

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte V.N. MALLIKARJUNA RAO, FRANK J. WEIGERT
and CARL G. KRESPAN

Appeal No. 1996-0683
Application 08/116,938

ON BRIEF

Before PAK, WALTZ and KRATZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 and 7. Claims 2 through 6 and 8 through 24 stand withdrawn from consideration by the examiner as being directed to a non-elected invention. See the final Office action dated December 8, 1994 (Paper No. 10).

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Pursuant to the restriction requirement set forth by the examiner in the Office action dated January 24, 1994 (Paper No. 4), appellants elected one of the species recited in claim 1 (the Response dated February 23, 1994, Paper No. 5).¹ This species is specifically defined in claim 7 which is reproduced below:

7. The compound of Claim 1 which is $\text{CF}_3\text{CF}_2\text{CH}_2\text{CF}_2\text{CF}_3$.

The prior art references of record relied upon by the examiner are:

Zhanxun C. et al. (Zhanxun I), "Esca Characterization of Plasma-Polymerized Tetrafluoroethylene (I)," Adv. Low-Temp. Plasma Chem. Technol. Appl., 2, pp. 265-273 (1988).

Zhanxun C. et al. (Zhanxun II), "Esca Characterization of Plasma-Polymerized Tetrafluoroethylene (I)," 4th Proc. Annual. Int. Conf. Plasma Chem. Technol., pp. 173-179 (1989).

The references of record relied upon by appellants are:

Miller, W. T. et al. (Miller), "Substitution and Addition Reactions of the Fluoröolefins: IV. Reactions of Fluoride Ion

¹ Appellants request that "upon allowance of Claim 1, Claims 2 through 6 and 8 be also allowed as [they recite] species of the Claim 1 invention..." See Brief, page 5. This request is inappropriate since claims 2 through 6 and 8 are not properly before us. Note also that our review is limited to the propriety of the examiner's rejection with respect to the elected species recited in claim 1, i.e., claim 7. The remaining non-elected species recited in claim 1 are also not properly before us.

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with Fluorölefins," Journal of American Chem. Soc., Vol. 82, pp. 3091-3099 (1960).

"Addition of Hydrogen Fluoride to Alkenes," Organic Fluorine Chemistry, (William A Sheppard et al, Ed., 1969), pp. 60-65 (hereinafter referred to as "Sheppard").

"Addition of Hydrogen Fluoride," Chemistry of Organic Fluorine Compounds, 2nd (Revised Edition), (Milos Hudlicky, Ed.,1992), page 39 (hereinafter referred to as "Hudlicky").

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b) as clearly anticipated by either of the Zhanxun references.

We reverse.

To establish anticipation of the claimed subject matter under 35 U.S.C. § 102(b), the examiner must demonstrate that the Zhanxun references individually describe all the claimed elements. **Richardson v. Suzuki Motor Co.**, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.), **cert. denied**, 100 S. Ct. 154 (1989). Further, the examiner must demonstrate that the Zhanxun references describe the claimed invention sufficiently to have placed a person of ordinary skill in the art in possession of it. **In re Payne**, 606 F.2d 303, 314-315, 203 USPQ 245, 255-56 (CCPA 1979); **In re Brown**, 329 F.2d 1006, 1011, 141

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USPQ 245, 249 (CCPA 1964). The claimed invention is not "possessed" absent some known or obvious way to make it. **In re Hoeksema**, 399 F.2d 269, 274, 158 USPQ 596, 601 (CCPA 1968). Relying on additional prior art references to establish "known or obvious ways" to make the compound disclosed in the Zhanxun references does not render a § 102 rejection improper. **In re Donohue**, 632 F.2d 123, 127, 207 USPQ 196, 199 (CCPA 1980); **In re Samour**, 571 F.2d 559, 562-63, 197 USPQ 1, 4 (CCPA 1978); **In re LeGrice**, 301 F.2d 929, 939, 133 USPQ 365, 373-74 (CCPA 1962).

In the present case, there is no dispute that the Zhanxun references describe the claimed compound, $\text{CF}_3\text{CF}_2\text{CH}_2\text{CF}_2\text{CF}_3$. The only dispute between the examiner and appellants is whether the Zhanxun references are capable, when taken in conjunction with the knowledge of those skilled in the art, of placing the claimed compound in the possession of the public. In other words, do the Zhanxun references, when taken together with the knowledge of those skilled in the art, provide known or obvious ways to make the claimed compound.

As stated by appellants, the Zhanxun references do not

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state whether or not the claimed compound is made. Nor do they state that the claimed compound can be produced by well known methods. The examiner states (Answer, pages 4 and 5) that:

the prior art compound may be produced by any number of well known synthesis procedures utilizing any number of well known starting materials. For instance, one well known olefin starting material which may be utilized in the production of the prior art compound is disclosed in the instant specification at page 22, lines 29+. The reaction of this known olefin with HF under a wide range of well known hydrofluorination conditions would be expected to produce at least some of the prior art compound.

The examiner's statement, however, is not supported by factual evidence. Thus, on this record, we are constrained to agree with appellants that the examiner has not demonstrated a **prima facie** case of enablement with respect to the relied upon prior art references.

In reaching this conclusion, we also note the examiner's reliance on Hudlicky and Sheppard, two of the three references referred to by appellants, at pages 5 and 6 of the Answer. However, these references have not been relied upon in the statement of the rejection provided in the Answer.

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Accordingly, we decline to consider them for the purpose of determining whether the examiner has established a **prima facie** case of enablement with respect to the relied upon prior art references. **See In re Hoch**, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.1 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.").

In view of the foregoing, we reverse the examiner's decision rejecting all of the appealed claims (species described in claim 7) under 35 U.S.C. § 102(b) over the Zhanxun references.

As a final point, we observe that appellants acknowledge (specification, pages 4 and 5) that:

U. S. Patent No. 2,975,220 discloses compounds of the general formula $R(\text{CH}_2\text{CF}_2)_n\text{Q}$, where n is an integer and Q is halogen or hydrogen and R is a halogenated radical. These compounds (e.g., $\text{CF}_3\text{CF}_2\text{CH}_2\text{CF}_2\text{CF}_3$) may be prepared by reacting vinylidene fluoride with certain telogens.

There are also means of synthesizing various fluorine-substituted alkenes. For example, U.S. Patent Nos. 4,820,883 and 4,820,884 disclose the use

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of activated carbon for the preparation of unsaturated fluorocarbons by defluorinating perfluoro compounds.

While the former shows preparation of a fluorinated compound similar to that claimed, the latter indicates that synthesizing various fluorine-substituted alkenes are known. If the claimed compound described in the Zhanxun references is no more than the isomerized product of the former or the hydrogenated product of the latter, a *prima facie* case of enablement may be demonstrated with respect to the Zhanxun references. Note also that we have not considered the merits of Hudlicky and Sheppard since they were not relied upon in the statement of the rejection provided in the Answer.

Upon return of this application, the examiner is to determine whether any combination of the Zhanxun and the above-mention references affect the patentability of the claimed subject matter under 35 U.S.C. § 102(b). This determination necessarily requires consideration of the above-mention references, together with the Zhanxun references, for the purpose of determining enablement of the Zhanxun references under 35 U.S.C. § 112, first paragraph. Any prior art references relied upon by the examiner must be included in

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his statement of the rejection.

In view of the foregoing, the decision of the examiner is reversed and the application is remanded to the examiner for appropriate action.

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

REVERSED and REMANDED

CHUNG K. PAK)	
Administrative Patent Judge)	
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THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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