

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN W. VANDERVEEN, RONALD G. ABBOTT,  
RALPH P. WILLIAMS, and MARVIN M. JOHNSON

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Appeal 2006-2285  
Application 08/459,990  
Technology Center 1700

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Decided: September 7, 2006

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Before KIMLIN, GARRIS, and OWENS, *Administrative Patent Judges*.  
KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7. Claims 8-14 and 44-50 have been allowed by the Examiner. Claim 1 is illustrative.

1. A composition comprising the components of:

a hydrogen halide; and

a sulfone, wherein said sulfone component is present in said composition in an amount less than about 50 weight percent of the total weight of said composition and wherein the weight ratio of hydrogen halide



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intended to **exclude only** Lewis acids from the catalyst” (Answer 5, penultimate sentence), the issue on appeal is not whether Appellants intend to exclude *only* Lewis acids but, rather, whether Appellants’ original specification describes a composition not containing a Lewis acid. Manifestly, Appellants’ attempt to exclude a Lewis acid from the composition is clear from the examples set forth at Table II on page 17 of the present specification.

We now turn to the Examiner’s Section 102 rejection over Siskin. Siskin clearly teaches a catalyst composition comprising a Lewis acid, and the Examiner acknowledges that the claims on appeal, containing the asserted new matter, distinguish “over the disclosure of Siskin et al.” (Answer 4, ¶ 4). The Examiner appreciates that Siskin discloses “using Lewis acid as an essential component” (*id.*). However, the Examiner apparently subscribes to the erroneous notion that asserted new matter can be ignored in the determination of whether a prior art reference describes the claim features within the meaning of Section 102. This is not the case. It is well settled that all claim limitations must be considered in evaluating the propriety of a prior art rejection under 35 U.S.C. § 102. *In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974). Indeed, even if the claim language at issue was new matter, i.e., it lacked descriptive support in the specification, the prior art reference must still describe the claim feature to support a rejection under Section 102. *Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. App. 1983). *See also In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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In conclusion, based on the foregoing, we are constrained to reverse the Examiner's rejections.

REVERSED

RICHMOND PHILLIPS HITCHCOCK & FISH  
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ECK:hh