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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS WACHTLER, REINHARD HITTICH, EIKE POETSCH, HERBERT PLACH, DAVID COATES, BERNHARD RIEGER and JOACHIM KRAUSE

Appeal No. 97-1278
Application No. 08/046,286[1]

ON BRIEF

Before KIMLIN, WARREN and ELLIS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10 and 11. Claim 9, the other claim remaining in the present

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[1] Application for patent filed April 15, 1993. According to appellants, this application is a division of Application No. 07/585,165, filed October 16, 1990, now abandoned.

application, has been allowed by the examiner. A copy of illustrative claim 10 is appended to this decision.

In the rejection of the appealed claims, the examiner relies upon the following reference:

Rieger et al. (Rieger)	5,286,411	Feb. 15, 1994 (filed June 5, 1991)

Appealed claims 10 and 11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the U.S. patent to Rieger.[2]

Upon careful consideration of the opposing arguments presented on appeal, we find that the examiner's rejection is free of reversible error. Accordingly, we will sustain the examiner's rejection.

Appellants do not dispute that the claimed compounds are encompassed by claim 1 of Rieger, specifically, the compounds defined by Rieger's structural formulae II and V. Rather, appellants contend that the claimed compounds of Rieger do not

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[2] We presume that the examiner's rejection of claims 10 and 11 under 35 U.S.C. § 102(f) or (g)/§ 103 has been withdrawn by the examiner in view of appellants' submission of a corrected Statement of Common Ownership with the Reply Brief. The Examiner's Answer to the Reply Brief does not repeat the rejection.

render obvious the presently claimed compounds because "where there is a large genus in a patent, it is submitted that, in the absence of direction to a smaller portion thereof, the smaller portion is not obvious" (page 3 of principal Brief). For legal authority, appellants cite In re Jones, 958 F.2d 347, 21 USPQ 1941 (Fed. Cir. 1992). Appellants maintain that in order to obtain compounds within the scope of the appealed claims:

> [I]t is necessary to select, from the disclosure of Rieger, not only structures II or V, from among the eight structures given as the second component of the liquid crystalline phase by patentees, but also to select, for patentee's "R", alkenyl from alkyl, oxaalkyl, fluoroalkyl or alkenyl, and, for the present claim 11, to select for "X" fluoro from among fluoro, chloro, trifluoromethyl, trifluoromethoxy and $-OCHF_2$. [Page 3 of principal Brief].

We are not persuaded by appellants' argument since, contrary to appellants' characterization of Rieger, we find a clear direction in claim 1 of Rieger to select compounds within the scope of the appealed claims. To wit, the structural formulae of II and V provide an express disclosure of a somewhat larger genus than the claimed genus, and the selection of formulae II and V requires a selection of only two out of seven, or less than one of four. Also, by claiming

that R can be alkenyl, Rieger provides specific direction for the presently claimed substituent and, again, the choice of alkenyl is only one from four possible substituents. Furthermore, Rieger's definition of X nearly coincides with appellants' definition of X in the appealed claims, i.e., Rieger adds only $OCHF_2$ to the four substituents claimed by appellants for X. We note that in such cases of selection the issue is typically whether the prior art anticipates under § 102 or renders obvious under § 103 a claimed invention, not whether a limited degree of selection from the prior art establishes a prima facie case of obviousness. See, for example, In re Schaumann, 572 F.2d 312, 316-17, 197 USPQ 5, 9 (CCPA 1978); In re Petering, 301 F.2d 676, 682-83, 133 USPQ 275, 280-81 (CCPA 1962). In re Jones, 958 F.2d 347, 21 USPQ 1941, represents an exception to the general rule since in Jones the reference disclosed a potentially infinite genus which embraced but did not point to the claimed salt of an acid known as "dicamba," and, therefore, is not controlling here.

Appellants also maintain that In re Braat, 937 F.2d 589, 594, 19 USPQ2d 1289, 1293 (Fed. Cir. 1991) requires us to apply

the two-way test for double patenting. We do not agree. In the recently decided In re Berg, ___ F.3d ___, ___, 46 USPQ 1226, 1229-30 (Fed. Cir. 1998), the court stated that the two-way test is a narrow exception to the general rule of the one-way test, and that the two-way test applied when a later-filed improvement patent issues before an earlier filed basic invention. In the present case, it does not appear that claim 1 of Rieger is an improvement over the appealed claims of the present application. Indeed, with respect to the claimed compounds of Rieger, claim 1 of Rieger is broader than the subject matter of the appealed claims. As apparently acknowledged by appellants, the compounds of the appealed claims are species within the claimed genus of Rieger.

Also, the court stated in Braat that if an applicant can file all of his claims in one application, but chooses not to do so, he is not entitled to the exception of the two-way test. In the present case, based on the close correspondence in subject matter disclosed in the present application and the patent specification,[3] it appears to us that claim 1 of Rieger

[3] Page 3 of the present specification states that the present invention relates to the compounds of formula I and to their use as components of liquid-crystalline media, and to

and the presently appealed claims could have been properly filed in one application with, of course, the properly named inventors. We note that the Rieger patent and the present application have four common inventors.

In addition, by filing a divisional application and not electing and prosecuting the appealed claims in the parent application, appellants have established that they, and not the PTO, controlled the rate of progress of the present application. In re Goodman, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993).

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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liquid-crystalline media containing at least one compound of the formula I.

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CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
JOAN ELLIS	)	
Administrative Patent Judge	)	

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Appeal No. 97-1278
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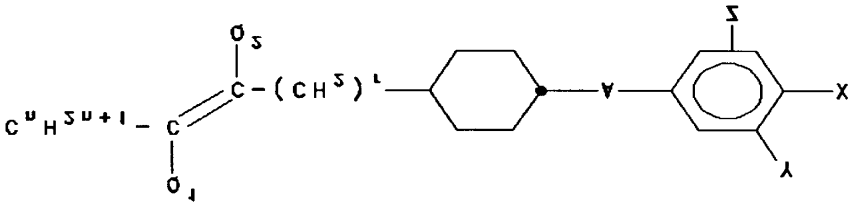
APPENDIX

10. A phenylcyclohexane of formula I



in which n is 0 to 7, Q^1 and Q^2 are H, or one of these radicals is alternatively CH_3, r is 0, 1, 2, 3, 4 or 5, A is trans-1,4-cyclohexylene, 1,4-phenylene, 3-fluoro-1,4-phenylene or a single bond, X is F, Cl, $-CF_3$ or $-OCF_3$ and Y and Z are each F.