

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG WERBITZKY and PHILIPP STUDER

Appeal No. 1995-3054
Application No. 08/059,384¹

ON BRIEF

Before DOWNEY, HANLON and LIEBERMAN, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-16, all of the claims pending in the application. The claims on appeal are directed to a process for producing 2-chloro-5-chloromethyl-pyridine.

¹ Application for patent filed May 11, 1993.

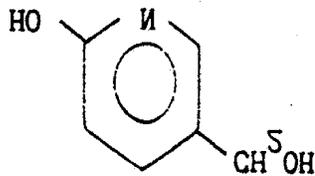
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Claim 1 illustrative of the claims on appeal and reads as follows:

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στυροκοωεφρυλ-βλκτγτμε οε ιοκωντγ Ι·

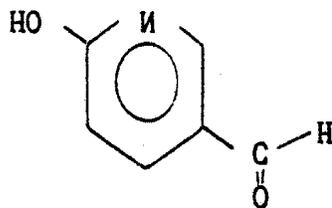
μλγροκλωεφρυλβλκτγτμε οε ιοκωντγ Ι το εμε δ-στυροκο-δ-
στυδ' τμ ε ιοκτμ εφεβ' στυοκτμσφτμδ εμε δ-μλγροκλ-δ-



Ι

δ-μλγροκλ-δ-μλγροκλωεφρυλβλκτγτμε οε ιοκωντγ:

μλγροκλτυσοφτμτς εστγ ετθεμλγε οε ιοκωντγ ΙΑ μτμ μλγροδευ το
τμ ε εμτγ εφεβ' εφετγλτςετγλ μλγροδευσφτμδ εμε ε-



ΙΑ

μλγροκλτυσοφτμτς εστγ ετθεμλγε οε ιοκωντγ:

μλγροκλτυσοφτμολγ στυοκτγ οε ιοκωντγ ΙΙΙ μτμ μλγροδευ το ε-

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The references relied upon by the examiner are:²

Lindel et al. (Lindel)	4,927,938	May 22, 1990
Jelich	4,958,025	Sep. 18, 1990

Hendrickson et al. (Hendrickson), "Oxidation and Reduction in Synthesis Sec. 18-8", Organic Chemistry, Third Edition, (1970) page 782.

1.

The sole issue³ in the appeal is whether claims 1-16 were properly rejected under 35 U.S.C. § 103 as unpatentable over the combination of Hendrickson, Lindel and Jelich. We reverse this rejection.

Discussion

² In the "Response to argument" (Answer, pp. 7-24), the examiner mentions three additional references. As stated in In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection"). Since these references have not been included in the statement of the rejection, we have not considered them in reaching our decision in this appeal.

³ In the Answer, claim 2 was the subject of a "new ground of rejection" based on 35 U.S.C. § 112, second paragraph (Answer, pp. 5-6). However, that rejection was withdrawn by the examiner in the Supplemental Examiner's Answer (see Paper No. 20, p. 1).

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The claims on appeal are directed to a process for producing 2-chloro-5-chloromethyl-pyridine comprising four distinct steps carried out with specific reactants in a particular sequence. According to the examiner (Answer, pp. 7-8):

Hendrickson teaches all four steps. Lindel shows an example of the instantly claimed step A. The Examiner does not rely upon more of the Lindel reference. Jelich shows the instantly claimed steps C and D (being conducted under similar conditions). . . . The product is known and has a valuable utility. The starting reactants are known. Steps A, B and C are taught in one-half of the diagram in Hendrickson (see the right half of figure 18-3). Steps C and D are taught in the left-half of the Hendrickson diagram. Due to this, it is the Examiner's position that the instantly claimed process is obvius [sic, obvious] over the combination of Hendrickson, Lindel and Jelich.

Appellants argue (Brief, p. 15):

[T]here is not any basis in the prior art of record for combining and modifying Hendrickson et al., Lindel et al. and Jelich in the manner suggested by the Examiner in her search for appellants' invention. In In re Geiger, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987), it was stated that, "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absence some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)." With regard to appellants' invention, the Examiner must have pointed to one or more sections

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of the cited references which suggest or teach the combination of references and modifications thereof asserted by the Examiner in her search for appellants' invention. The Examiner has not done this in the record.

While we recognize that the reactions disclosed in Hendrickson are known reactions, we agree with appellants that there is no suggestion in Hendrickson to perform the disclosed reactions in the order claimed by appellants to produce 2-chloro-5-chloromethyl-pyridine. Furthermore, the teachings in Lindel and Jelich fail to cure the deficiencies of Hendrickson. Without the benefit of appellants' disclosure there would have been no motivation to combine the teachings of Hendrickson, Lindel and Jelich as suggested by the examiner to arrive at appellants' claimed process. See In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps; the references themselves must provide some teaching whereby the applicant's combination would have been obvious).

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The examiner argues that appellants have failed to establish unexpected results of the claimed invention (Answer, p. 22). However, the examiner has improperly shifted the burden to appellants. The examiner bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Based on the record before us, the examiner has failed to satisfy that burden.

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For the reasons set forth above, the rejection of claims 1-16 under 35 U.S.C. § 103 as unpatentable over the combination of Hendrickson, Lindel and Jelich is reversed.

REVERSED

MARY F. DOWNEY)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ADRIENE LEPIANE HANLON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
PAUL LIEBERMAN)	
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