

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP E. HOWSE

Appeal No. 1997-2665
Application No. 08/099,248

ON BRIEF

Before WINTERS, PAK, and ROBINSON, Administrative Patent Judges.
ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 52 - 61. The remaining pending claims 47 and 48 have been indicated allowable by the examiner. (Paper No. 25).

Claims 52 and 61 are illustrative of the subject matter on appeal and read as follows:

52. A method of controlling a population of a selected species of ants by inducing foraging members of said population of said selected species of ants to transport a toxic substance back to their nest due to the behavior-modifying effects of a behavior-modifying substance on said selected species of foraging ants such that said toxic substance is distributed to other members of said population of said selected species of

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ants and said selected species of ants are killed by exposure to said toxicant substance, said method comprising the step of:

providing to said selected species of foraging ants a bait consisting essentially of:

(1) a toxic amount of a substance which is toxic to said selected species of ants which is transportable by said selected species of foraging ants from a location external to said ant's nest back to said population of said selected species of ants, said substance having delayed action sufficient to permit said selected species of foraging ants to transport said substance back to their nest before said selected species of foraging ants are killed by said substance;

(2) an effective amount of a behavior-modifying substance selected from the group consisting of 3-octanol, 3-octanone, nonanol, decanal, dodecanal, 2-phenylethanol, citral, farnesol, 6-methyl-5-hepten-2-one, 4-methyl-3-heptanone, decanoic acid, geraniol, tetradecanal, β -pinene and mixtures thereof, said behavior modifying substance and said toxic substance being in association with each other; and

whereby exposure of said selected species of ants to said behavior-modifying substance induces said selected species of ants to transport a greater amount of said toxic substance back to their nest, to admit said toxic substance to the nest and to distribute said toxic substance to other members of said population of said selected species of ants and said selected species of ants are killed by exposure to said toxic substance.

61. A method of improving the amount of toxic substance retrieved by a selected species of ants comprising the steps of:

providing to foraging members of said selected species of ants a toxic substance in association with an effective amount of behavior modifying substance, said behavior modifying substance comprising the structural equivalent of at least one component of the alarm pheromone of said selected species of ants, whereby a greater amount of said toxic substance is retrieved by said selected species of ants.

The references relied upon by the examiner are:

Hurt
(United Kingdom)

2,018,593

Oct. 24, 1979

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Stoner "Toxicity Effects and Chalkbrood Incidence in Honey Bee Colonies Fed Controlled Doses of Fungicides," Chemical Abstract Vol. 103, Abst. No. 191146e (1985)

Morgan "The Mandibular Gland Secretion of the Ant, Myrmica scabrinodis," Chemical Abstract, Vol. 89, Abst. No. 143599a (1978)

Kydonieus et al. (Kydonieus), Insect Suppression with Controlled Release Pheromone Systems, CRS Press, Boca Raton, Fl., Vol. 1. pp 108-118, (1982)

Grounds of Rejection

Claims 52 - 61 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an insufficient enabling disclosure for the subject claimed.

Claims 52 - 61 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Hurt, Stoner, Kydonieus, and Morgan.

We reverse the rejection under 112, first paragraph, and remand the application to the examiner for further consideration of the rejection under 103 for the reasons set forth herein.

Discussion

The rejection under 35 U.S.C. § 112, first paragraph

Claims 52 - 61 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure which is not enabling for the full scope of the claimed invention. The full text of the examiner's statement of the basis for this rejection is reproduced below (Answer, page 2):

The claims are method claims, and control could not be attained, unless additional information is provided, without undue experimentation by one of ordinary skill in the art. The claims thus are beyond the scope of the specification.

The Patent and Trademark Office (PTO) bears the initial burden of providing reasons for doubting the objective truth of the statements made by applicant as to the scope of enablement. Only when the PTO meets this burden, does the burden shift to applicant to provide suitable evidence indicating that the specification is enabling in a manner commensurate in scope with the protection sought by the claims. In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

Factors appropriate for determining whether undue experimentation is required to practice the claimed invention throughout its full scope are listed in In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). These factors include:

- (1) the quantity of experimentation necessary,
- (2) the amount of direction or guidance presented,
- (3) the presence or absence of working examples,
- (4) the nature of the invention,
- (5) the state of the prior art,
- (6) the relative skill of those in the art,
- (7) the predictability or unpredictability of the art, and
- (8) the breadth of the claims

A conclusion of lack of enablement means that, based on the evidence regarding the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510,

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1513 (Fed. Cir. 1993). The examiner's statements in support of this rejection fall far short of the minimum factual inquiry necessary to support a rejection of the appealed claims as based on a non-enabling disclosure. The record, before us, does not reflect a consideration of any of the factors enumerated in Wands. It is sufficient for purposes of reviewing this issue to note that conclusionary statements, unsupported by facts or evidence, can not be regarded as meeting the minimum threshold of establishing a prima facie case of lack of enablement. Therefore, the rejection of claims 52 - 61 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejection under 35 U.S.C. § 103

Claims 52 - 61 stand rejected under 35 U.S.C. § 103 as being obvious over Hurt, Stoner, Kydonieus, and Morgan.

In considering the issues raised by this rejection we have concluded that the record before us is not capable of meaningful review. We, therefore, remand this application to the examiner for further consideration of the rejection under 35 U.S.C. § 103.

We, initially, note that the Morgan reference would reasonably appear to be the most relevant to the claimed invention since it mentions ants and describes certain compounds which are described as "attractants". These compounds appear to be the same or at least closely related to the behavior modifying substances of claim 52. Yet, the abstract, relied on, provides no information on the possible use of these materials in the control of a selected specie of ant as presently claimed. Similarly, the examiner has relied

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upon an abstract of a published article by Stoner et al. which names a pesticide and an additional compound, i.e., citral, which reasonably appear to fall within the scope of the combination used in the claimed invention. However, the information provided by both abstracts is so limited as to preclude a reasonable consideration of both the examiner's position or that put forth by the appellant.

A patentability determination under 35 U.S.C. § 103 is fact specific. Almost by definition the full text document which is abstracted is more fact rich than the abstract. It is the experience of the board that review of the full text document when a rejection is premised upon an abstract will most likely significantly strengthen or weaken the examiner's position. Rarely does consideration of the full text document leave one in the same position where one was after considering the abstract alone. Here the abstracts offer little information beyond the mentioning of several ingredients and do not, on their face, relate to the presently claimed method of controlling an ant species.

For these reasons, we do not reach the rejection under 35 U.S.C. § 103, but remand to the examiner to ascertain whether the underlying articles of the abstracts presently relied on, would reasonably support a conclusion that the claimed subject matter is prima facie obvious within the meaning of 35 U.S.C. § 103.

Other Issues

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In reconsidering the patentability of the claims of this application we would urge the examiner to first ascertain the scope of the claimed subject matter. A patentability determination must begin with the scope of the claims being ascertained. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert denied, 481 U.S. 1052 (1987). (“Analysis begins with a key legal question--what is the invention claimed?”). In similar fashion, the court stated in In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970), “[t]he first inquiry must be into exactly what the claims define.”

In the present application, this effort should begin with a determination of just what is intended by the phrase “to transport a greater amount” as used in claim 52. From our review of the specification it is not readily apparent what this language intends to compare the claimed invention with. Similarly, claim 61 provides that the “behavior modifying substance” is comprised of “the structural equivalent of at least one component of the alarm pheromone.” The specification does not appear to provide guidance as to how this phrase should be interpreted by one skilled in this art trying to ascertain the scope of the claimed invention. We would urge the examiner and appellants to work together to determine the meaning or intent of these two phrases so as to permit a meaningful comparison of the claimed invention with the prior art.

Summary

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The rejection of claims 52 - 61 under 35 U.S.C. § 112, first paragraph is reversed.
We do not reach the rejection of claims 52 - 61 under 35 U.S.C. § 103 as unpatentable over Hurt, Stoner, Kydonieus and Morgan, but remand the application to the examiner for further consideration as outlined above.

REVERSED AND REMANDED

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| Sherman D. Winters |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| Chung K. Pak |) | |
| Administrative Patent Judge |) | APPEALS AND |
| |) | |
| |) | INTERFERENCES |
| |) | |
| Douglas W. Robinson |) | |
| Administrative Patent Judge |) | |

SW/dym

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