

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUJIO YAGIHASHI
and MINORU TAKAMIZAWA

Appeal No. 1997-2270
Application 08/294,214

ON BRIEF

Before KIMLIN, OWENS and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1 and 5-9, which are all of the claims remaining in the application.

THE INVENTION

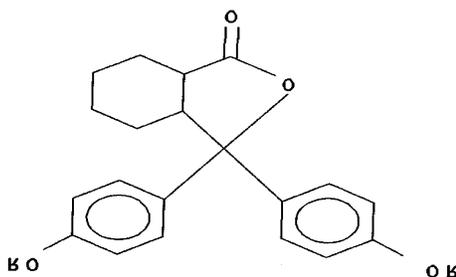
Appellants claim a bisphenol derivative which, appellants

state (specification, pages 1 and 4), is useful as an intermediate in the synthesis of compounds and as an indicator of hydrogen ion concentration.

Claim 1 is

reads as

1. A
of the following



illustrative and

follows:

bisphenol compound
formula:

where each R is a lower alkyl group, tetrahydropyranyl, methoxymethyl or trialkylsilyl group, and each of the benzene rings in the formula are optionally substituted by a lower alkyl group.

THE REFERENCES

Fukui et al. (JP '473)¹ 02-311473 Dec. 27,
1990
(Japanese Kokai)

¹Our consideration of this reference is based upon an English translation thereof, a copy of which is provided to appellants with this decision.

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Theodora W. Greene and Peter G.M. Watts (Greene), *Protective Groups in Organic Synthesis* 413 (John Wiley & Sons 1991).

THE REJECTION

Claims 1 and 5-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellants' acknowledged prior art in view of JP '473 and Greene.

OPINION

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

Appellants acknowledge that at the time of their invention a bisphenol derivative was known in the art which differed from appellants' claimed compound only in that the substituents on the phenyl rings were unprotected hydroxyl groups rather than appellants' protected hydroxyl (i.e., -OR) substituents (specification, page 1).

Green discloses that the protecting groups recited in appellants' claim 1 were known in the art at the time of appellants' invention (page 413). Green does not disclose a method of adding these protecting groups to compounds.

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JP '473 discloses fused lactones wherein a group can be either hydroxyl or a protected hydroxyl, and discloses a method for protecting the hydroxyl groups of the fused lactones (pages 2 and 15).

The examiner argues that "[i]t would have been prima facie obvious at the time the claimed invention was made to protect the hydroxy groups of the prior art by using the conventional hydroxy groups as taught by Japanese patent J 02-311473 and Greene et al. to form the protected prior art compounds without the loss of the same activity" (answer, page 3). For the following reasons, the examiner's argument is not persuasive.

First, as argued by appellants (brief, pages 4-5), the examiner has not explained why the applied prior art would have motivated one of ordinary skill in the art to use protecting groups for the hydroxyl groups of the prior art bisphenol derivative. Appellants argue that the fused lactones of JP '473 are not structurally similar to appellants' claimed compound (brief, page 5), and the examiner does not challenge this argument. Also, the examiner has not established that the mere knowledge that the protecting groups

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disclosed by Green were known in the art would have led one of ordinary skill in the art to use these groups as protecting groups for the admitted prior art bisphenol derivative.

Second, even if one of ordinary skill in the art desired to use appellants' protecting groups to protect the hydroxyl groups of the acknowledged prior art bisphenol derivative, the examiner has not established that such a person would have had a reasonable expectation of success in doing so. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). Appellants provide a declaration by Fujio Yagihashi (filed January 23, 1996, attachment to paper no. 5) which shows that when an attempt was made to use the method of JP '473 to add protecting groups to the hydroxyl groups of the admitted prior art bisphenol derivative, the method was not successful. The examiner argues that the reason why the experiment in the declaration failed was that a successful process, such as appellants' process, was not used (answer, page 4). The examiner, however, has provided no evidence that the process used by appellants was known in the art at the

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time of appellants' invention, or that any other process was known in the art at that time which would have been effective for protecting the hydroxyl groups of the admitted prior art bisphenol derivative.

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient for supporting a conclusion of obviousness of the invention recited in any of appellants' claims. Consequently, we reverse the examiner's rejection.

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DECISION

The rejection of claims 1 and 5-9 under 35 U.S.C. § 103 over appellants' acknowledged prior art in view of JP '473 and Greene is reversed.

REVERSED

)	
EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
PETER F. KRATZ))
Administrative Patent Judge)	

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