

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The 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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte IVAX INDUSTRIES

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Appeal No. 95-3361  
Application 90/003,195<sup>1</sup>

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ON BRIEF

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Before KIMLIN, JOHN D. SMITH and WEIFFENBACH, Administrative  
Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

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<sup>1</sup> Reexamination proceeding of U.S. Patent 5,213,581 to Ecolab Inc., now assigned to IVAX Industries, Inc., entitled "Compositions and Method That Introduce Variations In Color Density Into Cellulosic Fabrics Particularly Indigo Dyed Denim", issued May 25, 1993, based on application Serial No. 07/898, 845, filed June 15, 1992. According to applicant, this application is a continuation of Application 07/678,133, filed April 1, 1991, now Patent No. 5,122,159, issued June 16, 1992; which is a continuation of Application 07/245,123, filed September 15, 1988, now Patent No. 5,006,126 issued April 9, 1991.

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ON REMAND TO THE EXAMINER

In our decision entered January 29, 1996, we sustained the examiner's rejection of claims 1 through 11 under 35 U.S.C. § 103 over Geller in view of Tai or Barbesgaard and Novo in this reexamination proceeding involving U.S. Patent No. 5,213,581.

We also affirmed the examiner's rejection under 35 U.S.C. § 102(e) and § 103 based primarily on Olson `056 and Olson `864.

On appeal to the United States Court of Appeals for the Federal Circuit, the Court vacated the § 103 rejection and remanded for further consideration of two subsidiary factual issues. The Court also vacated and remanded the rejection under § 102(e) and § 103 in view of an asserted change in inventorship. With respect to the § 103 rejection based in part on Novo, the Court made the following statement at page 8 of its slip opinion<sup>2</sup>:

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<sup>2</sup> See *In re IVAX Industries*, No. 97-1012 (Fed. Cir. April 24, 1998).

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"[a] more thorough examination of Novo reveals that it teaches that cellulase achieves the desired effects of softening and color brightening by removing micro-fibrils protruding from the main fiber after extended wear and washing. The Board's analysis of Novo did not consider at least two questions of fact: (1) whether one of ordinary skill would glean from Novo not only the asserted effects of cellulase (softening and color brightening) but also the method for achieving those effects (microfibril removal) and (2) whether one of ordinary skill would derive from a teaching that cellulase removes microfibrils a suggestion that cellulase could be used to achieve effects in color variation.

Thus, the Court vacated and remanded the § 103 rejection for further proceedings consistent with their opinion.

Since questions of fact are best resolved at the examiner level, this reexamination proceeding is remanded to the examiner to consider and resolve the two subsidiary questions of fact raised by the Court, and, if appropriate, to restate a rejection under § 103 of the statute. In any restatement of this rejection, the examiner may wish to review the arguments at pages 26 and 27 of the Brief filed on behalf of the Commissioner of Patents and Trademarks (Paper No. 47).

In light of the Court's remand for consideration of the asserted change in inventorship, the examiner should also

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confirm whether or not the rejections based on Olson `056 and  
Olson `864 remain viable. In this regard, the examiner should  
review the

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various petitions of record and the decision on petition under  
37 CFR § 1.48(b) filed August 22, 1996 as Paper No. 43.

REMANDED

	EDWARD C. KIMLIN	)	
	Administrative Patent Judge	)	
		)	
		)	
	JOHN D. SMITH	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	CAMERON WEIFFENBACH	)	
	Administrative Patent Judge	)	

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