

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT ALLAN DAVIS,
ALEX R. A. VALCKE
and WALTER GERHARD BROUWER

Appeal No. 2000-0023
Application 08/967,856¹

ON BRIEF

Before KIMLIN, METZ and KRATZ, Administrative Patent Judges.

METZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the

¹ Application for patent filed November 12, 1997. According to the official records of the United States Patent and Trademark Office (PTO), said application is a division of Serial Number 08/295,117, filed on August 24, 1994, and now U.S. Patent Number 5,777,110, issued on July 7, 1998, and which is a continuation-in-part of Serial Number 08/111,386, filed on August 24, 1993, and now abandoned.

Appeal No. 2000-0023
Application 08/967,856

examiner's refusal to allow claims 4 through 6, 8 and 9. Claim 7, the only other claim remaining in this application, has been indicated to be allowable by the examiner in Paper Number 7. In Paper Number 5, the examiner gave reasons for his conclusion that the subject matter of claim 7 was allowable.

THE INVENTION

The appealed subject matter is directed to a method for preserving wood or a composite wood material which comprises treating the wood or the composite wood material with a fungicidally or bactericidally effective amount of one of a family of compounds generically defined as 3-aryl-5,6-dihydro-1,4,2-oxathiazine or oxides of said oxathiazines.

Claim 4 is believed to be adequately representative of the appealed subject matter and is reproduced below for a more facile understanding of the claimed invention.

4. A method for preserving wood or a composite wood material which comprises treating the wood or the composite wood material with a fungicidally or bactericidally effective amount of a compound of the formula

wherein n is 0, 1 or 2; R¹ is hydrogen, C₁-C₄ linear or branched alkyl, or benzyl; and R is:

(a) phenyl; naphthyl; phenyl substituted with 1-3 of the following substituents:

hydroxyl, halo, C₁-C₁₂ alkyl, C₅-C₆ cycloalkyl, trihalomethyl, phenyl, C₁-C₅ alkoxy, C₁-C₅ alkylthio, tetrahydropyranyloxy, phenoxy, (C₁-C₄ alkyl) carbonyl, phenylcarbonyl, C₁-C₄ alkylsufinyl, C₁-C₄ alkylsulfonyl, carboxy or its alkali metal salt, (C₁-C₄ alkoxy)carbonyl, (C₁-C₄ alkyl) aminocarbonyl, phenylaminocarbonyl,

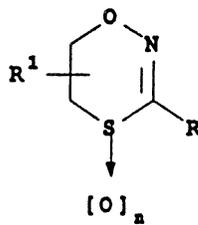
tolylaminocarbonyl,

amino, nitro, cyano,
or (C₁-C₄ alkoxy)

pyridinyl; thienyl;
furanlyl
substituted with 1 to
groups:

alkyl, alkoxy,
alkoxycarbonyl,
trihalomethyl,
benzoly,

nitro, phenyl or phenylaminocarbonyl, wherein the alkyl or alkoxy moiety is C₁-C₄, linear or branched;



morpholinocarbonyl,
dioxolanyl,
iminomethyl;
furanlyl; or thienyl or
3 of the following

alkylthio,
halogen,
cyano, acetyl, formyl,

Appeal No. 2000-0023
Application 08/967,856

or
(b)

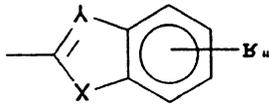
wherein X is oxygen or sulfur; Y is nitrogen, -CH-, or -C(C₁-C₄ alkoxy)-; and R" is hydrogen or C₁-C₄ alkyl.

THE REFERENCES

The references of record which are being relied on by the examiner as evidence of obviousness are:

Hagar
(Brouwer)
23, 1987

March 15,
4,



4,376,513
1983 Brouwer et al.
675,044 June

THE REJECTIONS

Claims 4 through 6, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable from the disclosure of Brouwer considered with Hagar.

OPINION

Appellants have failed to argue with any reasonable degree of specificity the patentability of any dependent claim. Further, on page 3 of their brief, appellants state that "The rejected claims (i.e., claims 4-6 and 8-9) stand or fall together." Therefore, we shall decide this appeal based on the patentability of independent claim 4. The patentability of all the claims stands or falls with independent claim 4 on which they depend. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642 (Fed. Cir. 1986); 37 C.F.R. § 1.192 (c)(7), first sentence.

There is no dispute between the examiner and appellants concerning the disclosure of Brouwer. Brouwer discloses the compounds used by appellants in their claimed method for "preserving wood." There is also no dispute that Brouwer discloses that the compounds therein disclosed are useful anti-fungals having a broad spectrum of activity against a variety of fungi, including *Phytophthora* (column 3, lines 35 through 42).

Appeal No. 2000-0023
Application 08/967,856

The active compounds are applied in solution or suspension to the target tissue (column 3, lines 27 through 34).

Hagar is directed to improved sprinkler heads for irrigation systems. Hagar recognizes that prior art sprinkler heads cause a problem with fungi in walnut and almond orchards by providing an environment so humid as to encourage the growth of fungi. Hagar recognizes that a particular fungus, *Phytophthora* (or Crown Rot), is of particular concern because it moves into and through live tissue, leaving a pathway for invasion by *Poria*, a moisture loving organism which enters the dead wood left behind by *Phytophthora* (column 1, lines 34 through 57).

The examiner has reasoned that the active ingredients of the claimed method are shown by Brouwer to be useful in combating *Phytophthora*. The examiner reasons that in light of that disclosure, it would have been obvious to treat *Phytophthora* on walnut and almond trees ("wood") with the agents of Brouwer, shown to be useful against *Phytophthora*, to protect the trees ("wood") against the fungus described in Hagar as a real problem in almond and walnut trees ("wood")

Appeal No. 2000-0023
Application 08/967,856

with the expectation that the active ingredient from Brouwer would kill the fungus, prevent rot and, therefore, preserve the trees ("wood").

Appellants argue that Brouwer does not teach or suggest that the therein disclosed compounds would have been expected to be useful for protecting "wood" against fungi. Appellants further argue that neither does Hagar disclose compounds as claimed as useful for protecting "wood" against wood-damaging organisms. Although appellants argue that the combination of references is improper because Hagar is from so-called "non-analogous art", appellants urge that even if combined the prior art would not have suggested the claimed method.

It is by now fundamental that pending claims in an application for patent are given their broadest, reasonable interpretation, in light of the teachings of the prior art and consistent with an applicants' disclosure as it would have been interpreted by a person of ordinary skill in the art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971); In re Prater, 415 F.2d 1393, 1404, 1405, 162 USPQ 541, 550,

Appeal No. 2000-0023
Application 08/967,856

551 (CCPA 1969) ("claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification *during examination of a patent application* since the applicant may then *amend* his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified" [footnote omitted]). However, the scope of a claim may not be narrowed by importing into the claim limitations from the specification which have no express basis in the claim. Prater 415 F.2d at 1404, 162 USPQ at 550.

We do not find any of appellants' arguments to be persuasive because they are founded on an unduly restrictive interpretation of the claim language. Appellants arguments are founded on their interpretation of the term "wood" in the claims as not encompassing living trees, to which the disclosure of Hagar is clearly limited. Rather, appellants argue that "Wood and composite wood materials are dead material - not live plants." See page 6 of the brief. Nevertheless, appellants have failed to direct our attention to that portion of their specification wherein the argued

Appeal No. 2000-0023
Application 08/967,856

definition of "wood" is set forth. Indeed, although it is not our burden to do so, we have scoured appellants' disclosure and have found no such definition for "wood."

Accordingly, we have resorted to a standard, English language dictionary for a definition of "wood." In "*The Random House Dictionary of the English Language*", Second edition, Unabridged, 1987, at page 2186, the first definition for "wood" is:

the hard, fibrous substance composing most of the stem and branches of a tree or shrub, and lying beneath the bark; the xylem.

Thus, the broadest, reasonable interpretation of the term "wood", in light of its ordinary, accepted meaning, includes trees as argued by the examiner.

Accordingly, we agree with the examiner that because *Phytophthora* is shown by Hagar to attack almond and walnut trees and because Brouwer discloses that the therein disclosed compounds, which are the active ingredients in the claimed method, effectively combat *Phytophthora*, it would have been prima facie obvious to "treat" almond and walnut trees with the agents disclosed in Brouwer to combat *Phytophthora*. At

page 13, lines 2 through 4 of their specification, appellants have defined "treating" as "brushing, spraying, dipping and the like." We find Brouwer considered with Hagar suggests "treating" trees ("wood") by spraying with a composition containing the active agents disclosed in Brouwer and, therefore, suggests the claimed method. Further, because killing the fungus would have been expected to prevent the incursion of *Poria* per the disclosure in Hagar, the destruction caused by treating against these organisms would have prevented damage to trees and, therefore, would have preserved the "wood" (trees).

To the extent appellants suggest that Hagar is so unrelated to the claimed invention as to be considered non-analogous art,

we reject that argument. The test for determining whether a reference is from a "non-analogous art" is a twofold determination. First, we determine if the reference is within appellants' field of endeavor. If it is not, we decide whether the reference is reasonably pertinent to the particular problem with which appellants were involved. In re

Appeal No. 2000-0023
Application 08/967,856

Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). We are satisfied that Hagar is within appellants' field of endeavor, that is, preservation of "wood" because it recognizes the need for inhibiting fungal growth in almond and walnut trees to prevent damage to the "wood" (trees). Moreover, as correctly observed by the examiner, appellants do not challenge the facts disclosed in Hagar on which the examiner relies but only that Hagar's main thrust is to an improved sprinkler head rather than treating fungi on "wood."

Appellants arguments concerning the examiner's allegedly improper "hindsight" application of the prior art is not persuasive. Appellants, again, read their claims too narrowly. As we have stated above, we reject appellants' interpretation of the claim terminology "treating the wood" as not embracing applying the active agents of Brouwer on a living tree ("wood").

Having concluded that the examiner has made out a prima facie case of obviousness with respect to the appealed subject matter, it is necessary for us to consider appellants' rebuttal

Appeal No. 2000-0023
Application 08/967,856

evidence and to reconsider the prima facie case anew in light of all the evidence. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). However, appellants have neither presented any rebuttal evidence nor advanced any arguments with respect to any probative showing of surprising or unexpected results represented by objective evidence in this record. Accordingly, the prima facie case of obviousness stands unrebutted.

OTHER ISSUES

On page 1 of appellants' brief two applications, unrelated to this application, are disclosed. It appears that the reference to said applications was an inadvertent error. We have not considered said applications in any fashion in reaching the decisions reflected in this opinion.

SUMMARY

The rejection of the claims under 35 U.S.C. § 103 is affirmed.

The decision of the examiner is AFFIRMED.

Appeal No. 2000-0023
Application 08/967,856

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

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
))
ANDREW H. METZ)	INTERFERENCES
Administrative Patent Judge)	
)	
)	
)	
)	
)	
PETER F. KRATZ))
Administrative Patent Judge)	

Appeal No. 2000-0023
Application 08/967,856

AHM/kis
DANIEL REITENBACH
UNIROYAL CHEMICAL COMPANY INC
WORLD HEADQUARTERS
MIDDLEBURY, CT 06749