

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MAURICE S. BROOKHART III  
and BROOKE L. SMALL

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Appeal No. 2005-2463  
Application 10/235,443

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BRIEF

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Before CAROFF, WARREN, and OWENS, Administrative Patent Judges.  
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-20 and 38-47, all the claims pending in appellants' application.

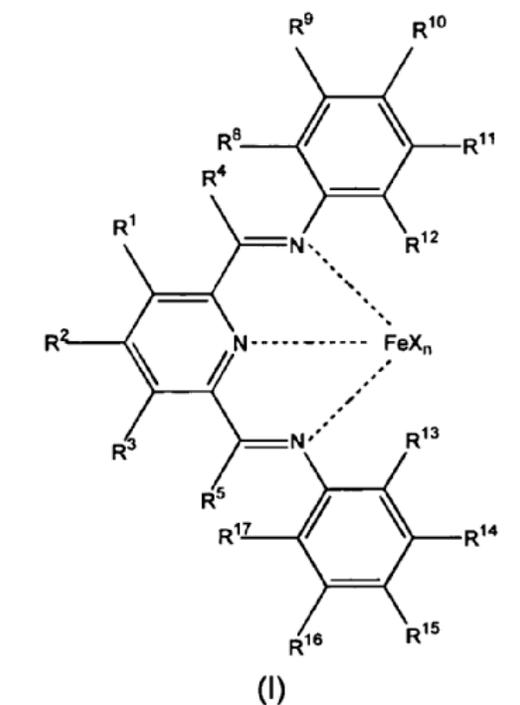
The appealed claims are directed to iron complexes of certain tridentate ligands; the ligands being diimines of 2,6-diacylpyridines or 2,6-pyridinedicarboxaldehydes.

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Appellants stipulate on page 3 of their brief that all of the pending claims stand or fall together for purposes of this appeal.

Accordingly, we shall limit our consideration to claim 13, one of two independent claims, which reads as follows:

13. A compound of the formula



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wherein:

each X is an anion;

n is 1, 2 or 3 so that the total number of negative charges on said anion or anions is equal to the oxidation state [sic: state] of a Fe atom present in (1);

R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> are each independently hydrogen, hydrocarbyl, substituted hydrocarbyl, or an inert functional group;

R<sup>4</sup> and R<sup>5</sup> are each independently hydrogen, hydrocarbyl, an inert functional group or substituted hydrocarbyl; and

R<sup>9</sup>, R<sup>10</sup>, R<sup>11</sup>, R<sup>14</sup>, R<sup>15</sup> and R<sup>16</sup> are each independently hydrogen, hydrocarbyl, an inert functional group or substituted hydrocarbyl; R<sup>8</sup> is a primary carbon group, a secondary carbon group or a tertiary carbon group;

and provided that:

when R<sup>8</sup> is a primary carbon group none, one or two of R<sup>12</sup>, R<sup>13</sup> and R<sup>17</sup> are primary carbon groups, and the remainder of R<sup>12</sup>, R<sup>13</sup> and R<sup>17</sup> are hydrogen;

when R<sup>8</sup> is a secondary carbon group, none or one of R<sup>12</sup>, R<sup>13</sup> and R<sup>17</sup> is a primary carbon group or a secondary carbon group and the remainder of R<sup>12</sup>, R<sup>13</sup>, and R<sup>17</sup> are hydrogen;

when R<sup>8</sup> is a tertiary carbon group all of R<sup>12</sup>, R<sup>13</sup> and R<sup>14</sup> are hydrogen; and any two of R<sup>8</sup>, R<sup>9</sup>, R<sup>10</sup>, R<sup>11</sup>, R<sup>12</sup>, R<sup>13</sup>, R<sup>14</sup>, R<sup>15</sup>, R<sup>16</sup> and R<sup>17</sup> vicinal to one another, taken together may form a ring.

The sole reference relied upon by the examiner is:

Bennett

6,214,761 B1                      Apr. 10, 2001  
(effective filing date Dec. 17, 1996)

The sole rejection applied by the examiner against the claims is based on the judicially-created doctrine of obviousness-type

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double patenting. Specifically, claims 13-20 and 38-47 stand rejected under the obviousness-type double patenting doctrine as being unpatentable over claims 1-19 of the Bennett patent.

We have carefully reviewed the entire record in this case in light of the respective positions taken by the appellants and the examiner on appeal. Having done so, we are compelled to reverse the rejection at issue.

We agree with the appellants that a rejection based upon obviousness-type double patenting doctrine is improper under the circumstances of this case. In this regard, we note that the instant application and the Bennett patent have entirely different inventive entities associated with them. Moreover, according to the record, the instant application was originally assigned solely to the UNC<sup>1</sup>, and is now co-owned by both UNC and Du Pont<sup>2</sup>. On the other hand, the Bennett patent is assigned solely to Du Pont.

Where different inventive entities are involved, an obviousness-type double patenting rejection is appropriate only if the patent and application in question are commonly owned. The fundamental issue before us is whether the Bennett patent and the

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<sup>1</sup> University of North Carolina

<sup>2</sup> E.I. du Pont de Nemours and Company

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instant application are currently "commonly owned" for purposes of applying an obviousness-type double patenting rejection.

Appellants assert that common ownership should be defined in accordance with MPEP § 706.02(1)(2) (Eighth Edition, Rev. 2, May 2004) which states that:

The term "commonly owned" is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person(s) or organization(s)/business entity(ies) at the time the claimed invention was made. If the person(s) or organization(s) owned less than 100 percent of the subject matter which would otherwise be prior art to the claimed invention, or less than 100 percent of the claimed invention, then common ownership would not exist. Common ownership requires that the person(s) or organization(s)/business entity(ies) own 100 percent of the subject matter and 100 percent of the claimed invention.

In other words, where co-owners are involved, common ownership requires that each co-owner have an interest in both the patent which would otherwise be prior art and the application at issue.

While the cited definition of "commonly owned" appears in a section of the MPEP that relates to an assertion of common ownership to disqualify a reference as prior art under 35 U.S.C. § 103(c), appellants assert that the meaning of the term should be consistent, whether being used in the context of 35 U.S.C. § 103(c) or in determining whether a double patenting rejection is appropriate. By "consistent", appellants presumably mean

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consistent with regard to the required interest of each co-owner, and not necessarily consistent in terms of the time frame in which ownership is considered.

We agree with the appellants. Indeed, MPEP § 1490, which relates to the filing of a terminal disclaimer for the purpose of obviating a double patenting rejection of the obviousness type<sup>3</sup>, explicitly links the meaning of common ownership in a double patenting context to the definition in MPEP § 706.02(1)(2). In our opinion, this is dispositive of the issue before us.

Accordingly, the double patenting rejection at issue is inappropriate because the Bennett patent and appellants' application are not "commonly owned" as defined in MPEP § 706.02(1)(2). Certainly, the examiner has cited no countervailing authority mandating that a different definition should apply.

Since we have found that an obviousness-type double patenting rejection is inappropriate in this case, the associated question of obviousness becomes moot. Nevertheless, we shall consider the

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<sup>3</sup> In accordance with 37 CFR § 1.321(c), terminal disclaimers are ordinarily filed for the purpose of obviating obviousness-type double patenting rejections, and must include a provision conditioning enforceability on maintenance of common ownership.

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question inasmuch as a rejection under 35 U.S.C. § 102(e)/103 may be appropriate upon further prosecution.

According to the examiner, a question of obviousness arises (within the meaning of 35 U.S.C. § 103) because the claims of Bennett embrace a species of the generic claims of the instant application. Appellants disagree to the extent that appellants characterize Bennett's claims as embracing a genus of compounds of which the presently claimed compounds are a relatively small subgenus. Even if we accept the appellants' characterization, which appears to be the more accurate view of the relationship between the instant claims and those of Bennett, a subgenus of compounds is ordinarily considered to be prima facie obvious from a prior art genus in the absence of a showing of unexpected results.

Here, appellants do not dispute that Bennett gives rise to a prima facie case of obviousness. Rather, appellants argue that any presumption of obviousness is rebutted by the allegation that the presently claimed subgenus of compounds possess the unexpected property of catalyzing the oligomerization of ethylene to form relatively pure alpha-olefins. Yet, appellants point to no objective evidence in the record, such as a comparative showing, to substantiate the allegation. Thus, Bennett gives rise to a prima facie case of obviousness which is not rebutted by any evidence of unexpected results.

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When this case is returned to the jurisdiction of the examiner for further disposition, the examiner should consider rejecting the appealed claims for obviousness under 35 U.S.C. § 102(e)/103 based upon Bennett and in view of our discussion, supra, highlighting the prima facie case for obviousness. In this regard, the examiner must first determine whether Bennett constitutes prior art against the instant claims under 35 U.S.C. § 102(e), viz. whether the Bennett disclosure is entitled to an effective filing date of December 17, 1996, the purported filing date of parent application 60/033,656.

Moreover, the examiner should also consider rejecting the appealed claims under 35 U.S.C. § 102(e) as being anticipated by Bennett since appellants apparently concede on page 7 of their brief that Bennett's compound "A" is within the scope of the present claims. Compound A is identified in column 18 of Bennett.

Furthermore, the examiner should consider the possibility of placing the instant application in interference with Bennett even in the event that Bennett is not considered to have an earlier effective filing date since both appear to be claiming the "same patentable invention". See 35 U.S.C. § 102(g) and 37 CFR § 1.601(i) and (n).

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For the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF	)	
Administrative Patent Judge)	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge)	)	

MLC/dal

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