

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN A. VAN REES

Appeal No. 1996-1040
Application 08/069,434

ON BRIEF

Before WINTERS, ROBINSON, and LORIN, Administrative Patent Judges.

ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-14, which are all of the claims pending in this application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A biodegradable insect repellent that breaks down in the presence of water to minimize solid waste, the insect repellent comprising:

The rejection under 35 U.S.C. § 112, second paragraph

The examiner has rejected claim 14 based on the presence, therein, of the term "providing" which the examiner urges renders the claim indefinite because it does not clearly set forth the metes and bounds of the claim. We have considered the arguments of both the examiner and appellant relating to this rejection and find that we are in agreement with the appellant that the rejection is improper. We reverse the rejection under 35 U.S.C. § 112, second paragraph, and adopt appellant's reasoning at pages 8-9 of the Appeal Brief as our own.

The rejections under 35 U.S.C. § 103

Claims 6-8:

In rejecting claims 6-8 under 35 U.S.C. § 103, the examiner states (Answer, page 3):

The process merely recites the mixing of foamed vegetable starch and cedar oil. There (sic, The) mere mixing of ingredients, broadly stated, cannot form the basis of a patentable process nor can patentability be predicated on a recitation of a result.

We have carefully considered the arguments of both the examiner and appellant relating to this rejection and are persuaded that the examiner has failed to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. We reverse this rejection and adopt appellant's reasoning as set forth at page 11 of the Appeal Brief as our own, adding only the following for emphasis.

On this record, the examiner has failed to consider the claimed subject matter as a

whole (35 U.S.C. § 103). The claimed subject matter is "not broadly stated" as urged by the examiner, but is directed to a method of making an insect repellent by combining a water soluble substrate made of a substantially dry, rigid, open-celled foam consisting essentially of vegetable starch with cedar oil. In failing to take into consideration these claim limitations in rejecting the claims under 35 U.S.C. § 103, the examiner committed reversible error. Therefore, this rejection under 35 U.S.C. § 103 is reversed.

Claims 1-14:

In rejecting claims 1-14 under 35 U.S.C. § 103, the examiner cites Eden as disclosing (Answer, page 4):

the encapsulation of insect repellents in a starch matrix, see the Abstract and col. 2, lines 1-19. In col. 3, lines 1-40 [or] this reference discloses that the starch product can be subjected to drying prior to use. Moreover, though the reference starch is described as a matrix, the product is capable of releasing is (sic, its) encapsulated material, also see claim 2.

However, the examiner acknowledges that while Eden (Answer, page 4):

does not explicitly disclose the present claims, the disclosure would suggest the present invention of utilizing a dry starch to absorb an insect repellent for release of same in a desired locus.

It is the initial burden of the patent examiner to establish that claims presented in an application for patent are unpatentable. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). We have carefully considered the evidence and discussion in support of the rejection presented by the examiner. However, a fair evaluation of the reference and consideration of the claimed subject matter as a whole, dictates a conclusion that the examiner has failed to provide the factual basis which would reasonably

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support a prima facie case of unpatentability of the subject matter of claims 1-14.

All of the claims require the presence or use of cedar oil which is indicated to be the insect repelling component. The examiner has offered no evidence which would reasonably establish that cedar oil was known to be an insect repellent at the time of the invention. Additionally, the examiner has failed to demonstrate that the vegetable starch matrix described for use in encapsulation by Eden, reasonably corresponds to the "substantially dry, rigid, open-celled foam consisting essentially of vegetable starch" as required by the claims on appeal. Appellant specifically argued that the claimed invention (Brief, page 12):

does not entail the formation of a starch matrix which is intended to serve as an encapsulation agent. Further, Applicant's invention employs a foamed vegetable starch.

The examiner does not respond to this argument (Answer, page 5). That the matrix material of Eden may be capable of absorbing oil and releasing it, is insufficient, standing alone, to establish that it reasonably corresponds to the foamed vegetable starch of the claims.

Where, as here, the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). Therefore, the rejection of claims 1-14 under 35 U.S.C. § 103 is reversed.

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CONCLUSION

The examiner's rejection of claim 14 under 35 U.S.C. § 112, second paragraph, is reversed.

The examiner's rejections of claims 1 - 14 under 35 U.S.C. § 103 are reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
DOUGLAS W. ROBINSON)	
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