

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SHEN SHI-HSIANG,
AHMAD SULTAN,
CLAES WAHLESTEDT, and
PHILIPPE WALKER

Appeal No. 2001-1900
Application No. 08/981,700

ON BRIEF

Before WILLIAM F. SMITH, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 13, 37, and 19, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A protein, except as existing in nature, consisting essentially of the rat GAL-R2 amino acid sequence as shown in SEQ ID NO:2.

The reference relied upon by the examiner is:

Shuji et al. (Shuji)

EP 0 711 830 A2

Oct. 11, 1995

GROUND OF REJECTION

Claims 1, 13, 37, and 19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Shuji.

We reverse.

DISCUSSION

On this record, the examiner finds (Answer, page 4), as set forth at page 19 of appellants' specification, that the "instant invention does not bind the chimeric peptide C7 as well as the prior art [G1] receptor does...." While the examiner agrees (Answer, page 6) that the claimed receptor subtype is different than the prior art receptor, the examiner maintains (Answer, page 3) that the transitional phrase "consisting essentially of" broadens the scope of the claimed receptor to encompass all galanin receptor subtypes as long as enough sequence identity is retained to classify the resulting receptor as a galanin receptor. We cannot agree with the examiner's position.

In contrast to the examiner's interpretation of the transitional phrase "consisting essentially of," the court in In re Herz, 537 F.2d 549, 551-552, 190 USPQ 461, 463 (CCPA 1976) explains:

In In re Janakirama-Rao, [317 F.2d 951, 137 USPQ 893 (CCPA 1963)] ... this court held that the phrase "consisting essentially of" limits the scope of a claim to the specified ingredients and those that do not materially affect the basic and novel characteristic(s) of a composition. It cited Ex parte Davis, 80 USPQ 448 (Pat. Off. Bd. App. 1948), ... and quoted approvingly the following portion of the opinion:

In the present case where the claims recite three ingredients and the reference discloses four, the important question is whether the term "consisting essentially of" excludes that fourth ingredient. We think that it does, since

the “modifier” materially changes the fundamental character of the three-ingredient composition....

Accordingly, we agree with appellants’ interpretation of the claimed invention (Specification page 2), “the invention encompasses proteins having exactly the same amino acid sequence as shown in the figures, as well as proteins with differences that are not substantial as evidenced by their retaining the basic, qualitative ligand binding properties of GAL-R2.” See also, Specification page 6.

The evidence on this record demonstrates that the claimed receptor is different than the receptor taught by Shuji. Therefore, Shuji cannot anticipate the claimed invention. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920-21 (Fed. Cir. 1989) (“anticipation” requires that the identical invention is described in a single prior art reference). Accordingly, the rejection of claims 1, 13, 37, and 39 under 35 U.S.C. § 102(b) as anticipated by Shuji is reversed.

REVERSED

William F. Smith)
Administrative Patent Judge)
)
) BOARD OF PATENT
Donald E. Adams)
Administrative Patent Judge) APPEALS AND
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Appeal No. 2001-1900
Application No. 08/981,700

Page 4

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