

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY L. RENKEN and MATTHEW W. FORKNER

Appeal No. 2005-0515
Application No. 10/124,925

ON BRIEF

Before GARRIS, PAK, and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-5, 11 and 12.

The subject matter on appeal relates to a catalyst which consists essentially of nickel, copper and chromium and wherein the improvement comprises the further inclusion of tin in the catalyst. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

Appeal No. 2005-0515
Application No. 10/124,925

1. In a catalyst useful in a reductive amination process for producing amines from alcohols, aldehydes, or ketones, wherein said catalyst consists essentially of nickel, copper and chromium, the improvement comprising the further inclusion of tin in said catalyst.

The reference set forth below is relied upon by the examiner as evidence of obviousness:

Bartley et al. (Bartley) 6,534,441 Mar. 18, 2003

All of the claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartley.¹

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

We are in complete agreement with the findings of fact, conclusions of law and rebuttals to argument expressed by the examiner in the answer. As a consequence, we hereby adopt these findings, conclusions and rebuttals as our own. We add the following comments for emphasis only.

¹On page 3 of the brief, the appellants state that "all claims should stand or fall together based upon the decision concerning claim 1." Therefore, in assessing the merits of the rejection before us, we will focus on independent claim 1.

Appeal No. 2005-0515
Application No. 10/124,925

The pivotal issue in this appeal is whether appealed claim 1 excludes the rhenium present in the catalyst composition of Bartley. The examiner argues that rhenium is not excluded by this claim and therefore does not propose any modification to patentee's composition vis-à-vis the absence versus presence of rhenium. In support of her interpretation of claim 1, the examiner advances a number of rationales.

In the first place, the examiner points out that the claim 1 phrase "consists essentially of" excludes only those ingredients which would materially affect the basic and novel characteristics or properties of the appellants' claimed catalyst composition. This is, of course, correct. See PPG Indus. v. Guardian Indus., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998); Atlas Powder Co. v. E.I. Dupont de Nemours & Co., 750 F.2d 1569, 1574, 224 USPQ 409, 411-12 (Fed. Cir. 1984); In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); In re De LaJarte, 337 F.2d 870, 873-74, 143 USPQ 256, 258 (CCPA 1964); In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963). The examiner also points out that it is the appellants' burden to establish that the rhenium ingredient of Bartley's catalyst composition, in fact, would materially affect the basic and novel

Appeal No. 2005-0515
Application No. 10/124,925

characteristics of the here claimed composition and therefore is excluded by the claim 1 language "consists essentially of." It is undisputed that the appellants have proffered no such proof on the record before us, and accordingly the examiner considers claim 1 to not exclude patentee's rhenium ingredient.

In response, the appellants argue that the Bartley reference itself evinces that rhenium would effect the basic and novel characteristics of patentee's composition. The deficiency of this argument stems from the fact that the appellants have misfocused the relevant inquiry. The question here is whether rhenium would affect the basic and novel characteristics of the appellants' catalyst not Bartley's catalyst. See Id.

In addition, the appellants disagree with the examiner's basic position that it is their burden to show that the rhenium of patentee's catalyst is excluded by the "consists essentially of" language of claim 1. However, the appellants are plainly incorrect on this matter. The placement of this burden on an applicant is well settled. See PPG, 156 F.3d at 1355, 48 USPQ2d at 1355; Herz, 537 F.2d at 551-52, 190 USPQ at 463; De LaJarte, 337 F.2d at 873-74, 143 USPQ at 258; Janakirama-Rao, 317 F.2d at 954, 137 USPQ at 896. Moreover, the fairness of so allocating this burden is evidenced by the inability of the Patent and

Appeal No. 2005-0515
Application No. 10/124,925

Trademark Office to obtain and compare prior art catalysts with and without the ingredient argued by an applicant to be excluded by his "consists essentially of" language. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

For these reasons alone, based on the record before us on this appeal, it is proper to interpret appealed independent claim 1 as not excluding the rhenium of Bartley by virtue of the claim language "consists essentially of."

However, the examiner has advanced another reason for interpreting this claim as including rather than excluding rhenium. More particularly, the examiner argues that rhenium is included by the term "comprising" in the claim 1 language "the improvement comprising the further inclusion of tin in said catalyst." This argument is well taken since the term "comprising" has long been interpreted as including ingredients other than those recited in a claim. See In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). Also see Berenter v. Quigg, 737 F.Supp. 5, 6-7, 14 USPQ2d 1175, 1176 (D.D.C. Oct. 31, 1988). Moreover, it is significant and noteworthy that the appellants have proffered no rebuttal whatsoever to this well taken argument. Compare the first paragraph on page 6 of the answer with the reply brief in its entirety.

Appeal No. 2005-0515
Application No. 10/124,925

In light of the foregoing, it is our ultimate finding that appealed claim 1 does not distinguish over Bartley by excluding rhenium from the here claimed catalyst as argued by the appellants. We shall sustain, therefore, the examiner's rejection of all appealed claims under 35 U.S.C. § 103(a) as being unpatentable over Bartley. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992).

Appeal No. 2005-0515
Application No. 10/124,925

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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PETER F. KRATZ)	
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BRG:hh

Appeal No. 2005-0515
Application No. 10/124,925

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