

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS G. CATES II

Appeal No. 1997-0221
Application 08/248,496

ON BRIEF

Before WINTERS, WALTZ, and LIEBERMAN, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1 through 7 as amended subsequent to the final rejection (see the amendment dated Jan. 16, 1996, Paper No. 9, entered as per the Advisory Action dated Feb. 7, 1996, Paper No. 10). Claims 8 through 13, the only other claims in this application, stand withdrawn from further consideration by the

Appeal No. 1997-0221
Application 08/248,496

Moorman Manufacturing Co. (Moorman), "IGR Minerals," date unknown;

Vit-A-Way, Inc. (Vit-A-Way), "Mineral-Vitamin Fortifier," date unknown.¹

Claims 3 through 6 stand rejected under the first paragraph of 35 U.S.C. § 112 "as the specification, as originally filed, fails to provide support for the invention as now claimed." (Answer, page 4).² All of the claims on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over the "state of the art," as exemplified by either ACCO or Moorman, in view of Hogan and Vit-A-Way (Answer, page 5).³ We reverse all of the examiner's rejections for reasons which

¹ The Moorman and Vit-A-Way references with unknown publication dates were cited in appellant's information disclosure statement dated June 10, 1994, Paper No. 2. In the examiner's action dated June 13, 1995, Paper No. 6, the examiner noted that certain references were cited in the information disclosure statement without any publication dates, assumed that these references were available as prior art, and requested any information from appellant regarding the publication dates (paragraph 14). However, there is nothing in the record before us as to the publication dates of these references. Since appellant does not contest the availability of these references as prior art, for purposes of this appeal we adopt the examiner's assumption that these references are available as prior art under 35 U.S.C. § 103.

² The final rejection of claims 1-7 under the second paragraph of 35 U.S.C. § 112 has been overcome in view of appellant's response subsequent to the final rejection (see the amendment dated Jan. 16, 1996, Paper No. 9, and the Advisory Action dated Feb. 7, 1996, Paper No. 10).

³ The examiner applies Hawley as a "factual reference" to show the composition of "trona" as disclosed by Hogan (Answer, page 5). Since appellant does not contest this definition of "trona," we accept the examiner's finding as fact and no further discussion of Hawley is necessary to this decision.

Appeal No. 1997-0221
Application 08/248,496

follow. We also *remand* this application to the examiner for appropriate action as noted below.

OPINION

A. *The Rejection under § 112, ¶1*

The examiner states that “[i]n claims 3 and 4, it is not clear if there is support for the limitation that there is less than 1% of each of the specified minerals.” (Answer, page 4). The examiner further states that it is “ambiguous” as to whether the total of all elements listed in these claims is less than 1% or if each element is present in an amount less than 1% (*id.*). The examiner also questions the support for the amendments to claim 5 (*id.*).

Appellant argues that the examiner admits that the specification appears to support either interpretation of the amounts of minerals, and thus there is support for the subject matter of claims 3-6 (Reply Brief, page 1).

We presume that the examiner’s rejection for “fails to provide support” is premised on the “written description of the invention” requirement of the first paragraph of 35 U.S.C. § 112. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19

Appeal No. 1997-0221
Application 08/248,496

USPQ2d 1111, 1114 (Fed. Cir. 1991). As stated by our reviewing court in *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1117:

The purpose of the 'written description' requirement is broader than to merely explain how to 'make and use'; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed* (citations omitted).

Appellant discloses that the trace elements "comprise less than 1% manganese, zinc, iron" (page 10, ll. 1-3, of the specification). Appellant also discloses the amounts of "trace elements and vitamins" in the "present invention" is 3-4% (specification, page 14, Example 1). Even though these disclosures might be termed "ambiguous," the examiner has not met the initial burden of establishing that appellant has failed to convey with reasonable clarity to those skilled in the art that he was in possession of the claimed subject matter in question as of the filing date of this application. *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). The examiner appears to urge that either interpretation of the claimed subject matter in question is

Appeal No. 1997-0221
Application 08/248,496

supported by appellant's originally filed disclosure (Answer, page 4). Accordingly, the examiner's rejection of claims 3-6 under the first paragraph of § 112 is reversed.

B. The Rejection under § 103

The examiner finds that range mineral supplements containing 20-30% salt, greater than 10% of a phosphorus compound, sulfur sources such as ferrous sulfate and copper sulfate, potassium salts such as potassium iodide, potassium sulfate, and potassium chloride, magnesium salts such as magnesium oxide, trace elements and vitamins are well known, as shown by ACCO and Moorman (Answer, page 5). However, the examiner admits that neither of these references teach adding sodium bicarbonate to a range mineral supplement (*id.*).

To remedy this deficiency in ACCO and Moorman, the examiner applies Hogan for the teaching of adding sodium bicarbonate and sodium sesquicarbonate to feed supplements for

Appeal No. 1997-0221
Application 08/248,496

cattle (*id.*). The examiner also applies Vit-A-Way to show that sodium bicarbonate is known as a component of mineral range elements (Answer at page 6). The examiner concludes that it would have been obvious to add sodium bicarbonate and sodium sesquicarbonate to well known feed supplements such as those disclosed by ACCO or Moorman "in order to increase milk production, as taught by Hogan." (*id.*). The examiner further concludes that

[a]s to the particular amounts, it would have been within the purview of the ordinary artisan to determine optimal amounts through routine experimentation. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 105 USPQ 233 (CCPA 1955). *Id.*

The examiner relies on the rule that discovery of an optimum value of a result effective variable in a known process is *ordinarily* within the skill of the art. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977); and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). However, there are exceptions to this rule, one of

Appeal No. 1997-0221
Application 08/248,496

which is noted in *In re Sebek*, 465 F.2d 904, 907, 175 USPQ 93, 95 (CCPA 1972):

However, while it may ordinarily be the case that determination of optimum values for parameters of a prior art process would be at least prima facie obvious, that conclusion depends upon what the prior art discloses with respect to those parameters.⁴

The examiner has based his conclusion on Hogan, who teaches beneficial results when adding sodium sesquicarbonate (i.e., trona) to an animal feed supplement (page 1, ll. 1-8). However, Hogan teaches adding sodium sesquicarbonate as an ingredient of an animal feed mixture "in an amount sufficient to maintain rumen pH within the range of 5.5 to 7.0." (page 7, ll. 9-13). Hogan teaches addition of a maximum amount of 1.5% of the sodium bicarbonate or the sesquicarbonate (page 7a, Experiment One, and claims 2 and 5 on page 18). The *minimum* amount of sodium bicarbonate and sesquicarbonate recited in the claimed subject matter on appeal is 5% (see claim 1). Accordingly, contrary to the examiner's assertion, "the general conditions of a

⁴ Although the decisions cited above all concern processes and the claims on appeal are directed to compositions, in our opinion the same factors must be considered in determining obviousness. See *In re Geisler*, 116 F.3d 1465, 1469-70, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), and *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Appeal No. 1997-0221
Application 08/248,496

claim" are not within the prior art (see the Answer, page 6, citing *Aller, supra*). The examiner has not shown any teaching or suggestion in Hogan to use more than 1.5% of the sodium bicarbonate or sesquicarbonate and also has not established why one of ordinary skill in the art would have been led to amounts more than necessary to achieve the desired rumen pH taught by Hogan. Vit-A-Way is silent as to the amount of sodium bicarbonate and thus does not add anything to the teachings of Hogan.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the references of record. Accordingly, the rejection of claims 1 through 7 under 35 U.S.C. § 103 is reversed.

C. Remand to the Examiner

Upon the return of this application to the jurisdiction of the examiner, the form of the claims must be reviewed by the examiner for compliance with 35 U.S.C. § 112, paragraphs 2 and 4. The term "further comprising," as used in claim 4, is

Appeal No. 1997-0221
Application 08/248,496

confusing as to whether an additional mineral supplement is recited or the mineral supplement of claim 1 is being further limited.⁵ The dependency of claim 4 is also improper since the amount of sodium chloride and monosodium phosphate in claim 4 does not further limit the ranges specified for these ingredients in independent claim 1. Furthermore, if claims 4 and 7 are drafted as separate embodiments of the invention (see the specification, pages 9-10), the claims should specify the essential amounts of sodium bicarbonate or sesquicarbonate.

This application is remanded to the examiner for appropriate action as noted above.

The decision of the examiner is reversed.

⁵ The term "further comprising" was deleted from claim 7 in the amendment dated Jan. 16, 1996, Paper No. 9, in response to the rejection under § 112, ¶2, in paragraph 8 of the final rejection (Paper No. 8). No corresponding amendment was made to claim 4.

Appeal No. 1997-0221
Application 08/248,496

REVERSED & REMANDED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
THOMAS A. WALTZ)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
)	
)	
)	
)	
)	
PAUL LIEBERMAN)	
Administrative Patent Judge)	

TAW/kis

James C. Wray
1493 Chain Bridge Road
Suite 300

Appeal No. 1997-0221
Application 08/248,496

McLean, VA 22101