

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 STEVEN CURTIS ZICKER, CHADWICK E. DODD
DENNIS JEWELL, and DALE A. FRITSCH**

Appeal No. 2006-2463
Application No. 10/065,326

ON BRIEF

Before MILLS, GREEN, and LEBOVITZ, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

VACATUR and REMAND TO THE EXAMINER

On consideration of the record we find this case is not in condition for a decision on appeal. For the reasons that follow, we vacate¹ the pending rejections and remand the application to the examiner to consider the following issues and to take appropriate action.

Claims 1-7 and 9-11 are on appeal. Claim 8 has been withdrawn from consideration by the examiner.

¹ Lest there be any misunderstanding, the term “vacate” in this context means to set aside or to void. When the Board vacates an examiner’s rejection, the rejection is set aside and no longer exists.

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Claims 1 reads as follows:

1. A method for influencing the behavior of an animal, the method comprising systemically administering to the animal a composition comprising at least about 0.5% by weight of an omega-3 fatty acid or mixture of omega-3 fatty acids as measured on a dry matter basis.

The prior art references cited by the examiner are:

Davenport et al. (Davenport) WO 2004/006688A1 Jan. 2004

Grounds of Rejection

Claims 1, 2, 5, 6 and 9-11 stand rejected under 35 U.S.C. § 102(e) over Davenport.

Claims 3, 4 and 7 stand rejected under 35 U.S.C. § 103(a) over Davenport

We vacate these rejections and remand the application to the examiner for consideration of the matters discussed herein.

DISCUSSION

The application is remanded to the examiner for further consideration of the following:

1. The examiner is reminded that the standard under ' 102 is one of strict identity. ^AUnder 35 U.S.C. ' 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.[@] Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). ^AEvery element of the claimed

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invention must be literally present, arranged as in the claim. @ Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is recommended that the examiner take a step back and reconsider the rejection of the claims for anticipation over Davenport and consider whether a rejection of the claims for obviousness in view of Davenport would be more appropriate. The examiner should determine whether every element of the claimed invention is literally present, arranged as in the pending claim in the disclosure of Davenport, or whether one of ordinary skill in the art is required to engage in some degree of choice among various aspects of different embodiments described in Davenport. If no specific example of administering the claimed composition is found in Davenport, it is recommended that the examiner consider a rejection of all of the claims for obviousness, instead of anticipation.

In addition, the examiner should carefully consider the relevance of Davenport to claim 11 which requires that the omega-3 fatty acids be present in an amount from 1 to about 5%.

2. The examiner should consider the relevance of Ishihara et al., U.S. Patent No. 6,297,280 B1 to the pending claims. Example 2 of Ishihara describes administration of cat food to animals to suppress behavior problems. The example describes administration of a specific food to one of nine cats. Cat "BB" received a food containing a DHA powder comprising 5% DHA. See also Example 3, test animals

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"BBB", "GGG" and "HHH".

In addition, the examiner should carefully interpret the claims to determine whether the claim scope is broad enough to encompass administering an animal food which is not dry but includes a dry component powder of DHA or EPA.

3. The examiner should further consider the relevance of U.S. Patent Publication US2003/0194478 A1 to Davenport et al. to the pending claims. This is a publication of an application filed April 12, 2002, which is prior to the October 3, 2002 filing date of the present application. This Davenport publication describes the administration of combinations of DHA and EPA to animals to influence various animal behaviors. Claim 1 describes administration of a total amount of EPA and DHA of greater than about 0.20 weight percent. The examiner should consider the relevance of this publication, discussing each claim individually.

CONCLUSION

Accordingly, we vacate the rejections and remand the application to the examiner for further consideration. Upon receipt of the administrative file, we encourage the examiner to take a step back and reconsider the claim scope together with any relevant prior art. The art may be applied alone or in combination. If, after having the opportunity to reconsider the record, the examiner finds that a rejection is necessary, the examiner should clearly articulate the basis for any ground of rejection on the record

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being careful to insure that every limitation of each claim is accounted for.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is **not** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

This application, by virtue of its “special” status, requires an immediate action. MPEP § 708.01(D) (8th ed., rev. 1, February 2003). It is important that the Board be informed promptly of any action affecting the appeal in this case.

VACATE AND REMAND

Demetra J. Mills Administrative Patent Judge)))))))))))))))))))))
BOARD OF PATENT					
Lora M. Green Administrative Patent Judge))))))))))
APPEALS AND					
INTERFERENCES					
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