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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte REGINALD KEITH WHITELEY,
MARILYN EMILY KARAMAN, and
GREGORY STUART WHITELEY¹

Appeal 2015-005665
Application 12/092,042
Technology Center 1600

Before DONALD E. ADAMS, TAWEN CHANG, and DAVID COTTA,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a non-foaming sterilizing composition, which have been rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

According to the Specification, “[f]oam generated during reprocessing [of surgical instruments such as endoscopes] seriously impedes cleaning and

¹ Appellants identify the real party in interest as Whiteley Corporation Pty Ltd. (Appeal Br. 3.)

biofilm removal” and, “[t]hus far, no detergent cleaning product or chemical sterilant has been developed that is both effective as a chemical sterilant and non-foaming under the high pressures exerted within the endoscope tubing and channels during reprocessing.” (Spec. 2:5–11.) Further according to the Specification, the claimed compositions, “with a novel foam control system, . . . are substantially non-foaming under high pressure conditions, thus allowing maximum benefit from the new, more reliable, generation of automated endoscope reprocessing machines.” (*Id.* at 4:10–14.)

Claims 31–39, 41, and 42 are on appeal. Claim 31 is illustrative and reproduced below:

31. A substantially non-foaming sterilizing composition comprising:

- (i) at least one aromatic dialdehyde;
- (ii) at least one glycol or polyol or derivative thereof;
- (iii) a first non-ionic surfactant; and
- (iv) a second surfactant having a cloud point in the range of about 30°C to 50°C and selected from the group consisting of an ethoxylated propoxylated C8-C10 alcohol; a branched alcohol ethylene oxide chlorine capped; and a polyoxyethylene polyoxypropylene block copolymer;

wherein said composition when combined with water has a pH in the range of about 7.40 to 8.0.

(Appeal Br. Appendix 1.)

The Examiner rejects claims 31–39 and 41–42 under 35 U.S.C. § 103(a) as being unpatentable over Julemont² and Zhu.³ (Ans. 3.)

² Julemont et al., US 6,380,152 B1, issued Apr. 30, 2002.

³ Zhu et al., *Solvent or Matrix-Mediated “Molecular Switches,” the Lipophilic Dialdehyde (OPA) and the Amphiphilic 1,3-Phthalandiol and OPA Disinfection Mechanism*, 9 CURRENT ORGANIC CHEMISTRY 1155–1166 (2005).

The Examiner rejects claims 31–39 and 41–42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–4, 6, and 8–10 of U.S. Patent No. 4,748,279 in view of Julemont and Zhu. (*Id.*)

The Examiner rejects claims 31–39 and 41–42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–7, 12, 16, and 23–28 of U.S. Patent No. 6,525,101 in view of Julemont and Zhu. (*Id.*)

I.

Issue

The Examiner has rejected claims 31–39 and 41–42 under 35 U.S.C. § 103(a) as being unpatentable over Julemont and Zhu. The Examiner finds among other things that Julemont teaches

antibacterial cleaning compositions comprising glutaraldehyde as a disinfecting agent in amounts of 0.1 – 2 wt.%, dipropylene or propylene glycols as cosurfactants, mixtures of surfactants including Pluronics (polyoxyethylene polypropylene block copolymers) and NEODOL ethoxylates formed from a C9-C11 alkanol condensed with 2.5-10 moles of ethylene oxide.

(Final Act. 5.) The Examiner finds that NEODOL meets the limitation of the claimed first non-ionic surfactant and Pluronics meets the limitations relating to the claimed second surfactant. (*Id.*)

Appellants argue among other things that “there is no teaching, suggestion or motivation in Julemont to select the . . . combination of surfactants . . . claimed in the present invention,” specifically a combination comprising “a second surfactant having a cloud point in the range of about 30°C to 50°C and selected from the group consisting of an ethoxylated

propoxylated C8-C10 alcohol; a branched alcohol ethylene oxide chlorine capped; and a polyoxyethylene polyoxypropylene block copolymer.”

(Appeal Br. 17–18; Reply Br. 11–12.)

The issue with respect to this rejection is whether the evidence of record supports the Examiner’s conclusion that the cited prior art suggests a composition comprising the claimed combination of surfactants.

Analysis

Appellants contend that, in light of Julemont’s broad disclosure of a large number of surfactants—with cloud points ranging from 2.1°C to 89°C—Julemont cannot be said to suggest the narrower claim limitation of “a second surfactant having a cloud point in the range of about 30°C to 50°C and selected from the group consisting of an ethoxylated propoxylated C8-C10 alcohol; a branched alcohol ethylene oxide chlorine capped; and a polyoxyethylene polyoxypropylene block copolymer.” (Appeal Br. 17–18; Reply Br. 11–12.)

The Examiner responds that “the criteria for establishing a case of prima facie obviousness is not whether the prior art exemplifies all the claimed limitations but whether the prior art suggests the claimed limitations.” (Ans. 7.) The Examiner contends that

Julemont suggests mixtures of surfactants including those with the instant cloud range (i.e., Pluronic L62) and non-ionic surfactants like NEODOL ethoxylates formed from a C9-C11 alkanol condensed with 2.5-10 moles of ethylene oxide. This is sufficient in establishing obviousness. . . . [R]eading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle. . . . Since all elements of the instant claims are taught in the prior art, combining the components for their intended use of disinfecting would have been obvious.

(*Id.* at 8.)

We find that Appellants have the better argument. While Julemont does disclose Pluronic L62 as a suitable water-soluble nonionic detergent for use in its invention (Julemont 7:9–24), Pluronic L62 is one of many nonionic surfactants disclosed. (*See id.* at 5:48–7:24.) The Examiner has articulated no persuasive reason why a skilled artisan would choose Pluronic L62 in particular for combination with the NEODOL ethoxylates. (*Id.* at 6:14–22.) *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (explaining that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”); *see also Ecolochem Inc. v. Southern California Edison*, 227 F.3d 1361, 1375 (Fed. Cir. 2000) (explaining that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”).

Accordingly, we reverse the Examiner’s rejection of claims 31–39 and 41–42 as obvious over the combination of Julemont and Zhu.

II.

The Examiner has rejected claims 31–39 and 41–42 on the ground of nonstatutory obviousness-type double patenting over claims 1–4, 6, and 8–10 of U.S. Patent No. 4,748,279 and claims 1–7, 12, 16, and 23–28 of U.S. Patent No. 6,525,101, in view of Julemont and Zhu. The Examiner finds that the reference claims “are not drawn to two surfactants and more specifically a second surfactant having a cloud point in the range of about 30°C to 50°C selected from the instant Markush group” but finds that

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Julemont renders incorporation of such a surfactant obvious for the same reasons described above with respect to the § 103 rejection. (Final Act. 13–14, 18–19.) Accordingly, we reverse the double patenting rejections for the same reasons already discussed.

SUMMARY

For the reasons above, we reverse the Examiner’s decision rejecting claims 31–39 and 41–42.

REVERSED