

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH M. CUMMINS

Appeal No. 94-2097
Application 07/875,630¹

ON BRIEF

Before WINTERS, JOHN D. SMITH and GRON, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 28, 1992. According to appellant, this application is a continuation of Application 07/044,317, filed April 30, 1987, now abandoned; which is a continuation of Application 06/688,868, filed January 4, 1985, now U.S. Patent No. 4,820,515, issued April 11, 1989; which is a continuation-in-part of Application 06/448,951, filed December 13, 1982, now U.S. Patent No. 4,497,795, issued February 5, 1985.

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This appeal was taken from the examiner's decision rejecting claims 2, 3, 5, 7, 8, 10, 21 and 22, which are all of the claims remaining in the application.

REPRESENTATIVE CLAIM

Claim 21, which is illustrative of the subject matter on appeal, reads as follows:

21. In a method for treating a warm-blooded vertebrate to stimulate antiviral, antiproliferative and immunomodulatory responses by oral administration of interferon whereby ingested interferon is subjected to the digestive conditions of the digestive tract of the warm-blooded vertebrate, the improvement which comprises administering the interferon orally in solution at about 0.1 to about 1.5 IU/lb of body weight per dose.

THE REFERENCES

The references relied on by the examiner are:

Cummins, Jr. (Cummins)	5,019,382	May 28, 1991
Hasegawa et al. (Hasegawa)	4,675,184	Jun. 23, 1987
		(filed Jan. 4, 1984)

M. B. Tompkins et al. (Tompkins), "Response of Feline Leukemia Virus-induced Nonregenerative Anemia to Oral Administration of an Interferon-containing Preparation," 12 Feline Practice no. 3, 6-15 (May-June 1982).

THE ISSUES

The issues presented for review are: (1) whether the examiner erred in entering a provisional rejection of all the appealed claims under the judicially created doctrine of

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obviousness-type double patenting over the claims in application Serial No. 08/009,353; (2) whether the examiner erred in rejecting all of the appealed claims under the judicially created doctrine of obviousness-type double patenting over the claims in U.S. Patent No. 5,019,382; and (3) whether the examiner erred in rejecting all of the appealed claims under 35 U.S.C. § 103 as unpatentable over Hasegawa or Tompkins.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) appellant's Brief before the Board; (3) the Examiner's Answer; (4) the prior art references cited and relied on by the examiner; (5) the Stewart Declaration, filed under the provisions of 37 CFR § 1.132, executed March 20, 1993; (6) the Cummins Declaration, filed under the provisions of 37 CFR § 1.132, executed March 19, 1993; and (7) the decision, adhered to on reconsideration, by another merits panel of this Board in parent application Serial No. 07/044,317 (Appeal No. 90-3336).

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The obviousness-type double patenting rejection over application Serial No. 08/009,353 is moot. We affirm the obviousness-type double patenting rejection over the claims of U.S. Patent No. 5,019,382, and we reverse the rejections under 35 U.S.C. § 103.

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OBVIOUSNESS-TYPE DOUBLE PATENTING

All of the appealed claims stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of application Serial No. 08/009,353. The Patent and Trademark Office records indicate that application Serial No. 08/009,353 is abandoned. Accordingly, this rejection is moot.

All of the appealed claims further stand rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 5,019,382. Appellant does not argue the merits of this rejection, i.e., appellant does not controvert the examiner's position that the appealed claims define merely an obvious variation of an invention claimed in U.S. Patent No. 5,019,382. See In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). Nor has appellant favored the record with a proper, timely filed terminal disclaimer which would overcome the rejection. See appellant's Brief before the Board, section V, pages 19 and 20. Accordingly, we affirm the double patenting rejection in

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view of the subject matter claimed in U.S. Patent No.
5,019,382.

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THE PRIOR ART REJECTIONS

In considering the rejections under 35 U.S.C. § 103, we first invite attention to the previous Board decision, adhered to on reconsideration, in parent application Serial No. 07/044,317 (Appeal No. 90-3336). See the parent file, Paper Nos. 24 and 26. The claims previously presented were broader than those now at issue. Compare illustrative claim 1 in Appeal No. 90-3336 (administering interferon orally at a dosage of about 0.1 to about 5 IU/lb of body weight) with claim 21 before us (administering interferon orally in solution at about 0.1 to about 1.5 IU/lb of body weight per dose). Furthermore, the Stewart and Cummins Declarations, filed under the provisions of 37 CFR § 1.132, are new to this application.

We are therefore presented with a different administrative record. We have taken a step back and re-evaluated the patentability of appellant's claims based on this different record. Cf. In re Willis, 455 F.2d 1060, 1062-63, 172 USPQ 667, 669 (CCPA 1972) (what the Patent Office concluded in previous cases not binding in subsequent cases, especially when different factual situations are involved).

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All of the appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Hasegawa or Tompkins. Having reviewed these references in their entireties, we find that Hasegawa constitutes the closest prior art relied on by the examiner. See particularly Hasegawa, column 2, lines 1 through 10. The Tompkins reference is, at best, cumulative.

Respecting the proper interpretation of appellant's claims, we observe the following passage in In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983):

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. . . . [A]nd that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. [Citations omitted.]

With that principle in mind, we conclude that appellant's claims are limited to administering interferon orally in solution at about 0.1 to about 1.5 IU/lb of body weight per dose per day. See the instant specification, page 11, lines 5 through 10; page 28, lines 4 through 7; page 32, lines 17 through 24; page 33, TABLE 12; and page 34, lines 3 through 9. In our judgment, any other interpretation would be inconsistent with the plain import of the specification.

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We shall not pass on the merits of the examiner's prima facie case of obviousness. We shall assume arguendo, without deciding, that the claimed method would have been prima facie obvious over Hasegawa or Tompkins. Nevertheless, in our judgment, comparative data in appellant's specification serves to rebut any such prima facie case. See particularly EXAMPLES 3, 4, and 5 in the specification, showing that low oral doses of human alpha interferon provide unexpectedly superior antiviral properties on treating cattle. EXAMPLES 3, 4, and 5 adequately represent the narrow low dose range set forth in the claims (about 0.1 to about 1.5 IU/lb of body weight per dose per day), and show that low doses of interferon provide unexpectedly superior antiviral properties compared with higher doses outside the claimed range. On the strength of this specification evidence, we reverse the § 103 rejections based on Hasegawa or Tompkins.

OTHER ISSUE

One further point warrants attention. In the Examiner's Answer, paragraph bridging pages 2 and 3, the examiner states as follows:

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It has been determined . . . that the present application has an effective filing date of December 13, 1982.

We disagree.

Having carefully reviewed the contents of parent application Serial No. 06/448,951, filed December 13, 1982, we find that this application does not provide adequate written descriptive support for the claims before us. The '951 application does not provide adequate written descriptive support for the step of administering interferon orally in solution at about 0.1 to about 1.5 IU/lb of body weight per dose per day. Accordingly, the appealed claims are not entitled to benefit of the filing date of this parent application. See In re van Langenhoven, 458 F.2d 132, 136-37, 173 USPQ 426, 429 (CCPA 1972).

We hold that the examiner's finding in the Answer, sentence bridging pages 2 and 3, is clearly erroneous. Therefore, the earliest possible date which the appealed claims can benefit from is January 4, 1985, the filing date of parent application Serial No. 06/688,868. Therefore, PCT publication WO 82/00588, published March 4, 1982, here constitutes legally available prior art under 35 U.S.C.

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§ 102(b).² Furthermore, see appellant's acknowledgment in the Appeal Brief, page 9, lines 1 and 2, that "[d]ocument WO 82/00588 . . . qualifies as prior art against the present application."

On return of this application to the Examining Corps, we recommend that the examiner evaluate the patentability of claims 2, 3, 5, 7, 8, 10, 21 and 22 in light of PCT publication WO 82/00588 as prior art.

² Appellant has attached a copy of the PCT publication as exhibit 1 to the Appeal Brief.

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