

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PIERRE CHABARDES  
and CLAUDE MERCIER

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Appeal No. 94-1868  
Application 07/864,385<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, WARREN and WALTZ, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal pursuant to 35 USC § 134 from the final rejection of claims 1 through 6, 8 through 20, and 24 and 25.

Claim 1 is representative and is reproduced below:

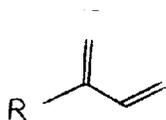
1. A process for the preparation of a terpenic ketone comprising the steps of:

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<sup>1</sup> Application for patent filed April 6, 1992. According to appellants the application is a continuation of Application 07/652,049, filed February 8, 1991 (ABN).

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reacting, in the presence of water, a butadiene derivative of the formula:



wherein R is a hydrocarbon radical having 1 to 20 carbon atoms with a  $\beta$ -keto ester; and

causing the product of said reaction to undergo decarbalkoxylation in the presence of water without adding an additional component selected from the group consisting of a solvent and a decarbalkoxylating agent, wherein said reaction step and said decarbalkoxylation are carried out in the same reaction zone.

The references of record relied upon by the examiner are:

Celli	4,092,362	May 30, 1978
Morel	4,621,165	Nov. 4, 1986

The appealed claims stand rejected under 35 USC § 103 over Morel in view of Celli.

We reverse.

The subject matter on appeal is directed to a process for preparing terpenic ketones. These compounds are known precursors in the synthesis of vitamins A and E and are usable in perfumes.

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The claimed process comprises a first step of reacting, in the presence of water and a rhodium catalyst, a butadiene derivative substituted at the two carbon position by a hydrocarbon chain with a  $\beta$ -keto ester to produce a keto ester reaction product. See the specification at page 6, lines 14 through 16. In a second step of the claimed process, the above reaction product is caused to undergo decarbalkoxylation in the presence of water. Importantly, the decarbalkoxylation step is carried out without adding an additional solvent or decarbalkoxyating agent. Also the claimed two-step reaction process is carried out in the same reaction vessel. Thus the appealed claims require that both the reaction step and the step of decarbalkoxylation are carried out ?in the same reaction zone? which is said to eliminate a potentially costly and time consuming isolation step required by prior art processes. See the Brief at page 10.

The examiner contends that the claimed process is rendered prima facie obvious in view of the combined teachings of Morel and Celli. Although the examiner's stated rejection is not without merit, appellants argue, and we agree, that neither Morel nor Celli teach or suggest a single reaction zone process as claimed by appellants. The examiner's contention that the claimed ?same reaction zone? process has not been shown by

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appellants to enhance the yields of terpenic ketone product, in effect, places the cart before the horse. Here, it is only appellants' disclosure which suggests a single reaction zone process, not the prior art. We have little doubt that one ordinarily skilled in this art, working with the available knowledge and expertise of the reactions in question, could have designed a process as claimed. However, the mere fact that the prior art processes could have been so modified to have been carried out in the same reaction zone would not have made the claimed process obvious unless the prior art suggested the desirability of this modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In short, we agree with appellants that the combined disclosures of the relied upon references fail to establish a prima facie case of obviousness for the specifically claimed process on appeal. We are therefore constrained to reverse the examiner's rejection of the appealed claims under 35 USC § 103.

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The decision of the examiner is reversed.

**REVERSED**

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JOHN D. SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
THOMAS WALTZ	)	
Administrative Patent Judge	)	

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