

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte ELY VEA and
FRANCOIS COLLIOT

Appeal No. 2001-1251
Application No. 08/369,865

ON BRIEF¹

Before WINTERS, ADAMS, and GRIMES, 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 2-8, which are all the claims pending in the application.

Claim 2 is illustrative of the subject matter on appeal and is reproduced below:

2. A process for the treatment of grasslands against grasshoppers or locusts comprising treating the grasslands attacked, or susceptible to attack, by grasshoppers or locusts with an effective amount of an active material which is 1-[2,6-dichloro-4-CF₃-phenyl]-3-cyano-4-CF₃SO-5NH₂-pyrazole].

The references relied upon by the examiner are:

¹ In accordance with 37 CFR 1.194(c), the Board decided that an oral hearing was not necessary in this appeal.

Hatton et al. (Hatton) 5,232,940 Aug. 3, 1993

Buntain et al. (Buntain)²
(European Patent Application) 0,295,117 A1 Dec. 14, 1988

GROUND OF REJECTION

Claims 2-8 stand rejected under 35 U.S.C. § 102(a) as anticipated by Hatton.

Claims 2-8 stand rejected under 35 U.S.C. § 102(b) as anticipated by Buntain.

We reverse.

DISCUSSION

Initially we note the prosecution history reflects that a rejection under 35 U.S.C. § 103 was made over Buntain. See Paper No. 19, page 2. We also note the examiner was not persuaded by appellants' evidence of non-obviousness found in the Twinn declarations (executed February 25, 1994 and April 19, 1995) filed under 37 CFR § 1.132. See Paper No. 19, pages 2-3. Nevertheless, the examiner subsequently withdrew the rejection under 35 U.S.C. § 103 over Buntain. See Paper No. 26, page 2. The only reasoning provided by the examiner for withdrawing the rejection is "[t]he U.S. Patent version of ... [Buntain] has issued and is being used as a reference." Id. While the record is

² The examiner and appellants refer to this reference as '117. We will refer to this reference, as is customary, by the name of the first inventor.

less than clear as to the reason the examiner withdrew the rejection under 35 U.S.C. § 103, the only issues before this Panel are the rejections under 35 U.S.C. § 102.

The rejections under 35 U.S.C. § 102:

Hatton:

According to the examiner (Answer, page 4) Hatton discloses the application of the claimed compound to grasslands. The examiner finds (id.) “the arthropod involved is a locust.” In support of this rejection, the examiner relies (id.) on claim 1, column 17, line 5, and column 18, line 18 of Hatton.

Buntain:

According to the examiner (Answer, page 5) Buntain teaches the application of appellants’ claimed compound to the same locus in order to treat insects. In support of this rejection the examiner relies on page 2, line 47; page 3, line 46; page 5, lines 26 and 27 and 36-51; page 6, lines 1-9; and page 8, lines 6-8.

Appellants’ response to the rejections under 35 U.S.C. § 102:

Appellants’ response to the rejections over Hatton and Buntain is essentially the same. In essence, appellants argue that the examiner, using appellants’ disclosure as a guide, selected from extensive lists of compounds, loci, and pest targets in order to arrive at the invention now claimed. According to appellants (Brief, page 5), this “[i]ndiscriminate picking and choosing does not qualify as an anticipation.”

To emphasize the examiner's indiscriminate selective process, appellants point out (Brief, page 6) with regard to Hatton that "the [e]xaminer has chosen one line from a list of pests spanning cols. 15, 16 and 17 of Hatton and a locus spanning col. 18, line 10 et seq and col. 19, lines 1-2." Similarly, with regard to Buntain, appellants argue (Brief, pages 7-8) that in order to arrive at appellants' claimed invention, a skilled artisan must choose from a list of 101 compounds, to apply to one locus from "a nine line listing of numerous loci," to treat grasshoppers or locusts from the various pests listed on pages 4 and 5 of Buntain.

Accordingly, appellants argue (Brief, page 6) "that an artisan who did not have the benefit of the instant disclosure would not have had the guidance to pick and choose [from the Hatton disclosure] as has the [e]xaminer." Appellants also urge (Brief, page 8) "that the artisan at the time the present invention was made would have had a difficult choice when trying to determine which of the 101 particularly interesting compounds listed on pages 2-4 of ... [Buntain] would be useful against which insect from the many listed...." Therefore, appellants conclude that Hatton or Buntain do not anticipate the claimed invention. We agree.

"Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). "Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913,

1920 (Fed. Cir. 1989). As set forth in In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972):

picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.

On this record, the examiner identified references with broad general disclosures and then, apparently using appellants' claimed invention as a guide, selected from the teachings provided in these general disclosures to arrive at appellants' claimed invention. Under these circumstances we are constrained to reverse the rejection of claims 2-8 under 35 U.S.C. § 102(a) and § 102(b).

REVERSED

Sherman D. Winters)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
Donald E. Adams)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Eric Grimes)
Administrative Patent Judge)

Appeal No. 2001-1251
Application No. 08/369,865

Page 6

Arnold I. Rady
Morgan & Finnegan
345 Park Avenue
New York, NY 10154