

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. BIERL,
VINCENT A. DURANTE,
LAWRENCE H. FINKEL and
DANIEL E. RESASCO

Appeal No. 1998-1157
Application No. 08/278,782

ON BRIEF

Before PAK, WALTZ and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-17. Claims 22-24 have been cancelled. We note that the examiner indicates that this appeal involves claims 1-17. The examiner also indicates that the rejection of claims 18-21 has been withdrawn and that claims 18-20 would be allowable. Because the examiner has also withdrawn the rejection of claim 21, we presume that the examiner intends to indicate allowability of claim 21. We therefore treat this claim the same as claims 18-20.

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Claims 1-17 stand rejected under 35 U.S.C. § 103 as unpatentable over Drehman.

Appellants have grouped the appealed claims as follows: **(1)** claims 1-3, 5-7, 9, 13, 15-17, 21, **(2)** claims 4, 8, 10, 12, 14 and **(3)** claims 18-20 (as noted above, claims 18-20 have been indicated as allowable).

With respect to claim 21, as indicated, *supra*, the rejection of claim 21 has been withdrawn, and therefore is not part of group **(1)**. Hence, group **(1)** includes claims 1-3, 5-7, 9, 13, and 15-17. With respect to group **(3)**, because these claims have been indicated as allowable, we need not consider this grouping.

Hence, with respect to groups **(1)** and **(2)**, we select the broadest claim from each of these groups for consideration on appeal, as follows:

- (1) claim 1
- (2) claim 8

See 37 CFR § 1.192(c)(7)(1997).

We refer to the brief and reply brief, and to the answer and supplemental answer, for a complete exposition of the opposing viewpoints expressed by appellants and by the examiner concerning the above-noted rejection.

OPINION

For the reasons expressed by the examiner and the reasons set forth below, we will sustain the rejection of claims 1-17 under 35 U.S.C. § 103 as unpatentable over Drehman.

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We agree with the examiner's understanding of the disclosure set forth in Drehman as summarized on page 4 of the answer, and as further discussed on page 6 of the answer.

Regarding our consideration of claim 1, on page 9 of the brief, appellants argue that Drehman does not require that the tin component of the catalyst be in the form of tin oxide.

However, as correctly pointed out by the examiner, Drehman discloses stannic oxide in Example 1 in column 3 of the reference. Also, we observe that Example 1 indicates that the pellets are calcined in air. Such an environment provides for oxidation.¹

Hence, as stated on page 6 of the answer, we agree with the examiner's position that because the same materials are being contacted under the same conditions, the process set forth in appellants' claim 1 is suggested by Drehman.

In view of the above, we sustain the rejection involving claims 1-3, 5-7, 9, 13, and 15-17.

With respect to claim 8, we provide the additional comments set forth below.

On page 10 of their brief, appellants state that the claimed subject matter relates to a process in which the endothermic reaction catalyst and the hydrogen oxidizing solid reagent are contained in separate particles. Also, on page 2 of the reply brief, appellants argue that Drehman does not suggest a process that includes intermixing

¹We are mindful of appellants' interpretation of Drehman's disclosure in column 2 beginning at line 14. However, we are not convinced that tin cannot be in the form of tin oxide, especially because of the fact that tin oxides are disclosed.

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particles of an endothermic reaction catalyst with separate particles of a hydrogen oxidizing solid reagent.

We note that whether the hydrogen oxidizing solid reagent and the solid catalyst are combined by being in the same particle, or are combined by intermixing separate particles, the result of utilizing the hydrogen oxidizing solid reagent in combination with the solid catalyst is reasonably expected to be the same. Absent proof in the record that the way in which the two are mixed produces any new and unexpected results, we determine that one of ordinary skill in the art would have been led to employ either mixture in the process of Drehman with a reasonable expectation of successfully producing the same or similar result. See In re Burhans, 154 F.2d 690, 692, 69 USPQ 330, 332 (CCPA 1946). In this light, we note that page 5 of appellants' specification indicates that the solid catalyst and the hydrogen oxidizing solid reagent are intermixed, either as separate particles or incorporated within the same particle. In other words, appellants acknowledge that either mixing technique would have provided the same result, thus indicating that the choice of separate particles is not critical. Although appellants state that the choice of separate particles provides for the ability to regenerate the catalyst and the reagent (brief, page 10), appellants do not show that such an ability is unexpected.

In view of the above, we sustain the rejection involving claims 4, 8, 10-12 and 14.

CONCLUSION

In view of the above, the rejection of claims 1-17 under 35 U.S.C. § 103 over Drehman is **affirmed**.

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Because our rationale is materially different than that discussed by the examiner, we denominate this affirmance as involving a new ground of rejection.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz, Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

AFFIRMED
37 CFR § 1.196(b)

Chung K. Pak)
Administrative Patent Judge)
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) BOARD OF PATENT
Thomas A. Waltz)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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Beverly A. Pawlikowski)
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