

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THOMAS Z. LI

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Appeal No. 2002-1751  
Application No. 09/098,679

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ON BRIEF

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Before WINTERS, TIMM, and GRIMES, *Administrative Patent Judges*.  
TIMM, *Administrative Patent Judge*.

***DECISION ON APPEAL***

This appeal involves claims 1-16 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

***INTRODUCTION***

The claims are directed to processes for improving the stability of glycerin and the products made by those processes. According to Appellant, glycerin oxidatively degrades upon prolonged storage or upon heating during finished good processing (specification, pp. 4-5). The degradation results in unwanted discoloration (specification, p. 5). Appellant adjusts the pH of

glycerin to inhibit the oxidative degradation and thus prevent discoloration (*Id.*). Claims 1, 5, 9, and 13 are illustrative of the subject matter on appeal:

1. A process for inhibiting the oxidative degradation of glycerin comprising adjusting the pH of glycerin to a range of from about 3.5 to about 5.0.
5. A process for inhibiting the oxidative degradation of glycerin comprising adjusting the pH of glycerin to a range of from about 10.0 to about 12.0.
9. The product of the process of claim 1.
13. The product of the process of claim 5.

All of the claims are rejected under 35 U.S.C. § 102(b). As evidence of anticipation, the Examiner relies upon the following prior art references:

Shaw et al. (Shaw)	5,134,130	Jul. 28, 1992
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CAPLUS Abstract (1972) of Turanskii et al., *Automatic Control of the Purification of Spent Lyes*, 37(11) Maslo-Zhir. Prom. 20 (1971) (Turanskii).<sup>1</sup>  
CAPLUS Abstract (1995) of Ueoka et al., JP 06184024 A2 (1994) (Ueoka).<sup>2</sup>

The Examiner lists six separate rejections over the three references. For simplicity, we will list the rejections as follows:

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<sup>1</sup>Appellant states that a copy of the Turanskii article was not received, only an abstract (Brief, p. 3). While the Examiner's statement of rejection lists the article, only the abstract is discussed (Answer, p. 4). A copy of the article and a translation thereof were not obtained until after the Brief was filed and there is no evidence that copies were forwarded to Appellant. Given that Appellant appears not to have had an opportunity to respond to the contents of the article, we will limit our review to the abstract. Copies of the article and translation accompany our Decision.

<sup>2</sup>Again, it appears the Examiner relied upon the abstract and Appellant was not given an opportunity to respond to the later obtained translation. We, therefore, limit our review to the abstract. We enclose a copy of the translation with our Decision.

1. Claims 1-7 and 9-16 as anticipated by Turanski.
2. Claims 1-4 and 9-12 as anticipated by Ueoka.
3. Claims 5-8 and 13-16 as anticipated by Shaw.

We reverse the rejections for the following reasons.

### ***OPINION***

The main purpose of examination is to determine whether the subject matter of the claims is patentable and, thus, the name of the game is the claims. *See In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). The very first question upon examination is thus: *What is the thing that is claimed.* *See Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Often, as in this case, claim interpretation will control the remainder of the decisional process. *Id.*

In the present case, the Examiner provides a conclusory statement of how the claims are being interpreted without providing the details of how this determination was made. Specifically, in response to Appellant's arguments that the references fail to disclose the pH of recovered glycerol, the Examiner states that "the claims of the instant application are broad enough to read on glycerin in a mixture." (Answer, p. 5). The Examiner states that no isolation or purification of the glycerin is required (*Id.*) and that there is no indication that the glycerin product is limited to an isolated or purified glycerin product (Answer, p. 6).

The basic question we must answer is whether the Examiner's interpretation is "reasonable" in light of the evidence before us. To this end we must give the claims their

broadest reasonable interpretation; this interpretation must be consistent with what those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999). With regard to the individual words of the claims, where consistent with the specification, we must give those words their ordinary and accustomed meaning. *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). We cannot ignore any interpretative guidance afforded by the specification. *In re Morris*, 127 F.3d 1048, 1053, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Moreover, the words must not be taken out of the context of the claim in which they occur. The claim is viewed as a whole and read in accordance with the precepts of English grammar. *See Abbott Labs. v. Syntron Bioresearch Inc.*, 334 F.3d 1343, 1351, 67 USPQ2d 1337, 1342 (Fed. Cir. 2003); *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

With regard to the individual words of the claim, the key word is “glycerin.” The Examiner notes that the term glycerin applies to purified commercial products normally containing  $\geq 95\%$  of glycerol (Answer, p. 3). This usage of the term is consistent with the ordinary and accustomed meaning in the art.<sup>3</sup> According to this usage of the term, glycerin is a composition which cannot contain anymore than 5% chemical compounds other than the chemical compound glycerol. Appellant does not define the term “glycerin” nor does Appellant give reasonable notice that the term is to have a different meaning. We, therefore, adopt the

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<sup>3</sup>See *Glycerol Nomenclature* in 12 Kirk-Othmer Encyclopedia of Chemical Technology 681 (Jacqueline I. Kroschwitz & May Howe-Grant eds., 4<sup>th</sup> ed. 1996). A copy accompanies this Decision.

ordinary and accustomed meaning of which we have evidence. *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

We must, however, look at more than just the term “glycerin” to interpret the claim, we must look at the claim as a whole. In this regard, claim 1 is illustrative of the issues. Claim 1 is directed to a process for inhibiting the oxidative degradation of *glycerin* (composition containing at least 95% glycerol) comprising adjusting the pH of *glycerin* (composition containing at least 95% glycerol). What is adjusted in pH is glycerin, the composition referred to in the preamble. To meet the requirements of the claim, one must start with a composition containing at least 95% glycerol and add pH adjusting ingredients thereto. While the claim uses the transitional term “comprising” the interaction between the preamble and the body of the claim precludes using mixtures containing less than 95% glycerol as starting materials in the adjustment.

The interpretation we give the claim is consistent with the specification. The specification does not describe pH adjustment of mixtures containing glycerin as an ingredient, it only speaks in terms of adjusting the pH of glycerin itself. For instance, all the examples are directed to compositions which contain only glycerin, water and pH adjusting acid or base (specification, pp. 6-12) and these examples are said to show how adjusting the pH of glycerin enhances the stability of glycerin as it relates to oxidative degradation (specification, p. 12).

We determine that the claims are limited to taking a composition containing at least 95% glycerol and adjusting the pH of that composition. The Examiner has not established that any of the references describe an adjustment of the pH of glycerin to the levels claimed or the resulting

product. Turanskii and Ueoka are relied upon for their descriptions of pH adjustment of intermediate mixtures present in processes of glycerol recovery. Glycerol is present in these mixtures of the references, but not at levels of at least 95%. Nor has the Examiner established that the end product glycerin of either process has the required pH. The intermediates undergo filtration, distillation and other recovery steps which would likely influence the pH. Shaw is relied upon for the adjustment of the pH of a lipid emulsion containing glycerin, the emulsion is not "glycerin." We, therefore, find that the Examiner has not established anticipation with regard to the subject matter of any of the claims.

### ***CONCLUSION***

To summarize, the decision of the Examiner to reject claims 1-16 under 35 U.S.C. § 102(b) is reversed.

REVERSED

SHERMAN D. WINTERS )  
Administrative Patent Judge )  
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) BOARD OF PATENT  
CATHERINE TIMM ) APPEALS  
Administrative Patent Judge ) AND  
) INTERFERENCES  
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ERIC GRIMES )  
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