

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte MARK E. WILSON, RONNY L. MOSER,
DONALD E. JR. ORR, DAVID D. HALL, and DOUGLAS M. WEBEL

Appeal No. 2005-2267
Application No. 09/870,899

ON BRIEF

Before SCHEINER, ADAMS, and MILLS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-6, 8, 9, 13-20, 23, 25, 41, and 71-102, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of increasing the reproductive performance of a female swine, comprising the step of administering to the female swine a feed composition comprising a marine animal product;
wherein the marine animal product comprises C₂₀ and C₂₂ omega-3 fatty acids or esters thereof; and
wherein the feed composition as a final mixture comprises about 0.025% to about 2% by weight of the marine animal product.

The references relied upon by the examiner are:

Fritsche et al. (Fritsche), "Enrichment of Omega-3 Fatty Acids in Suckling Pigs by Maternal Dietary Fish Oil Supplementation," J. Anim. Sci., Vol. 71, pp. 1841-1847 (1993)

Boudreaux et al. (Boudreaux), "The Effects of Varying Dietary n-6 to n-3 Fatty Acid Ratios on Platelet Reactivity, Coagulation Screening Assays, and Antithrombin III Activity in Dogs," J. American Animal Hospital Assoc., Vol. 33, pp. 235-243 (1997)

Abayasekara et al. (Abayasekara), "Effects of altering dietary fatty acid composition on prostaglandin synthesis and fertility," Prostaglandins, Leukotrienes and Essential Fatty Acids, Vol. 61, No. 5, pp. 275-287 (1999)

GROUNDINGS OF REJECTION

Claims 1-6, 8, 9, 13-20, 23, 25, 41 and 71-102 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fritsche in view of Boudreaux.

Claims 1-6, 8, 9, 13-20, 23, 25, 41 and 71-102 stand rejected under 35 U.S.C. § 103 as being unpatentable over Abayasekara.

We reverse.

DISCUSSION

Fritsche in view of Boudreaux:

According to the examiner (Answer, page 4), Fritsche "discloses that fish oil compositions (menhaden fish oil) which is known to comprise C20 and C22 omega-3 fatty acids ... are useful in dietary compositions to feed sows...." In this regard, the examiner finds (id.), such compositions provide, inter alia, the following benefits "pig survival, number of pigs born per sow, birth weight and weaning weights...." The examiner recognizes, however, that Fritsche

does not expressly disclose the particular amounts (percentage) of fish oil in the compositions, ... the particular amounts [of] fish oil such as salmon oil in the composition [,] ... the ratio of omega-6 to

omega-3 fatty acids, ... the particular time for the administration such as about 30 days before a first mating through a second mating, and stabilizing the fish oil by prilling.

Id.

The examiner relies on Boudreaux to make up for deficiency in Fritsche relating to appellants' claimed ratio of omega-6 fatty acids to omega-3 fatty acids. According to the examiner (Answer, page 5), Boudreaux teaches, "the range of the ratio of omega-6 fatty acids to omega-3 fatty acids ... in the composition to be administered to animals is within the instant claim." The examiner accounts for all other deficiencies in Fritsche by simply asserting that they would have been obvious to a person of ordinary skill in the art. See Answer, pages 5-6.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness." In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The test of obviousness is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention." In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). In our opinion, the combination of references relied upon by the examiner fail to establish a prima facie case of obviousness.

As appellants point out (Brief, page 9), notwithstanding the examiner's assertion, Fritsche "teaches that administering to pregnant sows a feed composition supplemented with 3.5% or 7% by weight of menhaden fish oil does not increase the number of live pigs born per litter, does not increase birth weights, and does not increase weaning weights." See e.g., Fritsche, page 1843, column 1, second full paragraph, "the number of live pigs born per litter ...

and pig birth weights ... did not differ among treatment groups [including the control group].” Regarding weaning weight, Fritsche teach, “no diet effect was noted”. Id. Accordingly, we fail to see how the examiner has reached the conclusion (Answer, page 4) that Fritsche teaches that the administration of fish oil compositions comprising C₂₀ and C₂₂ omega-3 fatty acids provide a benefit to female swine, including, inter alia, pig survival, number of pigs born per sow, birth weight and weaning weights.

In our opinion, Boudreaux does not make up for the deficiency in Fritsche. As the examiner points out (Answer, page 14), the teaching of Boudreaux is limited to “optimizing or determining the ratio of omega-6 fatty acids to omega-3 fatty acids” to include in animal feed. Boudreaux, however, fails to make up for the deficiency in Fritsche relating to a benefit relating to, inter alia, pig survival, number of pigs born per sow, birth weight and weaning weights.

Prima facie obviousness based on a combination of references requires that the prior art provide “a reason, suggestion, or motivation to lead an inventor to combine those references.” Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. . . . The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted). The suggestion to combine prior art references must come

from the cited references, not from the application's disclosure. See In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

For the foregoing reasons, it is our opinion that the examiner has failed to provide the evidence necessary to demonstrate that any benefit would be obtained from feeding female swine a marine animal product comprising C₂₀ and C₂₂ omega-3 fatty acids or esters thereof, as required by appellants' claimed invention. At best, the evidence of record indicates that no benefit would be expected. Accordingly, we find no suggestion in the prior art relied upon to combine the teachings of Boudreaux with those of Fritsche.

We recognize the examiner's reliance on section 2123 of the Manual of Patent Examining Procedure (MPEP), specifically, the examiner's reliance on Celeritas Technologies Ltd. V. Rockwell Internaitonal Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Answer, page 13. As we understand it, the examiner relies on this section of the MPEP to demonstrate that Fritsch does not teach away from the claimed invention. Id. As the examiner points out, the Celeritas court "held that the prior art anticipated the claims even though it taught away from the claimed invention." Id., emphasis added. The examiner, however, failed to explain why this holding in Celeritas, which relates to anticipation, would have any effect on the obviousness rejection presented for our review on this record. The only other case cited in the section of MPEP 2123 relied upon by the examiner is Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert denied, 493 U.S. 975 (1989). As the examiner points out Merck, sets forth that "[a] reference may

be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments.” While this is true, we fail to see how this supports the examiner’s prima facie case of obviousness. In our opinion, neither Merck nor Celeritas are relevant to the facts on this record.

For the foregoing reasons, we reverse the rejection of claims 1-6, 8, 9, 13-20, 23, 25, 41 and 71-102 under 35 U.S.C. § 103 as being unpatentable over Fritsche in view of Boudreaus.

Claims 1-6, 8, 9, 13-20, 23, 25, 41 and 71-102 stand rejected under 35 U.S.C. § 103 as being unpatentable over Abayasekare.

Abayasekare:

According to the examiner (Answer, page 7), Abayasekare teaches “dietary fatty acid compositions, i.e., fish oil, comprising instant fatty acids such as omega-6 fatty acids to omega-3, ... are useful in increasing ... female performance, i.e., follicular development in the ovary, ovulation, corpus luteum function, pregnancy, parturition, and lactation....” The examiner recognizes (id.),

however, that Abayasekare

does not expressly disclose the dietary fatty acid compositions therein to be administered to female swine, and the particular amounts (percentage) of fish oil in the composition there[in], 0.025% to 2% by weight, or the particular amounts [of] fish oil such as salmon oil in the composition therein, and the ratio of omega-6 to omega-3 fatty acids, and the particular time for the administration such as about 30 days before a first mating through a second mating, and stabilizing the fish oil by prilling.

However, in the examiner's opinion, all of these deficiencies in Abayasekara, are apparently accounted for by the knowledge of a person of ordinary skill in the art.

See e.g., Answer, pages 7-9.

The examiner, however, appears to disregard Abayasekara's conclusion (bridging paragraph, pages 282-283),

[o]ur relative lack of knowledge means that it is impossible to predict at present whether particular dietary manipulations, which may be desirable from a human health viewpoint will enhance or reduce fertility. Therefore, it is essential that further research into this general area is carried out before any changes in feed in terms of PUFA [(polyunsaturated fatty acids)] composition, are implemented....

As we understand Abayasekara's conclusion, in the absence of further research into the effect of polyunsaturated fatty acids on fertility, there is no reasonable expectation of success in the use of such fatty acids to either enhance or reduce fertility. To establish a prima facie case of obviousness, there must a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In the absence of a reasonable expectation of success one is left with only an "obvious to try" situation which is not the standard of obviousness under 35 U.S.C. § 103. In re O'Farrell, 858 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). On this record, the examiner's reliance on Abayasekara establishes only that it would have been obvious to try to, inter alia, increase the reproductive performance of a female swine, by administering polyunsaturated fatty acids. This is, however, not the standard of obviousness.

For the foregoing reasons, we reverse the rejection of claims 1-6, 8, 9, 13-20, 23, 25, 41 and 71-102 under 35 U.S.C. § 103 as being unpatentable over Abayasekare.

SECONDARY EVIDENCE

Having determined that the examiner has not established a prima facie case of obviousness, we find it unnecessary to discuss the Orr Declaration relied on by appellants to rebut any such prima facie case.

OTHER ISSUES

Prior to taking any further action on the merits, we encourage the examiner to consider Yeh et al., "Enrichment of (n-3) fatty acids of suckling rats by maternal dietary menhaden oil," J. Nutr., Vol. 120, page 436 (1990). According to Fritsche (page 1843, column 1, second full paragraph), "the observations of Yeh, who reported a 5 to 10% greater weight gain in the rats

suckling dams fed fish oil vs corn oil,” are contrary to the results reported in Fritsche.

REVERSED

Toni R. Scheiner
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

)
)
)
) BOARD OF PATENT
)
) APPEALS AND
) INTERFERENCES
)
)
)
)

BARNES & THORNBURG
11 SOUTH MERIDIAN
INDIANAPOLIS IN 46204