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BOARD OF PATENT APPEALS  
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 MASA HARU SAKAKI  
and KAZUO SAITOH

Appeal No. 94-3017  
Application No. 07/958,695<sup>1</sup>

HEARD: March 3, 1997

Before WEIFFENBACH, PAK and THIERSTEIN, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

Sakaki et al. (appellants) appeal from the examiner's final rejection of claims 1 through 24, which are all the claims remaining in the application.

<sup>1</sup> Application for patent filed October 9, 1992.

Appeal No. 94-3017  
Application No. 07/958,695

Claim 1 is the broadest representative subject matter on appeal and reads as follows:

1. A herbicidal composition comprising of (a) 2-[4-chloro-2-fluoro-5-(n-pentyloxycarbonylmethoxy)phenyl]-4,5,6,7-tetrahydro-2H-isoindole-1,3-dione and (b) at least one selected from the group consisting of N-(phosphonomethyl)glycine, (2-amino-4-methylphosphinobutyryl)alanyl-alanine, DL-homoalanin-4-yl(methyl)phosphinic acid and salts thereof.

The references of record relied upon by the examiner are:

Franz	3,799,758	Mar. 26, 1974
Rupp et al. (Rupp)	4,168,963	Sep. 25, 1979
Morita et al. (Morita '743)	4,756,743	Jul. 12, 1988
Nagano et al. (Nagano '695)	4,770,695	Sep. 13, 1988
Morita et al. (Morita '050)	4,935,050	June 19, 1990
		(filed Aug. 3, 1987)
Yoshida et al. (Yoshida)	4,906,289	Mar. 6, 1990
		(filed June 22, 1989)
Nagano et al. (Nagano '795)	4,938,795	Jul. 3, 1990
		(filed Dec. 17, 1986)
Yoshido et al. (Yoshido)	4,994,102	Feb. 19, 1991
		(filed Jul. 3, 1989)
Etheridge	5,108,488	Apr. 28, 1992
		(filed Jul. 21, 1989)

Claims 1 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined disclosures of Franz, Rupp, Nagano '795, Nagano '695, Morita '050, Morita '743, Yoshido, Yoshida and Etheridge.

We have carefully reviewed the record before us, including each of the arguments advanced by the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner has established a prima facie case of

Appeal No. 94-3017  
Application No. 07/958,695

obviousness regarding the claimed subject matter. However, the prima facie case of obviousness has been effectively rebutted by the evidence of unobviousness proffered by appellants.

Accordingly, we shall not sustain this rejection. Our reasons for these determinations follow.

The claimed subject matter is directed to a herbicidal composition comprising a combination of 2-[4-chloro-2-fluoro-5-(n-pentyloxycarbonylmethoxy)phenyl]-4,5,6,7-tetrahydro-2H-isoindole-1,3,-dione (hereinafter referred to as "indole component") and at least one selected from the group consisting of N-(phosphonomethyl)glycine, (2-amino-4-methylphosphinobutyryl)alanyl-alanine, DL-homoalanin-4-yl(methyl)phosphinic acid and salts thereof (hereinafter referred to as "glycine component").

As undisputed by appellants, the Nagano references disclose a number of indole derivatives, including the claimed indole component. See Brief, page 9. The claimed indole component, according to the Nagano references, is particularly useful as a herbicide for soybeans because it exhibits no material phytotoxicity when applied to soybeans. See Nagano '795, abstract, Table 2 and Nagano '695, column 34, claims 10 and 11 and Table 2. Although the Nagano references do not specifically mention

Appeal No. 94-3017  
Application No. 07/958,695

employing the claimed indole component with the claimed glycine component, they, as acknowledged by appellants, do indicate that the claimed indole component can be used together with other herbicidal compounds to improve their activity as herbicides and, in some cases, to produce a synergistic herbicidal effect. See brief, page 9. Franz also indicates that N-phosphonmethylglycine (the claimed glycine component) is most preferred among the herbicides disclosed because it does not harm many plants, including soybean. See columns 10 and 11. Further, Yoshido discloses employing an indole derivative together with N-phosphonmethyl glycine or its salt (the claimed glycine component) to impart a synergistic herbicidal activity. Finally, appellants acknowledge at page 10 of the specification that the claimed glycine component was commercially available at the time the application was filed. Given the ready availability of the claimed glycine component, the low phytotoxicity of the claimed glycine component toward soybean, the enhanced effect of the claimed glycine component on an indole derivative which is similar to the claimed indole component and the improved effect of combining the claimed indole component with other herbicide components, we are of the view that a person having ordinary skill in the art would have been led to use the claimed indole

Appeal No. 94-3017  
Application No. 07/958,695

evidence proffered by appellants effectively rebuts the prima facie case of obviousness.

Having determined that the evidence as represented by Tables 1 through 6 in the specification is sufficient to rebut the prima facie case of obviousness, we need not determine the sufficiency of the Sakaki declaration filed under 37 CFR 1.132.

REVERSED



CAMERON WEIFFENBACH )  
Administrative Patent Judge)



CHUNG K. PAK )  
Administrative Patent Judge)

BOARD OF PATENT )  
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INTERFERENCES )



JOAN THIERSTEIN )  
Administrative Patent Judge)

Appeal No. 94-3017  
Application No. 07/958,695

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