

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER WILLIAM LEDNOR
and KATHERINE SEARCY-ROBERTS

Appeal No. 2001-0784
Application No. 08/755,844

ON BRIEF

Before CAROFF, DELMENDO, and MOORE, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This a decision on appeal from the examiner's final rejection of claims 1 and 4-8, all of the claims remaining in appellants' involved application.

The claims at issue are directed to a process for preparing a ceramic foam support impregnated with a catalytically active component other than an inorganic oxide.

Appellants stipulate on page 2 of their brief that all of the claims at issue stand or fall together for purposes of this appeal.

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alone a viscosity within the range mandated by appellants' claims. Certainly, the comparative example on page 8 of appellants' specification demonstrates that an aqueous solution of a metal-containing compound will not necessarily have a viscosity within the range recited in appellants' claims.

Additionally, the examiner points to nothing in Jacobs which would apprise one of ordinary skill in the art of a need to perform a drying step "without substantial prior draining" of the impregnating solution from the ceramic foam support, as that concept is defined in appellants' specification (paragraph bridging pages 3 and 4).

For the foregoing reasons, the decision of the examiner is reversed.

Upon further review of the record, we note that appellants' specification (page 2, lines 18-26) credits European Patent Application 94 203453.9 (EPA 453.9) with disclosure of both of the concepts we have found missing from Jacobs. Although EPA '453.9 apparently is directed to inorganic oxides, we have no doubt that one of ordinary skill in the art would have little difficulty applying the teachings of EPA '453.9 to other catalytically active compounds as well, such as those disclosed in Jacobs, with the

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reasonable expectation of obtaining a significant increase in loading of the active material as in EPA '453.9.

Accordingly, we remand the instant application to the examiner for a determination of whether EPA '453.9 constitutes prior art within the purview of 35 U.S.C. § 102 (f). We expect appellants to cooperate by furnishing a copy of EPA '453.9 to the examiner so that she may determine the identity of the inventive entity involved.

If the examiner determines that EPA '453.9 constitutes prior art under 35 U.S.C. § 102 (f), she should reject appellants' claims for obviousness under 35 U.S.C. § 103 over EPA '453.9 in view of Jacobs for the reasons indicated above. See Ex parte Andresen, 212 USPQ 100, 102 (Bd. Appl. 1981).

Since we are remanding the involved application to the examiner, the examiner should also consider reinstating her prior obviousness-type double patenting rejection against appellants' claims based upon the claims of Kumar et al. (5,658,497) taken with Jacobs. This rejection should be premised essentially upon the same reasoning noted above with regard to EPA '453.9 since both references apparently have similar disclosures.

Additionally, we find that the phrase "without substantial prior draining" renders the claims indefinite. This finding is

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based upon the suggestion in appellants' specification (page 3, lines 28-30) that drainage from the pores prior to drying is permissible as long as it is less than 60%. In our view, this disclosure is inconsistent with claiming "without substantial prior draining" since drainage approaching 60% would ordinarily be considered substantial. Since we are remanding this application to the examiner to address other matters, rather than apply a new ground of rejection under 37 CFR 1.196(b), we direct the examiner to reject the claims under 35 U.S.C. § 112, second paragraph, as being indefinite for the reason stated above.

For the foregoing reasons, the decision of the examiner is reversed, and the application is hereby remanded to the examiner, via the Office of a Director of the involved Technology Center, for appropriate action consistent with our opinion. To summarize, the examiner is to consider imposing three rejections based, respectively, on (a) 35 USC §§ 102(f)/103, (b) the obviousness-type double patenting doctrine, and (c) 35 USC § 112, second paragraph.

This application, by virtue of its "special" status, requires immediate action on the part of the examiner. See MPEP § 708.01 (8TH Ed., Aug, 2001). It is important that the Board of Patent Appeals and Interference be promptly informed of any action affecting the appeal in this case.

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REVERSED AND REMANDED

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| MARC L. CAROFF |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| ROMULO H. DELMENDO |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| JAMES T. MOORE |) | |
| Administrative Patent Judge |) | |

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JUDGE CAROFF

APPEAL NO. 2001-0784

APPLICATION NO. 08/755,844

APJ CAROFF

APJ MOORE

APJ DELMENDO

DECISION: **REVERSED AND REMANDED**

PREPARED: Sep 25, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK