

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOCELYN JALBERT  
and  
ROLAND GILBERT

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Appeal No. 1999-0726  
Application No. 08/664,432

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HEARD: NOVEMBER 6, 2001

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Before KIMLIN, PAK, and DELMENDO, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2 through 5 and 7 through 20, which are all of the claims pending in the above-identified application.

Claim 18 is representative of the claimed subject matter

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and reads as follows:

18. A process, which comprises:

providing a material selected from the group consisting of mineral oil, aromatic and aliphatic solvents, said material containing small amounts of water;

contacting said material with previously crushed calcium carbide;

mechanically stirring said calcium carbide with said material thereby causing said calcium carbide to react with water present in said material for a time and under conditions effective to form a liquid phase consisting of said material having a water content less than 0.5 ppm and a solid phase comprising calcium hydroxide and unreacted calcium carbide;

separating said solid phase from said liquid phase;

taking aliquots of said liquid phase to form samples of said material free of said solid phase and containing less than 0.5 ppm water, said samples adapted to constitute standards by adding water to each dehydrated sample to achieve a water concentration level of at least 1 ppm, said standards to be used in a method of determining water content in a given oil or solvent.

In support of his rejections, the examiner relies on the following prior art references:

Alexander	2,399,192	Apr.
	30, 1946	
Earl	4,444,159	Apr.

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24, 1984  
Schneider et al. (Schneider) 4,577,978 Mar.  
25, 1986

Szepes et al. (Szepes), "A New Analytical Method for the  
Determination of the Water Content of Transformer Oils,"  
Vol. EI-17, *IEEE Transactions on Electrical Insulation*, No. 4,  
pp. 345-49 (Aug. 1982).

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The appealed claims stand rejected as follows:

1) Claims 2, 3, 5 and 6 through 20 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Alexander, Earl and Schneider; and

2) Claim 4 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Alexander, Earl, Schneider, and Szepes.

Having carefully reviewed the claims, specification, and applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions, we are persuaded that the examiner has not established a *prima facie* case of unpatentability within the meaning of 35 U.S.C. § 103. Consequently, we reverse each of the aforementioned § 103 rejections for substantially the same reasons set forth in the Brief and the Reply Brief. We only emphasize that Earl and Schneider, which are drawn to different processes than that taught by Alexander, would not have suggested reacting calcium carbide with water present in the claimed material "for a time and under conditions effective to form a liquid phase consisting of said material having a water content less than 0.5 ppm" for the purpose of

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forming standard samples (via adding water thereto). For the reasons indicated *supra*, we are convinced that the examiner's § 103 rejections are fatally premised upon impermissible hindsight. See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Accordingly, the decision of the examiner is reversed.

*REVERSED*

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

CKP:hh

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