

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. QUINN, W. MICHAEL BURK
WILLIAM S. HENRY and STEVEN A. GOODLIVE

Appeal 1997-2805
Application 08/355,712¹

Before: WINTERS and WILLIAM F. SMITH, Administrative Patent Judges and McKELVEY, Senior Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
Decision on appeal under 35 U.S.C. § 134

Upon consideration of the appeal brief and the examiner's answer, it is

¹ Application for patent filed 14 December 1994. According to applicants, the application on appeal is a continuation-in-part of application 07/709,745, filed 3 June 1991. The real party in interest is The Lubrizol Corporation.

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ORDERED that the examiner's rejection of claims 1-18 as being unpatentable under 35 U.S.C. § 103 over Itoh is reversed.

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A.

In the parent application a panel of the board reversed a rejection of claims 1-29 (as presented in the parent application) over Itoh (copy of prior board opinion attached). Applicants continued prosecution and the issue of whether claims 1-18 (as presented in the application on appeal) are unpatentable over Itoh is again before us.

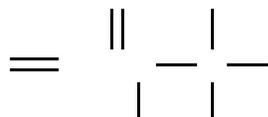
The brief presented by applicants and the examiner's answer have been of no assistance in this appeal. Instead, we have been left to review the record, essentially without help from either applicants or the examiner. The appeal is Exhibit 1 as to why the board has an unacceptably high backlog.²

We reverse the rejection of claims 1-18 over Itoh because it does not appear to us that Itoh describes the reaction of

² As of the end of November 1999, the ex parte backlog at the board was 8344 appeals. 1230 Off. Gaz. Pat. & Tm. Office 43 (Jan. 11, 2000).

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an impure "acid" with a "salt." Item (A) in claim 1 is an impure acid having the formula:



Note that the moiety SO₃H is an acid moiety, not a salt moiety.

Itoh describes a process for making the impure acid which includes the use of sulfuric acid. Essentially, Itoh reacts (1) a nitrile, (2) a sulfonic acid or sulfonic acid salt and (3) sulfuric acid (col. 3, lines 54-57). The result is a sulfonic acid salt (col. 3, last line to col. 4, line 2). Thus, the presence of sulfuric acid results in the preparation of a salt regardless of whether a sulfonic acid or a sulfonic acid salt is used as item (2), supra.

Accordingly, we hold that Itoh fails to make out a prima facie case of obviousness vis-a-vis claims 1-18. The examiner's reliance on the Itoh description of the use of a sulfonic acid fails because Itoh's subsequent reaction of the

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product of the reaction of (1), (2) and (3) always involves a reaction of a salt. Claims 1-18 require an acid.

B.

In the prior board opinion, the panel made a new ground of rejection of then claims 1-29 under 37 CFR § 1.196(b).

Facially, the new ground of rejection is equally applicable to claims 1-18 currently on appeal.

In making the new ground of rejection, the panel relied on and cited certain evidence; it also suggested that a further search and/or interrogatories to applicants might be appropriate. Insofar as we can tell, however, neither the examiner nor applicants have addressed the new ground of rejection. On this record, therefore, the issues raised by the new ground of still need to be taken up for action. At a minimum, the examiner should state on the record the reasons why it is believed the new ground of rejection should not be made as to claims 1-18 on appeal.

REVERSED.

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	SHERMAN D. WINTERS)
	Administrative Patent Judge)
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	WILLIAM F. SMITH)
PATENT)
	Administrative Patent Judge)
AND)
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INTERFERENCES)
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	FRED E. McKELVEY, Senior)
	Administrative Patent Judge)

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