

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

FEB 22 1996

PATENT OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte PRAMOD AGRAWAL  
and  
ISRAEL RABINOWITZ

Appeal No. 94-1599  
Application 07/634,089<sup>1</sup>

ON BRIEF

Before WILLIAM F. SMITH, GRON and ELLIS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 4 and 7 through 16, all the claims in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

<sup>1</sup> Application for patent filed December 20, 1990.



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neither the underlying Japanese patent document nor a translation thereof can be found in the record. While the undated abstract indicates that the underlying Japanese patent document was published on October 24, 1990, the record does not indicate when the abstract was publicly available. This is important since it is the abstract that is relied upon by the examiner as evidence of obviousness, not the underlying document. Thus, it is unclear whether the undated abstract qualifies as prior art, given appellants' filing date of December 20, 1990. Why the examiner would rely upon such a shaky factual basis for his conclusion of obviousness in view of the relative ease of obtaining the underlying Japanese patent document and having it translated using PTO resources is not apparent.

However, the examiner's error in relying upon the undated abstract is harmless under the circumstances of this appeal since appellants made of record the U.S. patent to Rabinowitz. As noted by appellants:

The Rabinowitz US '762 patent contains significantly more information than the cited abstract of the Japanese '387 application. (Brief page 4, paragraph 1).

It is not apparent why the examiner did not rely upon the U.S. patent when it was first cited in the amendment filed December 24, 1992. Our consideration of the issues raised in this appeal has been based upon the Rabinowitz U.S. patent.

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DECISION

The circumstances of this case provide a vivid example as to why patent examiners should not rely upon an abstract of a document as evidence of obviousness when the full text document which is abstracted can be obtained. One of the issues raised in this appeal is whether the undated Rabinowitz abstract can be properly combined with Greenberg under 35 U.S.C. § 103. This issue becomes a non-issue if the Rabinowitz U.S. patent is considered since this document explicitly states at column 3, lines 26-37, that the yeasts of Greenberg can be used in that method. Clearly, this issue would have been resolved earlier in the prosecution if (1) the underlying Japanese patent document was obtained and (2) it contained the same disclosure.

In any event, this issue should have been resolved upon citation of the Rabinowitz U.S. patent. This would have allowed the focus of this appeal to be on, in our view, the real issue, viz., whether Rabinowitz or Greenberg teach or suggest a micro-organism which consumes an alditol. The examiner has not established as a prima facie matter that either reference does so. Thus, the examiner's rejection is reversed.

The examiner refers to Greenberg as teaching the "claimed yeast." See, e.g., the paragraph bridging pages 5-6 of the Examiner's Answer. However, the most specific fact found by the



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TO SEPARATE, HOLD TOP AND BOTTOM EDGES, SNAP-APART AND DISCARD CARBON

FORM PTO-892 (REV. 3-78)	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	SERIAL NO. <b>07/634,089</b>	GROUPART UNIT 1815	ATTACHMENT TO PAPER NUMBER 21
NOTICE OF REFERENCES CITED		APPLICANT(S)		

U.S. PATENT DOCUMENTS												
*	DOCUMENT NO.						DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE	
A	5	0	6	4	7	6	2	11/12/91	Rabinowitz	435	155	05/07/87
B												
C												
D												
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FOREIGN PATENT DOCUMENTS													
*	DOCUMENT NO.						DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SHTS. DWG.   PP. SPEC.	
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OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)												
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EXAMINER	DATE	
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\* A copy of this reference is not being furnished with this office action.  
(See Manual of Patent Examining Procedure, section 707.05 (a).)