

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAIN CHENE and SCOT K. HUBER

Appeal No. 1998-0365
Application No. 08/501,336

ON BRIEF¹

Before WINTERS, SCHEINER and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 5-6 and 9-16. Claims 4, 7 and 8 are canceled², and claims 17-19 are indicated as allowed³.

Claim 1 is illustrative of the subject matter on appeal and is reproduced in the appendix to the appeal Brief.

¹ This merits panel found that the oral hearing scheduled for February 8, 2001, was not necessary. 37 C.F.R. § 1.194(c).

² Paper No. 16, received January 30, 1997.

³ Paper No. 18, mailed February 18, 1997.

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The references relied upon by the examiner are:

Barnes et al. (Barnes)	5,284,863	Feb. 8, 1994
Doehner et al. (Doehner)	5,359,090	Oct. 25, 1994

GROUND OF REJECTION⁴

Claims 1-3, 5-6 and 9-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Doehner in view of Barnes.

We reverse.

DISCUSSION

Every case, particularly those raising the issue of obviousness under section 103, must necessarily be decided upon its own facts. In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). Furthermore, our appellate reviewing court has made it clear that there are no per se rules of obviousness or nonobviousness. In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (“reliance on per se rules of obviousness is legally incorrect.”) Accord, In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996).

According to the examiner (Answer, page 4) Doehner disclose “pyrrole derivatives, structurally similar to the instant claimed compounds, which are highly effective insecticidal, fungicidal and acaricidal, etc. agents....” The examiner argues (Answer, page 4) that “[t]he difference between the compounds of the prior

⁴ Rejections not referred to in the Answer are assumed to have been withdrawn. Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 663, 231 USPQ 649, 651-652 (Fed. Cir. 1986), cert. denied, 480 U.S. 933 (1987).

art and the compounds instantly claimed is that of generic description.” According to the examiner (Answer page 4) Barnes is relied upon to disclose “a few more of [a]ppellants claimed substituents on pyrrole derivatives which have fungicidal activity....” In view of these disclosures, the examiner concludes (Answer, page 5) that “[o]ne skilled in the art would have been motivated to prepare the compounds of Doehner et al. and especially in view of the teachings of Barnes et al. to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would have fungicidal activity.”

Appellants argue (Brief, page 7) that Doehner:

[R]epresents an enormous number of possible pyrrole compounds. Indeed, there are millions of possible permutations of the disclosed structure, particularly in light of the fact that the positions of the substituents W, X, Y, and Z on the pyrrole ring are not specified. Thus, while this generic formula may encompass the instantly claimed compounds, Doehner et al do not expressly describe the instantly claimed compounds.

Appellants make similar arguments with regard to Barnes. See Brief, page 10. In addition, appellants note (Brief, page 10) that Barnes “do not disclose or suggest a pyrrole compound having no phenyl substituents.... X in the compounds disclosed by Barnes et al. must be phenyl or substituted phenyl.”

In response, the examiner argues (Answer, page 11) that the Doehner “reference can be taken alone and in combination with the Barnes et al. reference.” The examiner argues further (Answer, page 8) that “[b]y picking and choosing from

Accordingly, we note the examiner withdrew the Final Rejection of claim 16 under

the Doehner et al. reference, one skilled in the art would arrive at the instant claimed compounds.”

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). As argued by appellants (Brief, page 8) “there is nothing in the disclosure of Doehner et al suggesting that one should select the specific substituents that are recited in the instant claims.” As appellants argue (Brief, page 8) even Doehner’s preferred embodiments fail to lead one toward the claimed invention. Barnes fails to make up for the deficiency in Doehner. However, even if one were to select the specific substituents recited in the instant claims, the examiner failed to identify in either of the references where a suggestion can be found to order the substituents on the ring in the manner required by the claimed invention.

To establish a prima facie case of obviousness, there must be more than the demonstrated existence of all of the components of the claimed subject matter. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the substitutions required. That knowledge cannot come from the applicants' disclosure of the invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774

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F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). On the record before us, we find no reasonable suggestion for combining the teachings of the references relied upon by the examiner in a manner which would have reasonably led one of ordinary skill in the art to arrive at the claimed invention. Accordingly, we reverse the examiner's rejection of claims 1-3, 5-6 and 9-16 under 35 U.S.C. § 103 as being unpatentable over Doehner in view of Barnes.

REVERSED

SHERMAN D. WINTERS)
Administrative Patent Judge)
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) BOARD OF PATENT
TONI R. SCHEINER)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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DONALD E. ADAMS)
Administrative Patent Judge)

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NORMAN H. STEPNO
BURNS DOANE SWECKER AND MATHIS
P.O. BOX 1404
ALEXANDRIA VA 22313-1404

DEA/jlb