

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte ENRIQUE L. MICHELOTTI,  
DAVID H. YOUNG, and  
THOMAS A. McLAUGHLIN

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Appeal No. 2001-1946  
Application No. 08/874,463

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

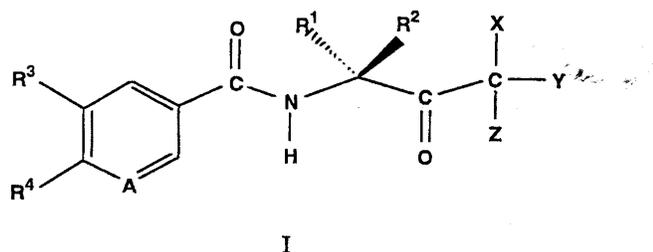
DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 4 and 8 through 10. Claims 5 through 7 and 11 through 13, which are the only other claims remaining in the application, stand allowed.

Representative Claims

Claims 1 and 8, which are illustrative of the subject matter on appeal, read as follows:

1. A composition, comprising:
  - a. a compound of formula I, with the stereochemistry depicted:



wherein:

1. A is selected from C-R<sup>5</sup>;
  2. R<sup>1</sup> and R<sup>2</sup> are different and are independently selected from H, (C<sub>1</sub>-C<sub>6</sub>)alkyl, (C<sub>2</sub>-C<sub>6</sub>)alkenyl, (C<sub>2</sub>-C<sub>6</sub>)alkynyl, and halo(C<sub>1</sub>-C<sub>6</sub>)alkyl and R<sup>2</sup> is stereochemically larger than R<sup>1</sup>;
  3. R<sup>3</sup>, R<sup>4</sup>, and R<sup>5</sup> are independently selected from H, halo, (C<sub>1</sub>-C<sub>6</sub>)alkyl, (C<sub>2</sub>-C<sub>6</sub>)alkenyl, (C<sub>2</sub>-C<sub>6</sub>)alkynyl, halo(C<sub>1</sub>-C<sub>6</sub>)alkyl, (C<sub>1</sub>-C<sub>6</sub>)alkoxy, halo(C<sub>1</sub>-C<sub>6</sub>)alkoxy, cyano, nitro, -CR<sup>6</sup>=NOR<sup>7</sup>, -NR<sup>8</sup>R<sup>9</sup>, -CONR<sup>10</sup>R<sup>11</sup>, and -NH-CO-OR<sup>12</sup> wherein R<sup>6</sup> is selected from H, (C<sub>1</sub>-C<sub>6</sub>)alkyl, (C<sub>2</sub>-C<sub>6</sub>)alkenyl, and (C<sub>2</sub>-C<sub>6</sub>)alkynyl, R<sup>7</sup> is selected from H, (C<sub>1</sub>-C<sub>6</sub>)alkyl, (C<sub>2</sub>-C<sub>6</sub>)alkenyl, (C<sub>2</sub>-C<sub>6</sub>)alkynyl, and (C<sub>1</sub>-C<sub>6</sub>)alkylcarbonyl, R<sup>8</sup> and R<sup>9</sup> are independently selected from H, (C<sub>1</sub>-C<sub>6</sub>)alkyl, and (C<sub>1</sub>-C<sub>6</sub>)alkylcarbonyl, R<sup>10</sup> and R<sup>11</sup> are independently selected from H and (C<sub>1</sub>-C<sub>6</sub>)alkyl; and R<sup>12</sup> is selected from H, (C<sub>1</sub>-C<sub>6</sub>)alkyl, (C<sub>2</sub>-C<sub>6</sub>)alkenyl, and (C<sub>2</sub>-C<sub>6</sub>)alkynyl; and
  4. X, Y, and Z are independently selected from H, halo, cyano, thiocyno, isothiocyno, and (C<sub>1</sub>-C<sub>4</sub>)alkylsulfonyloxy; provided that X, Y, and Z are not all H;
- and
- b. an agronomically acceptable carrier;
- wherein the composition is predominantly free of the compound of formula I wherein R<sup>1</sup> is stereochemically larger than R<sup>2</sup>.
8. A method for controlling pytopathological fungi comprising applying a fungicidally effective amount of the composition of Claim 1 to plant foliage, plant seed, or plant growth medium.

### The Prior Art Reference

In rejecting the appealed claims under 35 U.S.C. § 103(a), the examiner relies on the following prior art reference:

Michelotti et al. (Michelotti)	5,304,572	Apr. 19, 1994
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### The Issue

The issue presented for review is whether the examiner erred in rejecting claims 1 through 4 and 8 through 10 under 35 U.S.C. § 103(a) as unpatentable over Michelotti.

### Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief (Paper No. 10) and the review article attached to the brief; (3) the Examiner's Answer (Paper No. 11) and the first Office action mailed January 2, 1998 (Paper No. 3); and (4) the above-cited prior art reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 103(a).

### Discussion

In the Examiner's Answer (Paper No. 11), at the bottom of page 3, the examiner states that "[c]laims 1-4 and 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Michelotti (U.S. Patent no. 5,304,572)." The examiner, however, does not communicate the basis for this rejection in the Answer. Nor does the

examiner refer to any previous Office action for an appropriate explanation of the rejection. All we have is a statement identifying the claims under rejection (1-4 and 8-10); the reference relied on (Michelotti); and the relevant statutory provision (35 U.S.C. § 103(a)).

As best we can judge, the explanation supporting the rejection of claims 1-4 and 8-10 may be found in the first Office action mailed January 2, 1998 (Paper No. 3, page 3). There the examiner apparently invokes a per se rule of obviousness, i.e., a per se rule that the S enantiomer recited in applicants' claims would have been prima facie obvious in view of the racemate disclosure by Michelotti. According to the examiner,

racemic N-Acetylbenzamides are well known for their fungicidal activity as taught by Michelotti and the biological activity of compounds is well known to be dependent upon the optical isomeric form since biological molecules such as proteins, carbohydrates etc. are themselves optical enantiomers [Paper No. 3, page 3, emphasis added].

Therefore, the examiner argues, "it would have been obvious to one skilled in the art to prepare compositions containing either S or R enantiomers of [racemic] N-Acetylbenzamides (compounds of Machelotti [sic])" (id.). As stated in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), however,

The use of per se rules, while undoubtedly less laborious than a search and comparison of the claimed invention--including all its limitations--with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for a fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease.

Accordingly, to the extent that the examiner would apply a per se rule of obviousness to reach the S enantiomer recited in applicants' claims, in lieu of the comprehensive

analysis required by 35 U.S.C. § 103(a), this constitutes reversible error.

Further, the examiner's statement that "the biological activity of compounds is well known to be dependent upon the optical isomeric form" (Paper No. 3, page 3) is not supported by evidence in the record. On the contrary, the Tombo et al. review article relied on by applicants refutes what, according to the examiner, is "well known" in the art.<sup>1</sup> See Tombo et al. at page 1194, second column, stating that "the real situation in crop protection is far from black-and-white ('good enantiomer, bad racemate');" also note the six principal possibilities, frequently met in agrochemical research and development, outlined by Tombo et al. in the paragraph bridging pages 1194-95. The examiner has not established that a person having ordinary skill in the art, at the time applicants' invention was made, would have had a reasonable expectation that the compounds recited in claims 1 through 4 and 8 through 10, with the stereochemistry depicted, would possess the desired biological activity. Couched in terms of the case law, the examiner has not established that a person having ordinary skill would have a sufficient basis for the necessary predictability of success to here sustain a rejection under 35 U.S.C. § 103. In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Further, we agree with applicants that:

The processes disclosed for producing the compounds of '572 [Michelotti] would produce only racemic mixtures. There is no disclosure in '572 of any method or any other information on how to obtain or resolve

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<sup>1</sup> Tombo et al., "Chirality and Crop Protection," Angewandte Chemie International Edition in English, Vol. 30, pp. 1193-1215 (October 1991)

the separate stereoisomers of the instant invention. It is only in the Specification of the instant Application that a method for producing Appellants' claimed compounds is disclosed. [Paper No. 10, page 7]

The examiner's response, that the PTO "has already allowed claims 5-7 and 9-11 directed to the particular processes for preparing [applicants'] stereoisomers" (Paper No. 11, page 5, lines 6 through 8) does not counter applicants' argument, and amounts to a non-sequitur. As stated in In re Hoeksema, 399 F.2d 269, 274, 158 USPQ 596, 601 (CCPA 1968):

if the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public. In this context, we say that the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds. [Footnote omitted].

One further matter warrants attention. As stated in 35 U.S.C. § 112, fourth paragraph:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claim 4 in this application, which depends from claim 1, is manifestly improper because it does not "specify a further limitation of the subject matter claimed." Rather, claim 4 removes the limitation of "an agronomically acceptable carrier" recited in claim 1. Claim 4 defines a compound, i.e., "the compound of the composition of claim 1." On return of this application to the Examining Corps, we recommend that applicants and the examiner cooperate to correct the impropriety in dependant claim 4 noted in these remarks.

Conclusion

In conclusion, for the reasons set forth in the body of this opinion, we reverse the rejection of claims 1 through 4 and 8 through 10 under 35 U.S.C. § 103(a) as unpatentable over Michelotti. We also recommend that applicants and the examiner correct the impropriety in dependent claim 4.

The examiner's decision is reversed.

REVERSED

	)	
Sherman D. Winters	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
William F. Smith	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
Eric Grimes	)	
Administrative Patent Judge	)	

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