

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte OLAN S. FRUCHEY, BRIAN D. BURKE,
HUH-SUN CHIOU, and MICHELE L. NICHOLS

Appeal No. 2000-0639
Application No. 08/537,560

ON BRIEF

Before WINTERS, SCHEINER, and GREEN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 17 and 20. Claim 21 stands allowed. Claims 18, 19, and 22 through 25, the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

REPRESENTATIVE CLAIMS

Claims 1 and 5, which are illustrative of the subject matter on appeal, read as follows:

1. A process for the preparation of 1-aryl-2-(1-imidazolyl) alkyl ethers and thioethers comprising
 - (a) alpha brominating an aromatic or heterocyclic derivative under suitable reaction conditions; and ,
 - (b) coupling the product of step (a) with an imidazolyl ethanol derivative under suitable conditions.

5. A process for the preparation of tioconazole comprising
 - (a) alpha brominating 2-chloro-3-methylthiophene in the presence of a peroxide and cyclohexane solvent, under suitable reaction conditions; and,
 - (b) contacting the product of step (a) with 1-(2,4-dichlorophenyl [sic])-2-(1-imidazolyl)ethanol under suitable conditions.

THE PRIOR ART

In rejecting claims 1 through 17 and 20 under 35 U.S.C. § 112, second paragraph, the examiner does not rely on any prior art references.

THE REJECTION

Claims 1 through 17 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as not particularly pointing out and distinctly claiming the subject matter which applicants regard as their invention.¹

¹ As indicated in the Examiner's Answer (Paper No. 11), page 5, a previously entered rejection of claims under 35 U.S.C. § 112, first paragraph, has been withdrawn, and claim 21 now stands allowed.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the instant specification, including all of the appealed claims; the Appeal Brief (Paper No. 10); and the Examiner's Answer (Paper No. 11). Having carefully reviewed those materials, we reverse the examiner's rejection of claims 5 through 17 and 20. We affirm the rejection of claims 1 through 4.

CLAIMS 5 THROUGH 17 AND 20

We agree with appellants that claims 5 through 17 and 20 set out and circumscribe a particular area with a reasonable degree of precision and particularity.

These claims are drawn to a process for preparing tioconazole (claims 5 through 17) and to "[t]ioconazole produced by the process of claim 5" (claim 20). Independent claim 5 begins with a specific starting material, namely, 2-chloro-3-methyl-thiophene. In step (a) of claim 5, appellants recite alpha brominating that starting material "in the presence of a peroxide and cyclohexane solvent, under suitable reaction conditions." This constitutes a Wohl-Ziegler bromination (specification, page 5, line 3). In step (b) of claim 5, appellants recite "contacting the product of step (a) [2-chloro-3-bromomethyl-thiophene] with 1-(2,4-dichlorophenyl [sic])-2-(1-imidazolyl)ethanol under suitable reaction conditions."

These claims reasonably apprise those skilled in the art what is claimed; and persons skilled in the art would understand what is claimed. Appellants' process begins with specific starting materials and reagents, spelled out in the claims, and ends with the preparation of a specific final product. Although the examiner does not favor the

terms “contacting” or “under suitable reaction conditions” in claim 5, nonetheless, the examiner has not adequately explained why those terms render claims 5 through 17 and 20 indefinite.

The rejection of claims 5 through 17 and 20 under 35 U.S.C. § 112, second paragraph, is reversed.

CLAIMS 1 THROUGH 4

Claims 1 through 4, however, stand on different footing.

Independent claim 1 recites a two-step process for preparing “1-aryl-2-(1-imidazolyl) alkyl ethers and thioethers” (emphasis added). In step (b), appellants recite “coupling the product of step (a) with an imidazolyl ethanol derivative under suitable reaction conditions” (emphasis added). On reflection, it can be seen that this claim is internally inconsistent. If applicants begin with “an imidazolyl ethanol derivative,” it is unclear how they would or could prepare a thioether recited in claim 1. As stated by the examiner, “how is a thioether going to be obtained if an imidazolyl ethanol derivative is always the starting material?” (Examiner’s Answer, page 6, lines 2 through 4).

Furthermore, in claim 1, step (a), appellants begin with “an aromatic or heterocyclic derivative.” But the claimed process is drawn to preparing “1-aryl-2-(1-imidazolyl) alkyl ethers and thioethers” (emphasis added). Again, the claim is internally inconsistent. If applicants begin with “an aromatic or heterocyclic derivative,” it is unclear why they prepare “1-aryl-2-(1-imidazolyl) alkyl ethers and thioethers,” but not “1-heterocyclyl-2-(1-imidazolyl) alkyl ethers and thioethers.” As pointed out by the

examiner, the reactants and products recited in claim 1 are not “commensurate in scope” (Examiner’s Answer, page 6, line 8).

On this record, we do not find an adequate rebuttal or response by appellants to these matters of internal inconsistency in claim 1 which have been raised by the examiner. Accordingly, the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is affirmed. For the purposes of this appeal, appellants have not argued dependent claims 2 through 4 separately from independent claim 1. (Appeal Brief, section VI Grouping of Claims). Accordingly, the rejection of claims 2 through 4 under 35 U.S.C. § 112, second paragraph, is also affirmed.

In conclusion, we sustain the examiner’s rejection of claims 1 through 4 under 35 U.S.C. § 112, second paragraph. We do not, however, sustain the rejection of claims 5 through 17 and 20. The examiner’s decision is affirmed-in-part.

AFFIRMED-IN-PART

Sherman D. Winters
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

Lora M. Green
Administrative Patent Judge

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Pennie & Edmonds LLP
1667 K Street, NW
Washington, DC 20006