

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CRAIG B. WARREN, JERRY F. BUTLER, RICHARD A. WILSON,  
BRAJA D. MOOKHERJEE, LESLIE C. SMITH, and ANNA B. MARIN

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Appeal No. 1996-1513  
Application No. 08/241,555<sup>1</sup>

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HEARD: October 5, 1999

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Before PAK, WARREN, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed May 12, 1994. According to appellants, this application is a division of Application No. 08/130,256, filed October 1, 1993, now U.S. Patent No. 5,401,500, issued March 28, 1995; which is a division of Application No. 07/948,142, filed September 18, 1992, now abandoned.

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 22 through 30. In the Answer, the examiner allowed claims 24 and 30 subject to being rewritten in independent form. See Answer, page 3. Accordingly, the claims on appeal are 22 through 23 and 25 through 29 which are all the claims remaining in the application.

#### **THE INVENTION**

Appellants' invention is directed to a method of attracting *Aedes aegyptae*, mosquitos, to a three-dimensional space by exposing the three-dimensional space to an *Aedes aegyptae* attracting concentration and quantity of racemic borneol.

#### **THE CLAIMS**

Claim 22 is illustrative of appellants invention and is reproduced in the attached appendix.

#### **THE REFERENCE OF RECORD**

As evidence of lack of enablement, the examiner relies upon the following reference.

Hwang, et al. (Hwang), "Isolation and Identification of Mosquito Repellents In *Artemisia vulgaris*", *Journal of Chemical Ecology*, Vol. 11(9), pp. 1297-1306 (1985).

#### THE REJECTIONS

Claims 22 through 23 and 25 through 29 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.<sup>2</sup>

#### OPINION

We have carefully considered all of the argument advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, we will not sustain the rejection.

The examiner has rejected the claimed subject matter under the first paragraph of 35 U.S.C. § 112 for lack of enablement. The examiner has found that Hwang teaches that (-)-borneol, one of the enantiomorphs of racemic borneol is a repellent for *Aedes aegyptae*. Hence appellants' disclosure is not enabled. See Hwang, pages 1304 - 1305. Based upon this finding the examiner concludes that Hwang provides a reasonable

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<sup>2</sup>See Answer, page 4.

expectation that racemic borneol would likewise repel *Aedes aegyptae*. See Answer, pages 5 and 6. We concur with the examiners finding, albeit not with his conclusion.

When rejecting a claim under the enablement requirement of Section 112, the PTO bears the initial burden of setting forth a reasonable explanation as to why it believes the scope of protection provided by the claimed subject matter is not adequately enabled by the description of the invention provided in the specification of the application. This includes providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If this burden is met, the burden then shifts to the applicant to provide suitable proof that the specification is enabling. See In re Wright 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Although the examiner has provided some basis for doubting that a single enantiomorph of borneol is a repellent for *Aedes aegyptae*, the examiner has not correctly considered the enablement provided by appellants' description of the invention in the specification.

We find that graphs 5A, 5B and 5C depict the attraction of racemic borneol for *Aedes aegyptae*. We find that the data tabulated in Table V(A), V(B) and V(C), depicted on pages 54 - 55 of the specification, provides definitive evidence that racemic borneol is an insect attractant for *Aedes aegyptae*. We further find that appellants have disclosed proportions for each of the attractants taught in the specification. We find that the disclosed proportions include racemic borneol. See specification, pages 44 - 45. Based upon the above considerations we conclude that appellants have reasonable basis for stating that adequate support for the claims exists. See Brief, page 9. Weighing the finding of the examiner that a single enantiomorph of borneol is an insect repellent against the evidence presented by appellants, that racemic borneol is an insect attractant, we conclude that appellants have provided substantial proof in their specification that the claimed subject matter is enabled.

Since the specification disclosure contains a teaching of the process of making and using the invention, it must be taken as being in compliance with the first paragraph of 35 U.S.C.

§ 112. In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Based upon the above consideration, the examiner has not met his burden of showing lack of enablement. Accordingly, the rejection under the first paragraph of 35 U.S.C. § 112 is reversed.

#### **Other Matters**

Prior to any further action in the instant application, the examiner should consider whether further prosecution would be warranted by the disclosure in the last sentence of the Hwang reference. Hwang discloses therein that borneol was evaluated as a repellent against *A. aegypti* (King 1954). The disclosure is referenced by a citation to "King, W. V. 1954. Chemical Evaluated as Insecticides and Repellents. USDA Handbook, Orlando, Florida."

#### **DECISION**

The rejection of claims 22 through 23 and 25 through 29 under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure is reversed

The decision of the examiner is reversed.

**REVERSED**

CHUNG K. PAK	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PAUL LIEBERMAN	)	
Administrative Patent Judge	)	

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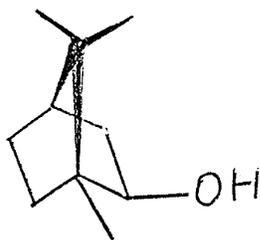
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APPENDIX

22. A method of attracting *Aedes aegyptae* to a three-dimensional space inhabitable by said *Aedes aegyptae* comprising the step of exposing said three-dimensional space to an *Aedes aegyptae*-attracting concentration and quantity of a composition of matter selected from the group consisting of racemic borneol having the structure:



and dihydrolinalool having the structure:

