

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES A. GIBSON

Appeal No. 97-0113
Application No. 08/083,987¹

ON BRIEF

Before WINTERS, Administrative Patent Judge, McKELVEY, Senior Administrative Patent Judge, and PAK, Administrative Patent Judge.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This appeal is from a decision of the primary examiner rejecting claims 2, 3, 5, 6, 8 and 16 under 35 U.S.C. § 103 as unpatentable over (1) the combined disclosures of Niebruegge et al. (U.S. Patent No. 4,731,165) and Latimer (U.S. Patent No. 4,956,506); and (2) the combined disclosures of Moss et al. (U.S.

¹ Application for patent filed June 28, 1993.

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Patent No. 3,131,132), Niebruegge et al. and Latimer. Technically, claim 1 also remains in the application, although applicant has withdrawn this claim from the appeal. See the Appeal Brief, page 2, first paragraph. Accordingly, the appeal with respect to claim 1 is dismissed. On return of this application to the Examining Group, both applicant and the examiner should ensure that claim 1 is canceled from the application.

On consideration of the record, including applicant's Appeal Brief (Paper No. 19), the Examiner's Answer (Paper No. 20) and the Reply Brief (Paper No. 21), it is

ORDERED that the examiner's decision rejecting claims 2, 3, 5, 6, 8 and 16 on both prior art grounds is reversed.

The Latimer reference, entitled "Vapor-Phase Hydration of Olefins to Alcohols in Series Reactors With Intermediate Alcohol Removal," is not within the field of applicant's endeavor. Nor is this reference reasonably pertinent to the particular problem with which applicant was involved, namely, the color contamination of alkanolamines or alkyleneamines. Accordingly, we find that Latimer is from a non-analogous art. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

Assuming arguendo that Latimer is not from a non-analogous art, nevertheless, we agree with applicant that both prior art

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rejections are predicated on the impermissible use of hindsight. The examiner has not established that a person having ordinary skill in the art, armed only with the cited references and not relying on information imparted by the specification, would have arrived at the claimed subject matter as a whole. The examiner has not established that a person having ordinary skill would have arrived at the method defined in independent claim 16, including the limitation that added water is maintained in the liquid phase at a temperature of 201 to about 230EC and a pressure of about 1 to about 100 psig, based only on teachings found in the prior art.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	
FRED E. McKELVEY)	BOARD OF PATENT
Senior Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHUNG K. PAK)	
Administrative Patent Judge)	

Union Carbide Chemicals
& Plastics Co., Inc.
Law Dept. E205
39 Old Ridgebury Rd.
Danbury, CT 06817-0001

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