

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte JOCHEN KALBE, ANDREAS TURBERG,
MICHAEL LONDERSHAUSEN, NORBERT MENCKE,
REINER POSPISCHIL, and RAINER SONNECK

Appeal No. 2001-0937
Application No. 09/077,119

REQUEST FOR REHEARING

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

LORIN, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a Request for Rehearing (Paper No. 20) in response to our Decision on Appeal (Paper No. 19). We GRANT the Request.

In our previous Decision on Appeal, we (a) reversed Examiner's rejection of claims 3-8 on appeal under 35 U.S.C. § 103 over Itoh alone, and (b), under the provisions of 37 CFR § 1.196(b), made a new grounds of rejection whereby claims 3-8 were rejected under 35 U.S.C. § 103 as being obvious over Itoh in view of the Himel article (Himel, Chester M., "The Optimum Size for Insecticide

Spray Droplets”, Journal of Economic Entomology, Vol. 62, no. 4, 1969, pp. 919-925). Appellants only take issue with the new grounds of rejection.

Regarding the new grounds, appellants disagree with the Board’s determination that:

(1) a prima facie case of obviousness for the claims has been established with respect to the Itoh and Himel disclosures; and,

(2) the Declaration of Dr. Jochen Kalbe (attached to Paper no. 10) does “not,” as the Board stated in the Decision (page 4), “persuasively establish the nonobviousness of applying the claimed composition at the claimed droplet sizes because droplet size is nowhere mentioned.”

We have carefully reviewed the Declaration. In the earlier Decision, the Board (footnote 2) stated that “[a]s best we can tell, the Declaration repeats exactly Examples A-D set forth in the Specification at pp. 10-12.” As appellants have shown, the Declaration is different in one important respect: the Examples in the Declaration do in fact mention the claimed droplet sizes. This was overlooked in rendering the earlier Decision.

After reading the Declaration in its entirety, we are now persuaded that the Declaration presents evidence of nonobviousness for the claimed droplet sizes. Because we now agree that appellants have “come forward with evidence of nonobviousness to overcome the prima facie case,” In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996), we need not address appellants’ arguments on whether the new grounds of rejection establish a prima facie case of obviousness.

On further reflection, the new grounds of rejection is withdrawn.

Consequently, no claim is currently under rejection.

The Request for Rehearing is hereby GRANTED.

SHERMAN D. WINTERS)
Administrative Patent Judge)
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) BOARD OF PATENT
HUBERT C. LORIN)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
DEMETRA J. MILLS)
Administrative Patent Judge)