

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER C. KNUPPEL, REINHARD LANTZSCH,
KLAUS JELICH, PETER ANDRES and ALBRECHT MARHOLD

Appeal No. 1996-2042
Application No. 08/086,602¹

HEARD: November 16, 1999

Before GARRIS, JOHN D. SMITH, and LIEBERMAN, Administrative
Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

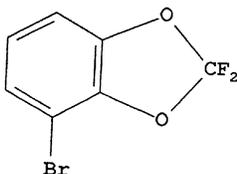
DECISION ON APPEAL

¹ Application for patent filed 08/086,602. According to appellants, the application is a division of Application No. 07/843,480, filed February 28, 1992, now U.S. Patent No. 5,258,526, issued November 2, 1993.

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This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claim 12, the sole claim remaining in this application.

Claim 12 is
12. The
difluorobenzodiox



reproduced below:
compound 4-bromo-2,2-
ole of the formula

The reference of record relied upon by the examiner is:
Kohl et al. (Kohl)² DE 36 42 256 A1 June 19,
1987

Appealed claim 12 stands rejected under 35 U.S.C. §
102(b) as "clearly anticipated" by Kohl.

We cannot sustain this rejection.

The subject matter on appeal is directed to a single
compound, 4-bromo-2,2-difluorobenzodioxole, which compound is
said to be especially useful as an intermediate for making

² Our consideration of Kohl is based on the attached
English translation.

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pesticides of outstanding activity. See the brief at page 3 and the specification at page 1, lines 2 and 3; page 11, line 13 to page 12, line 2; page 20, lines 3-8; and page 26, line 8 to page 27, line 3.

The examiner's anticipation rejection is predicated on his factual determination that the claimed "4-bromo" compound is one of only twenty eight possible compounds covered by generic formula I disclosed at page 3 of Kohl. See the answer at pages 4 and 5 and the supplemental answer at pages 1 and 2. Thus, the examiner, in effect, contends that because the number of compounds covered by formula I of the reference "is quite limited", Kohl provides a description of each of the twenty eight compounds "just as surely as if they were identified in the reference by name". See In re Schaumann, 572 F.2d 312, 316, 197 USPQ 5, 9 (CCPA 1978).

On the other hand, appellants correctly point that the examiner's determination that formula I of Kohl covers only twenty eight compounds is erroneously based on the assumption that the fourteen possible R¹ substituents of the formula I compounds are described as only single substituents on two possible ring positions. Our translation of Kohl confirms

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appellants' argument that there may be either one or two R¹ substituents on the ring of the prior art formula I compounds. See the attached translation of Kohl at the top of page 4. Thus, the examiner's determination that formula I of Kohl only covers twenty eight compounds was factually erroneous. As appellants observe, formula I of Kohl appears to cover at least 196 possible compounds. See the reply brief at page 3.

Both the question of what a prior art reference teaches and the question of anticipation under section 102(b) of the statute are factual determinations. See In re Graves, 69 F.3d 1147, 1151, 36 USPQ 2d 1697, 1700 (Fed. Cir. 1995). Here, the examiner's factual determination of what Kohl teaches was erroneous. It logically follows under the circumstances of this case that the examiner's rejection of appealed claim 12 as anticipated by Kohl cannot be sustained. The decision of the examiner is reversed.

In light of our disposition of anticipation rejection, the examiner should reconsider the propriety of a rejection of appealed claim 12 under 35 U.S.C. § 103 over Kohl. Compare the last line of the answer at page 5. The numerous declarations of record purportedly showing unexpected results

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attributed to the claimed compound of necessity must be considered with respect to the issue of obviousness.

We also observe that the examiner imposed a new ground of rejection of appealed claim 12 under the judicially created doctrine of obviousness-type double patenting over claims 1-3 of U. S. Patent No. 5,281,725 issued to Andres et al. (Andres) on January 25, 1994. See the answer at page 4. In his supplemental answer at page 2, the examiner indicated that "[T]he issue of US patent 5,281,725 is moot". However, as acknowledged by appellants, since the herein claimed compound falls within the two-compound subgenus of patented claim 3 of Andres and the six-compound genus of patented claim 1 of Andres, it was appellants' intention to take various actions including the filing of a terminal disclaimer relative to Andres. See pages 1 and 2 of the second supplemental brief on appeal filed March 31, 1995. Since appellants have failed to file the appropriate terminal disclaimer, we reimpose the obviousness-type double patenting rejection of claim 12 over claims 1 and 3 of Andres pursuant to our authority under 37 CFR § 1.196(b).

In summary, the examiner's rejection under 35 U.S.C.

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§ 102(b) as anticipated by Kohl is reversed; a new ground of rejection has been entered under the judicially created doctrine of obviousness-type double patenting; and the examiner is directed to reconsider the question of obviousness (35 U.S.C.

§ 103) of the appealed subject matter in view of the prior art Kohl reference.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that a new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR

§ 1.197(c)) as to the rejected claims:

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(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED 37 CFR § 196(b)

BRADLEY R. GARRIS)
Administrative Patent Judge)
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PAUL LIEBERMAN)	
Administrative Patent Judge)	

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APJ JOHN D. SMITH

APJ LIEBERMAN

APJ GARRIS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: April 20, 2001

Draft Final

3 MEM. CONF. Y

OB/HD GAU:

PALM /ACTS 2/BOOK
DISK(FOIA)/REPORT