

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FEB 21 1996

Ex parte J. HERBERT WAITE

PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 94-0514
Application 07/839,745¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and PAK, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision refusing to allow claims 24-35. Claims 17-22, which are the only other claims remaining in the application, stand withdrawn from

¹ Application for patent filed Feb. 19, 1992. According to applicant, the application is a continuation of Application 07/378,599, filed July 11, 1989.

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further consideration by the examiner as directed to a non-elected invention.

Claim 24, which is illustrative of the subject matter on appeal, reads as follows:

24. An isolated and purified polypeptide containing at least one of the amino acid sequences set forth below:

- (A) Gly-Dop-Lys
- (B) Thr-Gly-Dop-Ser-Ala-Gly-Dop-Lys
- (C) Gln-Thr-Gly-Dop-Val-Pro-Gly-Dop-Lys
- (D) Gln-Thr-Gly-Dop-Asp-Pro-Gly-Tyr-Lys
- (E) Gln-Thr-Gly-Dop-Leu-Pro-Gly-Dop-Lys

wherein the above three-letter symbols are defined as follows:

Gly is a glycine residue,
Dop is a 3,4-dihydroxyphenylalanine residue,
Lys is a lysine residue,
Gln is a glutamine residue,
Thr is a threonine residue,
Ser is a serine residue,
Ala is an alanine residue,
Val is a valine residue,
Pro is a proline residue,
Asp is an aspartic acid residue,
Tyr is a tyrosine residue and
Leu is a leucine residue.

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The prior art references relied on by the examiner are:

Waite	4,496,397	Jan. 29, 1985
Waite	4,585,585	Apr. 29, 1986
Waite	4,687,740	Aug. 18, 1987
Waite	4,808,702	Feb. 28, 1989
Benedict et al (Benedict)	5,015,677	May 14, 1991
Benedict et al (Benedict)	5,108,923	Apr. 28, 1992

The issues presented for review are: (1) whether the examiner correctly rejected claims 24-35 under 35 USC § 112, first paragraph, as based on a specification which does not contain an adequate written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same; (2) whether the examiner correctly rejected claims 24-35 under 35 USC § 112, second paragraph, as not particularly pointing out and distinctly claiming the subject matter which appellant regards as his invention; (3) whether the examiner correctly rejected claims 24-35 under 35 USC § 101 as directed to non-statutory subject matter; and (4) whether the examiner correctly rejected claims 24-35 under 35 USC § 102 as anticipated by or, in the alternative, under 35 USC § 103 as unpatentable over Benedict '677, Benedict '923, Waite '585, Waite '397, Waite '740, or Waite '702.

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Discussion

On consideration of the record, we reverse each of the examiner's prior art and non-prior art rejections. Essentially, we agree with the position succinctly stated by appellant in the Main Brief before the Board, pages 13-33, and the Reply Brief, pages 1-9. Where, as here, the rejections are manifestly untenable and we agree with appellant's stated position on appeal, we shall adopt that position as our own.

One portion of the examiner's answer warrants special attention. In discussing the issue of obviousness, the examiner states that

Changing an amino acid sequence for the sake of changing or for a purpose that would have been obvious to the skilled artisan does not rise to the level of invention.

See the Answer, page 8. The examiner thus implies, incorrectly, that appellant has not made an invention. The specification describes at length appellant's invention and contribution to the art. The issue presented is whether appellant's claims define a patentable invention or, in the language of 35 USC § 103, whether the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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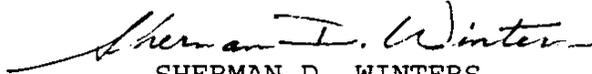
person having ordinary skill in the art to which said subject matter pertains.

We note that claim 25 appears to contain an inadvertent error in the recitation of formula (III). That formula, as depicted in the claim, cannot represent a nonapeptide because the formula contains too many amino acids. On return of this application to the examining corps, the matter should be clarified.

Finally, having reviewed the search notes in this file, we question whether the examiner has conducted an adequate search of the claimed polypeptides. On return of this application to the examining corps, the examiner should ensure that a proper search is conducted in all relevant data bases available to the PTO.

The examiner's decision is reversed.

REVERSED



SHERMAN D. WINTERS)
Administrative Patent Judge)



WILLIAM F. SMITH)
Administrative Patent Judge)

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CHUNG K. PAK)
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