

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte EDWARD R. STOVER

---

Appeal No. 2001-0727  
Application 08/215,446

---

ON BRIEF

---

Before KIMLIN, KRATZ and TIMM, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-20, and 29-36. Claims 24-28, the other claims remaining in the present application, stand withdrawn from consideration. Claim 1 is illustrative:

1. A method of inhibiting catalyzed oxidation of carbon-carbon composites comprising the steps of treating a carbon-carbon composite having pores with a liquid composition comprising (a) phosphoric acid, (b) a zinc salt, and (c) an aluminum salt, wherein the liquid composition contains less than about 0.1% by weight boron, and heating the treated carbon-carbon composite to a temperature sufficient to form a deposit within the pores.

Appeal No. 2001-0727  
Application No. 08/215,446

The examiner relies upon the following references as evidence of obviousness:

Strater	3,510,347	May 05, 1970
Wilson	4,439,491	Mar. 27, 1984
Block	4,454,193	Jun. 12, 1984
Chandler et al. (Chandler '232)	4,617,232	Oct. 14, 1986
Chandler et al. (Chandler '017)	4,621,017	Nov. 04, 1986
McAllister et al. (McAllister)	4,837,073	Jun. 06, 1989
Washburn et al. (Washburn)	5,362,567	Nov. 08, 1984

Appellant's claimed invention is directed to a method of inhibiting catalyzed oxidation of carbon-carbon composites. The method entails treating the composite with a liquid composition comprising phosphoric acid, a zinc salt, an aluminum salt and less than 0.1% by weight boron.

Appealed claim 1 stands rejected under 35 U.S.C. § 112, second paragraph. In addition, the appealed claims stand rejected under 35 U.S.C. § 103 as follows:

- (1) Claims 1-10 over Block in view of Chandler '232,
- (2) Claims 11-14, 16 and 21-23 over Block, Chandler '232 and McAllister,

Appeal No. 2001-0727  
Application No. 08/215,446

(3) Claims 31 and 32 over McAllister in view of Strater,

(4) Claims 15 and 17-19 over Chandler '232 and Block  
in view of Chandler '017 and Wilson.

Although appellant requests at page 4 of the brief that "the claims be considered individually", the examiner has held that the appealed claims stand or fall together (see page 2 of answer). Since appellant has not petitioned this holding of the examiner, we will consider all the appealed claims to stand or fall together. See Ex Parte Ohsumi, 21 USPQ2d 1020, 1023 (Bd. Pat. App. & Int. 1991).

Upon careful consideration of the arguments presented on appeal, we will not sustain the examiner's rejection under § 112, second paragraph. However, we will sustain the examiner's rejections under 35 U.S.C. § 103 to the extent that they are based upon the McAllister reference.

Regarding the § 112, second paragraph, rejection, although the examiner's answer does not present a statement of this rejection, the examiner has responded to appellant's argument by stating that the examiner would disagree with appellant's argument that the claim 1 language "less than about" is not indefinite (see paragraph bridging pages 10 and 11 of answer). Hence, we will treat the examiner's failure to state the

Appeal No. 2001-0727  
Application No. 08/215,446

rejection in the answer as an oversight. However, for the reasons set forth at page 17 of appellant's brief, we will reverse the examiner's rejection. In our view, the examiner has not set forth a prima facie case that one of ordinary skill in the art would not understand the scope of the claim language when it is read in light of the present specification and state of the prior art.

We will also not sustain the examiner's rejection of claims 1-10 under § 103 over Block in view of Chandler. It seems to be the examiner's position that Block only fails to teach the aluminum component of the claimed treatment composition. However, as properly pointed out by appellant, the treatment solution of Block also does not contain the claimed phosphoric acid. Rather, Block discloses an organophosphorus ester that "is free of acid groups or the corresponding salts thereof" (column 4, lines 50 and 51). Consequently, although Chandler '232 discloses a treatment composition comprising aluminum phosphate, the examiner has not explained how the combined teachings of Block and Chandler would have made the claimed composition, comprising phosphoric acid, obvious to one of ordinary skill in the art.

Appeal No. 2001-0727  
Application No. 08/215,446

The examiner's rejection of claims 15 and 17-19 over the collective teachings of Block, Chandler '232, Chandler '017 and Wilson is not on any sounder ground. Chandler '017 and Wilson do not remedy the deficiency of the combined teachings of Block and Chandler '232 discussed above, i.e., the obviousness of incorporating phosphoric acid in a treatment composition comprising a zinc and aluminum salt.

We will sustain the examiner's rejection of claims 11-14, 16 and 21-23 over Block in view of Chandler '232 and McAllister, as well as the examiner's rejection of claims 31 and 32 over McAllister in view of Strater. Like appellant, McAllister discloses a method of inhibiting catalyzed oxidation of carbon-carbon composites by treating the composites with a liquid composition comprising phosphoric acid, zinc salt, an aluminum salt and a material containing boron (see TABLE II, as well as the state of the prior art discussed at column 2, lines 19 et seq.) From our perspective, the collective teachings of Chandler, Block and McAllister, as well as McAllister alone, would have rendered the claimed method of treating a carbon-carbon composite with a liquid composition comprising phosphoric acid, a zinc salt, an aluminum salt and boron obvious to one of ordinary skill in the art.

Appeal No. 2001-0727  
Application No. 08/215,446

The examiner's answer states at page 5 that claims 29 and 30 are rejected under 35 U.S.C. § 102(b) as being anticipated by Washburn. However, in response to appellant's rebuttal of this rejection in the brief, the examiner states at page 10 of the answer that "[t]o this the examiner wishes to remind the appellants [sic: appellant] that said rejection is withdrawn." Accordingly, we consider the § 102 rejections of claims 29 and 30 over Washburn as withdrawn.

This application is remanded to the examiner to consider a rejection of claims 1-10, 16, 20, 29, 30 and 33-36 over McAllister, either alone, or in combination with other prior art. As explained above, McAllister discloses a method of inhibiting oxidation of carbon-carbon composites comprising the steps of treating the composite with a liquid composition comprising phosphoric acid, a zinc salt, an aluminum salt and a boron-containing material, and heating the treated composite to a temperature sufficient to form a deposit within the pores, as well as, as appreciated by the examiner, providing a barrier coating on the composite.

In conclusion, based on the foregoing, the examiner's rejection of claims 1-10, 15 and 17-19 under § 103 is reversed, as is the examiner's rejection under 35 U.S.C. § 112, second

Appeal No. 2001-0727  
Application No. 08/215,446

paragraph. The examiner's rejection of claims 11-14, 16, 21-23, 31 and 32 under 35 U.S.C. § 103 is affirmed. Additionally, this application is remanded to the examiner for the reasons set forth above.

This application, by virtue of its "special" status, requires an immediate action by the examiner. See the Manual of Patent Examining Procedure, § 708.01(D) (7th ed., Rev. 1, Feb. 2000). It is important that the Board of Patent and Appeals and Interferences be informed promptly of any action affecting the appeal in this case.

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

AFFIRMED-IN-PART/REMANDED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
CATHERINE TIMM	)	
Administrative Patent Judge	)	

Appeal No. 2001-0727  
Application No. 08/215,446

THE B.F. GOODRICH COMPANY  
PATENT LAW DEPARTMENT  
9921 BRECKSVILLE ROAD  
BRECKSVILLE, OH 44141-3289

VSH