

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OTTO NEUNER,
NORBERT LUI, DIETMAR BIELEFELDT,
and MICHAEL HOLZBRECHER

Appeal No. 2001-2300
Application No. 09/152,595

HEARD: January 22, 2003

Before OWENS, WALTZ, and PAWLIKOWSKI, **Administrative Patent Judges**.¹

PAWLIKOWSKI, **Administrative Patent Judge**.

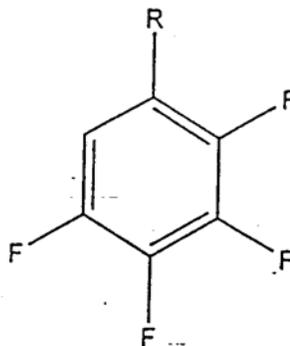
DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 2-7 and 9-11, the remaining claims in this application.

Claim 11 is representative of the subject matter on appeal and is set forth below:

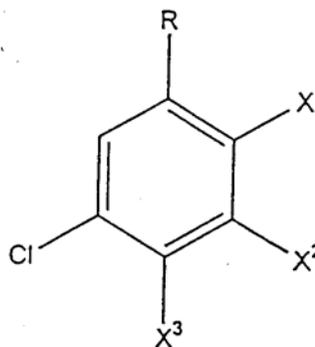
¹ One of the members of this merits panel has been substituted for a member at the oral hearing. See In re Bose, 772 F.2d 866, 868, 227 USPQ 1, 2 (Fed. Cir. 1985).

11. A process for the preparation of tetrafluorobenzene derivatives of the formula (I):



in which R is CF_3 , CN or COF, comprising:

reacting a chlorobenzene derivative of the formula (II):



in which R is as defined for Formula (I) and X^1 , X^2 , and X^3 , independently of another, are each F or Cl, with potassium fluoride in the presence of a solvent and catalyst under an initial pressure of from 1.3 to 6 bar and at an initial temperature of from 160 to 230 °C, such that the compound (I) is continuously distilled off through a column, and

subsequently setting the temperature and pressure conditions such that remaining fractions of the compound (I) distill off together with 2,3,4-trifluoro-5-chlorobenzene compound.

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(Fed. Cir. 1992). We also note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Here, the examiner has not shown such a teaching, suggestion, motivation or explanation. As mentioned above, the examiner simply states that "[t]he motivation to use the instantly claimed starting material in the prior art process is derived from the fact that it is a known compound and there would have been a reasonable expectation of obtaining the corresponding known useful product". (answer, page 3). Because of this lack of teaching, suggestion, motivation or explanation, we determine that the examiner has not established a prima facie case of obviousness. See In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ 1127 (Fed. Cir. 1995); In re Brouwer, 77 F.3d 422, 424, 37 USPQ2d 1663 (Fed. Cir. 1996).

Because we have determined that the examiner has not set forth a prima facie case obviousness, we do not need to reach the issue of whether or not the showing of unexpected results discussed in appellants' appeal brief and reply brief is sufficient. In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

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Conclusion

The rejection is reversed.

REVERSED

Terry J. Owens)
Administrative Patent Judge)
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) BOARD OF PATENT
) APPEALS AND
THOMAS A. WALTZ) INTERFERENCES
Administrative Patent Judge)
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BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

BAP/sld

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