

The opinion in support of the decision being entered today was *not* written for publication and 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 BARRY A. CULLEN
and BRIAN A. PARKER

Appeal No. 1999-1244
Application 08/453,003

ON BRIEF

Before KIMLIN, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the rejections of appealed claims 14, 17 and 18,¹ under 35 U.S.C. § 103 as being unpatentable over Hershmann.²

It is well settled that “[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be

¹ Claims 1 through 13, 15, 16 and 19 through 22 are also of record and stand allowed.

² Answer, pages 3-6.

carried out and would have a reasonable likelihood of success viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) ("When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]"); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

We find that, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), the plain language of appealed claim 14 requires in step "(d) ceasing said oxidation when the concentration of oxygen in said gaseous reaction products increases at a predetermined rate," which "gaseous reaction products" are vented from the vessel in step (c). We have carefully compared this requirement of the claimed process with the disclosure of Hershmann Example 4 as explained by the examiner and in light of appellants' arguments. While we agree with the examiner that the samples taken every half hour from the autoclave would have been analyzed to monitor the course of the reaction, we find no teaching within this reference which would have led one of ordinary skill in this art to modify the process of the reference by monitoring the reaction gases and using that information in the manner required by the claims, and the examiner has not established that knowledge in the art would have provided such a suggestion. Accordingly, we cannot subscribe to the examiner's reasoning and thus must reverse the rejection.

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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CHARLES F. WARREN)	
Administrative Patent Judge)	

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