

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETER M. BLUMBERG

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Appeal No. 95-2416  
Application 07/892,484<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, GARRIS and OWENS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1 through 5, 7, 9, 16, 17, 20, 21, 23 and 24. Claims 8, 10 through 13, 15, 18, 19, 25 and 26 stand withdrawn from further consideration as directed to a non-elected invention.

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<sup>1</sup> Application for patent filed June 3, 1992. According to appellant, this application is a continuation of Application 07/574,159 filed August 29, 1990, now abandoned.

Representative claims 1, 7, 20, 23 and 24 are reproduced below:

1. Treated birdseed, comprising:

(i) birdseed selected from the group consisting of sunflower seeds, millet, barley, oats, wheat, corn, peanuts, thistle seed, sorghum, sudan grass seed, watergrass seed, clover seed and mixtures thereof, and

(ii) an effective amount of a material containing capsaicin or a derivative or an analogue thereof coated on, impregnated in or mixed with said birdseed in a ratio of about 1 part in 200 to about 1 part in 100,000 by weight, for repelling animals having capsaicin sensitive receptors from eating said treated birdseed, with the proviso that said treated birdseed does not have effective amounts of other ingredients that would repel birds.

7. The treated birdseed of claim 1, wherein the proportion of the material containing capsaicin or a derivative or an analogue thereof to seed is in the range of about 1 part in 200 to 1 part in 10,000 by weight.

20. A method of selectively repelling animals having capsaicin sensitive receptors, which comprises feeding said treated birdseed of claim 1 to birds in an amount effective for repelling animals having capsaicin sensitive receptors from eating said treated birdseed.

23. Treated birdseed for wild birds, comprising:

(i) whole seed selected from the group consisting of sunflower seeds, millet, barley, oats, wheat, corn, peanuts, thistle seed, sorghum, sudan grass seed, watergrass seed, clover seed and mixtures thereof, and

(ii) a material containing capsaicin or a derivative or an analogue thereof coated on, impregnated in or mixed with said birdseed in a ratio of about 1 part in 200 to about 1 part in 100,000 by weight, for repelling animals having capsaicin

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sensitive receptors from eating said treated birdseed, with the proviso that said treated birdseed does not have effective amounts of other ingredients that would repel wild birds.

24. A method of selectively repelling animals having capsaicin sensitive receptors, which comprises feeding said treated birdseed of claim 23 to birds in an amount effective for repelling animals having capsaicin sensitive receptors from eating said treated whole birdseed.

The references of record relied upon by the examiner are:

Myers	321,909	Jul. 7, 1885
Cartwright	826,990	Jul. 24, 1906
Glabe et al. (Glabe)	4,161,543	Jul. 17, 1979

Sann et al. (Sann), "Effect Of Capsaicin Upon Afferent And Efferent Mechanism Of Nociception And Temperature Regulation In Birds," Can. J. Physiol. Pharmacol., Vol. 65 (1987) pp. 1347-1354.

The appealed claims stand rejected for obviousness (35 U.S.C. § 103) over Cartwright in view of Glabe. As evident from the discussion in the Answer and the Reply brief, the examiner also relies on Myers and Sann as additional evidence<sup>2</sup> of obviousness.

We affirm the rejection as to claims 1 through 5, 7, 9, 16,

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<sup>2</sup> When a reference is relied on to support a rejection even in a "minor capacity", ordinarily that reference should be positively included in the statement of rejection. See In re Hoch, 428 F.2d 1341, 1342, n.3, 166 USPQ 406, 407, n.3 (CCPA 1970). Here, it appears that appellant has not been prejudiced by the examiner's reliance on the Myers patent and the Sann publication, inasmuch as the examiner has entered appellant's Reply Brief which contains specific arguments with respect to disclosures in these prior art references.

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17 and 21. We reverse the rejection as to claims 20, 23 and 24.

The subject matter on appeal is directed to preparations of birdseed treated with capsaicin or its derivatives or analogues in an amount sufficient to be unpalatable to animals such as rats, mice and squirrels which have capsaicin sensitive receptors. Capsaicin is an oleoresin present in capsicum (cayenne pepper, chili, pepper red) and is a known powerful irritant which causes intense pain in humans and experimental animals. In appellant's invention, these "hot" capsaicin compounds, extracts or whole plant materials containing these compounds are coated on, impregnated in or mixed with birdseed to repel troublesome animals which recognize these compounds as "hot". In contrast, these same "hot" compounds do not repel birds because birds do not have capsaicin sensitive receptors. Also on appeal are method claims (claims 20 and 24) for selectively repelling animals having capsaicin sensitive receptors, which claims call for the positive step of feeding the treated birdseed of the invention to birds, in an amount effective for repelling animals having the capsaicin sensitive receptors.

The appealed claims stand rejected for obviousness principally in view of the disclosures of Cartwright. The review

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of any prior art rejection, whether for anticipation or obviousness, requires first that the claims have been correctly construed to define the scope and meaning of the relevant limitations. Gechter v. Davidson, 116 F.3d 1454, ----, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). In proceedings before the Patent and Trademark Office, claims are to be given their broadest reasonable interpretation consistent with the specification, and claim language should be read in light of the specification as it would be construed by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

With these legal principles in mind, we have reviewed appellant's claims in light of their specification. With respect to the claim language in appealed claim 1 regarding a birdseed selected from the group consisting of, inter alia, wheat, appellant's specification at page 7 indicates that the term "birdseed" refers to any food or food additive or material that a bird would eat and that wheat is a representative type of birdseed. Thus, when reasonably construed, the claim language in question covers any form of wheat, whether whole seed or wheat as wheat bran.

Cartwright discloses a poultry food supplement, referred to as "poultry-powder", which comprises two ounces of wheat bran

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mixed with one ounce of ground red pepper per pound of supplement. As stated above, wheat bran is a "birdseed" included by the language of appealed claim 1, "birdseed selected from the group consisting of...wheat". Further, it is undisputed that red pepper is a capsaicin containing material. In the amount described, i.e., a composition containing 1/16th red pepper, it is reasonable to conclude that Cartwright's "poultry-powder" contains capsaicin within the ratio range claimed (i.e. about 1 part in 200 to about 1 part in 100,000 by weight as required by claim 1 or about 1 part in 200 to 1 part in 10,000 by weight as required by claim 7). That Cartwright fails to expressly describe the poultry-powder supplement as containing an effective amount of capsaicin "for repelling animals having capsaicin sensitive receptors" is of no moment with respect to the examiner's rejection. It is settled law that the discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, cannot impart patentability to claims to the known composition. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 780-82, 227 USPQ 773, 777-78 (Fed. Cir. 1985); In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

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We recognize that the examiner's rejection is based on § 103 of the statute. However, a complete description in the prior art of the claimed invention is the ultimate of obviousness. Accordingly, we affirm the examiner's rejection as to appealed claims 1 through 5, 7, 9, 16, 17 and 21.

Composition claim 23 and method claims 20 and 24 stand on a different footing, however. Composition claim 23 requires a treated birdseed comprised of the "whole seed" from the group consisting of, inter alia, wheat. Wheat bran, of course, is not a whole seed as required by composition claim 23. We recognize, as pointed out by the examiner, that Cartwright indicates that his "poultry-powder" supplement is to be mixed with the regular poultry food which typically includes whole seed grain. Appellant points out, however, that when Cartwright's supplement is added to the regular food fed to the poultry that the amount of capsaicin in this combined feed is outside the scope of appellant's claimed range. Appellant has supported this argument with specific detailed calculations<sup>3</sup> present in the record in the amendment filed February 3, 1993 and reiterated in the Brief at page 4 and the Reply Brief at page 2. The examiner has not

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<sup>3</sup> There are no calculations of record that the "poultry-powder" supplement of Cartwright contains capsaicin in an amount outside the scope of appellant's claims.

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contended that these calculations are in error and we see no error therein.

Based on the above, we agree with appellant that there is an inadequate factual basis for believing that Cartwright's poultry-powder regular food mixture inherently contains capsaicin in the amounts required by the appealed claims. Thus, we reverse the examiner's rejection as it applies to composition claim 23 which requires whole seed birdseed. Likewise, we reverse the examiner's rejection of method claims 20 and 24. These claims require the positive method step of feeding birdseed having an amount of capsaicin which is effective for repelling animals having capsaicin sensitive receptors. As noted above, Cartwright's poultry-powder supplement is not fed directly to the birds but is simply used as a food supplement which is mixed with regular food. As relied on by the examiner, none of the "secondary references" remedy the basic deficiencies in the Cartwright disclosure with respect to appealed claims 20, 23 and 24. Hence we reverse the examiner's rejections of these claims.

In summary, we affirm the examiner's rejection as to claims 1 through 5, 7, 9, 16, 17 and 21. We reverse the examiner's rejection as to claims 20, 23 and 24. Accordingly, the decision of the examiner is affirmed-in-part.

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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**

JOHN D. SMITH	)	
Administrative Patent Judge)	)	
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	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
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