

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** GEORG FOLZ AND THEODOR PAPENFUHS

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Appeal No. 1996-0716  
Application 08/107,661<sup>1</sup>

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ON REQUEST FOR REHEARING

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Before METZ, JOHN DOUGLAS SMITH and DELMENDO, **Administrative Patent Judges**.

METZ, **Administrative Patent Judge**.

Appellants request rehearing under 37 C.F.R. § 1.197(b) (see Paper Number 26) of our decision mailed July 27, 2000 (Paper Number 25), wherein we affirmed the rejection of claims 1 through 10 and 13 through 15, all the claims remaining in this application. In affirming the examiner's rejection of the

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<sup>1</sup> Application for patent filed August 12, 1993, and filed under 35 U.S.C. § 371.

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claims under both 35 U.S.C. § 101 and § 112, first paragraph, we denominated our affirmance as a "new ground of rejection" under 37 C.F.R. § 1.196(b) because the examiner had specifically

withdrawn his rejection under 35 U.S.C. § 101 and because we relied on the "enablement" clause of 35 U.S.C. § 112, first paragraph in affirming the examiner's rejection under 35 U.S.C. § 112.

In our decision at page 12, appellants were advised of their options on how to proceed under the rule and appellants have chosen the second option under the rule. That is, appellants have requested rehearing of our decision based upon the same record. The relevant section of 37 C.F.R. § 1.197(b) provides that the request for rehearing:

must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.

We have carefully considered the entirety of appellants' request but, rather than being directed to facts or points of law which we "misapprehended or overlooked" in our decision,

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we find the request is, in essence, a statement by appellants expressing their disagreement with the merits of a particularly narrow portion of our opinion.

At page 2 of their request, appellants quote from a part of our decision at page 10 wherein appellants note that we observed that the issue before us was:

what "pesticides and herbicides" may be prepared from appellants' intermediates and how they are prepared.

Appellants then answer the question they have posed by concluding that the "pesticides and herbicides" which may be produced are the same as those disclosed in the patent to Ludvik (U.S. Patent Number 4,675,447). However, what appellants have failed to reproduce in their request are the sentences which immediately precede and follow the quoted portion above. Reproduced in context from our decision at page 10, we found:

In reaching the conclusion above, we have not overlooked appellants' argument from page 6 of their brief that the term "an intermediate for herbicides" is "an art recognized term." This is simply not the issue before us. Rather the issue before us is what "pesticides and herbicides" may be prepared from appellants' intermediates and how are they prepared. Appellants have simply failed to produce any evidence in this record which establishes that given only appellants' intermediates as starting materials a person of ordinary skill in the art could prepare useful "pesticides and herbicides" therefrom.

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For reasons expressed below, appellants have failed to convince us that we "misapprehended or overlooked" any fact or issue of law in reaching our conclusion that appellants' claims are not patentable under both 35 U.S.C. §§ 101 and 112.

As we noted at page 6 of our decision, whether or not an invention lacks utility is a question of fact. We also found that a deficiency under 35 U.S.C. § 101 created a deficiency under 35 U.S.C. § 112, first paragraph. We found that appellants' disclosure lacked sufficient detail to satisfy the requirements for an adequate disclosure of utility. We found the statement in appellants' specification at page 1, lines 11 and 12 that the compounds of appellants' process were "valuable intermediates for pesticides and herbicides" to be inadequate without more to establish a utility for the intermediates prepared by appellants' process. We also found that the two, parenthetical references to the Ludvik patent (page 1, lines 10 and 15 of the specification), taken in the context in which they were made, were understood to represent that Ludvik discloses the acknowledged prior art process over which appellants' process is said to be an improvement and that Ludvik discloses (and indeed claims) the compound 4-methylsulfonyl-1-methyl-2-chlorobenzene. See pages 7 and 8 of

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our decision.

Implicit in our factual findings with respect to 35 U.S.C. § 101 was a finding that making and using "herbicides and pesticides" from the intermediates prepared by appellants' claimed process would have required "undue experimentation" by the routinier in the art. Whether a disclosure is "enabling" is a legal conclusion based on the underlying facts. In re Wands, 858 F.2d 731, 735-37, 8 USPQ2d 1400, 1402, 1404 (Fed. Cir. 1988); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1268, 229 USPQ 805, 811 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1030 (1987).

Appellants' request suggests that we misapprehended that it should have been clear from appellants' specification that the claimed process was an improvement over the prior art process of Ludvik. However, on page 5 of our decision we specifically found that appellants' parenthetical reference to Ludvik's patent was understood to mean that Ludvik "discloses the aforementioned known prior art method for preparing the compounds obtained by appellants' process." Manifestly, we could not have "overlooked" a fact or an issue we have specifically addressed in our decision.

Further, appellants now urge that herein claimed process

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produces no new compounds but only the compounds of the prior art but by a new less expensive, non-polluting process which produces the prior art compounds in very good yields with high selectivity. On page 5 of our decision, we specifically analyzed appellants' disclosure from page 1, lines 4 through 10 of the specification and found said disclosure represented that except for the compound 4-methylsulfonyl-1-methyl-2-chlorobenzene which is disclosed by Ludvik, appellants' process produces "novel compounds." Thus, appellants now attempt to retreat from their representation on page 1, lines 4 through 10 of the specification that except for 4-methylsulfonyl-1-methyl-2-chlorobenzene the intermediates prepared by their process are different from (novel over) Ludvik's compounds. However, as the court observed in In re Ruff, 256 F.2d 590, 596, 118 USPQ 340, 346 (CCPA 1958):

When a man, or a witness, or an applicant for a patent, without knowing how it is going to affect his interest, makes a statement which he later attempts to deny when he has found it is against his interest, he will not be believed unless he produces convincing proof of his later assertion.

We have been provided no adequate explanation by appellants in their request for why we should now accept their change of position. Moreover, we could not have "misapprehended or

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overlooked" a fact or an issue we specifically addressed in our decision.

Contrary to appellants' representations in their request for rehearing, nowhere in appellants' specification is it disclosed that the products of appellants' process may be used as intermediates to prepare the same final products which Ludvik discloses may be prepared from his intermediates. We specifically addressed this issue in the paragraph bridging pages 4 and 5 of our opinion and on page 6 of our decision we specifically rejected appellants' attempt to broaden their disclosure by reference to Ludvik's disclosure.

Appellants' argument in their brief on rehearing is in reality a renewed argument that the entirety of the Ludvik patent has been incorporated by reference thereto in appellants' disclosure<sup>2</sup> and that Ludvik's disclosure satisfies appellants' burden under the statute. Thus, it is informative to review again exactly what Ludvik discloses as the utility for his compounds. Ludvik discloses at column 1, lines 15

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<sup>2</sup> Incorporation by reference is a means by which matter from another source for purposes of economy, amplification or clarity may be obtained by an incorporating statement which is clear and identifies exactly what the incorporated material is and where it may be found.

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through 17 that the compounds of Ludvik's synthesis are:

useful intermediates in the synthesis of pesticides such as herbicides containing an alkylsulfonylphenyl group.

However, as we stated in our decision with respect to Ludvik's disclosure:

the relevance of the disclosure in Ludvik's patent *vis-à-vis* appellants' disclosure is not apparent here because appellants' disclosure is not of the same scope as Ludvik's disclosure. Appellants only disclose pesticides and herbicides, generally, may be prepared from their intermediates unlike Ludvik who describes a family of herbicides defined by the presence of a particular chemical moiety may be prepared from his intermediates.

Thus, Ludvik discloses a particular type of pesticide, an herbicide "containing an alkylsulfonylphenyl group", may be prepared from his intermediates. Appellants' specification includes no comparable disclosure of what "herbicides and pesticides" may be prepared from appellants' novel intermediates. We recognize that, subject to compliance with 35 U.S.C. 112 and 132, the disclosure in a patent application may be supplemented or completed by reference to the disclosure set forth in other patents but the doctrine is not without limits. In re Lund, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1957). As the court observed in In re de Seversky, 474 F.2d 671, 674, 177 USPQ 144, 146:

mere *reference* to another application, or patent, or

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publication is not an *incorporation* of anything therein into the application containing such reference for the purposes of the disclosure required by 35 U.S.C. 112.

Even assuming, *arguendo*, that the entirety of Ludvik's was "incorporated" in appellants' disclosure, we adhere to our conclusion expressed on pages 6 and 7 of our decision that because we are not privy to the entire record of the prosecution of Ludvik's patent, we will not engage in speculating in what might have been done "on a different record in another application."

We also note that at page 7 of our decision, we observed that:

unless appellants' reference in their disclosure is a reference to a group of "pesticides and herbicides" well-known in the art at the time appellants' application was filed and a person of ordinary skill in the art would have known at the time appellants filed their application how to prepare said well-known "pesticides and herbicides" using appellants' compounds as starting materials, we find the disclosure to be inadequate to satisfy the statutory requirements of both 35 U.S.C. §§101 and 112, first paragraph.

Appellants have failed to direct our attention both in their brief and in their request for rehearing to any evidence which supports appellants' position implicit in their argument. That is, appellants have provided no evidence establishing that the hypothetical person of ordinary skill in the art would have

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known what "herbicides and pesticides" could be prepared from the intermediates prepared by appellants' process and would have known how to prepare such "herbicides and pesticides". As we observed at page 7 of our decision:

The parenthetical reference to U.S. Patent 4,675,447 at line 10 is understood to represent only that said patent discloses the compound 4-methylsulfonyl-1-methyl-2-chlorobenzene, although appellants' citation to the patent does not direct us to any particular portion of the patent. (emphasis added, footnote omitted)

Thus, we are left to conjecture which of appellants' intermediates may be converted to what specific "herbicides or pesticides" and by what method the "herbicides and pesticides" may be prepared.

At page 2 of their request, appellants discuss a portion of our decision wherein we found that with respect to the utility disclosed for Ludvik's compounds, appellants' disclosure was not of the same scope as Ludvik's disclosure. We specifically directed appellants' attention to Ludvik's disclosure concerning what uses Ludvik disclosed for his intermediates. Indeed, appellants acknowledged in their brief that Ludvik discloses at column 1, lines 5 through 17 that Ludvik's intermediates are "useful in the synthesis of pesticides such as herbicides containing an

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alkylsulfonylphenyl group." See page 8 of our decision. Thus, taken in context, our discussion concerning the scope of Ludvik's disclosure of utility for his intermediates *vis-à-vis* appellants' disclosure of utility for their intermediates was a discussion of the scope of Ludvik's statement of utility for his intermediates and not a general statement concerning the full scope of Ludvik's disclosure.

Nonetheless, to fully respond to appellants' arguments concerning the relative scope of appellants' disclosure *vis-à-vis* Ludvik's disclosure we observe that Ludvik's disclosure of "lower alkyl" for the substituents on the benzene and sulfonyl moieties in his intermediates is broader than appellants' disclosure of alkyl groups of from 1 to 4 carbon atoms for their intermediates. For example, in the classification system of the United States Patent and Trademark Office "lower alkyl" generally embraces any alkyl group of seven or less carbon atoms. Thus, while "lower alkyl" embraces alkyl groups having from 1 to 4 carbons, "lower alkyl" also embraces alkyl groups with more than 4 carbon atoms and up to 7 carbons. Accordingly, appellants' disclosure and Ludvik's are of different scope.

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Accordingly, appellants' request has been granted to the extent we have reviewed and reconsidered our decision in light of appellants' request for rehearing but it is otherwise denied because we decline to modify our decision in any other respect.

**DENIED.**

ANDREW H. METZ )  
Administrative Patent Judge )  
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JOHN D. SMITH ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
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