

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. SLACK
and HERSEL T. KEMP, II

Appeal No. 95-0801
Application 08/018,830¹

ON BRIEF

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

WALTZ, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 6, which are all the claims in this application.

According to appellants, the invention is directed to a

¹ Application for patent filed February 18, 1993.

Appeal No. 95-0801
Application 08/018,830

process of preparing polyisocyanates having isocyanurate structure which comprises heating an organic isocyanate at a temperature of 100-300EC. in the presence of a catalyst containing components (a) and (b)(main brief, page 2). Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A process for the preparation of a polyisocyanate having isocyanurate structure which comprises heating an organic polyisocyanate, or mixtures thereof, to a temperature of from about 100 to 300EC in the presence of a catalytic amount of

(a) a compound selected from the group consisting of

- i) lithium salts of aliphatic or aromatic monocarboxylic or dicarboxylic acids
- ii) lithium salts of hydroxyl group containing compounds having from 1 to 3 hydroxyl groups per compound, wherein said hydroxyl groups are directly attached to an aromatic ring, and
- iii) lithium hydroxide; and

(b) an organic compound containing at least one hydroxyl group for a period of from about 1 minute to about 240 minutes.

The examiner has relied upon the following reference in support of the rejection for lack of enablement under the

Appeal No. 95-0801
Application 08/018,830

first paragraph of 35 U.S.C. § 112:

Robin

4,412,073

Oct. 25, 1983

Claims 1 through 6 stand rejected under 35 U.S.C. § 112, first paragraph, as the enablement of the specification is not commensurate in scope with the claims (answer, page 1, last paragraph, and the paragraph bridging pages 2-3). We reverse this rejection for reasons which follow.

OPINION

The examiner states that appellants' disclosure is enabling only for claims limited to catalyst component (a)(i) containing a total of from about 1 to 36 carbon atoms, component (a)(ii) where the aromatic ring contains a total of from 6 to 18 carbon atoms, and to component (b) containing from 1 to 4 hydroxyl groups and having about 1 to 18 carbon atoms (answer, paragraph bridging pages 2 and 3). The examiner's position is that the claims should be limited to the inclusion of the clearly defined species of compounds which the appellants have disclosed as being operative in a process for the preparation of a polyisocyanate having an

Appeal No. 95-0801
Application 08/018,830

isocyanurate structure.? (answer, page 3). The examiner additionally takes the position ?that the specification would not enable any person skilled in the art to practice the process defined by each of the rejected claims without undue experimentation.? (answer, page 3). The examiner advances the reasoning that catalytic systems are generally considered unpredictable and specifically the catalysis of isocyanurate forming processes by alkali metal derivatives takes place unpredictably (answer, page 3, citing column 2, lines 34-38, of Robin).

The specification, when filed, must enable one skilled in the particular art to use the invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The specification must teach those of skill in the art how to make and use the invention as broadly as it is claimed. See *In re Goodman*, 11 F.3d 1046, 1050, 29 USPQ2d 2010, 2013 (Fed. Cir. 1993). However, it is well settled that the initial burden of establishing lack of enablement under the first paragraph of 35 U.S.C. § 112 lies with the examiner. See *In re Wright*, 999 F.2d 1557, 1561, 27

Appeal No. 95-0801
Application 08/018,830

USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

We find that the examiner has not met this initial burden of establishing lack of enablement. We agree with the examiner that many catalytic processes are unpredictable. See *In re Angstadt*, 537 F.2d 498, 502, 190 USPQ 214, 218 (CCPA 1976). However, the examiner's reliance on Robin to show unpredictability in the catalysts of the claimed process is misplaced. Robin, at column 2, lines 34-41, discloses that the onset of catalytic activity of alkali metal catalysts in the preparation of isocyanurates is unpredictable but does not teach that the components of the catalyst *per se* are unpredictable.

Additionally, it must be noted that the examiner only attempts to show the unpredictability of catalysts in the art but fails to analyze any other factors involved in the determination of undue experimentation. See *In re Wands*, *supra*. As stated by the court in *In re Angstadt*, *supra*, each case must be determined on its own facts. However, here, as in *Angstadt*, appellants have provided those skilled in the art

Appeal No. 95-0801
Application 08/018,830

with a large but finite list of catalyst components (see the specification, pages 3-6), have actually carried out 25 examples of varying scope, and have presented guidelines requiring only simple, routine experimentation. We find that the evidence as a whole negates the examiner's position that persons of ordinary skill in this art must engage in undue experimentation to determine what catalyst components will work. The key word is "undue", not experimentation. See *In re Angstadt*, 537 F.2d at 503, 190 USPQ at 219.

For the foregoing reasons, we find that the examiner has failed to meet the initial burden of presenting any evidence or reasoning as to why appellants' disclosure is insufficient to

enable one of ordinary skill in the art to carry out the invention as claimed. Accordingly, the rejection of claims 1 through 6 under 35 U.S.C. § 112, first paragraph, is reversed.

Appeal No. 95-0801
Application 08/018,830

REVERSED

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

Appeal No. 95-0801
Application 08/018,830

Miles Inc.
Mobay Road
Pittsburgh, PA 15205-9741