

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte M. STEPHEN LAJOIE, AMY L. JOSEPH,
KEITH A. JONES and ANTHONY E. WINSTON

Appeal No. 96-2311
Application 08/139,057¹

ON BRIEF

Before WINTERS, DOWNEY and WARREN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 42 and 46 through 61, which are all of the claims remaining in the application.

¹Application for patent filed October 21, 1993. According to appellants, this application is a continuation of Application 07/881,694, filed May 12, 1992, now abandoned.

Claims 42 and 52, which are illustrative of the subject matter on appeal, read as follows:

42. An aqueous pesticide formulation having a content comprising (1) between about 10-80 weight percent of a fungicidal ingredient selected from the group consisting of alkali metal and ammonium bicarbonates, based on the weight of ingredients; (2) between about 0.5-20 weight percent of a water-soluble polyhydroxy compatibility enhancing ingredient which is in solid form at a temperature below about 10°C, based on the weight of ingredients; (3) between about 0.01-10 weight percent of an insecticidal ingredient, based on the formulation weight; and (4) between about 1-20 weight percent of a surfactant ingredient, based on the weight of water-soluble [sic] ingredients.

52. A method of controlling fungal disease and insect damage in agricultural and horticultural applications which comprises applying to cultivated crops an aqueous pesticide formulation having a content comprising (1) between about 10-80 weight percent of a fungicidal ingredient selected from the group consisting of alkali metal and ammonium bicarbonates, based on the weight of ingredients; (2) between about 0.5-20 weight percent of a water-soluble polyhydroxy compatibility enhancing ingredient which is in solid form at a temperature below about 10°C, based on the weight of ingredients; (3) between about 0.01-10 weight percent of an insecticidal ingredient, based on the formulation weight; and (4) between about 1-20 weight percent of a surfactant ingredient, based on the weight of water-insoluble ingredients.

The references relied on by the examiner are:

Appeal No. 96-2311
Application 08/139,057

Wellinga et al. (Wellinga)	3,933,908	Jan. 20, 1976
Koch et al. (Koch)	4,324,799	Apr. 13, 1982
Misato et al. (Misato)	4,599,233	Jul. 08, 1986
Lahm	4,960,784	Oct. 02, 1990

Joo et al.	53-096319	Aug. 23, 1978
(Japanese Kokai Patent)		

Oosumi	60-153785	Aug. 13, 1985
(Japanese Kokai Patent)		

Chemical Abstracts, Volume 92, Number 5, issued February 4, 1980, D.L. Coudriet, et al. "Diflubenzuron; laboratory evaluation against three lepidopteran pests of vegetables" chem abstract no. 92:35946q, abstracting J. Ga. Entomol. Soc. 1979, 14(4), 325-9 (Eng.).

The issues presented for review are: (1) whether the examiner erred in rejecting claims 42 and 46 through 61 under 35 U.S.C. § 112, second paragraph, as indefinite; and (2) whether the examiner erred in rejecting claims 42 and 46 through 61 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Wellinga, Misato, Japanese Kokai Patent Publication No. 53-096319, Japanese Kokai Patent Publication No. 60-153785, Koch, Lahm, and Chemical

Appeal No. 96-2311
Application 08/139,057

Abstracts 92:35946q.

On consideration of the record, including appellants' main brief and Reply Brief and the Examiner's Answer, we shall not sustain these rejections.

35 U.S.C. § 112, second paragraph

The appealed claims stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite in view of the recitation (1) between about 10-80 weight percent of a fungicidal ingredient selected from the group consisting of alkali metal and ammonium bicarbonates, based on the weight of ingredients; and (2) between about 0.5-20 weight percent of a water-soluble polyhydroxy compatibility enhancing ingredient which is in solid form at a temperature below about 10°C, based on the weight of ingredients. The expression "based on the weight of ingredients" refers to the relative weight of an individual ingredient (alkali metal or ammonium bicarbonate or a water-soluble polyhydroxy compatibility enhancing ingredient) as a percentage of the total weight of ingredients. According to the examiner, however, it is unclear whether the weight of the

Appeal No. 96-2311
Application 08/139,057

aqueous medium is excluded from the total weight of the ingredients (Examiner's Answer, page 4). We disagree.

As stated in In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983),

[i]t is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. [Citations omitted].

Following that principle of claim interpretation, we conclude that "[t]he weight of the aqueous medium is excluded" (main

brief, page 7, first paragraph). This becomes clear on reading the claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. See the specification, page 3, last paragraph, stating that "[t]he inorganic salt ingredient typically will comprise between about 10-80 weight percent based on the weight of dry blend formulation." By the same token, see the specification, page 6, first paragraph, stating that "[t]he compatibility enhancing ingredient is incorporated in a quantity between

Appeal No. 96-2311
Application 08/139,057

about 0.5-20 weight percent, based on the weight of ingredients in a dry blend insecticide composition"

The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

35 U.S.C. § 103

Combining the cited references to meet appellants' claims requires overcoming two hurdles. In our judgment, the examiner overcomes the first hurdle, but not the second. Accordingly, on this record, the examiner does not establish that the claimed composition and method would have been obvious at the time the invention was made to a person having ordinary skill in the art.

We agree that Wellinga constitutes relevant prior art, and that Wellinga would have led a person having ordinary skill in the art to an aqueous pesticide formulation comprising (3) diflu- benzuron, and (4) a surfactant in relative amounts meeting the terms of the appealed claims. Wellinga also suggests adding known pesticidal compounds, for

Appeal No. 96-2311
Application 08/139,057

example, fungicides to that formulation to broaden the spectrum of its activity (Wellinga, col. 11, line 28 thru col. 12, line 11). We believe that it would have been obvious to a person having ordinary skill in the art to modify Wellinga's aqueous pesticide formulation, per the teachings of Misato, by adding sodium bicarbonate in amounts meeting the terms of appellants' claims. Misato discloses that sodium bicarbonate, in combination with an appropriate emulsi-fier, is a safe, non-polluting agricultural and horticultural fungicide. The combined disclosures of Wellinga and Misato overcome the examiner's first hurdle and would have led to an aqueous pesticide formulation comprising (1) sodium bicarbonate, (3) diflubenzuron, and (4) a surfactant in relative amounts meeting the terms of appellants' claims.

In overcoming the second hurdle, the examiner must establish that it would have been obvious to add (2) dihydroxybenzene not

only to an aqueous pesticide formulation comprising (3) diflubenzuron and (4) a surfactant in appropriate amounts but rather to an aqueous pesticide formulation comprising (1)

Appeal No. 96-2311
Application 08/139,057

sodium bicarbonate, (3) diflubenzuron, and (4) a surfactant in appropriate amounts. That is, the examiner must establish that it would have been obvious to add dihydroxybenzene to a composition of Wellinga, modified per the teachings of Misato, as discussed above.² The examiner attempts to overcome this hurdle based on the Koch disclosure of o-dihydroxybenzene among a large number of "possible fungicidal partners" mixed with thioglycolic acid anilides having the formula (I). See Koch, col. 11, line 20, naming o-dihydroxybenzene among a list of "possible fungicidal partners" running from col. 9, line 56 through col. 14, line 6. This is where the examiner's case breaks down. In our judgment, a person having ordinary skill in the art would not have selected o-dihydroxybenzene from Koch's lengthy list of "possible fungicidal partners," and added same to an aqueous pesticide formulation comprising (1) sodium bicarbonate, (3) diflubenzuron, and

²Dihydroxybenzene is a preferred water-soluble polyhydroxy compatibility enhancing ingredient (2) and constitutes elected subject matter in this case (examiner's answer, page 3).

Appeal No. 96-2311
Application 08/139,057

(4) a surfactant without the impermissible use of appellants' disclosure as a guide. On consideration of the record, including appellants' main brief and Reply Brief, and the Examiner's Answer, we believe that the § 103 rejection is predicated on the impermissible use of hindsight and must be reversed.

In conclusion, we reverse the examiner's rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MARY F. DOWNEY)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
CHARLES F. WARREN)	
Administrative Patent Judge)	

vsh

Appeal No. 96-2311
Application 08/139,057

Appeal No. 96-2311
Application 08/139,057

Charles B. Barris
Church & Dwight Co., Inc.
469 North Harrison Street
Princeton, NJ 08543