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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL KRAPP, RAINER BERGHAUS,  
MARKUS BECKER, KLAUS KOLB, and BERND SIEVERNICH

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Appeal 2015-004649  
Application 12/516,461  
Technology Center 1600

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Before DONALD E. ADAMS, ERIC B. GRIMES, and  
RACHEL H. TOWNSEND, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

This appeal under 35 U.S.C. § 134(a) involves claims 32–55 (Br. 2). Examiner entered rejections under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 103(a) and obviousness-type double patenting. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

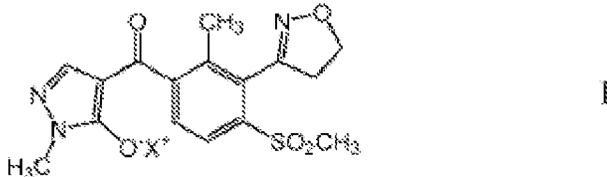
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<sup>1</sup> Appellants identify the real party in interest as “BASF SE” (Br. 2).

STATEMENT OF THE CASE

Claim 32 is representative and reproduced below:

32. A method for controlling harmful grasses comprising applying to the grasses or to the locus where the grasses are present a herbicidal mixture or composition comprising compounds of the formula I dissolved in water



where X is a monovalent cation selected from the group of alkaline metal and ammonium salts, wherein the compound of the formula I is present in a concentration of from 0.005 [g/l] to 500 [g/l], and

whereby the mixture or composition has a better herbicidal activity, without further additives, than a suspension concentrate of a compound corresponding to formula I but having hydrogen in the position of X.

(Br. 26.)

The claims stand rejected as follows:

Claim 32 stands rejected under 35 U.S.C. § 112, second paragraph.

Claims 32–55 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Bratz<sup>2</sup> and Sievernich.<sup>3</sup>

Claims 32–55 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Vantieghem.<sup>4</sup>

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<sup>2</sup> Bratz et al., US 6,479,437 B1, issued Nov. 12, 2002.

<sup>3</sup> Sievernich et al., US 6,908,883 B2, issued June 21, 2005.

<sup>4</sup> Vantieghem et al., US 2007/0123426 A1, published May 31, 2007.

Claims 32–34, 40, and 47 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 9–14, and 17 of Sievernich.

Claims 32–39, 41, 45, and 46 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–5, 7–9, and 11 of Bratz.

Claims 32–34, 39, 40, and 47 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–6, 8, and 9 of O’Neal.<sup>5</sup>

*Definiteness:*

ISSUE

Should the rejection under 35 U.S.C. § 112, second paragraph be summarily affirmed by the Board?

ANALYSIS

“If a ground of rejection stated by the examiner is not addressed in appellant’s brief, that ground of rejection will be summarily sustained by the Board.” Manual of Patent Examining Procedure (MPEP) § 1205.02 (Rev. 8, July 2010). Appellants do not address the rejection under 35 U.S.C. § 112, second paragraph, therefore it is summarily affirmed. In this regard, we recognize the arguments made in Appellants’ response received February 18, 2014. Examiner’s Advisory Action did not address Appellants’ arguments relating to the rejection under 35 U.S.C. § 112, second paragraph. Examiner’s Answer, however, states that “[e]very ground of rejection set forth in the [Final] Office action dated 12/18/2013 from which the appeal is

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<sup>5</sup> O’Neal et al., US 7,521,395 B2, issued Apr. 21, 2009.

taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading ‘WITHDRAWN REJECTIONS’” (Ans. 2; *see* Final Act. 2–3 (setting forth the basis of Examiner’s rejection under 35 U.S.C. § 112, second paragraph). Examiner’s Answer does not contain a section concerning withdrawn rejections. Therefore, taken together, we find that the rejection under 35 U.S.C. § 112, second paragraph was maintained by Examiner and not addressed in Appellants’ Brief.

#### CONCLUSION OF LAW

The rejection of claim 32 under 35 U.S.C. § 112, second paragraph is summarily affirmed. *See* MPEP § 1205.02.

*Obviousness:*

#### ISSUE

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

#### FACTUAL FINDINGS (FF)

FF 1. Bratz “relates to a synergistically acting herbicidal mixture of a 3-heterocyclyl-substituted benzoyl derivative, a nitrogenous fertilizer and an adjuvant” (Bratz 1: 6–8).

FF 2. Examiner finds that Bratz discloses

a composition comprising compound (I) further comprises a nitrogenous fertilizer (aqueous ammonia solution, ammonium salts, urea, thiourea and mixtures thereof) at least one adjuvant and one further herbicide (Col. 3, ln. 48-65 (suitable nitrogenous fertilizers); Col. 4, ln. 4-41 (suitable adjuvants));

Col. 8, ln 41-67 (herbicidal mixture can be mixed and applied with other herbicidal active ingredients)).

(Final Act. 8.)

FF 3. Bratz discloses “4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole . . . or [its] environmentally compatible salts,” such as “alkali metals, alkaline earth metals, ammonia or amines” as a preferred compound within the scope of Bratz’s disclosure (Bratz 3: 34–47; Final Act. 8).

FF 4. Appellants disclose a “[w]ater-soluble concentrate of the compound of the formula I,” wherein “100 g of the active substance 4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole (I-H; 99% technical grade) are dispersed [in water] . . . neutralized with a dilute base” and “[t]hereafter, if appropriate, . . . 500 g of AG 6202, is stirred in. After the mixture has been homogenized, the pH is checked again and, if necessary, corrected. The product is then made up to 1 liter”

(Spec. 18: 20–29.)

FF 5. Bratz discloses that a

[w]ater-soluble [c]oncentrate [wherein] 100 g of the active ingredient 4-[2-chloro-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole (99% technical grade) are dispersed in water . . . neutralized with a dilute [base] and then made up to 1 liter.

(Bratz 7: 43–50; *see* Final Act. 8 (Bratz discloses a “water-soluble concentrate”).)

FF 6. Examiner finds that Bratz discloses the application of a “composition comprising topramezone [] to harmful grasses present in crop plants selected from wheat, rice and more specifically corn plants and wherein the harmful grasses are controlled without causing significant damage to crop plants”

(Final Act. 9, citing Bratz 5: 43–49). Topramezone is the same as the compound of formula I (Br. 11).

FF 7. Examiner finds that “Bratz does not specifically teach the weight ratio of compound (I) to a further herbicide (1:0.001 to 1:1000)” or

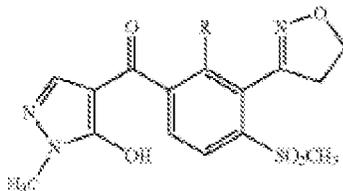
a composition comprising Compound (I) and a nitrogen-containing fertilizer are present in a weight ratio of 1:2.5 to 1:10000, compound (I) and the adjuvant are present in a weight ratio of from 1:2.5 to 1:5000, and compound (I) and the further herbicide are present in a weight ratio of from 1:0.001 to 1:1000 are applied to control unwanted grasses

and relies on Sievernich to make up for the foregoing deficiencies in Bratz (Final Act. 9–10).

FF 8. Vantieghem

relates to [herbicidally active] mixtures comprising

a) a 4,5-dihydroisoxazol-3-yl-substituted benzoyl derivative of the formula I,



where R is chlorine or methyl, or one of its environmentally compatible salts, esters or amides; and

b) esters of C<sub>6</sub>-C<sub>22</sub>-fatty acids of vegetable origin.

(Vantieghem ¶¶ 1–4; *see* Final Act. 12–13.)

FF 9. Vantieghem discloses that “[c]omponent a) of the mixtures according to the invention is[, *inter alia*,] 4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole” (Vantieghem ¶ 16; Final Act. 12).

FF 10. Vantieghem discloses “[s]uitable cations are in particular ions of the alkali metals, preferably lithium, sodium and potassium, of the alkaline earth metals, preferably calcium and magnesium, and the transition metals, preferably manganese, copper, zinc and iron, and also ammonium” (Vantieghem ¶ 233; *see* Final Act. 12).

FF 11. Vantieghem discloses that

[a]queous application forms of the mixture according to the invention can be produced from emulsion concentrates, suspensions, pastes, wettable powders or water-dispersible granules. To prepare emulsions, pastes or oil dispersions, the herbicidal mixture or components thereof, as such or dissolved in an oil or solvent, may be homogenized in water using wetting agents, adhesives, dispersants or emulsifiers. However, it is also possible to prepare, from the herbicidal mixture or components thereof, wetting [sic] agent, adhesive, dispersant or emulsifier and optionally solvent or oil, concentrates suitable for dilution with water.

(Vantieghem ¶ 242; *see* Final Act. 12.)

FF 12. Examiner finds that Vantieghem discloses a “composition compris[ing Vantieghem’s] compound (I) present in a concentration of 0.005 [g/L] to 500 [g/L], preferably 1 g/L to 400 g/L, and further comprises a nitrogenous fertilizer” (Final Act. 12).

FF 13. Examiner finds that

[w]hile Bratz [or Vantieghem] do[] not expressly report that the topramezone salt has a better herbicidal activity, without further additives, than a suspension concentrate of a compound corresponding to formula I but having hydrogen in the position of X, Bratz [or Vantieghem] do[] report the exact same salts[, as claimed by Appellants,] being dissolved in water for application to kill the exact same grassy weeds. Therefore, [Appellants’] findings of better herbicidal activity would obviously already be included/happening in [Appellants’] method of killing the same weeds since [Appellants] disclose

the same compositions for the **exact** same application/purpose [as is disclosed by Bratz or Vantieghem].

(Final Act. 9 and 13–14.)

FF 14. Bratz declares that

[w]hile water is a common carrier in herbicidal formulations, the suitability of water as a solvent depends on whether the active compound is sufficiently polar to dissolve in water in the necessary amounts. Also, while salts may be more likely to be dissolved in water, the mere fact that a compound is employed as a salt, in and of itself, does not suggest that the compound is soluble in water, or that the compound should be formulated and employed in form of an aqueous solution.

(Bratz Decl. <sup>6</sup> ¶ 7.b; *see also id.* ¶ 6.c.)

FF 15. Bratz declares that

[o]ne having ordinary skill in the art readily appreciates that not all of the compounds (A) and (B) enumerated by *Sievernich* are sufficiently water soluble and, thus, that the use of an aqueous solution is not an option which is generally applicable to any and all of those compounds and all possible mixtures thereof

(Bratz Decl. ¶ 6.j; *see also id.* ¶ 8.j (discussing the Bratz document of record)).

FF 16. Bratz declares that Regalis® is “[a] well-known example of a plant protection agent which is in [the] form of a salt” and the “Material Safety Data Sheet [] for Regalis® . . . describes the product as dispersible rather than soluble in water” (*id.*).

FF 17. Bratz declares “that the solution formulation of the salt of topramezone proved to be more effective against [] unwanted grasses than the suspension concentrate of topramezone” (*id.* ¶¶ 11–12).

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<sup>6</sup> Declaration of Matthias Bratz, signed Nov. 16, 2012.

FF 18. Bratz declares that the use of

an aqueous solution of the salt of topramezone in accordance with the method of current Claim 23 [sic] not only results in a higher herbicidal action but also brings about an improved selectivity, as compared to the method in which a suspension concentrate of topramezone is used. This result is particularly astonishing considering that Zea mays belongs to the family of Poaceae or Grammineae, i.e., grasses, that is, the same family as the Brachiaria, Echinochloa, Eriochloa, Panicum and Setaria species which were included in the described investigations.

(Bratz Decl. ¶ 13.)

#### ANALYSIS

*The rejection over the combination of Bratz and Sievernich:*

Based on the combination of Bratz and Sievernich, Examiner concludes that, at the time Appellants' invention was made, it would have been prima facie obvious

to combine the 1:0.001 to 1:1000 weight ratio of compound (I) and a further herbicide as taught by Sievernich to the method of controlling unwanted grasses by treating them with a composition comprising compound (I), a nitrogenous fertilizer, and adjuvant, and optionally a herbicide as taught by Bratz in order to develop the method of the instant invention which comprises the same components in a composition to be used for the same purpose (controlling unwanted/harmful grasses).

(Final Act. 11.)

Bratz discloses aqueous formulations comprising a 3-heterocyclyl-substituted benzoyl derivative, such as an environmentally compatible salt of "4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole," which falls within the scope of Appellants' claimed invention, and a method of applying the foregoing composition to "harmful grasses present in crop plants . . . without causing significant

damage to crop plants” (FF 3, 5, and 6; *cf.* FF 4 (wherein Appellants disclose a “[w]ater-soluble concentrate” of a compound within the scope of their claimed invention, wherein the compound is “dispersed in water”). Thus, notwithstanding Appellants’ contentions to the contrary, Bratz discloses a compound dissolved in water, which falls within the scope of a compound of formula I dissolved in water, as required by Appellants’ claimed invention (*see* Br. 11–13). Therefore, we are not persuaded by Appellants’ contention that “[w]hile Topramezone is listed as one of [Bratz’s] three preferred compounds and their ‘environmentally compatible salts’ there is no disclosure that this [compound] should be applied as a salt in a water solution” (Br. 11; *see id.* at 12 (“the mere fact water or aqueous forms are mentioned provides no disclosure that a Topramezone salt should be dissolved in water as claimed”); *see* FF 14–18; *see* Ans. 2–3). We recognize, but for the foregoing reasons, are not persuaded by, Appellants’ similar contentions with regard to Sievernich, which was relied upon by Examiner to suggest specific weight ratios of a first and second herbicide, nitrogen-containing fertilizer, and adjuvant (*see* Br. 13; *see also* FF 15; *cf.* FF 7).

We recognize Appellants’ contentions regarding unexpected results, but find that Examiner has the better argument (Br. 13–16; *see* Spec. 19–21; *see also* FF 18). In this regard, Examiner explains that, notwithstanding Appellants’ contentions to the contrary, Bratz discloses a method of treating plants comprising applying a composition within the scope of Appellants’ claimed invention “dissolved in water” to grasses or the locus where the grasses are present (*see* Ans. 6 (“Bratz teaches forming the salt in water, which would therefore dissolve the salt in the water and then treating the

same weeds/undesired vegetation with this soluble concentrate composition”); *see generally* Ans. 5–6; *see also* FF 5 (exemplifying a water-soluble concentrate of an active ingredient within the scope of Bratz’s disclosure dispersed in water); *cf.* FF 4 (Appellants’ Specification exemplifies a water-soluble concentrate of a compound within the scope of Appellants’ claimed invention dispersed in water).

For the foregoing reasons, we agree with Examiner’s conclusion that based on the combination of Bratz and Sievernich, Appellants’

method was already known and practiced in the prior art and as such any “unexpected results” that [Appellants] have now “discovered” does not render the method patentable because this method was already disclosed in [Bratz’s] work on topramezone and its same alkali metal and ammonium/quaternary amine salts for controlling the same species of unwanted/undesired vegetation.

(Ans. 6; *see* FF 13.) *See In re Huai-Hung Kao*, 639 F.3d 1057, 1070 (Fed. Cir. 2011) (the discovery of a new benefit of an old process cannot render the old process patentable).

*Unexpected Results:*

The evidence provided in Appellants’ Specification and the Bratz Declaration is limited to a comparison of the sodium salt Appellants’ formula I compound to the free acid form of that same compound. Thus, to the extent that Appellants’ evidence establishes unexpected results, the evidence is not commensurate in scope with Appellants’ claimed invention (*see* Spec. 20–21; Bratz Decl. ¶¶ 11–16; *cf.* Br. 26 (The method of Appellants’ claim 32 comprises alkaline metal and ammonium salts of the compound of formula I). *See In re Greenfield*, 571 F.2d 1185, 1189 (CCPA

1978) (In order to establish unexpected results for a claimed invention, objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support). Therefore, we are not persuaded by Appellants' contentions relating to an unexpected result obtained by their claimed invention (*see* Br. 12 (“In view of the broad Bratz disclosure, one of skill in the art would not immediately know that the salt form of Topramezone should be applied in a water solution to produce unexpected results”); *see also id.* at 13 (“the mere mention of an aqueous form [in Sievernich] is not sufficient for one of skill in the art to predict an aqueous form of the Topramezone salt claimed, or that the same would produce unexpected results”); *see id.* at 13–16, citing the Bratz Decl.).

*The rejection over Vantieghem:*

Based on Vantieghem, Examiner concludes that, at the time Appellants' invention was made, it would have been prima facie obvious to apply the herbicidal composition comprising a salt of topramezone in water to corn and other crop plants in order to develop the method of the instant invention which comprises the same components in a composition to be used for the same purpose (controlling unwanted/harmful grasses) because Vantiegham [sic] specifically teaches using the salts of topramezone as water soluble concentrates/aqueous solutions/aqueous use forms for treating grassy weeds in the same crop species without causing any significant damage.

(Final Act. 14–15.)

We are not persuaded by Appellants' contention that “[w]hile Vantiegham [sic] names []Topramezone, there is no disclosure that its salt form should be dissolved in water or that it would produce unexpected results” (Br. 17; *cf.* FF 8–12). Vantieghem discloses “aqueous solution and

aqueous application forms” of a compound that falls within the scope of Appellants’ claimed invention (Ans. 7; FF 11). Therefore, we are not persuaded by Appellants’ intimation that Vantieghem does not disclose a composition within the scope of Appellants’ claimed invention, because “[o]ne having ordinary skill in the art readily appreciates that the respective mixtures[, disclosed by Vantieghem,] were formulated using a suspension concentrate of Topramezone” (Br. 18).

We are not persuaded by Appellants’ contention that Vantieghem “cannot be deemed to teach applying the pyrazole herbicide ‘as a salt,’” because Vantieghem’s “disclosure is not limited to salts” (Br. 17; *cf.* Ans. 7, citing Vantieghem ¶¶ 232–233 (“Vantieghem [sic] clearly teaches the same salts as instantly claimed [], and expressly states that suitable cations are, ‘. . . in particular ions of the alkali metals, specifically lithium, sodium and potassium. . .and also ammonium.”)) (emphasis removed)). *See In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976) (a reference disclosure is not limited only to its preferred embodiments, but is available for all that it discloses and suggests to one of ordinary skill in the art).

For the foregoing reasons, we are not persuaded by Appellants’ contention that, notwithstanding Vantieghem’s disclosure, “one of ordinary skill in the art would look to esters or amides of the pyrazole compounds rather than focus on the salts in general or the salts with alkali metals, ammonia or amines in particular,” because “the uptake of an active ingredient by the plant foliage is influenced by the polarity of the ingredient and the uptake tends to decrease as the ionic character of the active ingredient increases” and “salts, esters or amides [are] not among the preferable embodiments” of Vantieghem (Br. 17–18; *cf.* FF 8–10

(Vantieghem discloses a composition comprising an environmentally compatible salt, ester, or amide of a compound within the scope of Appellants' claimed invention); Ans. 7).

In this regard, we recognize Appellants' contention that "one having ordinary skill would not reasonably expect esters of C6-C22- fatty acids of vegetable origin to be soluble in water" and find that it is proper to "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). *See also id.* at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton."). Thus, a person of ordinary skill in this art would have utilized a water-soluble form of a compound falling within the scope of Vantieghem's disclosure to formulate a water-soluble composition.

Examiner finds that Vantieghem discloses a compound within the scope of Appellants' claimed invention, formulated with "the exact same salts[, as claimed by Appellants,] being dissolved in water for application to kill the exact same grassy weeds" (FF 13; *see* Ans. 7–9). Therefore, we are not persuaded by Appellants' contention that

it can make a significant difference whether a herbicide is employed in a formulation in which water merely serves as a liquid carrier, or the herbicide is employed in [the] form of its aqueous solution because the waxy surface of the leaf restricts

access of aqueous solutions to the underlying cells and, thus, impairs uptake of the herbicide which is employed in that form. (Br. 19, citing Hassall<sup>7</sup>). To the contrary, we agree with Examiner's conclusion that

it would have been obvious to one of ordinary skill in the art at the time of the instant invention that applying topramezone as a salt in water to the weeds species of Vantiegham [sic] would have been expected to provide control of these weeds based upon Vantiegham[']s [sic] teaching that topramezone and its salts were useful compounds for controlling the same weed species as instantly claimed.

(Ans. 9; *see id.* 9–10.) For the foregoing reasons, we are not persuaded by Appellants' contentions regarding unexpected results (*see* Br. 20–21). In this regard, we are not persuaded by Appellants' contention that Vantieghem's "examples [] are not representative of results which are achieved when the pyrazole herbicide is applied as a salt and dissolved in water," because Vantieghem's examples relate to Topramezone that is suspended or emulsified in water (Br. 21). *See Lamberti*, 545 F.2d at 750.

*Unexpected Results:*

The evidence provided in Appellants' Specification and the Bratz Declaration is limited to a comparison of the sodium salt Appellants' formula I compound to the free acid form of that same compound. Thus, to the extent that Appellants' evidence establishes unexpected results, the evidence is not commensurate in scope with Appellants' claimed invention (*see* Spec. 20–21; Bratz Decl. ¶¶ 11–16; *cf.* Br. 26 (The method of Appellants' claim 32 comprises alkaline metal and ammonium salts of the

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<sup>7</sup> Kenneth A. Hassall, PhD, FRSC, *The Chemistry of Pesticides*, 26–29 (VCH Publishers Inc., New York, NY) (1990).

compounds of formula I)). *See In re Greenfield*, 571 F.2d at 1189.

Therefore, we are not persuaded by Appellants' contentions relating to an unexpected result obtained by their claimed invention (*see* Br. 17 (“there is no disclosure [in Vantieghem] that it would produce unexpected results”); *see also id.* at 21).

#### CONCLUSION OF LAW

The preponderance of evidence relied upon by Examiner supports a conclusion of obviousness.

The rejection of claim 32 under 35 U.S.C. § 103(a) as unpatentable over the combination of Bratz and Sievernich is affirmed. Claims 33–55 are not separately argued and fall with claim 32.

The rejection of claim 32 under 35 U.S.C. § 103(a) as unpatentable over Vantieghem is affirmed. Claims 33–55 are not separately argued and fall with claim 32.

*Obviousness-type Double Patenting:*

#### ISSUE

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness-type double patenting?

*The obviousness-type double patenting rejection over Sievernich or Bratz:*

Having found no deficiency in the rejection of claim 32 as obvious in view of the combination of Bratz and Sievernich, we are not persuaded by Appellants' contention that “[f]or the reasons discussed above with regard to the rejection [over] Bratz in view of Sievernich, [] the obviousness-type double patenting rejection in light of Sievernich [or Bratz] [should] be [] withdrawn” (Br. 21–22; *cf.* Final Act. 4–6 (Examiner's statement of the

obviousness-type double patenting rejection over Sievernich or Bratz); Ans. 10).

*The obviousness-type double patenting rejections over O’Neal:*

#### FACTUAL FINDINGS (FF)

FF 19. O’Neal claims a composition comprising “4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole or one of its environmentally compatible salts” and

[a] method of controlling undesired vegetation, comprising applying before, during or after the emergence of the undesired vegetation, either simultaneously or separately, a synergistic herbicidal combination of[, *inter alia*,] 4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole or one of its environmentally compatible salts . . . wherein the undesired vegetation is proximate crop plants, and the . . . combination is applied to the leaves of the crop plants and of the undesired plants.

(O’Neal 16: 44–47; *id.* at 17: 18–18: 5 and 18: 15–18; *see* Final Act. 6–7.)

FF 20. O’Neal defines environmentally compatible salts as comprising alkali metals, alkaline earth metals, transition metals, and ammonium (O’Neal 4: 45–49).

FF 21. O’Neal states that “[t]he mixtures according to [O’Neal’s] invention, or the herbicidal compositions comprising them, can be employed, for example, in the form of directly sprayable aqueous solutions, powders, suspension, [and] also highly-concentrated aqueous, oily or other suspensions or dispersions” (O’Neal 11: 61–67).

#### ANALYSIS

Examiner concludes that O’Neal’s claims make obvious the subject matter of Appellants’ claim 32 (*see* Final Action 6–7; FF 20–22).

We are not persuaded by Appellants' contention that O'Neal's "claims taken together with the supporting disclosure fail to suggest that any one of the salt forms is preferable to the non-salt form of topramezone, or that alkali metal or ammonium ions are preferable to the other enumerated anions or cations, or genera of anions or cations . . . [or] that any one of the components (a), (b) or (c)[, set forth in O'Neal's claims] should preferably be employed in [the] form of an aqueous solution" (Br. 23, citing the Bratz Declaration and Hassall; *see also* Br. 24 ("using Topramezone in [the] form of a salt, and employing the salt in [the] form of an aqueous solution, can be detrimental to the uptake of the herbicide and, thus, may adversely affect its herbicidal action because uptake by the plant is a prerequisite of achieving the herbicidal effect")). To the contrary, O'Neal suggests a method within the scope of Appellants' claimed invention that utilizes a composition comprising the salt of a compound that falls with the scope of Appellants' claimed invention. Thus, we agree with Examiner that, notwithstanding Appellants' contention to the contrary, O'Neal claims a method that is not patentably distinct from Appellants' claimed invention (*see* Ans. 11–12).

O'Neal discloses compositions "in the form of directly sprayable aqueous solutions" (FF 21). Therefore, we are not persuaded by Appellants' contention "that not all of the compounds within components (a), (b) and (c) of O'Neal's mixtures are sufficiently water soluble to be employed in [the] form of an aqueous solution" (Br. 24). A person of ordinary skill in this art would have utilized a water-soluble form of a compound falling within the scope of O'Neal's claims to formulate an aqueous solution within the scope of O'Neal's disclosure. *See KSR*, 550 U.S. at 418 and 421.

*Unexpected Results:*

The evidence provided in Appellants' Specification and the Bratz Declaration is limited to a comparison of the sodium salt of Appellants' formula I compound to the free acid form of that same compound. Thus, to the extent that Appellants' evidence establishes unexpected results, the evidence is not commensurate in scope with Appellants' claimed invention (*see* Spec. 20–21; Bratz Decl. ¶¶ 11–16; *cf.* Br. 26 (The method of Appellants' claim 32 comprises alkaline metal and ammonium salts of the compounds of formula I). *See In re Greenfield*, 571 F.2d at 1189. Therefore, we are not persuaded by Appellants' contentions relating to an unexpected result obtained by their claimed invention (*see* Br. 24).

CONCLUSION OF LAW

The preponderance of evidence relied upon by Examiner supports a conclusion of obviousness-type double patenting.

The rejection of claim 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 9–14, and 17 of Sievernich. Claims 33, 34, 40, and 47 are not separately argued and fall with claim 32.

The rejection of claim 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–5, 7–9, and 11 of Bratz. Claims 33–39, 41, 45, and 46 are not separately argued and fall with claim 32.

The rejection of claim 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–6, 8, and 9 of O'Neal. Claims 33, 34, 39, 40, and 47 are not separately argued and fall with claim 32.

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TIME PERIOD FOR RESPONSE

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

AFFIRMED