

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETER COLSON  
and HOLGER WEIL

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Appeal No. 97-2089  
Application 08/097,801<sup>1</sup>

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ON BRIEF

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Before KIMLIN, GARRIS, and PAK, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal involving claims 13  
through 21 which are all of the claims remaining in the  
application.

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<sup>1</sup> Application for patent filed July 27, 1993.



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We refer to the brief and to the answer for a complete discussion by the appellants and the examiner respectively of their contrary viewpoints concerning the above noted rejection.

OPINION

For the reasons which follow, we will sustain this rejection.

The only arguments advanced by the appellants in their brief concern (1) the "consisting essentially of" language of method claim 13 and (2) the lack of motivation in Alexander for deleting compounds from patentee's antifoaming composition. As correctly indicated by the examiner on page 6 of the answer, however, neither of these arguments is relevant to the concentrate claims on appeal. More specifically, the concentrate claims employ the expression "contains" (rather than the "consisting essentially of" language of method claim 13) and accordingly do not exclude any of the compounds which make up Alexander's antifoaming composition.

Under these circumstances, it is clear that the examiner's section 103 rejection of concentrate claims 16

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concentrate claims 16 through 21.

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through 21 as being unpatentable over Alexander must be sustained.

As for method claims 13 through 15, the appellants seem to understand that the "consisting essentially of" language of these claims is open only for the inclusion of unspecified ingredients or steps which do not materially affect the basic and novel characteristics of the composition or method. In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963); Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Int. 1989). It appears to be the appellants' fundamental position that the "consisting essentially of" language of claim 13 distinguishes over the antifoaming method/composition of Alexander because "the patentee expounds on the necessity of each and every 'component ingredient' in the patented invention" (brief, page 3).

The appellants' position is not well taken because it is premised upon a misapplication of the "materially-affect" test which relates to the claim language under consideration. Contrary to the appellants' misconception, the analysis of whether an affect is material concerns the invention (e.g., a composition or a method) claimed by an applicant and not the

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invention disclosed by the applied prior art. Thus, whether claim 13 by virtue of its "consisting essentially of" language is open to unspecified ingredients or steps depends upon whether such ingredients or steps would materially affect the basic and novel characteristics of the here claimed method rather than the antifoaming method/composition of Alexander.

In addition, we here emphasize that it is an applicant's burden to show that the basic and novel characteristics of his claimed invention would be materially affected by an ingredient or step of the prior art. In re De Lajarte, 337 F.2d 870, 874, 143 USPQ 256, 258 (CCPA 1964); Ex parte Hoffman, id. On the record before us, the appellants have not even alleged, much less carried their burden of showing, that the basic and novel characteristics of the invention defined by appealed claim 13 would be materially affected by any aspect of Alexander's antifoaming method/composition. For this reason, we cannot agree with the appellants' viewpoint that claim 13 by virtue of its "consisting essentially of" language distinguishes over Alexander.

As a consequence, we will also sustain the examiner's section 103 rejection of claims 13 through 15 as being

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unpatentable over Alexander.

The decision of the examiner is affirmed.

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

AFFIRMED

	Edward C. Kimlin	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Bradley R. Garris	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Chung K. Pak	)	
	Administrative Patent Judge	)	

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