

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ELLIOTT J. SIFF

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Appeal No. 1996-2918  
Application 08/164,879

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HEARD: March 23, 2000

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Before KIMLIN, JOHN D. SMITH and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's second rejection of claims 19-21, which are all of the claims remaining in the application.<sup>1</sup>

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<sup>1</sup> Claims 20 and 21 were submitted when the present continuation-in-part application was filed. However, the continuation-in-part specification has not been substituted for the parent case specification, and claims 20 and 21 have

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*THE INVENTION*

Appellant's claimed invention is directed toward a kit for combating recited types of eye conditions. The kit includes propanethial S-oxide in a container having a device for the microscopic dispensing of the propanethial S-oxide.

Claim 19 is illustrative and reads as follows:

19. A kit for combating a pathogenic, benign, dry or irritated eye condition comprising;

a) a container having a means for the microscopic dispensing of propane thial-s-oxide in a dosage amount effective to produce moisture in a mammalian eye; said container being capable of manipulation with a single hand; and

b) an amount of propane-thial-s-oxide to provide a plurality of individual dosages of sufficient strength to induce tearing in a mammalian eye.

*THE REFERENCE*

Eric Block et al. (Block), "The Lachrymatory Factor of the Onion: An NMR Study", 21 *Tetrahedron Letters* 1277-80 (Pergamon Press 1980).

*THE REJECTION*

Claims 19-21 stand rejected under 35 U.S.C. § 103 as

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not been formally entered. Upon return of the application to the examining group, the examiner should have the continuation-in-part specification and claims 20 and 21 formally entered.

being unpatentable over Block.

*OPINION*

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejection is not well founded. Accordingly, we reverse this rejection.

Block discloses that the lachrymatory factor of an onion, i.e., its ability to bring tears to the eyes, is a 19 to 1 mixture of (*Z*)- and (*E*)-propanethial *S*-oxide (page 1277).

The examiner argues (answer, page 2) that "Block et al. teach the use of the lachrymatory factor in onion." This argument is not supported by the reference. Block does not disclose a use of propanethial *S*-oxide but, rather, discloses the particular ratio of diastereomers of the compound which is responsible for the tear-forming ability of an onion.

The examiner argues (answer, page 3) that "[a]ny active ingredient for the pharmaceutical or clinical purposes is packaged in some type of container or dispenser" and that "to put such agent in the conventional pharmaceutical dispensers and determine the proper dosage is within the skill of

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artisan." These arguments are not well taken because the examiner has not explained where Block discloses, or would have fairly suggested to one of ordinary skill in the art, a pharmaceutical or clinical use of propanethial S-oxide. Moreover, appellant does not merely recite a container but, rather, recites a container having a means for microscopic dispensing. The examiner has not explained why Block would have fairly suggested, to one of ordinary skill in the art, placing propanethial S-oxide in such a container.

For the above reasons, we find that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the invention recited in any of appellant's claims. Consequently, we reverse the examiner's rejection.

*DECISION*

The rejection of claims 19-21 under 35 U.S.C. § 103 over Block is reversed.

*REVERSED*

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EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN D. SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
TERRY J. OWENS	)	)
Administrative Patent Judge	)	

TJO/pgg  
Pennie & Edmonds  
1155 Avenue of The Americas  
New York, NY 10036-2711