

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT RICHARD DYKSTRA  
and  
LON MONTGOMERY GRAY

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Appeal No. 2005-0467  
Application No. 10/217,278

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ON BRIEF

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Before KIMLIN, KRATZ and TIMM, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-8, 10-20 and 22-30. Claims 9 and 21, the other claims pending in the present application, have been allowed by the examiner. A copy of illustrative claim 1 is appended to this decision.

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The examiner relies upon the following reference as evidence of obviousness:

Anderson et al. (EP' 211)                      936,211 A2                      Aug. 18, 1999  
(European Patent Application)

Appellants' claimed invention is directed to a photo-labile pro-fragrance having the recited formula. According to appellants, "[t]he present invention is directed to the surprising discovery that R<sup>1</sup> units, which are electron-donating groups, modulate the rate at which the photo-labile fragrance raw material is released" (page 2 of Brief, paragraph three).

Appealed claims 1-8, 10-20 and 22-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP '211.

Appellants submit at page 2 of the Brief that "[c]laims 1-8, 10-20 and 22-30 stand or fall together." Accordingly, all the appealed claims stand or fall together with claim 1, and we will limit our consideration to the examiner's rejection of claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will adopt the examiner's reasoning as our own in sustaining the rejection of record, and we add the following for emphasis only.

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Although EP '211 does not exemplify the claimed compounds, we, like the examiner, are convinced that the reference teaches compounds within the scope of the appealed claims and, thereby, would have rendered them obvious to one of ordinary skill in the art. As explained by the examiner, the abstract of the reference defines substituents  $R^3$  and  $R^4$ , which correspond to appellants'  $R^1$ , as electron donating groups. Accordingly, we agree with the examiner that the reference fairly teaches aryl acrylates claimed by appellants.

Appellants' principal contention is that EP '211 fails to provide an enabling disclosure of compounds that are embraced by the appealed claims. However, appellants fail to provide any compelling line of reasoning, let alone the requisite objective evidence, which demonstrates that one of ordinary skill in the art would be unable to make the claimed compounds based upon the reference disclosure. See Amgen Inc. v. Hoechst Marion Roussel Inc., 314 F.3d 1313, 1355 n. 22, 65 USPQ2d 1385, 1416-17 n. 22 (Fed. Cir. 2003). Appellants' pointing to mistakes of a typographical nature in the reference disclosure falls far short of establishing that one of ordinary skill in the art would be unable to make compounds that are fairly taught by EP '211. It is well settled that counsel's arguments in the Brief are no

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substitute for objective evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Appellants also maintain that the applicants of EP '211 did not make the claimed compounds and, therefore, "*they could not have realized the properties Appellants' novel compounds possess*" (page 5 of Brief, second paragraph). However, it is not necessary for a finding of obviousness that the applicants of EP '211 actually made all the compounds disclosed therein, or realized all their properties. The issue at hand is whether one of ordinary skill in the art would have been able to make the compounds taught by the reference, and appellants have advanced no evidence to the contrary. Furthermore, patentability does not attach to the discovery of a new property for an old or obvious compound.

Appellants further contend that "[t]here is no recitation, teaching, or suggestion that the phenyl ring of EP '211 requires an electron donating group" (page 5 of Brief, third paragraph). It is sufficient for a finding of obviousness, however, that the reference teaches the presence of an electron donating group on the phenyl ring as a viable option, but not a requirement. Contrary to appellants' arguments, EP '211 need not teach the "criticality" of selecting electron donating groups to form the evidentiary basis for a prima facie case of obviousness.

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As noted by the examiner, appellants base no argument upon objective evidence of nonobviousness, such as unexpected results or criticality, to rebut the prima facie case of obviousness established by the examiner.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, 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)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

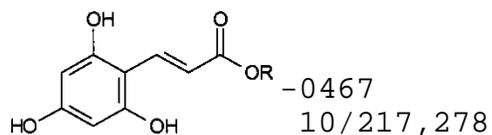
AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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PETER F. KRATZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
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CATHERINE TIMM	)	
Administrative Patent Judge	)	

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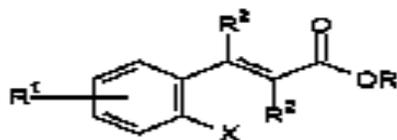
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APPENDIX

1. A photo-labile pro-fragrance having the formula:



wherein -OR is a unit derived from a fragrance raw material alcohol, HOR;  $R^1$  is one or more electron donating groups; each  $R^2$  is independently hydrogen,  $C_1$ - $C_{12}$  alkyl,  $C_7$ - $C_{12}$  alkylenearyl; and mixtures thereof; X is selected from the group consisting of -OH,  $-NH_2$ ,  $-NHR^3$ , and mixtures thereof;  $R^3$  is hydrogen,  $C_1$ - $C_{12}$  linear or branched alkyl,  $C_6$ - $C_{10}$  aryl,  $C_7$ - $C^{12}$  alkylenearyl, and mixtures thereof.