

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIRO OKAZAKI, YASUHIRO TAKASHIMA,
SHOJI NAKAMURA, KATSUYUKI YOMOGIDA
and MASAHIRO TANIDA

Appeal No. 1997-3037
Application 08/390,412¹

HEARD: November 30, 2000

Before WILLIAM F. SMITH, SCHEINER and MILLS, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

¹ Application for patent filed February 17, 1995. According to appellants, this application is a continuation of application serial no. 08/126,195, filed September 24, 1993, now abandoned.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 9, 12, 16, 22 and 24 through 27, all the claims remaining in the application.²

Claims 9, 22 and 25 are representative and read as follows:

9. A sedative fragrance composition comprising (a) 1,3-dimethoxy-5-methylbenzene in an amount of from 0.01 to 30% by weight as a fragrance modifier, and (b) a stimulative component, wherein said stimulative component is a jasmine formulation.

22. A process for imparting sedative effect to a fragrance product by blending the fragrance product with a fragrance composition which contains (a) 1,3-dimethoxy-5-methylbenzene in an amount of from 0.01 to 30% by weight as a fragrance modifier, and (b) a stimulative component selected from the group consisting of a jasmine formulation and a floral formulation, said fragrance composition having a relative value of less than 100% in a CNV measurement.

25. A sedative fragrance composition comprising (a) 1,3-dimethoxy-5-methylbenzene in an amount of from 0.01 to 30% by weight as a fragrance modifier, and (b) a stimulative component, wherein said stimulative component is selected from the group consisting of jasmine oil, ylang-ylang oil and basil oil.

The references relied on by the examiner are:

Machida et al. (Machida)	5,023,020	Jun. 11, 1991
Japanese Kokoku (Yomogida)	61-43106	Mar. 1, 1986

² The record shows that the claims numbered 25 through 28 in the Appendix accompanying the Brief were originally presented in the amendment filed November 1, 1995, and were renumbered under 37 CFR § 1.126 as claims 24 through 27.

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Claim 22 stands rejected under 35 U.S.C. § 102 (b) as anticipated by Yomogida, and claims 9, 12, 16 and 24 through 27 stand rejected under 35 U.S.C. § 103 as unpatentable over Yomogida and Machida. We reverse both rejections.

DISCUSSION

Anticipation

We begin with the premise that “[a]nalysis begins with a key legal question -- what is the invention claimed?” since “[c]laim interpretation . . . will normally control the remainder of the decisional process.” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir., cert. denied, 481 U.S. 1052 (1987)).

In rejecting claim 22 under 35 U.S.C. § 102 (b), the examiner notes that Yomogida discloses “modern rose aromatic compositions comprising 0.2-50% by weight 1,3-dimethoxy-5-methylbenzene and one substances [sic] selected from the group consisting of phenyl ethyl alcohol, citronellol, geraniol, nerol, citronellyl acetate and geranyl acetate.” According to page 10 of the present specification, these latter compounds are components of floral formulations, thus the examiner concludes that “‘sedative’ properties would be inherent in [Yomogida’s] composition.” Examiner’s Answer, page 3.

In response, appellants point to evidence of record that demonstrates that 1,3-dimethoxy-5-methylbenzene (DMB) “does not always have a sedative effect,” and “submit that it is improper to assert . . . that DMB inherently possesses a sedative effect.” Brief, page 4.

When we consider that claim 22 is directed to a process, rather than a composition, it is apparent that neither the examiner's nor appellants' position is on point. "Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied . . . in a single reference." Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc., 45 F.3d 1550, 1554, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995).

Claim 22 requires a step of blending a "fragrance product" with a "fragrance composition" containing two components: (a) 1,3-dimethoxy-5-methylbenzene in an amount of from 0.01 to 30% by weight; and (b) a stimulative component, either a jasmine formulation or a floral formulation. The examiner does not point out, and we do not find, a description of that step in Yomogida. At best, the reference describes the step of blending one component of the fragrance composition, 1,3-dimethoxy-5-methylbenzene, with a fragrance product ("dialkoxydialkylbenzene is particularly effective . . . when it is mixed with a natural rose essence or a synthetic rose aromatic containing one or more substances from the group consisting of phenyl ethyl alcohol, citronellol, geraniol, nerol, citronellyl acetate and geranyl acetate" (page 6)).

Accordingly, we find that Yomogida does not anticipate the invention of claim 22, and the rejection under 35 U.S.C. § 102 (b) is reversed.

Obviousness

Claims 9, 12, 16 and 24 through 27 stand rejected under 35 U.S.C. § 103 as unpatentable over Yomogida and Machida. Representative claim 9 is directed to a sedative fragrance composition comprising (a) 1,3-dimethoxy-5-methylbenzene in an amount of from 0.01 to 30% by weight, and (b) a jasmine formulation; claim 16 is directed to a process for imparting a sedative effect to a fragrance product by blending the fragrance product with the sedative fragrance composition of claim 9.

Again, the examiner notes that Yomogida discloses “modern rose aromatic compositions comprising [1,3-dimethoxy-5-methylbenzene] and one or more substances selected from the group consisting of phenyl ethyl alcohol, citronellol, geraniol, nerol, citronellyl acetate and geranyl acetate.”

In addition, we note that Yomogida teaches that “natural rose essence has always been extracted from the petals of Rosa Damascene or Rosa Centifolia and gives out a strong, but slightly too heavy, sweet smell,” which no longer suits “the modern consumers’ taste which prefers sweetness but also softness and freshness.” Page 3. Yomogida teaches that dialkoxyalkylbenzene, on its own, “gives out a humid green note and phenolic spicy powdery note, hardly that of a modern rose,” but “creates a modern rose aromatic that simulates the aroma of modern roses” when “mixed with a natural rose essence or a synthesized aromatic.” Page 4.

The examiner relies on Machida to show that both jasmine oil and phenyl ethyl alcohol are recognized as materials imparting a hypnotic effect, and concludes that “[i]t

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would have been obvious to one having ordinary skill in the art to substitute jasmine oil for the phenyl ethyl alcohol in the compositions of [Yomogida] to produce a jasmine fragrance having a hypnotic effect since [Machida teaches] that both materials provide a hypnotic activity.” Examiner’s Answer, page 4.

We disagree with the examiner’s reasoning and conclusion. The examiner proposes adding jasmine oil to Yomogida’s composition “to produce a jasmine fragrance having a hypnotic effect.” However, Machida teaches that jasmine oil, on its own, has a hypnotic effect. Therefore, it is unclear why one skilled in the art would combine it with anything to impart a property it already exhibits.

Moreover, Yomogida is directed to developing a synthetic, idealized “modern rose” aroma. The examiner has not explained why one skilled in the art would compromise the “modern rose” aroma of Yomogida’s compositions by combining them with a distinctly different scent like jasmine.

We hold that the examiner has not established a prima facie case of obviousness. Accordingly, the rejection of claims 9, 12, 16 and 24 through 27 under 35 U.S.C. § 103 is reversed.

REVERSED

William F. Smith)
Administrative Patent Judge)
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Toni R. Scheiner
Administrative Patent Judge

Demetra Mills
Administrative Patent Judge

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