

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RADHAKPISHNA B. KASAT and BHALCHANDRA D. MOGHE

Appeal No. 1996-4133
Application No. 08/264,073

HEARD: February 23, 2000

Before WILLIAM F. SMITH, ROBINSON, and SPIEGEL, Administrative Patent Judges.
ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 - 15 and 17 - 27, which are all of the claims pending in this case. Independent claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A gel stick composition comprising at least one alcohol selected from the group consisting of monohydric alcohols and polyhydric alcohols; water; and a soap gelling agent, the at least one alcohol being a solvent for the soap gelling agent, the composition including a sufficient amount of the soap gelling agent to form a solid stick composition, the soap gelling agent including alkali metal salts of fatty acids having carbon chain length within the range of C₁₂-C₂₂, wherein at least 65% by weight, of the total weight of the soap

Appeal No. 1996-4133
Application 08/264,073

alcohol; about 6-10% by weight of an alkali metal salt of a saturated fatty acid gelling agent having from about 8 to 22 carbon atoms; about 10-30% water and as the active ingredient, an analgesic compound. The examiner refers to Column 3, lines 26-36 of Geria as teaching that sodium stearate is the most preferred gelling agent and the "sodium stearate" connotes the sodium salt of a mixture of fatty acids, of which stearic acid and palmitic acid predominate and including small proportions of closely related fatty acids. (Office Action mailed 12/13/94, Paper No. 3, pages 2-3). In addition, the examiner relies on applicants disclosure that (id):

an illustrative soap gel-forming agent which can be used in the instant invention is sold under the name RTD Sodium Stearate OP-65.

The examiner then concludes that (id):

[i]t would have been obvious to one having ordinary skill in the art to which the invention pertains to use a commercially available soap gelling agent such as RTD Sodium Stearate OP-65 as the soap gel-forming agent in Geria for manufacturing convenience.

Even if we were to accept, for purposes of argument, that RTD Sodium Stearate OP-65 was available as prior art and thus known to those of ordinary skill in this art at the time of the invention, it remains that the examiner has provided no evidence, present in the prior art, which would have reasonably suggested the substitution of the RTD Sodium Stearate OP-65 for the soap gel-forming agent of Geria. It is the initial burden of the patent examiner to establish that claims presented in an application for patent are unpatentable.

Appeal No. 1996-4133
Application 08/264,073

In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In order to meet the burden of establishing a prima facie case of unpatentability of the claimed subject matter the examiner must establish that there is a reason, based on the prior art, or knowledge generally available in the art as to why it would have been obvious to one of ordinary skill in the art to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, n.24, 227 USPQ 657, 667, n.24 (Fed. Cir. 1985).

On the record before us, the examiner has failed to provide any evidence which would have reasonably led one of ordinary skill in this art to modify the composition of Geria by substituting a soap gel-forming agent an alkali metal salt of a fatty acid "wherein at least 65% by weight, of the total weight of the soap gelling agent, are alkali metal salts of fatty acids having carbon chain length in a range of C₂₀-C₂₂ " for the sodium fatty acid salts disclosed therein. Where, as here, the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). Therefore, the rejection of claims 1-8 under 35 U.S.C. § 103 is reversed.

Appeal No. 1996-4133
Application 08/264,073

SUMMARY

The rejection of claims 1-15 and 17-27 under 35 U.S.C. § 103 is reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
CAROL A. SPIEGEL)	
Administrative Patent Judge)	

DWR/wgb

Appeal No. 1996-4133
Application 08/264,073

Antonelli, Terry, Stout & Kraus
Suite 1300
1300 North 17th Street
Arlington, VA 22209