

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OWEN R. CHAMBERS and RODERIC N. F. SIMPSON

Appeal No. 1996-0696
Application 08/150,268¹

ON BRIEF

Before OWENS, WALTZ and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION

This is an appeal from the examiner's final rejection of

¹ Application for patent filed November 10, 1993. According to appellants, the application is a continuation of Application 08/033,434, filed March 18, 1993, now abandoned, which is a continuation of Application 07/782,323, filed October 24, 1991, now abandoned.

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claims 10, 17, 18 and 22-25, which are all of the claims remaining in the application.

THE INVENTION

Appellants claim a process for making a fluorinated ether having a recited formula by reacting an ether which has a specified formula and is in the vapor phase with a solid transition metal fluoride selected from a recited Markush group. Claim 10 is illustrative and reads as follows:

10. A process for the preparation of the of a fluorinated ether formula:

$$\text{R}''\text{-CF}_2\text{-CF}\begin{array}{c} | \\ \text{R} \end{array}\text{-O-CF}_2\text{-R}'$$

wherein R is hydrogen, R' is hydrogen or -CHF₂CF₃, and R'' is fluorine or perfluoroalkyl of 1 to 6 carbon atoms, which comprises reacting an ether of the formula:

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where R, R' and R" are hereinbefore defined in the vapor phase with a solid transition metal fluoride fluorinating agent selected from the group consisting of cobalt trifluoride, silver difluoride, potassium tetrafluorocobaltate, potassium hexafluoronickelate, manganese trifluoride, cerium tetrafluoride, mercuric fluoride and potassium tetrafluoroargentate.

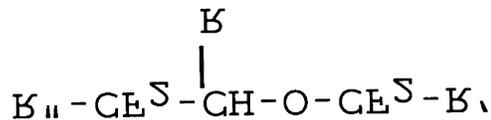
THE REFERENCES

McBee et al. (McBee) 1952	2,614,129	Oct. 14,
Drakesmith et al. (WO '909) 1984 (PCT application)	WO 84/02909	Aug. 2,

THE

Claims

25 stand



REJECTIONS

10, 17, 18 and 22-
rejected under 35

U.S.C. § 103 as being unpatentable over McBee and/or WO '909.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Appellants acknowledge that desflurane, which is the product recited in appellants' claim 10 when R' is hydrogen and R" is fluorine, was known in the art at the time of their invention (specification, page 1, lines 5-9), as was the recited starting material for making desflurane (specification, page 6, lines 17-22).

Neither of the references relied upon by the examiner discloses appellants' starting material or product. The examiner argues that one of ordinary skill in the art would have expected that using the processes of McBee and WO '909, wherein the fluorinating agent is, respectively, silver difluoride and cobalt trifluoride, to fluorinate appellants' starting material would have produced a mixture of compounds which includes partially fluorinated compounds in which different hydrogens are substituted (answer, pages 5-6).

This argument is not well taken because the examiner has

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not provided evidence or technical reasoning which shows that one of ordinary skill in the art would have reasonably expected the product mix to include some of the monofluorinated product recited in appellants' claim 10. The examiner provides only speculation, and such speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). Accordingly, we reverse the examiner's rejections.

Since no *prima facie* case of obviousness has been established, we need not address the experimental results relied upon by appellants. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

DECISION

The rejections of claims 10, 17, 18 and 22-25 under 35 U.S.C. § 103 over McBee and/or WO '909 are reversed.

REVERSED

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TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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