

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS BURJES
and CALVIN W. SCHROECK

Appeal No. 95-0460
Application 07/962,382¹

On BRIEF

Before KIMLIN, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner finally rejecting claims 1 through 12 and 37-44. Claims 13 through 36 are also of record and have been withdrawn from consideration by the examiner as directed to a nonelected invention.

The appealed claims as represented by claims 1 and 37 are drawn to compounds and compositions wherein the compounds contain two to about four phenol moieties bridged to each

¹ Application for patent filed October 16, 1992.

other ortho to the hydroxy substituent by an alkylene or alkylidene bridge. The phenol moieties further contain a tertiary alkyl group of from 4 to about 8 carbon atoms in the other ortho position, at least one aliphatic hydrocarbon group containing at least 7 carbon atoms para to the hydroxy substituent, and are unsubstituted in the meta positions. The claimed compounds are antioxidants and are used in "minor" amounts in composition with natural and synthetic resins, rubbers, oils, normally liquid fuels and waxes.

The references relied on² by the examiner are:

Sullivan	2,796,444	Jun. 18, 1957
Beaver et al. (Beaver) (Canadian Pat.)	480,524	Jan. 22, 1952

We have considered the following references made of record by appellants to the extent noted below:

Filbey et al. (Filbey)	2,807,653	Sep. 24, 1957
Knowles et al. (Knowles)	2,830,025	Apr. 8, 1958
Godin et al. (Godin)	928,169	Jun. 6, 1963

The examiner has rejected claims 1 through 12 and 37 through 44 on appeal under 35 U.S.C. ' 112, first paragraph, enablement, and second paragraph, as well as under 35 U.S.C. '103 as being unpatentable over Beaver and Sullivan. We reverse.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and to appellants' brief for a complete exposition thereof.

² We observe that the examiner has listed the references made of record by appellants in the IDS of July 15, 1994 (Paper No. 16) on page 2 of his answer but has not discussed or relied on these references in the answer.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in complete agreement with appellants that the examiner has failed to make out a *prima facie* case that the claims do not comply with any of the three statutory provisions as applied in the two grounds of rejection. With respect to ' 112, second paragraph, the examiner has not provided any explanation why one skilled in this art could not have determined the scope of the appealed claims from the disclosure in the specification (pages 5-7) pointed to by appellants. The examiner has also failed to provide any scientific explanation why one of ordinary skill in the art could not make and use the claimed compounds and compositions from the disclosure in the specification without undue experimentation as required by ' 112, first paragraph, enablement.

With respect to ' 103, we observe that the compounds disclosed by Beaver contain the hydroxy substituent in the para rather than in the ortho position to the alkylene bridge on the phenol moiety as in the claimed compounds, with the other two ring substituents also in relatively different positions. Thus, the claimed compounds and those of this reference may be said to be position isomers. The difference between the claimed compounds and those prepared by the processes disclosed by Sullivan have an alkyl substituent of 1 to 3 carbon atoms para to the hydroxy substituent on the phenol moiety rather than an aliphatic hydrocarbon group containing at least 7 carbon atoms as in the claimed compounds. Thus, the claimed compounds may be said to be higher homologs of the compounds of this reference. However,

the examiner has not established on this record that the actual structural relationship between the claimed compounds and those of Beaver and Sullivan is so close as to have reasonably suggested the claimed compounds as a whole to one of ordinary skill in this art at the time the claimed invention was made and thus has not established that the claimed compounds would have been *prima facie* obvious as a whole. Indeed, we note that Sullivan teaches that it is difficult to prepare such compounds and limits the alkyl substituent para to the hydroxy substituent on the phenol moiety to no more than 3 carbon atoms. We find no basis in either Sullivan or Beaver, on which to conclude that, in view of such teachings in Sullivan, the presence of an alkyl substituent in a different position on the ring of Sullivan's compounds, or of Beaver's compounds, would have reasonably suggested to one of ordinary skill in this art to extend the alkyl group in the para position to at least 7 carbon atoms (answer, page 5, lines 4-7). We also cannot conclude that one of ordinary skill in this art would have found it obvious from the teachings of Beaver alone or in combination with Sullivan that the alkyl substituents and the alkylene bridge could be in any position relative to the hydroxy substituent on the phenol moieties and still possess similar properties (answer, sentence bridging pages 3-4). *Cf. In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 254-55 (CCPA 1979).

The examiner's decision is reversed.

This application is *remanded* to the examiner to consider the references acknowledged by appellants in their specification (pages 2-3) and the references submitted by appellants in their Information Disclosure Statements (Papers No. 4 and 15) with respect to the applicability thereof to the

appealed claims under 35 U.S.C. ' 102 and 103. We have randomly reviewed several of these references on a cursory basis and find that the same are clearly relevant to the claimed invention. *For example*, it appears to us that the antioxidant compounds and compositions containing the same as disclosed by Knowles at least would have reasonably suggested (e.g., col. 2, lines 10-37, and col. 2, line 64, to col. 3, line 4), if not anticipated (e.g., col. 2, lines 48-49), the antioxidant compounds and compositions of at least appealed independent claims 1 and 37 to one of ordinary skill in this art. In similar manner, the antioxidant compounds and compositions containing the same disclosed by Filbey (e.g., col. 1, lines 19-24, col. 2, lines 1-18, and col. 6, lines 32-33; cf. col. 5, line 61, to col. 6, line 16) and by Godin (e.g., page 1, lines 34-45, page 2, lines 42-55) at least would have reasonably suggested the antioxidant compounds and compositions containing the same of these appealed claims to one of ordinary skill in this art. Because of the large number of references cited and submitted by appellants and the differences between the appealed dependent claims, we have not fully considered the references with respect to the claimed invention and thus decline to exercise our authority to enter new ground(s) of rejection under 37 CFR ' 1.196(b)(1993). Thus, we remand the case to the examiner for consideration of the references cited and submitted by appellants and to augment the record with respect to the knowledge of those of ordinary skill in this art as required.

We remand this application, via the Office of the Group Director, for appropriate action in view of the above comments.

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This application, by virtue of its "special" status, requires immediate action. See MPEP ' 708.01(d)(6th ed., Rev. 2, July 1996).

Reversed and Remanded

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
BRADLEY R. GARRIS)	BOARD OF PATENT
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