

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MING-HONG HUNG and SHLOMO ROZEN

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Appeal No. 96-0008  
Application 08/243,428<sup>1</sup>

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ON BRIEF

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Before KIMLIN, JOHN D. SMITH and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-5, all the claims remaining in the present application. A copy of illustrative claim 1 is appended to this decision.

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<sup>1</sup>Application for patent filed May 16, 1994. According to appellants this application is a continuation of application 07/991,401, filed December 15, 1992, which is a continuation of application 07/530,376, filed May 30, 1990, now abandoned.

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In the rejection of the appealed claims, the examiner relies upon the following references:

Ohmori et al. (Ohmori II)	4,544,720	Oct. 01,
1985		
Ohmori et al. (Ohmori I)	4,581,412	Apr.
08, 1986		

Appellants' claimed invention is directed to epoxides containing a perfluorovinyl group of the recited formula. According to appellants, the claimed compounds may be polymerized through either the epoxy or vinyl functionality to form polymers that find utility as coatings, adhesion control agents, etc.

The present application is a continuation of U.S. Serial No. 07/991,401 filed Dec 15, 1992, which, in turn, is a continuation of U.S. Serial No. 07/530,376, filed May 30, 1990. Appellants took an appeal in the grandparent application, U.S. Serial No. 07/530,376, on the same claims now before us. In a decision dated Nov. 25, 1992, this Board affirmed the examiner's rejection of claims 1-5 under 35 U.S.C. § 103 over Ohmori I and Ohmori II. Although it was appellants' contention in the prior appeal that the Ohmori

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patents did not enable the synthesis of appellants' claimed compounds, the Board sustained the examiner's rejection because "appellants have not proffered any objective evidence in the form of a declaration or an affidavit which establishes that the reactions disclosed by Ohmori do not, in fact, result in the disclosed compounds." (page 4 of the decision).<sup>2</sup> In addition, the Board found that the claimed compound would have been obvious to one of ordinary skill in the art in view of the known selective epoxidation taught by S. Rozen et al., cited by appellants at page 2 of the present specification.

Appellants now come before us with declaration evidence and objective evidence from scientific literature to support their contention that the Ohmori patents do not provide an enabling disclosure for compounds within the scope of the appealed claims, i.e., where n is 2 thru 10.

Appealed claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by either Ohmori I or Ohmori II. In

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<sup>2</sup>The declaration attached to the reply brief in the grandparent application was not entered by the examiner, and therefore, not before the Board.

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addition, claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpat-entable over the combined teachings of Ohmori I and Ohmori II .

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

There is agreement between appellants and the examiner that both Ohmori I and Ohmori II generically disclose epoxide com-

pounds that embrace those presently claimed. Both references disclose a formula that encompass the claimed epoxides (see Ohmori I at col. 3, line 40 and Ohmori II at col. 3, lines 30-35). It can be seen from the formula disclosed in the references that, when m is 0 and n is the number 2 to 4, appel-lants' compounds result. However, appellants maintain that the references are enabling only for compounds wherein n is 1, i.e., the references do not describe a process for making such compounds wherein n is 2 or greater, nor has the examiner established that one of ordinary skill in the art would have known how to make compounds conforming to the

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reference formula when n is 2 or greater. For legal support of their position, appellants cite In re Hoeksema 399 F.2d, 269, 158 USPQ 596, 600 (CCPA 1968) and In re Legrice 301 F.2d 929, 133 USPQ 365 (CCPA 1962). For scientific evidence in support of their position, appellants rely upon declarations of Carl George Krespan, Ming-Hong Hung, and Alicia P. King as well as an article by L.D. Moore, the abstract of European Patent Application 438,166 to Q.Y. Chen et al., and a translation of an article by T.I. Gorbunova et al.

On the other hand, the examiner essentially relies upon the presumption of validity accorded to the Ohmori patents. The examiner's position is stated at page 7 of the answer as follows:

While the data presented allegedly may provide evidence to the inoperability of the patent, it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. It is to be presumed also that the skilled worker would as a matter of course, if they do not

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immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight.

Upon reviewing appellants' evidence of non-enablement, and the examiner's analysis thereof, we find that appellants' evidence is of sufficient weight to effectively shift to the examiner the burden of demonstrating that one of ordinary skill in the art would have been able to make the presently claimed compounds at the time of filing the grandparent application. Since the examiner has not come forth with a convincing line of reasoning based on scientific evidence that refutes appellants' evidence, we find that appellants have rebutted the presumption of validity attached to the Ohmori patents. See Hoeksema at 158 USPQ 601.

Appellants rely upon the Moore article and the publication of Chen et al. and Gorbunova, as well as the Hung declaration, as evidence that the reaction between the perhalogenated alkyl iodide and the allyl alcohol disclosed by the Ohmori patent (see Ohmori I at col. 3, lines 60-65) does

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not yield the halohydrin taught by Ohmori but, rather, a primary alcohol with the iodine substituent on the carbon adjacent the terminal carbon. In our view, appellants' have produced convincing evidence that the reaction scheme of Ohmori does not produce the depicted inter-mediate prior to forming the epoxide. However, the question remains, unasked by the examiner, whether the error attributed to Ohmori's reaction scheme is relevant to the ultimate epoxide produced. Appellants have produced no evidence that even if the intermediate of Ohmori's reaction scheme is a primary alcohol, the epoxidizing and dehalogenation steps disclosed by Ohmori would not produce the described epoxide compound that is homologous to the claimed compounds .

In our view, the compelling evidence for non-enablement is found in the declarations of Krespan and King. Appellants present Dr. Krespan as "a nationally and internationally renowned

scientist in the field of organofluorine chemistry," (page 6 of brief) and his credentials as an expert in the relevant art

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are self-evident. At page 2 in his declaration, Dr. Krespan states that the Ohmori patents "provide enablement only for the case in which  $n$  is 1." Dr. Krespan goes on to explain that the reaction scheme disclosed by Ohmori to obtain the epoxides is inherently limited to the production of the intermediate where  $n=1$ , "since only in the case of an allyl reactant can the I atom appear on the carbon adjacent to that bearing the OH group, a prerequisite for ring-closure to the three-membered epoxide ring (col., 3, line 60). Further distancing the double bond from the OH moiety will necessarily result in a larger ring, not the epoxide structure, where  $n > 1$ ." In addition, declarant King, who holds a MS degree in Chemistry, states that a search of Chemical Abstracts Services and Beilstein's, On-line found the existence of no compounds corresponding to the epoxide intermediate before the dehalogenation step wherein  $n$  is 2 to 10.

We also cannot sustain the examiner's § 103 rejection to the extent it is based upon the reasoning in the prior Board decision regarding the admission found at page 2 of the present specification regarding the article to Rozen et al. According to

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appellants, Rozen et al. did not disclose the making of 1,1,2-trifluoro-1,5-hexadiene, which compound is used as the starting material for one of the presently claimed compounds. It is our understanding that the claimed epoxides are made by procedures found in Rozen et al. performed on starting materials disclosed in U.S. 5,015,790 and U.S. 5,043,490, which commonly-assigned patents are not available as prior art to the present application (see page 9 of appellants' brief, second paragraph, as well as the paragraph bridging pages 9 and 10).

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN D. SMITH	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
CHUNG K. PAK	)	

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