

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YASUO ISHIDA, KAZUNARI OHTA and HARUTOSHI YOSHIKAWA

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Appeal No. 1996-0332  
Application No. 08/075,017<sup>1</sup>

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HEARD: July 15, 1999

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Before CAROFF, JOHN D. SMITH and LIEBERMAN, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection (Paper No. 16) of claims 21-40. Subsequent to the final rejection, appellants first cancelled claims 21-40 and added claims 41-50 (Paper No. 17: Amendment E); then cancelled

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<sup>1</sup> Application for patent filed June 11, 1993. According to the appellants, the application is a continuation of Application No. 07/760,392, filed September 16, 1991.

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claims 41-50 and added claim 51 (Paper No. 23: Amendment F).  
Thus, the only claim now before us for consideration on appeal  
is claim 51.

The sole claim on appeal is directed to a method for  
controlling two specific graminaceous weed species in an  
upland-field of wheat with a particular herbicide as described  
in the claim as follows:

51. A method for controlling a graminaceous weed  
selected from the group consisting of at least one of black  
grass and downy brome in an upland-field of wheat comprising  
applying to the field a herbicidally effective amount of the  
compound N-(2-  
ethylsulfonylimidazo[1,2-a]pyridin-3-ylsulfonyl)-N'-(4,6-  
dimethoxy-2-pyrimidinyl)urea or an agriculturally acceptable  
salt thereof.

Claim 51 stands rejected under 35 U.S.C. § 102 as being  
anticipated by or, in the alternative, under 35 U.S.C. § 103  
as obvious over the following single prior art reference:

Ishida et al. (Ishida)                      5,017,212                      May 21,  
1991

Preliminary Matters

At the outset, we note that appellants have proffered  
four declarations for consideration as follows:

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(1) Ishada Declaration of record (Paper No. 10) filed Nov. 5, 1992.

(2) Ishada Declaration (not of record) executed on May 17, 1993 and offered as a hand-out at oral hearing.

(3) Yoshikawa Declaration belatedly filed as part of Paper No. 42 on July 22, 1999 after oral hearing.

(4) A second Yoshikawa Declaration also filed as part of Paper No. 42 on July 22, 1999 after oral hearing.

After a thorough review of the prosecution record in the instant application, we find that, of the four declarations mentioned above, only the first was of record prior to an appeal being taken by appellants in this case. Furthermore, appellants have provided no showing of good and sufficient reasons why the other declarations were not earlier presented. Accordingly, pursuant to 37 CFR § 1.195, the declarations designated as (2), (3) and (4) above will not be admitted or considered by us in rendering a decision on appeal in this case. Additionally, the fact that the two Yoshikawa declarations were filed and considered in a continuing application has no bearing on our decision here since the examiner had no opportunity to consider the Yoshikawa

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declarations with regard to the issues before us prior to the appeal and briefing stage in the present case.<sup>2</sup>

#### OPINION

With regard to anticipation under 35 U.S.C. § 102, we agree with appellants that the generic disclosure in the Ishida reference of a myriad of possible "method-species" precludes a finding of anticipation with regard to the two particular method-species claimed by appellants.

On the other hand, we agree with the examiner that the Ishida disclosure is sufficiently specific as to the particular weeds (black grass and downy brome), crop (wheat) and herbicide (compound 53) encompassed by appellants' claimed method to support a prima facie case of obviousness absent a showing of unexpected results.

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<sup>2</sup> The cited continuing application was referred to by counsel at oral hearing, and indicated as having matured into Patent No. 5,534,482.

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The Ishida Declaration (Paper No. 10), the only declaration of record before us for consideration, is not demonstrative of unexpected results for the reasons suggested in the examiner's answer and final rejection. To wit, the results showing that some compounds (Compound Nos. 2 and 6) within the scope of the Ishida disclosure are effective against black grass and downy brome, whereas others (Compounds A and B) are not, is not dispositive especially considering the significant differences between those compounds in terms of chemical structure. In other words, the compounds chosen for comparison purposes are not the closest prior art compounds in the sense that there appear to be other specific compounds within the ambit of the Ishida disclosure which are more closely related structurally to the compound of appellants' claim, e.g., Ishida compounds 52 and 67.

Moreover, the examiner's analysis of the Ishida Declaration of record stands unrebutted. In this regard, we note that appellants' brief does not refer to any declaration; and the only declaration discussed in appellants' reply brief does not appear to correspond to the Ishida declaration of record but, rather, to an Ishida declaration which we have

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decided has not been properly introduced as evidence for consideration on appeal (see the discussion, supra, relating to declaration (2)).

In concluding, we note that appellants' counsel at oral hearing expressed a willingness to file a terminal disclaimer in the instant application relative to the claims in appellants' Patent No. 5,534,482. Since, we are affirming the examiner's rejection under 35 U.S.C. § 103, we see no need at this time to apply a new ground of rejection under 37 CFR § 1.196(b). However, in the event of any future prosecution of the present claim, for example as in a continuing application, the examiner should consider the imposition of an obviousness-type double patenting rejection. Of course, such a rejection could be overcome by a terminal disclaimer.

For the foregoing reasons, the decision of the examiner is affirmed based upon the provisions of 35 U.S.C. § 103.

AFFIRMED

MARC L. CAROFF )  
Administrative Patent Judge )  
)

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JOHN D. SMITH  
Administrative Patent Judge

PAUL LIEBERMAN  
Administrative Patent Judge

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Foley & Lardner  
3000 K Street, N.W. Suite 500  
Washington, D.C. 20007-5109