

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANANTHA N. DESIKAN and GEORGE E. WHITWELL

Appeal No. 2004-0599
Application No. 09/843,554

ON BRIEF

Before OWENS, WALTZ, and TIMM, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 18 and 19, which are the only claims pending in this application.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

¹Appellants submitted an amendment subsequent to the final rejection which cancelled claims 10-16 and this amendment has been entered by the examiner (see the amendment dated Mar. 27, 2003, Paper No. 13, entered as per the Advisory Action dated April 11, 2003, Paper No.14; see the Answer, page 2, ¶(4)). We note that the amendment of Paper No. 11 was incorrectly entered. This error should be corrected upon return of this application to the examiner. For purposes of this appeal, we consider claim 18 as presented in the amendment of Paper No. 7.

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According to appellants, the invention is directed to a novel composition of mixed alkylphenols, where the ratio of ortho- to meta- and para- isomers is no more than about 1.0, the amount of 2,6-dialkyl phenol is from about 0.5% to 3%, and the amount of trialkyl phenol is from about 4% to about 75% and the alkyl group is isopropyl (Brief, page 2). Representative independent claim 18 is reproduced below:

18. A composition comprising mixed alkylphenols wherein the ratio of ortho- to meta- and para- isomers is no more than about 1.0, the amount of 2,6-dialkyl phenol is from about 0.5% to 3%, by weight of the entire composition, and the amount of trialkyl phenol is from about 4% to about 75%, by weight of the entire composition, wherein the alkyl is isopropyl.

The examiner has relied upon Terhune et al. (Terhune), U.S. Patent No. 3,936,410, issued Feb. 3, 1976, as the sole evidence of obviousness (Answer, page 3, ¶(9)). Accordingly, claims 18-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Terhune (Answer, page 3, ¶(10)).² We reverse the rejection on appeal for reasons stated below.

OPINION

²We note that the final rejection of claim 18 under section 102(b) as anticipated by U.S. Patent No. 4,275,248 (Paper No. 12, page 3) has been withdrawn by the examiner (see the Advisory Action, Paper No. 14, and the Answer, page 2, ¶(6)). We also note that this application is a divisional application of application no. 09/241,911, Appeal No. 2003-0801, in which a decision on appeal was mailed Jul. 30, 2003 (Paper No. 17).

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The examiner finds that the isomerized product of Example 1 in Terhune differs from the claimed composition "only in the amount of 2,6-dialkyl phenol and trialkyl phenol present" (Answer, page 3, footnote omitted). The examiner finds that the reference suggests isopropylphenol compositions falling within the scope of the claims, citing col. 3, ll. 11-20, of Terhune (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art that a variety of compositions are "within the purview of the teaching of the prior art" and "would be suitable for the prior art use" (*id.*).

It is well settled that the initial burden of establishing a case of *prima facie* obviousness rests with the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In appropriate circumstances, a single prior art reference can render a claim obvious, although the examiner must still show a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). On this record, we determine that the examiner has admitted that the amount of 2,6-dialkyl phenol disclosed by

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Terhune differs from the claimed amount (Answer, page 3) but the examiner has failed to state why it would have been obvious to one of ordinary skill in this art to modify this amount (0.1%) to include the claimed range (about 0.5% to 3%) (see the Answer in its entirety). In the "Response to Argument" (Answer, page 5), the examiner finds that the reference suggests that the final product may contain 5-10% of the di- or tri-isopropyl species, citing Terhune, col. 3, ll. 11-17. However, the examiner has not explained how this reference disclosure to all di-alkyl species is relevant to the claimed amount of 2,6-dialkyl phenol. We note that Example 1 of Terhune discloses three (3) other dialkyl phenols in addition to the 2,6-dialkyl phenol isomer.

Additionally, we do not agree with the examiner that the claimed amount of trialkyl phenol would have been obvious in view of Terhune (Answer, page 3). Even assuming *arguendo* that the examiner's claim construction of the term "about 4%" is correct (Answer, pages 4-5),³ the examiner has not shown why one of ordinary skill in this art would have modified the amount of trialkyl phenol disclosed and exemplified by Terhune (0.1%) to render obvious the lowest amount of trialkyl phenol (0.8%) of

³See *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

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claim 18 as construed by the examiner. The examiner's reasoning regarding "[w]orking backwards" from the final product (Answer, page 5) is not persuasive since the examiner has not pointed to any teaching or suggestion in Terhune that the amount of the di- or tri-alkyl species falls within the amount required by claim 18 on appeal. Similarly, the examiner's reliance on the various process conditions to influence the composition are not supported by any suggestion or motivation from the reference (Answer, page 6). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. [Citations omitted]." *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For the foregoing reasons, we determine that the examiner has not met the initial burden of establishing a *prima facie* case of obviousness in view of Terhune. Accordingly, we cannot sustain the examiner's rejection of claims 18 and 19 under section 103(a) over Terhune.

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The decision of the examiner is reversed.

REVERSED

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| Terry J. Owens |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| Thomas A. Waltz |) | APPEALS |
| Administrative Patent Judge |) | AND |
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| Catherine Timm |) | |
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TAW/tdl

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