

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LAWRENCE ALLEN FLOOD and RAM BABOO GUPTA

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Appeal No. 1997-3045  
Application 08/286,835<sup>1</sup>

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ON BRIEF

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Before WILLIAM F. SMITH, WARREN and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's final rejection of claims 3-17 and 21-25, which are all of the claims remaining in the application.

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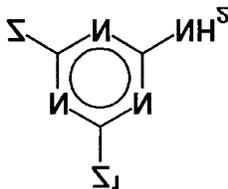
<sup>1</sup> Application for patent filed August 5, 1994.

*THE INVENTION*

Appellants claim a process for making a carboxylated amino-1,3,5-triazine by reacting an amino-1,3,5-triazine having a recited formula with carbon dioxide in the presence of a base. Claim 21 is illustrative and reads as follows:

21. A process for preparing a carboxylated amino-1,3,5-triazine comprising the step of contacting:

(i) an amino-1,3,5-triazine having at least one  $\text{NH}_2$  group or an oligomer thereof, the amino-1,3,5-triazine being represented by the general formula



wherein  $\text{Z}$  and  $\text{Z}^1$  are independently selected from the group consisting of hydrogen, a hydrocarbyl, a hydrocarbyloxy and a group represented by the formula  $-\text{N}(\text{Q})_2$ , and

each  $\text{Q}$  is independently selected from the group consisting of hydrogen and a hydrocarbyl;

(ii) carbon dioxide; and

(iii) a base,

under reaction conditions sufficient to produce a corresponding carboxylated amino-1,3,5-triazine.

Appeal No. 1997-3045  
Application 08/286,835

*THE REFERENCES*

McGhee et al. (McGhee)	5,189,205	Feb. 23, 1993
McGhee et al. (EP '948) (European patent application)	0 511 948 A2	Nov. 4, 1992
McGhee (WO '032) (PCT application)	WO 94/17032	Aug. 4, 1994

Yasuhiko Yoshida et al. (Yoshida), "A Direct Synthesis of Carbamate Ester from Carbon Dioxide, Amine and Alkyl Halide", *Chem. Lett.* 1571-72 (1984).

*THE REJECTIONS*

Claims 3-17 and 21-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over McGhee, EP '948, WO '032 or Yoshida.<sup>2</sup>

*OPINION*

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

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<sup>2</sup> The examiner states in the answer that claims 1-17 are rejected (page 3). However, because the examiner states in the answer (page 1) that the appeal involves claims 3-17 and 21-25 and states in the final rejection (mailed November 20, 1995, paper no. 7) that claims 3-17 and 21-25 are rejected, the statement in the answer that claims 1-17 are rejected appears to be inadvertent. Thus, we consider the rejection of claims 3-17 and 21-25 to be before us.

Appeal No. 1997-3045  
Application 08/286,835

The examiner argues that the applied references disclose reacting amines with carbon dioxide in the presence of a base, that the claims differ from the references only in that a different amine is used as the starting material, and that one of ordinary skill in the art would have expected appellants' amines and those in the references to react similarly (answer, page 3). This argument is not well taken because, although appellants have challenged the argument (brief, page 4), the examiner has provided no supporting evidence which establishes that the applied references, separately or combined, would have indicated to one of ordinary skill in the art that appellants' amino-triazine and the primary and secondary amines of the references react similarly.

Appellants argue, in reliance upon *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) and *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995), that the examiner improperly has applied a *per se* rule of obviousness (brief, pages 3-4). The examiner argues that *Brouwer* and *Ochiai* are not on point because "neither the starting material, amino-1,3,5-triazine, diamino-1,3,5-

Appeal No. 1997-3045  
Application 08/286,835

triazine or melamine are new or the product 2,4,6-carbamate-1,3,5-triazine are novel" (answer, page 5). This argument does not have a sound factual basis because the product made by appellants' claimed process is not a carbamate. The product is a compound which contains an aminocarboxyl group or the salt thereof (specification, page 4, lines 30-32). A carbamate functional compound can be formed in a subsequent step by reacting the product of appellants' claimed process with a hydrocarbylating agent (specification, page 7, lines 15-19). The examiner has provided no evidence that appellants' carboxylated amino-1,3,5-triazine was known in the art.

Moreover, regardless of whether appellants' starting material and product were known, the examiner's argument that "[o]nce the examiner has cited prior art showing a general reaction to be old, the burden is on applicant to present evidence for believing that triazine ring would take part in or affect the carbonylation of amino group disclosed in the references" is based upon a *per se* rule. As stated by the court in *Ochiai*, 71 F.3d at 1572, 37 USPQ2d at 1133:

Appeal No. 1997-3045  
Application 08/286,835

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention - including all its limitations - with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease.

The examiner has not carried out the required fact specific analysis. That is, the examiner has not explained why evidence relied upon by the examiner shows that one of ordinary skill in the art would have been led to make appellants' carboxylated amino-1,3,5-triazine by reacting appellants' starting amine compound with carbon dioxide in the presence of a base, and 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); *In re Longi*, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985).

For the above reasons, we conclude that the examiner has

Appeal No. 1997-3045  
Application 08/286,835

not carried his burden of establishing a *prima facie* case of obviousness of the invention recited in any of appellants' claims.

*DECISION*

The rejection of claims 3-17 and 21-25 under 35 U.S.C. § 103 over McGhee, EP '948, WO '032 or Yoshida is reversed.

*REVERSED*

WILLIAM F. SMITH                    )  
Administrative Patent Judge        )  
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Appeal No. 1997-3045  
Application 08/286,835

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CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
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TERRY J. OWENS	)	)
Administrative Patent Judge	)	

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