

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 JOHN T. WHITE
and D. MORGAN TENCH

Appeal No. 1997-0493
Application 08/336,353

ON BRIEF

Before PAK, WARREN and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 20.¹

We have carefully considered the record before us, and based thereon, find that we cannot sustain any of the three grounds of rejection under 35 U.S.C. § 103 based on the combined teachings of Tench, Baxter and Riggs, which in one of the grounds of rejection are further combined with Florence et al. (answer, pages 3-5).²

¹ See specification, pages 10-13, and the amendment of June 12, 1995 (Paper No. 4).

² The references relied on by the examiner are listed at pages 2-3 of the answer.

It is well settled that in order to establish a *prima facie* case of obviousness, “[b]oth the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness can be established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants’ disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chemical, supra*.

We reverse the grounds of rejection advanced on appeal because the prior art as applied by the examiner does not address the limitation of claim 1, and thus present in all of the appealed claims, that the electrolyte must be in the form of a *deoxygenated gel*. We interpret the term “deoxygenated gel electrolyte” in light of appellants’ specification as it would be interpreted by one of ordinary skill in this art to have its ordinary meaning of a gel electrolyte that is deoxygenated. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027, 1029 (Fed. Cir. 1997). Indeed, appellants disclose that the deoxygenated electrolyte can be “prepared by bubbling inert gas through an electrolyte solution and maintaining the electrolyte in an inert atmosphere during the gelling process” (specification, page 7). Appellant submits, *inter alia*, that the “use of a deoxygenated gel electrolyte . . . is not addressed by the Examiner and is not mentioned in any of the cited references” (brief, page 10; original emphasis omitted).

We agree with appellant that the examiner has not addressed this issue in the answer. In reviewing the prior art as applied by the examiner, we find no direction in Tench to deoxygenate the electrolyte solution employed in the methods disclosed therein (e.g., col. 1, line 57, col. 3, lines 26-29, and col. 5, lines 38-57). We find that Tench discloses that “[r]eservoir **50** contains an electrolyte solution **52** and an inert gas **54**, such as argon, *above* electrolyte **52**” that is “used to flush *air* from the system to eliminate . . . data caused by the presence of oxygen” (col. 5, lines 40-52; emphasis supplied). We find no disclosure in Baxter and Riggs which would suggest deoxygenating the

electrolyte prior to gelling. While Florence et al. may suggest the use of ascorbic acid to remove dissolved oxygen from test solutions (e.g., pages 127 and 133), there is no suggestion in the combination of this reference with Tench which would have suggested the use of such a scavenger or “getter” in the electrolyte solutions of Tench that are used under an inert gas to deoxygenate the electrolyte.

Accordingly, it is inescapable that the combined teachings of the references as applied by the examiner taken as a whole would not have resulted in the claimed method encompassed by the appealed claims. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988). Thus, on this record, it is manifest that the only direction to appellants’ claimed method as a whole on the record before us is supplied by appellants’ own specification.

The examiner’s decision is reversed.

Reversed

CHUNG K. PAK)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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