

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOMINIQUE PARIS, JEAN-MAXIME NIGRETTO,
BRUNO BONNEMAIN, DOMINIQUE MEYER and DIDIER DOUCET

Appeal No. 95-1798
Application 07/397,415¹

ON BRIEF

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

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 2 through 7, 10 through 12 and 14 through 18. Claim 9, which is the only other claim remaining in the application, stands objected to as depending from a rejected base claim. As stated in the Final Rejection mailed March 29, 1993 (Paper No.

¹ Application for patent filed September 21, 1989.

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17), page 6, claim 9 would be allowed if rewritten in independent form.

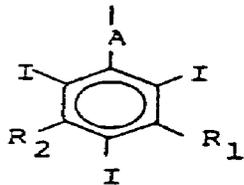
REPRESENTATIVE CLAIM

Claim 14, which is illustrative of the subject matter on appeal, reads as follows:

14. A water-soluble iodinated polymer comprising a dextran backbone having grafted thereon groups of the formula

wherein

A
group
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an
one and
benzene

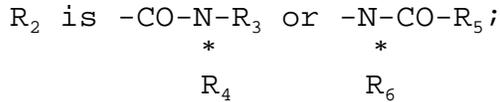


is a
formi
bridg
betwe
dextr
backb
the
ring;

R₁ is -COOH, -COOH salified with a pharmaceutically acceptable base, -CO-N-R₃, or -N-CO-R₅; and

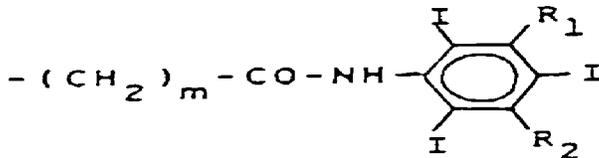
* *
R₄ R₆

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in which

R_3 is C_{1-6} alkyl, C_{1-6} hydroxyalkyl, C_{1-6} polyhydroxyalkyl, C_{1-6} alkoxy C_{1-6} alkyl, C_{1-6} alkoxy C_{1-6} hydroxyalkyl or



m being an integer from 1 to 6 and R_1 and R_2 having the same meanings as above;

R_4 and R_6 are independently hydrogen, C_{1-6} alkyl, C_{1-6} hydroxyalkyl, C_{1-6} polyhydroxyalkyl, C_{1-6} alkoxy C_{1-6} alkyl, or C_{1-6} alkoxy C_{1-6} hydroxyalkyl; and

R_5 is C_{1-6} alkyl, C_{1-6} hydroxyalkyl, C_{1-6} polyhydroxyalkyl, C_{1-6} alkoxy C_{1-6} alkyl, or C_{1-6} alkoxy C_{1-6} hydroxyalkyl. [Emphasis added.]

THE REFERENCES

The prior art references relied on by the examiner are:

DeBoer	4,406,878	Sept. 27, 1983
Bertoni	4,455,292	June 19, 1984

THE ISSUES

The issues presented for review are: (1) whether the examiner erred in rejecting claims 5 through 7, 10 and 11 under 35 U.S.C. § 112, second paragraph, as indefinite; and (2) whether the examiner erred in rejecting claims 2 through 4, 12 and 14

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through 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of DeBoer and Bertoni.

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) appellants' main Brief and Reply Brief before the Board; (3) the Examiner's Answer and Supplemental Answer; and (4) the DeBoer and Bertoni references relied on by the examiner.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103.

SECTION 112

Claims 5 through 7, 10 and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. According to the examiner, the processes recited in these claims "are incomplete in that no reaction conditions (such as solvent, heat or catalyst) has [sic] been set forth." See the Examiner's Answer, page 4. We disagree.

As stated in Ex parte Jackson, 217 USPQ 804, 806 (Bd. App. 1982),

[c]laims 2 to 6 have been finally rejected under the second paragraph of 35 U.S.C. § 112 as being

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"incomplete" for failing to recite various process parameters. We shall not affirm this rejection.

It is by now well established that it is the function of the descriptive portion of the specification and not that of the claims to set forth operable proportions and similar process parameters and that claims are not rendered indefinite by the absence of the recitation of such limitations. [Citations omitted.]

With respect to the non-prior art rejection in this appeal, Jackson is dispositive. We therefore reverse the rejection of claims 5 through 7, 10 and 11 under 35 U.S.C. § 112, second paragraph.

SECTION 103

Claims 2 through 4, 12 and 14 through 18 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of DeBoer and Bertoni. According to the examiner, it would have been obvious to modify DeBoer's iodinated contrast agent for radiography, per the teachings of Bertoni, to arrive at the claimed subject matter. We disagree.

Independent claim 14 defines a water-soluble iodinated polymer comprising a dextran backbone having grafted thereon groups of the formula

where A, R₁ and R₂ are spelled out in the claim. On the
contrary, DeBoer discloses a water-insoluble, substantially non-
wat e



inated polymer, useful as a contrast agent for radiography. We
see no cogent reason stemming from the prior art which would have
led a person having ordinary skill to modify DeBoer's iodinated
polymer, per the teachings of Bertoni, to arrive at the water-
soluble product of claim 14. In fact, such modification would
have destroyed the very essence of the teachings in DeBoer.

In presenting their case before the Board, appellants
emphasize the different solubility characteristics between the
claimed polymers (water-soluble) and the polymers disclosed by
DeBoer (water-insoluble and non-water-swellable). Appellants
further emphasize the difference between the polymers of DeBoer
(water-insoluble and non-water-swellable) and the products of
Bertoni (water-soluble). See the main Brief before the Board,

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pages 7 through 9. In response, the examiner states the following:

Appellants argue that one skilled in the art would have no motivation to combine the water-insoluble polymers of DeBoer with the iodobenzamido-glucopyranose of Bertoni, in order to obtain water-soluble iodinated polymers. However, this argument is not persuasive since both of the references of DeBoer and Bertoni set forth saccharide units comprising a closely analogous iodinated aromatic group attached to a glucose monomer unit. Also, both of the DeBoer and Bertoni References disclose using these compounds as agents for contrast media. It appears that a person having skill in the art would be motivated to combine the DeBoer and Bertoni References having these facts at hand.

See the Examiner's Answer, page 9, last paragraph. Manifestly, that response does not come to grips with the argument set forth in appellants' main Brief.

In column 3, lines 42 through 46, DeBoer discloses that the backbone chain of the disclosed iodinated polymers can represent a naturally occurring polymer, for example, a polysaccharide containing repeating glucose units such as starch, glycogen, cellulose, cellulosic derivatives, and equivalent naturally occurring polymers.

The examiner has determined that the above-quoted description in DeBoer encompasses dextran. However, to the extent that a person having ordinary skill would have envisioned dextran as the backbone chain in DeBoer's polymers, such hypothetical person would have understood that the polymers must be water-insoluble and substantially non-water-swellable. This is the sine qua non

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of DeBoer, and follows from a review of the DeBoer patent in its entirety. The examiner is not at liberty to pick and choose selective portions of the reference which lead toward the claimed invention (dextran), but ignore or discard portions which lead away from the claimed invention (water-insoluble and substantially non-water-swellable). In our judgment, the combined disclosures of DeBoer and Bertoni would not have led toward the claimed water-soluble product. Accordingly, the examiner's decision rejecting claims 2 through 4, 12 and 14 through 18 under 35 U.S.C. § 103 is reversed.

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CONCLUSION

In conclusion, we do not sustain the examiner's non-prior art or prior art rejections. Accordingly, the examiner's decision rejecting claims 2 through 7, 10 through 12 and 14 through 18 is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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MARC L. CAROFF)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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WILLIAM F. SMITH)	
Administrative Patent Judge)	

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