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EXAMINER
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KUNZ, GARY L

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Patent Trial and Appeal Board

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Standard Operating Procedure 2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BAYER CROPSCIENCE, LP  
Appellant

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Appeal 2011-005039  
Reexamination Control 90/008,317  
Patent 5,700,460  
Technology Center 3900

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Before RICHARD E. SCHAFER, RICHARD M. LEBOVITZ, and  
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellant, requests rehearing pursuant to 37 C.F.R. § 41.52 (“Req. Reh’g”) of the Decision mailed May 16, 2011 (“Dec.”) in which we affirmed the Examiner’s final rejections of claims in U.S. Patent No. 5,700,460 (hereinafter, “the ‘460 patent”).

The claims in this appeal involve methods of offering fipronil, a known insecticide, to insects. The claim preambles recite that the methods

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are “for attracting insects,” a result which had not been recognized in the prior art cited in the rejections. However, fipronil had been offered to insects as an insecticide to control them, the same purpose described in the ‘460 patent (col. 1, ll. 56-58):

An object of the instant invention is to provide a simplified and efficient method of controlling and combatting insects.

The claims in this appeal were rejected by the Examiner as anticipated by two prior art publications, Hatton and Colliot (Dec. 2). Although the Hatton and Colliot references did not describe fipronil as attracting insects, they did provide it to insects as an insecticide. The Examiner found that, once fipronil was provided as a bait or in the soil as taught by Hatton and Colliot, it would have attracted insects, as recited in the claim preambles.

#### 1. Intent

Appellant contends that “attracting insects” and “attracting and killing insects” as recited in the preamble of claims 1 and 15 are “necessary components” of the claimed invention and should be interpreted to require that the methods be practiced with the intent of attracting insects (Req. Reh’g 5). Appellant argues that because “Hatton and Colliot do not show any intent to attract insects or attract and kill insects by offering them fipronil for ingestion, the instant claims are patentable over Hatton and Colliot.” (Req. Reh’g 5.)

In the Decision, we addressed the issue of whether “intent” alone was sufficient to distinguish the claimed method from the prior art. Based on a long line of Federal Circuit cases, we concluded that the intent to achieve a particular result does not change the way the method is practiced and

therefore does not avoid the cited prior art, which described all steps of the claimed method

2. Attracting at a distance

Appellant contends that the preamble phrases "attracting insects" and "attracting and killing insects" distinguish the claimed methods from Hatton and Colliot because the phrases require the use of fipronil at a location distinct from that shown in Hatton and Colliot (Req. Reh'g 6-7). Appellant contends that the phrases serve to limit the claims by requiring the use of fipronil at a distance from the insects (Req. Reh'g 6). "Hatton and Colliot fail to teach application at a distance from said insects; they only teach application at the specifically appropriate place where the insects are to travel and feed." (Req. Reh'g 7.)

Both Hatton and Colliot describe placing the fipronil in soil, baits, and other forms (FF5, FF11, & FF12<sup>1</sup>) which would be placed at a distance from the insects. It is unclear how placing fipronil at a place where insects "travel and feed" is any different from placing fipronil at a distance from the insects, because in each case, the fipronil is remote from the insect's location.

Appellant alleges that the locations in its claims are distinct from those shown in the cited prior art. However, Hatton describes utilizing its compounds in domestic and industrial premises (FF4), the same settings described in the '460 patent (col. 3, ll. 63-67; col. 4, ll. 21-24).

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<sup>1</sup> "FF" refer to Findings of Fact listed in our previous Decision in this appeal.

In sum, Appellant's argument that the claims differ from the prior art with respect to where the fipronil is placed is not supported by adequate evidence.

### 3. Attraction by fipronil

Appellant argues that the phrases "an effective attractant amount" and "an amount which is effective both as an attractant and as an insecticide" further distinguish the claimed methods because they require that fipronil, and not an additional attractant, attracts the insects (Req. Reh'g 8). Appellant contends that both Hatton and Colliot teach that other sources of attractants attracted the insects, rather than the fipronil as claimed (Req. Reh'g 8-9).

We addressed this argument in the Decision and found it unpersuasive:

This argument ignores Hatton's teaching that its compounds can be utilized in solid and liquid forms which do not involve baits comprising molasses (FF5, FF7, & FF8). The same can be said of Colliot which describes baits, but also other fipronil forms (FF11 & FF12). Thus, even were it true that the bait components would somehow mask fipronil's attractant properties, there is disclosure in each of Hatton and Colliot of nonbait fipronil forms in which fipronil is not associated with molasses or another food ingredient.

(Dec. 11.)

### 4. Accidental results

Appellant contends that fipronil was not intended to attract the insects, nor appreciated even if it did occur, and that the U.S. Supreme Court has

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held that ““accidental results, not intended and not appreciated, do not constitute anticipation.”” (Req. Reh’g 9.)

With respect to *Eibel Process Co. V. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 66 (1923) cited for that statement, the Supreme Court wrote:

It is contended on behalf of the defendant that, whether Barrett and Horne perceived the advantage of speeding up the stock to an equality with the wire, yet the necessary effect of their devices was to achieve that result, and therefore their machine anticipated Eibel. In the first place, we find no evidence that any pitch of the wire, used before Eibel, had brought about such a result as that sought by him, and, in the second place, if it had done so under unusual conditions, accidental results, not intended and not appreciated, do not constitute anticipation. *Tilghman v. Proctor*, 102 U. S. 707, 102 U. S. 711; *Pittsburgh Reduction Co. v. Cowles Electric Co.*, 55 F. 301, 307; *Andrews v. Carman*, 13 Blatchford, 307, 323, Fed.Cas. No. 371.

Thus, in *Eibel Process*, the Supreme Court did not find evidence that the result in the claim at issue had been achieved, and if it had, only under “unusual circumstances.” In other words, it was not the necessary result of carrying out prior process. *Eibel Process* is fully consistent with *Trintec Indus. v. Top-U.S.A.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) in which the Federal Circuit held “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.”

In *Tilghman v. Proctor*, 102 U.S. 707, 711-12 (1880), a claim to a process of “manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure” was at issue. The Supreme Court found in *Tilghman* that “accidental” formation of fat acid in prior art processes was not anticipatory because “the operators were in

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pursuit of other and different results, without exciting attention and without its even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of Tilghman's discovery."

The same cannot be said here. Fipronil was used in the cited Hatton and Colliot publications to control insect infestation (FF2, FF3, FF4, FF8, FF10, & FF11). Fipronil was a known insecticide. Fipronil was known to kill insects as recited in the preamble of claim 15, and had been offered for ingestion to insects as recited in the body of claims 1 and 15 (Dec. 10). The inventors' purpose in offering fipronil to insects for ingestion was to control and kill them ('460 patent, col. 1, ll. 56-58), the same purpose taught by Hatton and Colliot. It was not an "accident" that fipronil attracted the insects, but a necessary consequence of carrying out the same process described in the prior art for the same purpose of controlling insects as claimed.

REHEARING DENIED

ack

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