

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANFRED GALLUS, HERBERT GEBAUER
and OTTO IMMEL

Appeal No. 95-3827
Application No. 08/031,793¹

ON BRIEF

Before GARRIS, HANLON, and WALTZ, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-16, all of the claims pending in the application. The claims on appeal are directed to a process for the production of an isocyanate or a mixture of

¹ Application for patent filed March 15, 1993.

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isocyanates. Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A process for the production of an isocyanate or a mixture of isocyanates which is substantially free of color imparting material comprising treating a phosgenation product of an amine with hydrogen at a pressure of from about 3 to about 150 bar at a temperature of from about 100 to about 180°C for from about 15 minutes to about 4 hours in the presence of a catalyst.

The sole reference relied upon by the examiner is:

Bruchmann	2,038,126	Sep. 15, 1991
(Canada)		

The sole issue in this appeal is whether claims 1-16 were properly rejected under 35 U.S.C. § 103 as unpatentable over Bruchmann.

Discussion

The claimed invention is directed to a process for the production of an isocyanate or a mixture of isocyanates which is substantially free of color imparting material comprising treating a phosgenation product of an amine with hydrogen at a specific temperature and pressure for a period of time in the presence of a catalyst.

Bruchmann discloses a method of improving the quality of crude diaminodiphenylmethanes comprising the treatment thereof

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with hydrogen in the presence of a hydrogenation catalyst (p.2). The conditions of the hydrogenation treatment are as follows (p.3):

- (1) Pressure: from 1 to 300 bar, preferably from 10 to 200 bar and more preferably from 20 to 60 bar;
- (2) Temperature: from 20E to 400EC, preferably from 70E to 320EC; and
- (3) Time: from 10 minutes to 2 hours.

Compare appellants' specification, p.3, lines 8-13 ("the amine corresponding to the desired isocyanate is phosgenated and the resultant isocyanates or isocyanate mixtures are subjected to a hydrogen treatment at a pressure of from about 3 to about 150 bar and a temperature of 100 to 180EC in the presence of a catalyst for from about 15 minutes to about 4 hours").

Suitable catalysts include platinum and palladium (p.3; compare appellants' specification, p.3, lines 20-24).

According to Bruchmann, the disclosed diaminodiphenylmethanes are reacted with phosgene to produce the corresponding diphenylmethane diisocyanates (p.1). The process disclosed in Bruchmann is said to avoid any discoloration of the isocyanate produced (p.2, lines 6-9). See Answer, p.2.

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According to the examiner (Answer, pp.2-3):

Bruchmann differs from the claims by performing the hydrogenation step on amines, the isocyanate compound precursor, rather than on the isocyanate compound formed after phosgenation of the amine.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to hydrogenate after phosgenation rather than before because one would expect a purer product if the purification step were performed on the product than the intermediate.

We agree with appellants that the examiner has failed to provide any factual basis for her conclusion that one having ordinary skill in the art would have expected a purer product or realized any other advantage if the purification step were performed on the isocyanate rather than the corresponding amine. Based on this record, there would have been no motivation, absent appellants' disclosure, to hydrogenate the isocyanate rather than the corresponding amine. See Brief, p.5. Compare In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103, the references themselves, rather than applicant's disclosure, must provide some teaching whereby the applicant's combination would have been obvious).

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The examiner further relies on In re Durden, F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985), to establish the obviousness of the claimed process (Answer, p.4):

[I]f one looks at the larger picture, the starting materials are the same (polyamines) and the final products are the same (polyisocyanates). The two processes, hydrogenation and phosgenation, are just switched so that hydrogenation is the second step versus being the first step performed in converting polyamines to polyisocyanates according to Bruchmann.

Appellants dispute the applicability of Durden to the facts in this appeal (Reply Brief, pp.2-3). Notwithstanding appellants' argument, we emphasize that Durden has not dispensed with the fact-intensive inquiry mandated by 35 U.S.C. § 103. See In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995) ("there are not 'Durden obviousness rejections' or 'Albertson obviousness rejections,' but rather only section 103 obviousness rejections"); see also In re Brouwer, 77 F.3d 422, 426, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). Therefore, to the extent that the process claimed by appellants and the process disclosed in Bruchmann may yield the same polyisocyanates, this fact alone holds little weight in the rejection under 35 U.S.C.

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§ 103 before us. Absent a more factually specific statement of the rejection, we cannot sustain the rejection of claims 1-16 under 35 U.S.C. § 103 as unpatentable over Bruchmann. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (the examiner bears the initial burden of presenting a prima facie case of unpatentability).

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Based on the record before us, the decision of the
examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ADRIENE LEPIANE HANLON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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APJ HANLON

APJ GARRIS

APJ WALTZ

DECISION:
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: December 1, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT