

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte JON M. LINDSTROM
and RALF D. SCHOEPFER

SEP 28 1994

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

Appeal No. 94-0653
Application 07/413,947¹

ON BRIEF

Before WINTERS, WILLIAM SMITH and JOHN SMITH, Administrative
Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the examiner's decision refusing to allow claims 1-18 and 27-30, which are all of the claims remaining in the application.

¹ Application for patent filed September 28, 1989.

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Claim 1 is representative:

1. An isolated DNA molecule, comprising a sequence of nucleotides encoding an α subunit of a neuronal α -bungarotoxin-binding protein subtype or a fragment of said subunit, wherein said DNA fragment is sufficiently homologous to the DNA of Figure 2A or Figure 2B to hybridize thereto under conditions of low stringency.

The references relied on by the examiner are:

Suggs et al. (Suggs), Proc. Natl. Acad. Sci., "Use of synthetic oligonucleotides as hybridization probes: Isolation of cloned cDNA sequences for human β_2 -microglobulin", Vol. 78, No. 11, pages 6613-6617 (1981).

Conti-Tronconi et al. (Conti-Tronconi), Proc. Natl. Acad. Sci., "Brain and muscle nicotinic acetylcholine receptors are different but homologous proteins", Vol. 82, pages 5208-5212 (1985).

Claudio, Proc. Natl. Acad. Sci., "Stable expression of transfected *Torpedo* acetylcholine receptor α subunits in mouse fibroblast L cells", Vol. 84, pages 5967-5971 (1987).

Schoepfer et al. (Schoepfer), FEBS LETTER, "The human medulloblastoma cell line TE671 expresses a muscle-like acetylcholine receptor", Vol. 226, No. 2, pages 235-240 (1988).

The issues presented for review are:

- (1) Whether the examiner correctly rejected claims 28-30 under 35 USC 112, second paragraph, as indefinite;
- (2) Whether the examiner correctly rejected claim 28 under 35 USC 112, first paragraph, as based on a non-enabling disclosure;

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(3) Whether the examiner correctly rejected claims 1-8, 27, and 28 under 35 USC 103 as unpatentable over Conti-Tronconi in view of Suggs and Schoepfer; and

(4) Whether the examiner correctly rejected claims 9-18, 29, and 30 under 35 USC 103 as unpatentable over Conti-Tronconi in view of Suggs and Schoepfer, further taken in view of Claudio.

OPINION

Our deliberations in this matter have included evaluation and review of the following materials:

(1) The instant specification, including Figures 1A, 1B, 2A, 2B, 3, and 4, and all of the claims on appeal;

(2) Appellants' main Brief before the Board, including the references attached thereto;

(3) Appellants' Reply Brief before the Board, including the references attached thereto;

(4) The examiner's Answer and the communication mailed by the examiner April 1, 1993; and

(5) The prior art references cited and relied on by the examiner.

Having carefully considered those materials, we agree with the examiner that claims 28-30 are indefinite within the meaning of 35 USC 112, second paragraph. We agree with

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appellants, however, that the examiner has not established a *prima facie* case of non-enablement of claim 28 within the meaning of 35 USC 112, first paragraph. We further agree with appellants that the examiner has not established a *prima facie* case of obviousness within the meaning of 35 USC 103 of claims 1-18 and 27-30, based on teachings found in the above-cited prior art.

Appellants do not controvert the merits of the rejection of claims 28-30 under 35 USC 112, second paragraph. Rather, appellants argue that "[e]ntry of the amendment after final...would have obviated this ground of rejection" [emphasis added]. See the main Brief before the Board, page 8. The amendment, however, was not entered and this Board does not have authority or jurisdiction to review the examiner's refusal to enter an amendment after final rejection. Therefore, we summarily affirm the rejection of claims 28-30 under 35 USC 112, second paragraph.

We shall not sustain the rejection of claim 28 under 35 USC 112, first paragraph, for the reasons well stated by appellants in the main Brief before the Board, pages 4-8. In the Answer, the examiner does not respond to those reasons. For the reasons set forth by appellants, which we adopt as our own, the rejection of claim 28 under 35 USC 112, first paragraph, is reversed.

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With respect to the rejections under 35 USC 103, we find that a person having ordinary skill in the art would not have arrived at the subject matter sought to be patented in claims 1-18 and 27-30 based on teachings found in Conti-Tronconi, Suggs, Schoepfer, and Claudio. In this regard, we agree with the substantive content of appellants' Reply Brief before the Board including the reference to and reliance on Hermans-Borgmeyer et al., Couturier et al., and Schoepfer et al. We shall therefore adopt the position set forth in the Reply Brief as our own. In the communication mailed April 1, 1993, the examiner does not respond to that position. For the reasons set forth by appellants in the Reply Brief, the rejection of claims 1-18 and 27-30 under 35 USC 103 is reversed.

Under the provisions of 37 CFR 1.196(b), we enter the following new ground of rejection.

Claims 1-18 and 27-30 are rejected under 35 USC 101 as drawn to an invention lacking utility and 35 USC 112, first paragraph, as based on a non-enabling disclosure.

An invention must be "useful" to be patentable. 35 USC 101. As stated in Brenner v. Manson, 383 U.S. 519, 534, 535, 148 USPQ 689, 695 (1966), relevant criteria under 35 USC 101 are whether the claimed invention has been "developed and pointed to the degree of specific utility" and whether "specific benefit exists in currently available form". In the language of the court,

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This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something "useful", or that we are blind to the prospect that what now seems without "use" may tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.

Brenner v. Manson, 383 U.S. at 535, 536, 148 USPQ at 696. Further, see Ex parte Aggarwal, 23 USPQ2d 1334, (BPAI 1992).

The specification must enable any person skilled in the art to make and use the claimed invention. 35 USC 112, first paragraph. For a claimed invention to be enabled, the specification must teach any person skilled in the art how to make and use the claimed invention without "undue experimentation". In re Wright, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); In re Wands, 858 F.2d 731, 8 USPQ2d 1400, (Fed. Cir. 1988); In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970).

Applying those principles of law to the facts before us, we find that claims 1-18 and 27-30 are (1) drawn to an invention lacking utility, and (2) based on a non-enabling disclosure. In so finding, we have no doubt that appellants' invention relates to a DNA molecule, plasmid, expression vector, and recombinant host cell which are the subject of serious scientific investigation. We have no doubt that appellants' contribution, if published, would add to the

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fund of scientific information. In our judgment, however, the claimed invention has not been "developed and pointed to the degree of specific utility". Nor can it be said that "specific benefit exists in currently available form". Rather, as stated by appellants in the specification, page 11, lines 33-35,

The present invention provides critical groundwork for practical applications and future studies of neuronal α BgtBPs.

Having carefully reviewed the specification in its entirety, including the above-quoted portion from page 11, we find it clear that "future studies" will be required before appellants' invention is refined and developed to the point where specific benefit exists in currently available form. 35 USC 101. By the same token, the specification does not teach any person skilled in the art how to use the claimed invention without "undue experimentation", i.e., without unspecified future studies which may give rise to an invention which will ultimately prove useful.

In conclusion, we sustain the rejection of claims 28-30 under 35 USC 112, second paragraph, as indefinite. However, we do not sustain the rejection of claim 28 under 35 USC 112, first paragraph, as based on a non-enabling disclosure. Nor do we sustain the §103 rejection of claims 1-8, 27, and 28 over Conti-Tronconi in view of Suggs and Schoepfer or the rejection of claims 9-18, 29, and 30 under 35 USC 103 over Conti-Tronconi in view of Suggs and

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Schoepfer, further taken in view of Claudio. We enter a new ground of rejection of claims 1-18 and 27-30 under 35 USC 101 and 35 USC 112, first paragraph. Accordingly, the examiner's decision refusing to allow claims 1-18 and 27-30 is affirmed-in-part.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within **ONE MONTH** from the date hereof (37 CFR 1.197).

With respect to the new rejection[s] under 37 CFR 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire **TWO MONTHS** from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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

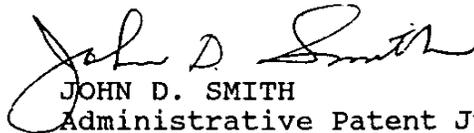
AFFIRMED-IN-PART
37 CFR 1.196(b)



SHERMAN D. WINTERS)
Administrative Patent Judge)



WILLIAM F. SMITH)
Administrative Patent Judge)



JOHN D. SMITH)
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