

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 COSIMA NUNINGER, MARTIN WEISS  
and ANDREW JOHN LEADBEATER

---

Appeal No. 2006-0333  
Application No. 09/798,181

---

#### ON BRIEF

---

Before ADAMS, GREEN, and LINCK, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 5 and 10. Claim 1 is representative of the claims on appeal, and reads as follows:

1. A method of combating phytopathogenic diseases on crop plants which comprises applying to the crop plants or the locus thereof being infested with said phytopathogenic disease an effective amount of a combination of a first component I metalaxyl having an R-enantiomer content of more than 95% by weight, in association with a second component II, methyl (E)-2-methoxyimino-[2-(o-tolyloxymethyl)phenyl]acetate, wherein components I and II are applied in a quantity producing a synergistic phytopathogenic disease controlling effect.

The examiner relies upon the following references:

Wenderoth et al. (Wenderoth)	4,829,085	May 09, 1989
Nuninger et al. (Nuninger)	5,723,491	Mar. 03, 1998

Claims 1, 5 and 10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Nuninger and Wenderoth. After careful review of the record and consideration of the issues before us, we reverse.

### DISCUSSION

Nuninger is relied upon for teaching that in methods of controlling and/or preventing Oomycetes diseases, “the R-enantiomer of metalaxyl results in higher fungicidal activity compared to racemic metalaxyl . . . and teaches . . . compositions wherein 85%, over 92% and more than 97% R-enantiomer is present . . .” Examiner’s Answer, page 4.

Wenderoth is cited for teaching methods of combating fungi using oxime ethers. See id. According to the examiner, the reference teaches that the compounds have high fungicidal activity, with the methyl (E)-2-methoxyimino-[2-o-tolyoxymethyl]phenyl]acetate compound being specifically named, and that the compounds may be combined with other fungicides to achieve greater fungicidal activity. See id. at 4-5.

The examiner concludes:

The references do not teach the method wherein the compounds are combined together in a single, synergistic composition. However, at the time of the claimed invention, it would have been obvious to one of ordinary skill in the art to combine the compounds of Wenderoth and Nuninger for their known and common effect, as disclosed by the references, since each is well known in the art for their claimed purpose. Moreover, at the time of the claimed invention, one of ordinary skill in the art

would have been motivated to combine the components of Wenderoth and Nuninger with a reasonable expectation for successfully combating Oomycetes infection in plants. This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effects of the ingredients, In re Sussman, 1943 C.D. 518.

Id. at 5.

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citations omitted). 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).

As noted by appellants, while Wenderoth discloses compound II of appellants claimed composition, it is one of 191 listed compounds. See Appeal Brief, page 8. Moreover, “[n]o characterizing data are given for it and it is not mentioned in the Use Examples 1 to 3,” and “[n]or does Wenderoth teach the specific admixture of this compound with the other fungicides listed in columns 15 and 16.” Id. And while Wenderoth while does list racemic metalaxyl, “its combination with Compound 130 is only one of 15,000 possible combinations.”

Id.

Appellants thus admit that each of the compounds of the claimed composition is present in the prior art, and each was known for use as a fungicide. In determining obviousness, however, “[w]hen it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant. ‘Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.’” In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citation omitted); see also In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”).

As noted above, compound II of the claimed composition is only one of 191 different named compounds, and its combination with the racemic metalaxyl is only one of 15,000 combinations. We can find nothing in the Wenderoth reference that would motivate one of ordinary skill to choose compound 130 from the 191 listed compounds, and then combine it with metalaxyl to arrive at the claimed composition. Thus, we conclude that the examiner has failed to set forth a prima facie case of obviousness, and the rejection is reversed.

The examiner asserts that Wenderoth “specifically identifies the claimed compound (130) as extremely effective on a broad spectrum of phytopathogenic fungi (col. 11 lines 63-65).” Examiner’s Answer, page 7. Column 11, lines 63-65 of the Wenderoth patent, however, states that “[i]n general terms, the novel compounds are extremely effective on a broad spectrum of phytopathogenic fungi.” Thus, the statement being relied upon by the examiner is not drawn to compound 130 specifically, but to the entire class of compounds, and as above, we do not find that it provides any suggestion to choose compound 130, which is not used in any of the examples, nor named any place in the patent outside of the table found at columns three to twelve, listing the 191 different compounds.

CONCLUSION

Because the examiner has failed to set forth a prima facie case of obviousness under 35 U.S.C. § 103(a), the rejection is reversed.

REVERSED

Donald E. Adams )  
Administrative Patent Judge )  
 )  
 )  
 ) BOARD OF PATENT  
Lora M. Green )  
Administrative Patent Judge ) APPEALS AND  
 )  
 ) INTERFERENCES  
 )  
Nancy Linck )  
Administrative Patent Judge )

Syngenta Crop Protection, Inc.  
Patent and Trademark Department  
410 Swing Road  
Greensboro, NC 27409