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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/483,596	05/30/2012	Stephen J. MILLER	70205.0035USC2	2520
95916	7590	11/08/2016	EXAMINER	
Merchant & Gould - Chevron PO Box 2903 Minneapolis, MN 55402			MAYES, MELVIN C	
			ART UNIT	PAPER NUMBER
			1732	
			NOTIFICATION DATE	DELIVERY MODE
			11/08/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEPHEN J. MILLER

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Appeal 2015-002454  
Application 13/483,596  
Technology Center 1700

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Before PETER F. KRATZ, KAREN M. HASTINGS, and  
LILAN REN, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seeks our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 10, 11, and 15–18 under 35 U.S.C. § 103(a) as unpatentable over Hasenzahl (US 6,710,193 B2, issued Mar. 23, 2004) in view of Zhou et al. (US 6,534,661 B1, issued Mar. 18, 2003) (“Zhou”).<sup>2</sup>

We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> The real party in interest is stated to be Chevron U.S.A., Inc. (App. Br. 1).

<sup>2</sup> The Examiner withdrew all of the other § 103 rejections made in the final rejection (Ans. 2).

Independent claim 10 is illustrative of the subject matter on appeal (emphasis added):

10. A process for oxidation of hydrocarbons comprising contacting said hydrocarbon with hydrogen peroxide in the presence of a *catalytically effective amount of crystalline, titanosilicate zeolite TS-1* for a time and at a temperature effective to oxidize said hydrocarbon, *wherein the catalyst* is in the form of a binderless, shaped particle having a cross-sectional diameter between about 1/64 inch and about 1/2 inch and *comprising essentially all TS-1 and TS-1 precursors*.

Appellant does not separately argue any of the claims (App. Br. 3–10); accordingly all of the claims stand or fall with claim 10.

#### ANALYSIS

Upon consideration of the evidence on this record and each of Appellant's contentions, we find that the preponderance of evidence supports the Examiner's conclusion that the subject matter of Appellant's claim 1 is unpatentable over the applied prior art. We sustain the Examiner's § 103 rejection essentially for the reasons set out by the Examiner in the Answer.

We add the following primarily for emphasis.

Appellant's principal argument in the Appeal Brief and the Reply Brief is that, contrary to its express teaching, Hasenzahl does not produce a TS-1 zeolite (App. Br. 5–9). Appellant relies upon a Rule 132 Declaration by the inventor, Dr. Stephen J. Miller,<sup>3</sup> in support of these arguments, as

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<sup>3</sup> Declaration under 37 C.F.R. 1.132, filed March 2, 2011 (App. Br., Evidence App.).

well as a technical article by Thangaraj<sup>4</sup> (App. Br. Evidence App. Exhibits 1 and 2). Appellant also contends that while Zhou discloses TS-1 zeolite, including shaped particles, it does not disclose binderless particles (App. Br. 9).

A preponderance of the evidence supports the Examiner's determination that a person of ordinary skill in the art would have, using no more than ordinary creativity, used binderless shaped particles of TS-1 as exemplified in Hasenzahl in a process encompassed by claim 1, and that the use of particles within the claimed range of sizes would have been prima facie obvious in light of Zhou's teaching of an overlapping range of sizes for TS-1 particles. (*E.g.*, Final Action 3–6; Ans. 3–8).

The burden of rebutting the presumption of enablement of the cited prior art by a preponderance of the evidence falls on the applicant. *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980); discussed further in *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012) (“we now hold that a prior art printed publication cited by an examiner is presumptively enabling”).

While the Miller Declaration contends that TS-1 can not be produced by Hasenzahl's process, the Examiner aptly points out that the conditions used by Dr. Miller were not the same as in Hasenzahl (Ans. 5, 6). The Examiner's rejection also relied upon Zhou, which teaches the use of TS-1. Therefore, Appellants have not established that a preponderance of the evidence fails to support the Examiner's de facto position that one of ordinary skill in the art would have been able to make and use the taught TS-

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<sup>4</sup> Thangaraj et al., *Catalytic Properties of Crystalline Titanium Silicalites*, 130 J. Catalysis 1–8 (1991) (“Thangaraj”).

1 zeolite catalyst. We give more weight to the publications than the testimony of an interested party. We discern no reversible error in the Examiner's assessment of the weight to be given to the submitted evidence. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (The Board has discretion to give more weight to one item of evidence over another “unless no reasonable trier of fact could have done so”); *see also In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”); *Velandar v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (“In giving more weight to prior publications than to subsequent conclusory statements by experts, the Board acted well within [its] discretion.”).

Appellant has not asserted that making a TS-1 would have been beyond the capabilities of a person of ordinary skill in the art. Absent such an assertion, we “take account of the inferences and creative steps that a person of ordinary skill in the art would employ,” and find a person of ordinary skill in the art would have overcome those difficulties within their level of skill. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (under the flexible inquiry set forth by the Supreme Court, the PTO must take account of the “inferences and creative steps,” as well as routine steps, that an ordinary artisan would employ (emphasis omitted)).

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Accordingly, we affirm the Examiner's prior art rejection of the claims under 35 U.S.C. § 103(a) for the reasons given above and presented by the Examiner.

#### DECISION

The Examiner's § 103 rejections are affirmed.

#### TIME PERIOD FOR RESPONSE

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).

AFFIRMED