

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** HERMANN BIERINGER, ERWIN  
HACKER, RUDOLF HEINRICH, HANS-PHILIPP  
HUFF and JEAN KOCUR

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Appeal No. 94-2612  
Application 07/759,478<sup>1</sup>

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HEARD: March 4, 1998

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Before KIMLIN, GARRIS and WALTZ, ***Administrative Patent Judges.***

WALTZ, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 20, which are all the claims in this application.

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<sup>1</sup> Application for patent filed September 13, 1991.

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According to appellants, the invention relates to combinations of plant protection agents and surfactants (brief, page 2). An election of species was required by the examiner (see the Office action dated April 22, 1992, Paper No. 3). Appellants elected the species combination of fenoxaprop-ethyl herbicide and the alkyl polyglycol ether sulfate surfactant with traverse (see the amendment dated June 22, 1992, page 5, Paper No. 5). The examiner repeated the election requirement and deemed the appellants' reasons for traverse "non-persuasive" (page 2, Office action dated Sept. 10, 1992, Paper No. 6). As noted by the examiner (answer, page 2), "the claims have been examined insofar as they read on the elected species combination of fenoxaprop-ethyl and C<sub>10</sub>-C<sub>18</sub> alkyl polyglycol ether sulfate surfactants." Appellants have not contested this statement and therefore we will limit our review to the elected invention.

Appellants state that the claims should be considered in two groups (brief, page 3) and set forth specific reasons therefore for the group of claims 6-9 and 17-18 that contain "consisting essentially of" language (brief, page 4). No

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reasons are set forth for the separate patentability of the one group designated as claims 1-5, 10-16 and 19-20.

Therefore the claims stand or fall together. See *In re Nielson*, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987); *Ex parte Schier*, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991); and 37 CFR § 1.192(c)(5)(1993). Claims 17 and 18 are illustrative of the subject matter on appeal and are reproduced below:

17. A herbicidal agent which consists essentially of

a) herbicides selected from the group consisting of leaf-acting selective herbicides, and

b) surfactants selected from the group consisting of the C<sub>10</sub>-C<sub>18</sub>-alkyl polyglycol ether sulfates and their physiologically acceptable salts, with the exception of aqueous preparations of herbicides selected from the group consisting of fenoxaprop-P-ethyl, isoproturon and diclofop-methyl, which contain sodium C<sub>12</sub>-C<sub>14</sub>-alkyl diglycol ether sulfate in combination with a salt of tallow fatty amine ethoxylate having 15 EO and C<sub>6</sub>-C<sub>12</sub>-perfluoroalkylphosphinic acids/-phosphonic acids, and water dispersible granules which contain fenoxaprop-ethyl or fenoxaprop-P-ethyl and sodium C<sub>12</sub>-C<sub>14</sub>-alkyl diglycol ether sulfate, defoamers based on silicone, dispersants based on cresol/formaldehyde condensation products and aluminum silicate.

18. The herbicidal agent as claimed in claim 17, wherein the leaf-acting selective herbicide is fenoxaprop-

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ethyl.

The following prior art reference has been relied upon by the examiner as evidence of obviousness:

Röechling et al. (Röechling)	4,870,103	Sep. 26,
1989		

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Röechling.<sup>2</sup> We *affirm* for reasons which follow.

#### **OPINION**

The herbicidal agent of appealed claim 17 "consists essentially of" a leaf-acting herbicide (i.e., the elected species, fenoxaprop-ethyl, see claim 18) and C<sub>10</sub>-C<sub>18</sub>-alkyl polyglycol ether sulfate surfactants.<sup>3</sup>

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<sup>2</sup> In the event of further or continuing prosecution, the examiner should note that claims 1 and 15 fail to recite any active, positive process steps. See *Ex parte Erlich*, 3 USPQ2d 1011, 1017 (Bd. Pat. App. & Int. 1986), and *Ex parte Dunki*, 153 USPQ 678, 679 (Bd. App. 1967).

<sup>3</sup> Appealed claims 6 and 17 contain an exception clause to the possible combinations encompassed by the claim language but this is directed to excluding the

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The examiner asserts that Röechling discloses in Examples 13 and 26 the specific combination of herbicide and surfactant as per appellants' elected invention (answer, page 3).<sup>4</sup>

Röechling does require another ingredient, i.e., a phosphorylated emulsifier listed as emulsifier type I (column 1, lines 30-49, column 2, lines 34-40, and claim 1).

Appellants argue that "consisting essentially of" in the claim excludes the third "active ingredient" of Röechling while the examiner contends that the additional ingredient does not distinguish Röechling from the claimed subject matter (see the brief, pages 3 and 4, and the answer, pages 3-5).

It is well settled that the recital of "essentially" along with "consisting of" renders the claim open only for the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the

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combinations disclosed by European Patent Application No. 90,112,739.9 and German Patent Application P 3,938,564.7 (see the specification, page 10). There is no argument or evidence that the exception clause of claims 6 and 17 excludes the disclosed combinations of Röechling.

<sup>4</sup> It is noted that appellants' particularly preferred surfactant is @Genapol LRO (specification, page 9, lines 20-28), which is the same surfactant used in Examples 13 and 26 of Röechling (see column 2, lines 34-40, column 6, line 24, column 9, line 6, and column 10, line 1).

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composition.<sup>5</sup> See *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); *Ex parte Boukidis*, 154 USPQ 444 (Bd. App. 1966); *In re DeLajarte*, 337 F.2d 870, 873-74, 143 USPQ 256, 258 (CCPA 1964); *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963); and *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). To determine the ingredients excluded by the language "consisting essentially of", the claim must be read in light of the specification. See *In re Herz*, 537 F.2d at 551, 190 USPQ at 463, and *In re Janakirama-Rao*, 317 F.2d at 954, 137 USPQ at 896. In this regard, we emphasize that, from our perspective, it is an applicant's burden to establish that an ingredient included in a prior art composition is excluded by "consisting essentially of" language. See *In re Herz*, 537 F.2d at 551-52, 190 USPQ at 463, and *Ex parte Hoffman*, 12 USPQ2d at 1064.

The phrase "consisting essentially of" does not necessarily limit the claims to exclude other things when the specification clearly indicates that other constituents may be

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<sup>5</sup> The term "consisting essentially of" is similarly applied to process claims. See *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Int. 1989).

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present as well. *Ex parte Boukidis*, 154 USPQ at 444. Here appellants' specification clearly indicates that customary auxiliaries such as emulsifiers may be added to the claimed combination of herbicide and surfactant. See the specification, page 2, lines 3 and 4, page 13, lines 4-7, and page 13, line 34-page 14, line 7. Therefore appellants' argument that the additional emulsifier of Röechling is excluded from the appealed claims is not well taken.

Additionally, there is no evidence in this record that the additional emulsifier of Röechling would affect the basic and novel characteristics of appellants' claimed compositions. Appellants' and Röechling's compositions both have herbicidal activity, although the composition of Röechling may possess additional stability properties (see column 1, lines 10 and 30-34).

We find no patentable difference between the composition or herbicidal agent of appealed claim 17 and the composition of Examples 13 and 26 of Röechling. When every limitation of a claim identically appears in a single prior art reference,

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the claim is anticipated under 35 U.S.C. § 102. See *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). The examiner has characterized the rejection under § 103 but, as noted by our reviewing court:<sup>6</sup>

However, this Court has sanctioned the practice of nominally basing rejections on § 103 when, in fact, the actual ground of rejection is that the claims are anticipated by the prior art. See *In re Dailey*, 479 F.2d 1398, 178 USPQ 293 (CCPA 1973). The justification for this sanction is that lack of novelty in the claimed subject matter, e.g., as evidenced by a complete disclosure of the invention in the prior art, is the "ultimate or epitome of obviousness." *In re Kalm*, 54 CCPA 1466, 1470, 378 F.2d 959, 962, 154 USPQ 10, 12 (1967)[footnote omitted].

Appellants argue that sufficient evidence has been submitted to rebut any *prima facie* case of obviousness (brief, pages 5-9). However, as discussed above, the subject matter on appeal is described by Röechling within the meaning of 35 U.S.C. § 102(b). A proper rejection under § 102 cannot be overcome by a showing of new and unexpected results. See *In*

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<sup>6</sup> *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). See also *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

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*re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA  
1974).

For the foregoing reasons, the rejection of claims 1  
through 20 under 35 U.S.C. § 103 as unpatentable over  
Röechling is affirmed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

**AFFIRMED**

	)	
EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
THOMAS WALTZ	)	
Administrative Patent Judge	)	

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