

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 HANS ROCHLING,
HANS SCHUMACHER,
and JOACHIM BAUMGARTNER

Appeal No. 1998-1247
Application 08/445,165

HEARD: JUNE 13, 2001

Before, GARRIS, WALTZ, and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicant appeals the decision of the Primary Examiner finally rejecting claims 17, 18 and 20-22.¹ We have jurisdiction under 35 U.S.C. § 134.

¹ Claim 19 has been withdrawn from consideration by the Examiner as drawn to a non-elected species. (See paper no. 25)

BACKGROUND

The invention is directed to water dispersible granules of suspoemulsions. Suspoemulsions are aqueous dispersions of solids of sufficiently high melting point, such as isotroturon, and in which the solution of a second active substance, such as fluoroglycofen ethyl, is emulsified. The selection of a solvent which does not evaporate during the granulation process is required for the invention. (Specification, p. 2). The granules are useful for crop production. Claim 17 which is representative of the claimed invention is reproduced below:

17. Water-dispersible granules of suspoemulsions consisting essentially of
- 10 to 90% by weight of one or more pesticidally active substance as the main component, said active substance having a melting point of more than 65°C, which can be formulated in the form of an aqueous dispersion,
 - 0.1 to 20% by weight of one or more liquid pesticidally active substance or a pesticidally active substance having a melting point below 65°C and/or which is not sufficiently active in the solid state, in dissolved form,
 - 0.2 to 20% by weight of a solvent or solvent mixture with a boiling point above 170°C,
 - 1 to 12% by weight of one or more wetting agents,
 - 2 to 15% by weight of one or more dispersants,
 - 0.2 to 5% by weight of one or more adhesives,
 - 0.5 to 80% by weight of inert substance and
 - 0.5 to 10% by weight of one or more emulsifiers.

As evidence of unpatentability, the Examiner relies on the following references:

Appeal No. 1998-1247
Application No. 08/445,165

Schlicht et al. (Schlicht) EP 388,867 Sep. 26, 1990
(published EP patent application)

The Agrochemicals Handbook. The Royal Society of Chemistry, UK, August 1991,
p. A0973.

THE REJECTIONS

The Examiner entered the following rejections:

Claims 17 and 20-22 are rejected as unpatentable under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure. (Answer, p. 3).

Claim 21 is rejected as unpatentable under 35 U.S.C. § 112, second paragraph, as improperly dependent on claim 17. (Answer, p. 4).

Claims 17, 18 and 20-22 are rejected as unpatentable under 35 U.S.C. § 103 over the combination of EP 388,867 (Schlicht) and The Agrochemicals Handbook. (Answer, p. 4).

OPINION

We affirm the rejection under § 112, second paragraph, and reverse the remaining rejections for the reasons below.

The Rejection under 35 U.S.C. § 112, First Paragraph²

² We will not address Appellants comments regarding claims 18 and 19 because these claims have not been rejected under § 112, first paragraph.

Appeal No. 1998-1247
Application No. 08/445,165

In rejecting claims 17 and 20-22 under the first paragraph of 35 U.S.C. § 112, the Examiner asserts the specification as originally filed, does not provide support for the invention as is now claimed. In order for a claim to satisfy the written description requirement, the original application must reasonably convey to those skilled in the relevant art that the applicants, as of the filing date of the application, had possession of the claimed invention. *In re Alton*, 76 F.3d 1168, 1172, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). However, the written description requirement does not require the applicants to describe exactly the subject matter claimed in the original application. Instead, the description must clearly allow persons of ordinary skill in the art to recognize that the applicants invented what is claimed. *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Rather than carry his initial burden of establishing a *prima facie* case, the Examiner has inappropriately leaped to the conclusion that specification as originally filed, does not provide support for the invention as is now claimed. The Examiner, in the statement of the rejection, did not specifically provide reasons for doubting any assertions in the specification as to the scope of enablement. Thus, the Examiner inappropriately has required the Appellants to carry the initial burden of proving that the claimed subject matter is described. For example, the Examiner asserts “[a]pplicants have

Appeal No. 1998-1247
Application No. 08/445,165

demonstrated how one specific combination appears to attain enhanced activity when formulated according to the instant application. That the activity of one specific combination of ingredients appears enhanced when formulated according to the instant application does not appear to provide support for any unexpected activity when other ingredients are used in said formulation(s).” (Answer, p. 3).

The rejection before us appears to be premised upon nothing more than a concern over the breadth of the claims. It appears that the Examiner would limit the appealed claim coverage to water dispersible granules containing isoproturon and fluoroglycofenethyl. It has long been established, however, that to provide effective incentives, claims must adequately protect inventors. Therefore, to demand that the first to disclose shall limit his claims to what they have found will work would not serve the constitutional purpose of promoting progress in the useful arts. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

In light of the foregoing, the rejection of claims 17 and 20 to 22 under § 112, first paragraph is reversed.

The Rejection under 35 U.S.C. § 112, Second Paragraph

Appeal No. 1998-1247
Application No. 08/445,165

The Examiner has rejected claim 21 as unpatentable under 35 U.S.C. § 112, second paragraph as indefinite.

The purpose of the second paragraph of Section 112 is to basically insure an **adequate** notification of the metes and bounds of what is being claimed. *See In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

According to the Examiner, claim 17 does not provide proper antecedent basis for claim 21. The Examiner states “[c]laim 21 which now depends from claim 17, recites a method of controlling undesired plants using the preparation of claim 17. Claim 17 recites the active component as being a ‘pesticidally active substance’. It is not seen how any ‘pesticidally active substance’ would provide the dependent claim 21’s utility of plant control.” (Answer, p. 4). The Examiner suggests this rejection can be overcome by amending claim 21 to include the language “which contains a herbicidal agent”.

In response to this rejection, Appellants state, in the reply brief, “applicants will amend claim 21 to overcome this formal issue and insert the language suggested by the Examiner”. (Reply Brief, p. 3).

Appeal No. 1998-1247
Application No. 08/445,165

Claim 21, as of the time of this decision, has not been amended as suggested by the Examiner. Since Appellants have acquiesced to the rejection as presented by the Examiner, we will affirm the rejection of claim 21 as unpatentable under 35 U.S.C. § 112, second paragraph as indefinite.

The Rejection under 35 U.S.C. § 103

Claims 17, 18 and 20-22 are rejected as unpatentable under 35 U.S.C. § 103 over the combination of Schlicht and The Agrochemicals Handbook.³

We have thoroughly reviewed each of the arguments for patentability contained in the Examiner's Answer and in Appellants' Brief and Reply Brief. We are in complete agreement with Appellants that the claimed subject matter would not have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will reverse the Examiner's rejection of claims 17, 18 and 20 to 22.

“[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.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

³ In rendering our decision, we will refer to the English translation of Schlicht which has been provided by the USPTO and included in the present record.

Appeal No. 1998-1247
Application No. 08/445,165

The Examiner's position is the stabilization of the known combination of fluoroglycofen-ethyl and isoproturon would have been obvious. The Examiner's position is reproduced below:

EP 388,867 [sic, Schlicht] teaches that isoproturon may be formulated into water dispersible granules.

The Ag. Handbook teaches fluoroglycofen-ethyl and isoproturon are known to exist in combination.

It would appear to have been obvious to one of ordinary skill in the herbicidal art to stabilize the known water dispersible isoproturon granule with an additional active ingredient which is known to be formulated with isoproturon wherein a herbicidally effective granule would ensue. (Answer, pp. 4-5).

The subject matter of claim 17 is directed to water-dispersible granules of suspoemulsions. The suspoemulsion of claim 17 is an emulsified composition including an aqueous dispersion of a pesticidally active substance having a melting point more than 65°C, a solution of a second active pesticidally active substance having a melting point below 65°C and a solvent which has a boiling point above 170°C. Isoproturon is an example of a high melting point substance. Fluoroglycofen ethyl is an example of a low melting point substance. (Specification, p. 3).

The Examiner cites The Agrochemicals Handbook as evidence that the combination of fluoroglycofen-ethyl and isoproturon is known to those skilled in the art. The Examiner has not indicated that a suspoemulsion of fluoroglycofen-ethyl and isoproturon is known. The Examiner has not indicated that the granulation of

Appeal No. 1998-1247
Application No. 08/445,165

fluoroglycofen-ethyl is known. The present record indicates the selection of the solvent which does not evaporate during granulation is important in forming a suspoemulsion. (Specification, p. 2). The Examiner has not specified the portions of the cited references which recognize or suggest the use of solvents with this property. To the extent that Schlicht teaches isoproturon may be formulated into water dispersible granules, Schlicht does not describe the formation comprising a suspoemulsion of the combination of an aqueous dispersion of a pesticidally active substance having a melting point more than 65°C, a solution of a second active pesticidally active substance having a melting point below 65°C and a solvent which has a boiling point above 170°C as required by claim 17.

In the absence of sufficient factual evidence or scientific rationale on the part of the Examiner to establish why and how a skilled artisan would have arrived at

Appellants' claimed invention from the applied references' teachings as discussed above, we find that the Examiner has failed to meet the initial burden of establishing the *prima facie* obviousness of the claimed subject matter. Accordingly, we are constrained to reverse the Examiner's rejection.

Appeal No. 1998-1247
Application No. 08/445,165

Since we reverse for the lack of the presentation of a *prima facie* case of obviousness by the Examiner, we need not reach the issue of the sufficiency of the evidence in the specification as allegedly demonstrating unexpected results. *See In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

CONCLUSION

The rejection of claims 17 and 20-22 as unpatentable under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure is reversed.

The rejection of claim 21 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejection of claims 17, 18 and 20 to 22 as unpatentable under 35 U.S.C. § 103 over the combination of Schlicht and The Agrochemicals Handbook is reversed.

Appeal No. 1998-1247
Application No. 08/445,165

Time for taking action

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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| BRADLEY R. GARRIS |) | |
| Administrative Patent Judge |) | |
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| THOMAS A. WALTZ |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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Appeal No. 1998-1247
Application No. 08/445,165

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