 135, or that there was anyone not on the initial distribution list who requested a copy of the report and whose request was granted. *Suozzi*, 125 USPQ at 447. The examiner has provided no more than mere speculation that the statement on the front of the Nielsen report rendered the report publicly accessible, and this speculation is not sufficient for establishing a *prima facie* case of unpatentability. *Natale*, 11 USPQ2d at 1226.

The examiner argues that *Natale, supra*, is distinguishable because only 5 or 6 copies of the document were made, whereas the initial distribution of the Nielsen report was 96, and because there were no security markings on the document in *Natale* (answer, page 5). We are not persuaded by this argument because the examiner has not explained why these factual differences would have caused a difference in the reasoning or decision in *Natale*.

For the above reasons, we find that the examiner has not carried his burden of establishing a *prima facie* case that the Nielsen report was publicly available within the meaning of

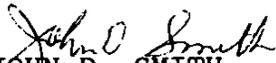
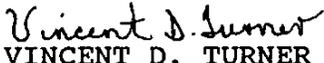
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35 U.S.C. §§ 102(b) and 103 as of appellant's filing date.  
Accordingly, the rejections over Nielsen are reversed.

*DECISION*

The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Nielsen, the rejection of claims 2, 3, 5-12 and 14-28 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over Nielsen, and the rejection of claims 4 and 13 under 35 U.S.C. § 103 as being unpatentable over Nielsen are reversed.

*REVERSED*

  
JOHN D. SMITH )  
Administrative Patent Judge )  
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VINCENT D. TURNER )  
Administrative Patent Judge )  
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TERRY J. OWENS )  
Administrative Patent Judge )

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Office of Counsel (Code 006)  
Naval Weapons Center  
China Lake, CA 93555-6001

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