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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SAROJINI DEEVI, RANGARAJ S. SUNDAR,
and YEZDI B. PITHAWALLA

Appeal 2019-000140
Application 13/923,823
Technology Center 1700

Before LINDA M. GAUDETTE, KAREN M. HASTINGS, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 64–68 and 71–77 as being unpatentable over at least the basic combination of Finlay et al. (WO 03/088771 A1; Oct. 30, 2003) and P. Harrison et al. (Nature and Surface Redox Properties of Copper(II)-

¹ Appellant is the Applicant, Philip Morris USA Inc., which is also stated to be the real party in interest (Appeal Br. 2).

Promoted Cerium(IV) Oxide CO-Oxidation Catalysts, 12 Chem. Mater. 3715-3725).^{2,3} We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Claim 64 is illustrative of the claimed subject matter:

64. A cigarette comprising a tobacco rod, cigarette paper and an optional filter, wherein at least one of the tobacco rod, cigarette paper and optional filter comprise composite nanoscale particles, wherein said composite nanoscale particles comprise a first metal and/or a first metal being different than the second metal, and wherein the composite nanoscale particles have an average particle size of less than about 100 nm.

(Appeal Br. Claims Appendix 1).

OPINION

The Examiner has the initial burden of establishing a prima facie case of obviousness of the claimed subject matter under 35 U.S.C. § 103. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). To establish a prima facie case of obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would

² The Examiner further applies Seehofer et al. (US 4,182,348; June 8, 1980) to dependent claim 71 (Final Action 7). A discussion of this rejection is not necessary for disposition of this appeal.

³ The Examiner withdrew the rejection of the claims under 35 U.S.C. § 112 (Ans. 5). The Examiner also inadvertently did not include the proper claims in the heading of the § 103 rejection, however, this is harmless error (e.g., Appeal Br. 2; Reply Br. 2).

have been obvious based on the knowledge of those of ordinary skill in the art or the inferences and creative steps a person of ordinary skill in the art would have employed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Claim 64 requires that nanoscale particles of the first metal or first metal oxide are “homogeneously incorporated in nanoscale particles of an oxide of a second metal.” There is no dispute that Finley does not describe nanoscale particles. The Examiner relies upon Harrison for this feature (e.g., Ans. 4, 8). Appellant’s Specification defines homogeneous incorporation as “the first metal and/or metal oxide located in the crystal lattice of the oxide of the second metal” (Spec. ¶ 23).⁴ Appellant points out that Harrison explicitly states that the analysis of the product indicates that “no incorporation of copper into the ceria lattice occurs” (Appeal Br. 13, 14; Reply Br. 4; *see* Harrison p. 3719, col. 2). Appellant also contends that the Examiner has improperly “picked two words of Finlay and one sentence of Harrison, out of context” to support his position (Reply Br. 2). The Examiner relied upon a sentence in Harrison that stated “copper loadings . . . were achieved as homogeneous materials” (Ans. 8; Harrison p. 3717, col. 2). Appellant posits that Harrison’s use of the term “homogeneous materials” must be read to simply mean that the materials produced were uniform in

⁴ Paragraph 23 describes two options, and then ends with “(i.e., a homogeneous or inhomogeneous composite).” This appears to mean that the first option described is a homogeneous composite, while the second described option is an inhomogeneous composite. Nonetheless, the Examiner also has not established that Harrison teaches a second phase of the first metal/metal oxide homogeneously incorporated “into the matrix of the oxide of the second metal” (the second described alternative).

their level of copper loading (Reply Br. 4). A preponderance of the evidence supports Appellant's position that the Examiner has not adequately explained how the Harrison/Finlay combination teaches or suggests the disputed feature in light of the direct teaching in Harrison that no incorporation of the first metal into the lattice of the second metal oxide (ceria) occurs.

We are mindful that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product, and that it is of no moment whether the rejection is based on § 102 or § 103 since the burden on the applicant is the same. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). Here, however, the Examiner has not shown that the product disclosed in the prior art is substantially the same and/or is produced by substantially the same method described in Appellant's Specification so as to shift the burden to Appellant to prove otherwise.

In light of these circumstances, a preponderance of the evidence supports Appellant's position that the Examiner has not pointed to any evidence to adequately establish that the applied prior art teaches or suggests the claimed product.

On the record before us, the Examiner has not shown that each and every limitation of the claim is either described or suggested by the prior art or would have been obvious based on the knowledge or inferences and creativity of the ordinary artisan. *See In re Fine*, 837 F.2d at 1074; *see also In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) ("A rejection based on

section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art”).

The Examiner does not rely upon the other reference applied in the § 103 rejection of claim 71, or any other rationale to cure the above noted deficiency. Accordingly, we reverse the § 103 rejections on appeal.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
64–68, 72–77	103	Finlay, Harrison		64–68, 72–77
71	103	Finlay, Harrison, Seehofer		71
Overall Outcome				64–68, 71–77

REVERSED