

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANG T. PHAM, GARY KNOPECK,
RONALD RIEGAL, MARY C. BOGDAN,
LESLIE BEMENT, and DAVID J. WILLIAMS

Appeal 2008-6040
Application 10/885,434
Technology Center 1700

Decided: January 9, 2009

Before CHARLES F. WARREN, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-7. We have jurisdiction pursuant to 35 U.S.C. § 6.

We affirm the Examiner's anticipation rejection. As for the Examiner's provisional double patenting and provisional obviousness-type double patenting rejections, these latter rejections are moot given the current abandoned status of Application No. 10/885,359.

Rejection under § 102(e)

Appellants argue the rejected claims as a group. Thus, we select claim 4 as the representative claim on which we shall decide this appeal as to the anticipation rejection.

Appellants do not argue the Examiner's anticipation rejection on the basis that Nyberg lacks a description of a sprayable composition comprising a propellant (*see* the Appeal Brief in its entirety). Moreover, Appellants do not argue that Nyberg fails to teach a propellant/blowing agent that can include 2-chloropropane and 1,1,1,3,3-pentafluoropropane. Rather, Appellants contend that Nyberg does not disclose an azeotropic mixture of 2-chloropropane and 1,1,1,3,3-pentafluoropropane (Br. 8).

On the other hand, the Examiner essentially maintains that Appellants have not established that the claim 4 product retains an azeotropic characteristic that distinguishes the claimed product over Nyberg's sprayable product containing 2-chloropropane and 1,1,1,3,3-pentafluoropropane (Ans. 6).

ISSUE

The principal issue before us raised by Appellants' arguments in the Appeal Brief is: Have Appellants' established reversible error in the Examiner's anticipation rejection of the sprayable product required by

representative claim 4 based on the argument that Nyberg does not disclose an azeotrope of 2-chloropropane and 1,1,1,3,3-pentafluoropropane?

We answer this question in the negative and we affirm the Examiner's anticipation rejection, on this record.

PRINCIPLES OF LAW

During examination, claims terms must be given "their broadest reasonable construction consistent with the specification." *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1378-79 (Fed. Cir. 2007). In this regard, during examination proceedings, claims are given their broadest reasonable interpretation consistent with the Specification as they would have been understood by one of ordinary skill in the art. *See In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995).

Under 35 U.S.C. § 102, anticipation is established only when a single prior art reference describes, either expressly or under the principle of inherency, each and every element of a claimed invention. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

However, anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. *See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

Anticipation under this section is a factual determination. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991) (citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)).

FACT FINDINGS AND ANALYSIS

The Specification provides that “there is a range of compositions containing the same components in varying proportions that are azeotrope-like [or constant boiling]” and “[a]ll such compositions are intended to be covered by the terms “azeotrope-like” [and “constant boiling]”” (*see* paragraph bridging Spec. pp. 4-5). Appellants state that preferred inventive compositions “are characterized by a boiling point of about $14.54^{\circ}\text{C} \pm 4^{\circ}\text{C}$...” (Spec. 5). All of the 2-chloropropane/HFC 245fa binary mixtures presented in Table 4 of the subject Specification handily meet such a loosely defined “constant boiling point” boiling point criteria (Spec. 6).

Nyberg discloses a blowing agent/propellant for use in an aerosol composition that can include 2-chloropropane and HFC-245fa in admixture, including amounts of each that fall within the broad range encompassed by representative claim 4 for these constituents (*see*, e.g., col. 1, ll. 47-51; col. 4, ll. 29-30; col. 6, l. 8; and Fig. 1).

In this regard and in giving representative claim 4 its broadest reasonable construction as it would be understood by one of ordinary skill in the art when read light of the subject Specification, we determine that claim 4 requires the addition of a propellant component including any amount, however small, of a loosely defined azeotrope of 2-chloropropane and HFC-245fa (1,1,1,3,3-pentafluoropropane) as set forth in the subject Specification. Moreover, the claim 4 product does not require that this azeotrope is the only propellant found in the claimed sprayable composition. Also, claim 4 calls for a sprayable product and employs the transition term “comprising” in listing the components of the recited product, which transitional term

leaves the product required by claim 4 open to the inclusion of other ingredients, including other propellants, such as a 2-chloropropane propellant in addition to the called for azeotrope additive component of 2-chloropropane and 1,1,1,3,3-pentafluoropropane. Nor does Claim 4 require that the product composition thereof meet the loosely defined boiling point parameters for a binary azeotrope of 2-chloropropane and HFC-245fa, as set forth in Appellants' Specification, for an overall composition product within the scope of claim 4.

Thus, Nyberg discloses a sprayable composition using a propellant (blowing agent) that includes 2-chloropropane and HFC-245fa in admixture that falls within the scope of the claim 4 requirements therefor as set forth by the Examiner in the Answer.

In light of our claim construction above and the teachings of Nyberg, it is appropriate that Appellants bear the burden to establish that representative claim 4 requires a product spray which patentably distinguishes over the sprays made according to Nyberg based on Appellants' loosely defined azeotrope criteria. After all, the Patent and Trademark Office is not equipped to make and compare products. On this record, Appellants have not discharged this burden. *See, e.g., Spada*, 911 F.2d at 708-09; *In re Best*, 562 F.2d 1252, 1255-56 (CCPA 1977).

In view of the above, we are not persuaded of any reversible error in the Examiner's anticipation rejection of representative claim 4 based on the arguments presented in the Appeal Brief.¹ In particular, we note that the

¹ In the Evidence Appendix to the Brief, Appellants do not identify any evidence being relied upon and state "No additional evidence presented."

arguments presented in the Appeal Brief with respect to the lack of a description of an azeotropic propellant/blowing agent comprising 2-chloropropane and HFC-245fa in Nyberg is not persuasive because Appellants have not established an actual product distinction for the sprayable product of representative claim 4. In this regard, Appellants' assertions with respect to the lack of a recognition of such an azeotropic binary propellant/blowing agent in Nyberg are not persuasive for the reasons discussed above. As such, we affirm the Examiner's anticipation rejection of claims 1-7 over Nyberg.

CONCLUSION

Appellants have not established reversible error in the Examiner's anticipation rejection of the sprayable product required by representative claim 4 based on the argument that Nyberg does not disclose an azeotrope of 2-chloropropane and 1,1,1,3,3-pentafluoropropane.

ORDER

The decision of the Examiner to reject claims 1-7 under 35 U.S.C. § 102(e) as being anticipated by Nyberg is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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