Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD R. PRICE,
JOEL M. SCHNUR,
PAUL E. SCHOEN,
MARY TESTOFF,
JACQUE H. GEORGER, JR.,
ALAN RUDOLPH,
and
ROBERT F. BRADY

Appeal No. 1997-1937
Application No. 08/206,149

HEARD: JANUARY 18, 2001

Before GARRIS, WARREN, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 8 through 12 and 16 through 24, which are all the claims pending in this application. [1]

[1]Claims 1 through 7 and 13 through 15 were canceled by an amendment received April 10, 1996, and entered by the examiner. See Answer, page 2.

THE INVENTION

The invention is directed to a composition in the form of a solution or dispersion of an active agent present in the lumen of a tubule for causing the controlled release of the active agent to the environment. The active agent is present in a carrier. The dimensions of the tubule comprise an inner diameter of 0.1 to 1 µm and a length of 1 µm to 1 mm.

THE CLAIM

Claim 8 is illustrative of appellants' invention and is reproduced below:

8. A composition for effecting the controlled release of an active agent to the environment, comprising a tubule containing a solution or dispersion of an active agent in a carrier in the lumen thereof, wherein said tubule has an inner diameter of from 0.1 to 1 µm and a length of 1 µm to 1 mm.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Frensch et al. (Frensch)	4,244,836	Jan. 13, 1981
Schnur et al. (Schnur)	4,911,981	Mar. 27, 1990
della Valle et al. (della Valle)	5,416,205	May 16, 1995

Kydonieus et al. (Kydonieus), Insect Suppression with Controlled Release Pheromone Systems, Vol. 1, p. 200-04 (Boca Raton, FL, CRC Press, Inc., 1982).

THE REJECTIONS[2]

Claims 8, 10 through 12, 17 through 19, and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kydonieus in view of Frensch.

Claims 9 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kydonieus in view of Frensch and further in view of Schnur.

Claims 20 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Frensch in view of Schnur.

Claims 21 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Frensch in view of della Valle.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner, and agree with the appellants that the aforementioned rejections of claims 8 through 12 and 16 through 24 are not well founded. According to ***The Rejections under §103***

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a ***prima facie*** case of unpatentability," whether on the grounds of anticipation or obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On the record before us the examiner relies upon four separate rejections, each relying upon a combination of at least two references to reject the claimed subject matter and establish a ***prima facie*** case of obviousness. The basic premise of the rejection is that, "it would have been obvious to one of ordinary skill in the art of active

[2]A double patenting rejection over U.S. Patent No. 5,492,696 was withdrawn by the examiner. See paper no. 24, a communication from the examiner mailed September 20, 2000.

agent release in an environment to practice the capsule of desired size and active for control of a desired pest, whether crop or medical pathogen." See Answer, page 5. We disagree.

Our initial inquiry is directed to the scope of the claimed subject matter. During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, and the claim language is to be read in view of the specification as it would be interpreted by one of ordinary skill in the art. ***In re Morris***, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); ***In re Sneed***, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); ***In re Okuzawa***, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 19

Our construction of the subject matter defined by appellants' claim 8 is that the claimed subject matter is directed to a "tubule." We find that the appellants have stated that a tubule is a "submicron diameter hollow cylinder[]." See specification, pages 1 and 8. We further find that in form and structure "tubules are analogous to soda straws." See specification, page 8. Accordingly, we conclude that the claimed "tubules" are hollow and cylindrical in form with both ends being open. Moreover, we find this conclusion to be in accordance with the Brief, page 2, wherein the appellants state, "[t]he tubules of the present inventi microcylinders (pages 16-17). They are small cylindrical containers that are open [at] both ends."

In accordance with our analysis herein, we make the following findings. We find that Kydonieus is directed to insect suppression by controlled release pheromone systems. We find that solid plastic pellets are formulated from a low temperature fusing polyvinyl chloride resin, a phthalate plasticizer and attractant. See page 202. The plastisol mixture is transferred into a mold which may be hollow glass tubing. Sections of the glass tubing are thereafter broken off. See page 203. The polyvinyl chloride acts as a carrier for the pheromone. The exposed strip of polyvinyl chloride is thereafter cut into a pellet sized bait. See l wherein 5 mm by 3 mm polyvinyl chloride monitoring baits are cut to size. Although there are similarities to the claimed subject matter, the final product is a plastic pellet, not a tubule. In addition, the dimensions of the product are of a different order than that of the claimed subject matter.

As to the reference to Frensch, we find that Frensch discloses microcapsules of water soluble polyvinyl alcohol. See Abstract and column 1, lines 6-7. The microcapsules are used as carriers for substances including pharmaceutical preparations and chemical reagents. See column 1, lines 18-20 and lines 55-65. The particle size of the microcapsules is from about 1 to 20 microns. See column 4, lines 45-48 and Example 1. We find that active agents are exemplified at column 5, lines 7-24. Note however, that microcapsules are structurally distinct from tubules, which are hollow cylinders open at

each end. Microcapsules, in contrast, completely enclose the active agent. Accordingly, they neither anticipate nor establish a ***prima facie*** case of obviousness over the claimed subject matter directed to a tubule.

Even if were we able to combine the references to Kydonieus and Frensch alone or with other references, in the manner suggested by the examiner, the structure created would, in any event fall short of the invention defined by the claimed subject matter, as the aforesaid claimed subject matter require of a particular dimension that cannot be achieved by combining the references of record. ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), ***cert. denied***, 488 U.S. 825 (1988). Accordingly, the examiner has not established a ***prima facie*** case of obviousness.

The rejections of the examiner are not sustained.

DECISION

. The rejection of claims 8, 10 through 12, 17 through 19, and 22 under 35 U.S.C. § 103 as being unpatentable over Kydonieus in view of Frensch is reversed.

The rejection of claims 9 and 16 under 35 U.S.C. § 103 as being unpatentable over Kydonieus in view of Frensch and further in view of Schnur is reversed.

The rejection of claims 20 and 23 under 35 U.S.C. § 103 as being unpatentable over Frensch in view of Schnur is reversed.

The rejection of claims 21 and 24 under 35 U.S.C. § 103 as being unpatentable over Frensch in view of della Valle is reversed.

REVERSED

BRADLEY R. GARRIS)
Administrative Patent Judge)
)
)
)
)
)
)
CHARLES F. WARREN) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)
)
)
PAUL LIEBERMAN)
Administrative Patent Judge)

PL:hh

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT
1755 JEFFERSON DAVIS HIGHWAY
FOURTH FLOOR
ARLINGTON, VA 22202