

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte HENRY YOKOYAMA, JAMES H. KEITHLY  
and HAROLD W. GAUSMAN

---

Appeal No. 96-0769  
Application No. 08/203,386<sup>1</sup>

---

ON BRIEF

---

Before SOFOCLEOUS, JOHN D. SMITH, and KRATZ, 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 examiner's final rejection of claims 2-4, all of the claims

---

<sup>1</sup> Application for patent filed March 1, 1994. According to appellants, the application is a division of 07/860,413, filed March 30, 1992, now U.S. Patent No. 5,298,483, issued March 29, 1994.

Appeal No. 96-0769  
Application No. 08/203,386

remaining in the application. The appealed claims are reproduced below:

2. N,N-diethylaminoethyl 2,4-dichlorobenzyl ether.
3. N,N-diethylaminoethyl 3,4-dichlorobenzyl ether.
4. N,N-diethylaminoethyl 4-methylbenzyl ether.

The sole reference relied upon by the examiner is:

United Kingdom Patent 1,239,567(UK'567) July 21, 1971

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over UK'567. We affirm as to claim 4. We reverse as to claims 2 and 3.

The subject matter on appeal is directed to the three named benzyl substituted triethylamine ether compounds above which appellants have discovered function as plant bioregulators and thus enhance plant growth when applied in bioregulatory amounts to plants (e.g., citrus crops). See the specification at page 2, lines 22-30.

As evidence of obviousness of the claimed compounds, the examiner relies on UK'567 which discloses a class of ether compounds which are useful for the treatment of cardiovascular conditions. Notwithstanding appellants' contrary arguments, the examiner correctly determined that the fourth compound

Appeal No. 96-0769  
Application No. 08/203,386

from the top of the table of page 3 of UK'567 is an "adjacent homolog" of appellants' claim 4 compound, since this prior art compound, N,N-diethylaminoethyl 4-methylphenethyl ether, differs from appellants' claim 4 compound only by the presence of an additional CH<sub>2</sub> moiety between the phenyl group and the oxy moiety in the ether compound. In any event, an assuming for purposes of argument that the compound is not a homolog of appellant's claim 4 compound, we point out that in an obviousness rejection based on similarity in chemical structure, the name used to designate the relationship between the related compounds (e.g., "adjacent homolog") is not necessarily controlling. "It is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." In re Druey, 319 F.2d 237, 240, 138 USPQ 39, 41 (CCPA 1963). Here, we agree with the examiner that one skilled in the art would have been motivated to make the appellants' claim 4 compound in the expectation that this compound would have similar properties to the prior art compound. That appellants have found that the claimed compound has properties which make it useful for a purpose not expressly disclosed for the prior art compound is

Appeal No. 96-0769  
Application No. 08/203,386

not enough to overcome the prima facie case of obviousness, which requires objective evidence of actual differences in properties of the related compounds, not merely alleged differences related to a newly discovered property which may be inherently<sup>2</sup> possessed by the prior art compound. Compare In re Hoch, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (CCPA 1970). Here, as the examiner has emphasized, there is no evidence of record regarding actual differences in the properties of the claim 4 compound and the prior art compound. Accordingly, we affirm the examiner's rejection of appealed claim 4.

The rejection of appealed claims 2 and 3 stands on a different basis. With respect to these claimed compounds, the UK'567 reference does not exemplify prior art homologs or isomers of the claimed compounds. It is only by making a number of fortuitous selections of variables from the structural formula (I) described at page 1, lines 13-26 that one may arrive at the "homologs" of the respective compounds of

---

<sup>2</sup> Compare the specification at page 3, lines 1-16 which identifies a structural formula that covers the prior art compound when, inter alia,  $n_1$  is 2.

Appeal No. 96-0769  
Application No. 08/203,386

appealed claims 2 and 3. The examiner's finding in the answer at page 4 that UK'567 describes homologs of the compounds of respective claims 2 and 3 is erroneous. In our view, the factual basis established from the disclosures in UK'567 is inadequate to support the examiner's obviousness rejection of these claims. We, therefore, reverse the rejection of claims 2 and 3..

The decision of the examiner is affirmed-in-part.

**AFFIRMED-IN-PART**

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

MICHAEL SOFOCLEOUS                    )  
Administrative Patent Judge        )  
  )

Appeal No. 96-0769  
Application No. 08/203,386

	)	
	)	
	)	BOARD OF PATENT
JOHN D. SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

lp

Appeal No. 96-0769  
Application No. 08/203,386

JOHN KURUCZ  
KANE, DALSIMER, SULLIVAN, KURUCZ, LEVY,  
EISELE AND RICHARD  
711 3RD AVENUE, 20TH FLOOR  
NEW YORK, NY 10017

***Leticia***

Appeal No. 96-0769  
Application No. 08/203,386

APJ JOHN D. SMITH

APJ SOFOCLEOUS

APJ KRATZ

DECISION: AFFIRMED-IN-PART  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: July 25, 2000

Draft    Final

3 MEM. CONF.   Y    N

OB/HD    GAU

PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT