

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 ERNST G. LESER and JAMES A. WINGRAVE

Appeal No. 96-3426
Application No. 08/115,274¹

ON BRIEF

Before GARRIS, PAK and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 4, 6 through 10 and 12 through 16, which are all of the claims remaining in the application. An amendment filed concurrently

¹ Application for patent filed August 31, 1993.

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with the Brief on September 11, 1995 (Paper no. 14) was entered for purposes of appeal. See the advisory action dated November 28, 1995 (Paper no. 15).

THE INVENTION

The invention is drawn to a method for making an emulsion by contacting a solid which contains at least one of tetraethyl lead or bromoethane with a solution having an appropriate hydrophilic lipophilic balance or HLB value, the solution being present at a sufficient concentration to emulsify tetraethyl lead and bromoethane. Thereafter the emulsion is separated from the solid, and recovered.

THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced below.

1. A method for making an emulsion comprising:
 - (a) preparing an aqueous surfactant solution,
 - (b) contacting a solid, which contains at least one of a tetraalkyllead and a bromoethane with an amount of the solution that has a hydrophile lipophile balance value and concentration sufficient to form an emulsion comprising at least one of a tetraalkyllead and a bromoethane,

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- (c) separating the emulsion from the solids, and;
- (d) recovering the emulsion.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references.

Guymon 1993	5,252,138	Oct. 12,
Lahoda et al. (Lahoda) 1993	5,266,494	Nov. 30,
Hosmer et al. (Hosmer) 1994	5,302,320	Apr. 12,

THE REJECTION

Claims 1 through 4, 6 through 10 and 12 through 16 stand rejected under 35 U.S.C. § 103 as unpatentable over Lahoda in view of Guymon and Hosmer.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection are not well founded. Accordingly, we will not sustain the rejection.

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"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner relies upon a combination of three references to reject the claimed subject matter. The basic premise of the rejection is that Lahoda discloses the procedure of removing organic materials from solids by treatment of the soil with surfactants to solubilize the organics. See column 9, 31-35. Exemplification is found in Example 2 which uses a mixture of gasoline, lead and diesel. The secondary references to Guymon and Hosmer disclose the use of surfactants such as ethoxylated alcohols or ethoxylated nonyl phenols respectively for removal or emulsification of hydrocarbons respectively, including gasoline.

However, none of the references before us disclose the presence of either tetraethyl lead or bromobutane as required by the claimed subject. According, the dispositive issues before are whether the gasoline component disclosed by the references of record inherently includes the presence of tetraethyl lead or bromobutane and whether the treatments by

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the emulsion prepared in the references of record would remove either tetraethyl lead or bromobutane.

It is the examiner's position, with respect to tetraethyl lead and bromobutane, that "these compounds would be present in at least some degree in contaminated soil in view of the long use of tetraethyl lead as an antiknock/octane enhancer booster in gasoline." See Answer, paragraph bridging pages 5 and 6. We disagree. Inherency requires that the characteristic must necessarily be present. It may not be established by probabilities or possibilities. The mere fact that tetraethyl lead may be present in gasoline contaminated soil is not sufficient. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986). The examiner must provide some evidence or scientific reasoning that the presence of tetraethyl lead is an inherent characteristic of the prior art composition. In the case before us no such evidence or reasoning has been set forth.

Furthermore, appellants in referring to the statement in the Answer above have argued that, "[t]his statement is unsupported by Lahoda or conventional practice as of the

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filing date of Lahoda, i.e., Jan. 31, 1991. On Jan. 1991 tetraethyl lead was not normally used in the U.S. as an antiknock/octane booster in gasoline since such usage was regulated out of existence." See Brief, page 5. We agree. We add only that even when tetraethyl lead was widely used, gasoline was available free of tetraethyl lead.

In addition, the references before us neither disclose nor suggest the removal of tetraethyl lead or bromobutane. Lahoda removes gasoline, diesel oil and lead in Example 2. However, there is no teaching or suggestion that tetraethyl lead or bromobutane is present, and even if present would be removed by Lahoda's process. Moreover, the secondary references to Guymon and Hosmer are specifically directed to the removal of hydrocarbons, the first in the absence of emulsion formation and the second in the presence of emulsion formation. Neither tetraethyl lead nor bromobutane are hydrocarbons. We find no reason to conclude that the removal of hydrocarbons will result in the simultaneous removal of tetraethyl lead or bromobutane. Based upon the above consideration, we conclude that the examiner has met his burden of establishing a *prima facie* case of obviousness.

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Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion is not supported by the facts it cannot stand. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

DECISION

The rejection of claims 1 through 4, 6 through 10 and 12 through 16 under 35 U.S.C. § 103 as unpatentable over Lahoda in view of Guymon and Hosmer is reversed.

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The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PAUL LIEBERMAN)	
Administrative Patent Judge)	

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Michael K. Boyer
E.I. du Pont de Nemours & Co.
Legal-Patents
Wilmington, DE 19898