

***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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LANNY D. VENHAM,  
SHARON D. HICKS and DOUGLAS A. WICKS

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Appeal No. 1997-1790  
Application 08/171,550<sup>1</sup>

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ON BRIEF

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Before CAROFF, DOWNEY and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 13 through 15. Claims 1 through 12 are also of record and have been allowed by the examiner. Claim 13 is illustrative of the claims on appeal:

13. An aldimine based on the reaction product of diamino dicyclohexyl methane with an aldehyde corresponding to the formula:



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<sup>1</sup> Application for patent filed December 21, 1993.



aldimines (col. 4, lines 7-20), constitute a description of an aldimine prepared from isobutyraldehyde and bis-(4-aminocyclohexyl)-methane that would fall within appealed claims 13 and 15 as if the same were described by name, such that Mormile *describes* the invention encompassed by appealed claims 13 and 15 within the meaning of § 102(e). *See generally, In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982).

The examiner has advanced the position that because of such disclosure in Mormile, it would not require judicious selection from the teachings of the reference to select isobutyraldehyde and bis-(4-aminocyclohexyl)-methane to form an aldimine falling within claims 13<sup>4</sup> and 15, relying on the authority of, *inter alia, Sivaramakrishnan, supra* (answer, pages 4-5). Appellants submit that the sole disclosure of bis-(4-aminocyclohexyl)-methane (HMDA) as a “suitable starting material for preparing aldimines . . . is not sufficient to satisfy the description requirement of” § 102(e) and point out that the depicted “preferred cycloaliphatic diamines include” (Mormile, col. 4, line 18, to page 5, line 20) “all of the known cycloaliphatic diamines” (principal brief page 4). Thus, appellants contend that because of the wording of the disclosure of Mormile and the listing therein of “most, if not all, of the known cycloaliphatic diamines,” there has been no “narrowing of the broad term ‘cycloaliphatic diamines’” and the reference “merely names HMDA as a suitable cycloaliphatic diamine for reacting with any number of aldehydes and ketones to form aldimines or ketimines” (principal brief, page 5). Thus, appellants submit that “a similar listing of compounds was not found sufficient to anticipate the claims in In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973),” pointing to the statement by the court that “the listing of the compounds by name constituted nothing more than speculation about their potential or theoretical existence. The mere naming of a compound in a reference, without more, cannot constitute a description of the compound” (principal brief, pages 5-6). Accordingly, appellants take the position

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<sup>4</sup> Contrary to the examiner’s interpretation of the term “diamino dicyclohexyl methane” in claim 13 (answer, page 4), we interpret this term to be limited to the unsubstituted isomers of bis-(aminocyclohexyl)-methane as set forth at page 13, lines 2-4, of the specification, bearing in mind that this term must be given the broadest reasonable interpretation consistent with appellants’ specification as it would be interpreted by one of ordinary skill in this art. *In re Morris*, 127 F.3d 1048, 1053-56, 44 USPQ2d 1023, 1027-30 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

that only the diamines used to prepare Aldimines #1 (HMDA), #2 (triethylene glycol diamine) and #3 (isophorone) “satisfy the description requirement” of § 102(e) as “[a]ll of the other amines, including HMDA, are merely named,” thus constituting an insufficient description for purposes of this section of the statute “based on the holding in Wiggins” (principal brief, page 7). Appellants further submit that claim 15 involves the selection of the starting materials, that is, a diamine and an aldehyde, and there is “nothing to direct the skilled artisan to the necessary species” (principal brief, pages 7-8).

We have carefully reviewed the record before us in light of appellants’ arguments and find that we agree with the examiner that Mormile would have reasonably described the aldimine prepared from isobutyraldehyde and HMDA to one of ordinary skill in this art within the meaning of § 102(e). Not only is isobutyraldehyde the only aldehyde or ketone starting material used to prepare aldimines in the Mormile Examples but it is reacted with the dimethyl homolog of HMDA to prepare Aldimine #1, which dialkyl homolog along with three other dialkyl homologs and HMDA is included in a listing of preferred cycloaliphatic diamines. Thus, we conclude that the facts in the record before us are more akin to *Sivaramakrishnan* wherein the court distinguished *Wiggins*, and find that, as in *Sivaramakrishnan*, one of ordinary skill in this art would not have difficulty following the teachings of Mormile and thus would arrive at the aldimine prepared from isobutyraldehyde and HMDA without having to “choose judiciously from a genus of possible combinations of . . . [starting materials] to obtain the very subject matter to which appellant’s . . . claims are directed.” 673 F.2d at 1384-85, 213 USPQ at 442.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in Mormile with appellants’ countervailing evidence of and argument for no anticipation in fact and find that the claimed invention encompassed by appealed claims 13 through 15 are anticipated as a matter of fact under 35 U.S.C. § 102(e).

The examiner’s decision is affirmed.

Appeal No. 1997-1790  
Application 08/171,550

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

*AFFIRMED*

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|-----------------------------|---|-----------------|
| MARC L. CAROFF              | ) |                 |
| Administrative Patent Judge | ) |                 |
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| MARY F. DOWNEY              | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
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|                             | ) |                 |
| CHARLES F. WARREN           | ) |                 |
| Administrative Patent Judge | ) |                 |

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Application 08/171,550

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