Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte RANULPH M. ALSOP,
RAYMOND B. FORRESTER and
DAVID J. MANNING

_____

Appeal No. 1995-3232
Application 07/954,686

_____

ON BRIEF

_____

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

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 41, 42 and 44, all of the claims remaining in the application.

REPRESENTATIVE CLAIM

Claim 41, which is illustrative of the subject matter on appeal, reads as follows:

41. A method of treatment of a human requiring dialysis of the serum by use of an aqueous solution of a physiologically acceptable mixture of glucose polymers derived from the hydrolysis of starch, wherein at least 50% by weight of said mixture comprises polymers having molecular weights in the range of from 5,000 to 30,000, and wherein said mixture has a weight average molecular weight of from 5,000 to 50,000, and a number average molecular weight of from 2,890 to 8,000 [emphasis added].

THE PRIOR ART REFERENCE

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner relies on the following reference:

Milner	4,886,789	Dec. 12, 1989

THE ISSUES

The previously entered rejection of claims 41, 42 and 44 under 35 U.S.C. § 102 as described by Milner has been withdrawn. See the Examiner's Answer, page 2, section (4). The issues remaining for review are:

(1) whether the examiner erred in rejecting claim 41 under 35 U.S.C. § 112, first paragraph, as based on a specification which does not provide adequate, written descriptive support for the invention now claimed; and

(2) whether the examiner erred in rejecting claims 41, 42 and 44 under 35 U.S.C. § 103 as unpatentable over Milner.

DELIBERATIONS

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

(1) the instant specification, including Figures 1 through 5 and all of the claims on appeal;

(2) applicants' main Brief (Paper No. 44), Reply Brief (Paper No. 46), and Supplemental Reply Brief (Paper No. 50);

(3) the Examiner's Answer (Paper No. 45), the communication mailed by the examiner August 30, 1994 (Paper No. 47), the Supplemental Examiner's Answer (Paper No. 49), and the communication mailed May 12, 1999 (Paper No. 52); and

(4) the above-cited Milner reference.

On consideration of the record, including the above-listed materials, we reverse both of the examiner's rejections.

35 U.S.C. § 112, FIRST PARAGRAPH

According to the examiner, applicants' specification does not provide adequate, written descriptive support for the recitation in claim 41 of a physiologically acceptable mixture of glucose polymers having “a number average molecular weight of from 2,890 to 8,000.” The examiner acknowledges that the lower limit of the range for number average molecular weight, i.e., 2,890, is supported in the specification (Example 7, page 18, line 20.) See the Supplemental Answer, Paper No. 49, page 1. The examiner argues, however, that the upper limit of the range, 8,000, is not adequately supported. We disagree.

The claim recitation “a number average molecular weight of from 2,890 to 8,000" is subject to these interpretations:

(a) applicants' physiologically acceptable mixture of glucose polymers has a number average molecular weight from 2,890 up to, but not including 8,000; or

(b) applicants' physiologically acceptable mixture of glucose polymers has a number average molecular weight from 2,890 up to, and including 8,000.

Viewing claim 41 either way, we find that the instant specification provides adequate, written descriptive support for the invention now claimed. Note particularly the following description in the specification, page 3, lines 21 and 22: “We prefer the glucose polymer (I) [applicants' physiologically acceptable mixture of glucose polymers] to have a number average molecular weight of less than 8,000.” In our judgment, “less than 8,000"

reasonably conveys to any person skilled in the art that the upper limit of the range of number average molecular weight is up to, but not including 8,000. Furthermore, it is apparent that applicants prefer a number average molecular weight of less than 8,000. Again, see the specification, page 3, lines 21 and 22. In our judgment, that stated preference is reasonably suggestive of a broader range which would include an upper limit of 8,000.

On these facts, we find that applicants conveyed with reasonable clarity to persons skilled in the art that, as of the specification filing date, they were in possession of the invention now claimed. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The rejection of claim 41 under 35 U.S.C. § 112, first paragraph, is reversed.

35 U.S.C. § 103

As can be seen from a review of independent claim 41, and as emphasized in the preceding discussion, applicant's method requires the use of a physiologically acceptable mixture of glucose polymers with “a number average molecular weight of from 2,890 to 8,000.” Having reviewed the Milner patent in its entirety, we find that Milner constituents insufficient evidence to support a conclusion of obviousness of claims containing that limitation.

The examiner acknowledges that Milner does not disclose a number average molecular weight from 2,890 to 8,000 (Examiner's Answer, Paper No. 45, page 3, lines 11 and 12.) According to the examiner, the parameter of number average molecular weight, for Milner, is not significant (Examiner's Answer, Paper No. 45, page 3, lines 15 and 16; page 5, lines 19 and 20.) In fact, based on our review of the reference, we find that Milner does not mention number average molecular weight. Milner does not disclose or suggest that number average molecular weight is a result-effective variable or in any way relevant for achieving effective peritoneal dialysis.

Generally speaking, the discovery of an optimum value of a variable in a known process is obvious within the meaning of 35 U.S.C. § 103. Our reviewing court has found exceptions to this rule in cases where the results of optimizing a variable, known to be result-effective, were unexpectedly good. This case, where the parameter optimized was not recognized by Milner to be a result-effective variable, is another exception. See In re Antonie, 559 F.2d 618, 621, 195 USPQ 6, 9 (CCPA 1977).

The rejection of claims 41, 42 and 44 under 35 U.S.C. § 103 as unpatentable over Milner is reversed.

CONCLUSION

In conclusion, for the reasons set forth in the body of this opinion, we do not sustain the examiner's rejections under 35 U.S.C. § 112, first paragraph, or 35 U.S.C. § 103. The examiner's decision rejecting claims 41, 42 and 44 is reversed.

REVERSED

	)
Sherman D. Winters	)
Administrative Patent Judge	)
	)
	)
	) BOARD OF PATENT
William F. Smith	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
Toni R. Scheiner	)
Administrative Patent Judge	)

SDW/cam

Basil P. Mann
Marshall, O'Toole, Gerstein, Murray & Borin
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402