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McBee Moore & Vanik, IP, LLC			CHONG, YONG SOO	
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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* BERND ALIG, SILVIA CEREZO-GALVEZ, REINER FISCHER,  
ADELINE KÖHLER, JULIA JOHANNA HAHN, PETER LÖSEL, and  
OLGA MALSAM

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Appeal 2020-000933  
Application 15/301,347<sup>1</sup>  
Technology Center 1600

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Before JEFFERY N. FREDMAN, DAVID COTTA, and CYNTHIA M.  
HARDMAN *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a method for controlling animal pests with one or more of N-arylamidine-substituted trifluoroethyl sulfoxide derivatives. The Examiner rejected the claims on appeal on the ground of non-statutory obviousness-type double patenting. We reverse.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest Bayer CropScience AG. Appeal Br. 4.

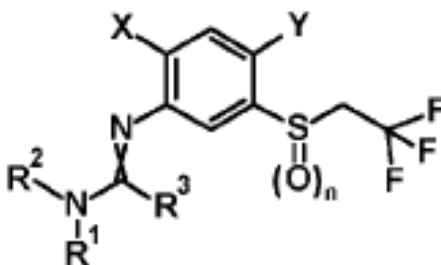
## STATEMENT OF THE CASE

The Specification discloses that “[t]he present invention relates to the use of *N*-arylamidine-substituted trifluoroethyl sulphoxide derivatives for controlling insects and/or spider mites and/or nematodes by watering, droplet application, dip application, soil injection or by treating seed.”

Spec. 1.

Claims 1, 3, 5–10, and 13–19 are on appeal. Claim 1 is representative and reads as follows:

1. A method for controlling animal pests with one or more of *N*-arylamidine substituted trifluoroethyl sulphoxide derivatives of formula (I)



(I),

where

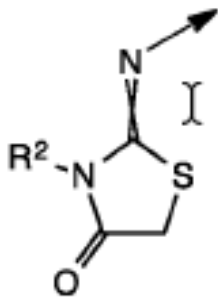
n represents the number 1,

X represents fluorine, chlorine, bromine, or iodine,

Y represents (C<sub>1</sub>-C<sub>4</sub>)-alkyl or (C<sub>1</sub>-C<sub>4</sub>)-haloalkyl,

R<sup>2</sup> represents hydrogen, (C<sub>1</sub>-C<sub>4</sub>)-alkyl or (C<sub>1</sub>-C<sub>4</sub>)-haloalkyl, and

R<sup>1</sup> and R<sup>3</sup> together with the atoms to which they are attached represent the group



where the arrow points to the remainder of the molecule, wherein the compound of the formula (I) is its R enantiomer, with respect to the chiral sulphur atom, or is a mixture of the R enantiomer and the S enantiomer in which the proportion of the R enantiomer is at least 55% by weight, based on the enantiomer mixture, comprising drenching soil, applying by drip application to the soil, immersing roots, tubers or bulbs in soil or an artificial growth substrate, or applying by soil injection with the derivative of formula (I) to thereby control the animal pests.

Appeal Br. 26.

The Examiner rejected claims 1, 3, 5–10, and 13–19 on the ground of non-statutory obviousness-type double patenting over claims 1–20 of US Patent No. 9,642,363 B2 (“the ’363 patent”) in view of Yamazaki.<sup>2</sup>

#### ANALYSIS

The Examiner’s position, essentially, is that the pending claims would have been obvious over the reference claims because the reference claims disclose a genus of compounds that encompasses the compounds<sup>3</sup> recited in the pending claims. Ans. 5 (“There is sufficient overlap in the core structure of the two formulas. . . . Therefore, it would have been obvious for one of ordinary skill in the art to readily envision the claimed compound from a limited list of possibilities and with the guidance of the dependent claims.”); *see also, generally, id.* at 2–6.

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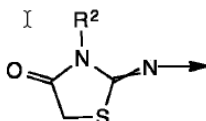
<sup>2</sup> Yamazaki, et al., WO 2007/131680 A1, published November 22, 2007 (“Yamazaki”).

<sup>3</sup> The pending claims include claims reciting a subgenus of compounds (e.g., claims 1, 3, 5–10, 13, 14, and 18) as well as claims reciting a specific compound (e.g., claims 15–17 and 19). As used herein when discussing the pending claims, the term “compounds” encompasses both the subgenera and the specific compound recited in the claims.

Appellant argues that in order to arrive at the compounds recited in the pending claims, the ordinary artisan would need to make a number of specific choices to narrow the genus recited in the reference claims.

Specifically, Appellant asserts that the artisan would need to:

modify a compound of the '363 patent having the structure



from among the 14 ring systems recited for R<sup>1</sup> and R<sup>3</sup> together in Claim 1 or the 16 groups recited in Claim 8 (the compound claims upon which the respective method Claims 12 and 20 depend) and then, on top of that, to specifically modify n to be 1 (from 0 or 1) and to modify X<sup>2</sup> (corresponding to Appellants' group X) to be fluorine, chlorine, bromine, or iodine from among 41 other substituents, many which are further optionally substituted, and to modify X<sup>4</sup> (corresponding to Appellants' group Y) from among 41 other substituents, some optionally substituted, and to modify R<sup>2</sup> (corresponding to Appellants' group R<sup>2</sup>) from among all of the large number of potential groups listed in column 291, lines 16-42.

Appeal Br. 14. Appellant argues that the Examiner's rejection should be reversed because the number of compounds encompassed by the reference claims are "almost limitless" and that the "claims of the '363 patent provide no teaching whatsoever that would suggest the specific choices that would lead to the claimed compounds." *Id.*

As stated in *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992): "[T]he examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability." Appellant has persuaded us that the Examiner has not carried the burden of establishing that the claimed invention is unpatentable for obviousness-type double patenting over claims 1–20 of the '363 patent in view of Yamazaki.

The fact that the pending claims recite compounds encompassed within the genus disclosed in the prior art is not, by itself, sufficient to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”); *In re Jones*, 958 F.2d 347, 350 (Fed. Cir. 1992) (The Federal Circuit has “decline[d] to extract from *Merck [& Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804 (Fed. Cir. 1989)] the rule that . . . regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it.”)); *see also* MPEP § 2144.08 II.

In both *Baird* and *Jones*, our reviewing court reversed rejections similar to the present rejection, in which the rejected compounds were encompassed by large genera that included millions of compounds, but the prior art did not suggest selecting from those genera the particular compound, or subgenus of compounds, recited in the claims at issue. *See In re Baird*, 16 F.3d at 382–83; *In re Jones*, 958 F.2d at 350–51.

As in *Baird* and *Jones*, we are not persuaded that the Examiner has provided a sufficient evidentiary basis explaining why, out of the enormous number of possibilities encompassed within the genus described in the ’363 patent, a skilled artisan would have made the particular set of selections and modifications that would be required to arrive at the compounds recited in the pending claims. *See* MPEP § 2144.08.II.A.5 (When asserting that an examined species is obvious over a prior art genus, the Examiner’s “fact-findings should specifically articulate what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to select the claimed species or subgenus.”). The mere fact that one might arrive at

Appellant's claimed compounds by a hindsight-guided selection of appropriate substituents from the large genus disclosed in the reference claims does not persuade us that the pending claims would have been obvious to a skilled artisan. *See In re Baird*, 16 F.3d at 382–83; *In re Jones*, 958 F.2d at 350–51. Accordingly, we reverse the Examiner's rejection of claims 1, 3, 5–10, and 13–19.

### CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3, 5– 10, 13– 19		Double patenting		1, 3, 5– 10, 13– 19
<b>Overall Outcome</b>				1, 3, 5– 10, 13– 19

REVERSED