

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte COLIN C. FOAN and ANTHONY R. WOODFORD

Appeal No. 1997-1903
Application No. 08/229,118

HEARD: October 24, 2000

Before KIMLIN, WARREN and JEFFREY SMITH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-4, 7-23 and 28-32, all the claims remaining in the present application. Claim 1 is illustrative:

1. A mixture of bromoxynil n-octanoate and bromoxynil n-heptanoate wherein the molar ratio of bromoxynil n-octanoate to bromoxynil n-heptanoate is from 1:1.5 to 1.5:1.

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The examiner relies upon the following references as evidence of obviousness:

Heywood et al. (Heywood) (Great Britain patent specification)	1,067,033	Apr. 26, 1967
Esposito	4,332,613	Jun. 1, 1982

Appellants' claimed invention is directed to a herbicidal mixture of bromoxynil n-octanoate and bromoxynil n-heptanoate. According to appellants, the claimed mixture possesses an unexpectedly lower melting point than the melting point of either of the separate compounds, a significantly lower crystallization temperature than that exhibited by either of the separate compounds, as well as unexpected superiority in herbicidal activity.

Appealed claims 1-4, 7-23 and 28-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heywood in combination with Esposito.

Upon careful consideration of the opposing arguments presented on appeal, we agree with appellants that the prior art applied by the examiner fails to establish the obviousness of the claimed subject matter within the meaning of 35 U.S.C. § 103. Accordingly, we will not sustain the examiner's rejection.

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While there is no dispute that Heywood discloses a broad genus which encompasses appellants' bromoxynil n-octanoate and bromoxynil n-heptanoate which exhibits herbicidal activity, the examiner relies upon Esposito for disclosing a combination of esters of bromoxynil within a narrower genus which includes C₄-C₈ esters. Like the presently claimed compounds and those disclosed by Heywood, Esposito teaches that the mixture of esters exhibits herbicidal activity. According to the examiner, "[a]lthough Esposito suggests the combination of the n-butyrate and n-octanoate esters of bromoxynil as the preferred and most effective embodiment, the initial teaching embodies various combination [sic, combinations] of C₄-C₈ esters of bromoxynil" (page 4 of Answer, first paragraph).

The fatal flaw in the examiner's reasoning is that Esposito does not disclose C₄-C₈ esters of bromoxynil. Rather, in the section of Esposito relied upon by the examiner (column 2, lines 10-23), Esposito expressly discloses that "n is an integer having a value of 2 or 6" (lines 22 and 23, emphasis added), which translates into the singular mixture of the n-butyrate and n-octanoate esters. Hence, the examiner errs in

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stating that the structural formula disclosed by Esposito includes the n-heptanoate ester. Consequently, based on this deficiency in Esposito, it cannot be said that Esposito provides the motivation to select a mixture of the particular esters recited in the appealed claims from the genus disclosed by Heywood.

To the extent that the genus of Heywood, considered alone, establishes a prima facie case of obviousness for appellants' mixture, the prima facie case has been effectively rebutted by appellants' specification evidence and Declaration of Robert G. Bruss. Regarding the examiner's criticism that the Bruss Declaration is not probative of nonobviousness because the herbicidal advantages demonstrated in the Declaration "were never disclosed by the applicant in the specification at the time the application was filed" (page 7 of Answer), the examiner has not demonstrated that such herbicidal advantages would not naturally flow from use of the claimed mixture. In re Davies, 475 F.2d 667, 670, 177 USPQ 381, 384-85 (CCPA 1973); In re Khelghatian, 364 F.2d 870, 876,

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150 USPQ 661, 666 (CCPA 1966); In re Zenitz, 333 F.2d 924,
927-28, 142 USPQ 158, 161 (CCPA 1964). See also
In re Herr, 304 F.2d 906, 909, 134 USPQ 176, 178-79 (CCPA
1962).

In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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