

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA MATSUNAGA, AKIRA FUJII,
SHINJI TSUYUTANI, TOSHIO NOZAKI
and MASAYUKI UEDA

Appeal No. 1999-1400
Application No. 08/849,211

HEARD: January 8, 2002

Before KIMLIN, GRON and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 3-6, all the claims remaining in the present application.

Claim 1 is illustrative:

1. A process for the preparation of a phosphoric monoester by reacting an organic hydroxyl compound with a pre-mixed phosphorylating agent consisting essentially of phosphorus pentoxide and at least one compound selected from the group

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consisting of water, phosphoric acid and polyphosphoric acid, under such conditions that a) the ratio as defined by formula (I) has a value in the range of from 0.5 to 1.0, and b) the ratio

defined by
 formula
 has a
 value in
 the
 range
 from
 to

$$\frac{\left[\begin{array}{l} \text{phosphoric acid} \\ \text{in the phosphoric acid} \\ \text{solution} \end{array} \right]}{\left[\begin{array}{l} \text{phosphoric acid} \\ \text{in the phosphoric acid} \\ \text{solution} \end{array} \right] + \left[\begin{array}{l} \text{polyphosphoric acid} \\ \text{in the phosphoric acid} \\ \text{solution} \end{array} \right]} \quad (II)$$

$$\frac{\left[\begin{array}{l} \text{phosphoric acid} \\ \text{in the phosphoric acid} \\ \text{solution} \end{array} \right]}{\left[\begin{array}{l} \text{phosphoric acid} \\ \text{in the phosphoric acid} \\ \text{solution} \end{array} \right]} \quad (I)$$

as
 defined
 form
 (II)
 value
 the
 of
 2.8
 3.2:

The examiner relies upon the following reference as evidence of obviousness:

Reierson 5,554,781 Sep. 10, 1996
 (filed Mar. 6, 1995)

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Appealed claims 1 and 3-6 stand rejected under 35 U.S.C. § 102(e), and under 35 U.S.C. § 103(a), as being unpatentable over Reierson.

The Reierson patent relied upon by the examiner has a filing date of March 6, 1995. The application which matured into the Reierson patent was a continuation-in-part of U.S. Serial No. 220,069, filed March 30, 1994, now abandoned. The threshold issue on appeal is whether the examiner properly relied upon the filing date of Reierson's parent application, March 30, 1994, as the effective date of Reierson as a reference under 35 U.S.C. § 102(e). Manifestly, the filing date of the Reierson patent, March 6, 1995, renders the patent ineffective as a reference under 35 U.S.C. § 102(e) against the present application, which has an effective filing date of December 9, 1994.

As accurately pointed out by appellants, and not refuted by the examiner, the patented claims of Reierson recite two limitations that are narrower than the subject matter disclosed in Reierson's parent application, namely, (1) exclusively reacting phosphoric anhydride and phosphoric acid,

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and (2) "the weight percent of the residual alcohol and phosphoric acid are individually each less than 6%."

The applicable law is stated in In re Wertheim, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981):

Thus, in a situation such as this, only an application disclosing the patentable invention before the addition of new matter, which disclosure is carried over in to the patent, can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a §§ 102(e)/103 rejection.

Hence, if the claim limitations in the Reierson patent regarding "exclusively reacting" and the amount of residual alcohol and phosphoric acid are new matter in the Reierson application, the filing date of the parent application cannot serve as the effective filing date of the Reierson patent as a reference.

In the present case, we concur with appellants that the examiner has not established, in the first instance, that the parent application described, within the meaning of 35 U.S.C. § 112, first paragraph, the claimed invention in the Reierson patent with respect to "exclusively reacting" and "the weight percent of the residual alcohol and phosphoric acid are individually each less than 6%." While the examiner states

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that "an examination of the first Reierson application does not describe or even suggest possible additional additives" (page 4 of Answer), the examiner has not established that the new "exclusively" limitation was not critical to the issuance of the Reierson patent. As stated in Wertheim, 646 F.2d at 563, 209 USPQ at 563, "the type of new matter added must be inquired into, for if it is critical to the patentability of the claimed invention,

a patent could not have issued on the earlier filed application and the theory of Patent Office delay has no application."

Likewise, the examiner has not established that the claim limitation regarding residual amounts of alcohol and phosphoric acid was described in the parent application, nor has the examiner demonstrated that the added limitation was not critical to the issuance of the Reierson patent. While the examiner

posits that this claim limitation is "inherently obtained" by

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practicing the invention described in the parent application (sentence bridging pages 4 and 5 of Answer), appellants have shown in their Reply Brief that the Reierson invention does not necessarily, or inherently, obtain products wherein the residual alcohol and phosphoric acid are individually each less than 6%. See pages 3 and 4 of appellants' Reply Brief.

Inasmuch as it is our judgment that Reierson is not an effective reference under 35 U.S.C. § 102(e)/103 against the presently claimed invention, we cannot sustain the examiner's rejections.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
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)	
TEDDY S. GRON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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