

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MEL W. EKLUND, FRANK T. POYSKY,
ROHINEE N. PARANJPYE, LAURA C. LASHBROOK,
MARK E. PETERSON and GRETCHEN A. PELROY

Appeal No. 1996-2598
Application No. 08/220,212

HEARD: April 6, 2000

Before WILLIAM F. SMITH, HANLON, and SPIEGEL, *Administrative Patent Judges*.
SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5 through 10 and 22. Claims 13-21 have been withdrawn from further consideration under 37 CFR § 1.142(b) as not readable on the elected invention. Claims 1-4 and 11-12, the only other claims

pending in this application, are not on appeal (brief, page 1). Claims 5 and 22 are representative of the subject matter on appeal and read as follows:

5. A selective and differential medium for *Listeria monocytogenes*, devoid of esculin, [sic] and phenylethanol comprising:
- i) an agar base layer comprising lithium chloride, antibiotics and/or acceptable salts thereof in amounts effective to selectively inhibit microbes other than *Listeria*, and
 - ii) an agar overlay comprising blood in amounts effective to produce β -hemolytic zones characteristic of *L. monocytogenes* colonies.¹
22. A selective and differential medium for *Listeria monocytogenes*, consisting essentially of
- i) an agar layer comprising lithium chloride, antibiotics and/or acceptable salts thereof in amounts effective to selectively inhibit microbes other than *Listeria*, and
 - ii) an agar overlay comprising blood in amounts effective to produce β -hemolytic zones characteristic of *L. monocytogenes* colonies.

The references relied on by the examiner are:

Blanco et al. (Blanco), "A technique for the direct identification of haemolytic-pathogenic listeria on selective plating media," 9 *Letters in Applied Microbiology* 125-128 (1989).

Cassiday et al. (Cassiday), "Evaluation of ten selective direct plating media for enumeration of *Listeria monocytogenes* in hams and oysters," 6 *Food Microbiology* 113-125 (1989).

Cox et al. (Cox), "Enhanced haemolysis agar (EHA) - an improved selective and differential medium for isolation of *Listeria monocytogenes*," 8 *Food Microbiology* 37-49 (1991).

Lee et al. (Lee), "Improved *Listeria monocytogenes* Selective Agar," 52 *Applied and Environmental Microbiology* 5, 1215-1217 (November 1986).

¹It is our understanding that appellants intend to remove the comma between the words "esculin" and "and" as unnecessary and editorially incorrect (reply brief, page 4, last para.).

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Appellants rely on the following reference supplied with their reply brief:

H. Ramsey Fowler et al. (Fowler), *THE LITTLE, BROWN HANDBOOK* 202-203 (5th ed., 1992).

ISSUES²

Claims 5 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blanco.

Claims 5-10 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cox taken with Blanco, Lee and Cassidy. Claims 5-10 are newly rejected under 35 U.S.C. § 112, first paragraph, as based on new matter and because the specification fails to provide an adequate written description of the claimed invention.³ We reverse all three rejections.

In reaching our decision in this appeal we have given careful consideration to the appellants' specification and claims and to the respective positions articulated by the appellants and the examiner.

We make reference to the examiner's answer (Paper No. 9, mailed

June 1, 1995) and to the examiner's supplemental answer (Paper No. 13, mailed

² According to the examiner, upon reconsideration the final rejection of claim 22 under 35 U.S.C. § 112, second paragraph, as indefinite is withdrawn (answer, page 2). Moreover, in that the final rejection of claims 5-10 under 35 U.S.C. § 112, second paragraph, is not repeated in the answer, it is presumed to have been withdrawn. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

³ This is a new ground of rejection entered by the examiner in her answer (page 6).

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October 18, 1995) for the examiner's reasoning in support of the rejections and to the appellants' brief (Paper No. 8, filed March 30, 1995), to the appellants' reply brief (Paper No. 12, filed

August 1, 1995) and to the appellants' supplemental reply brief (Paper No. 15, filed

November 17, 1995) for the appellants' arguments thereagainst.

Appellants' claimed invention is directed to a selective and differential medium for the isolation of *Listeria monocytogenes* (brief, page 2).

OPINION

I. Rejection of claims 5-10 under 35 U.S.C. § 112, first paragraph, based on new matter because of a lack of adequate written description of the claimed invention in the specification as originally filed.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

According to the examiner there is no basis or support in the specification for the exclusion of phenylethanol from the claimed composition (answer, page 6). Appellants argue that page 15 of the

specification states “only chemical agents that do not negatively impact the viability of *L. monocytogenes* should be used in the medium of the invention and agents such as acriflavine are to be avoided” and page 4 of the specification clearly discloses that phenylethanol inhibits repair of heat-injured cells of *Listeria* (reply brief, page 2). We agree with appellants that the originally filed disclosure supports excluding phenylethanol from the later claimed composition. Literal support of the later claimed subject matter is not required. *Id.* The examiner has the initial burden of establishing a *prima facie* case of lack of an adequate written description. *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). The examiner erred in not addressing appellants’ explicit arguments based on pages 4 and 15. Thus, we will not sustain the rejection of claims 5-10 on the basis of an inadequate written description and new matter. Having concluded that the examiner has failed to establish a *prima facie* case of lack of an adequate written description, we do not reach the rebuttal evidence discussed at pages 2-3 of appellants’ reply brief.

II. Rejection of claims 5 and 22 under 35 U.S.C. § 102 as anticipated by Blanco.

Blanco describes adding an agar overlay comprising red blood cells to a selective plating medium after listeria growth in order to detect directly the hemolytic activity of pathogenic listeria (abstract; page 126, col. 1, first full para.). Five selective media are disclosed, including (1) modified McBride agar (MMA) (Lovett 1988), (2) lithium chloride-phenylethanol-moxalactam (LPM), (3) polymyxin-acriflavine-lithium chloride-ceftazidime-aesculin-mannitol (PALCAM), (4)

listeria selective medium (LSM) (Oxford formulation), and (5) LSAMM composed of agar, lithium chloride, aesculin, ammonium ferric citrate, potassium tellurite, acriflavine HCl, polymixin B sulphate and sodium ceftazidime sulphate (page 126, "MEDIA").

According to the examiner, "[t]he McBride agar (MMA) comprises lithium chloride and antibiotics in amounts effective to selectively inhibit microbes other than Listeria, while the agar overlay comprises blood in amounts effective to produce β -hemolytic zones" and, thus, claims 5 and 22 are anticipated by Blanco (answer, pages 3 and 4). However, MMA comprises phenyl ethanol agar, glycine anhydride, lithium chloride and cycloheximide.⁴ Therefore, since the claim 5 preamble language "devoid of ... phenylethanol" and the claim 22 language "consisting essentially of" both preclude the presence of phenylethanol, we will not sustain the examiner's rejection of claims 5 and 22 based on Blanco.

III. Rejection of claims 5-10 and 22 under 35 U.S.C. § 103 as unpatentable over Cox taken with Blanco, Lee and Cassidy.

Cox describes a selective and differential medium for *L. monocytogenes* comprising an agar base, lithium chloride, 4-methylumbelliferyl- β -D-glucoside, antibiotic supplement (i.e., cycloheximide, colistin sulphate, acriflavine, cefotetan, fosfomycin), whole sheep blood and sphingomyelinase (Table 2,

⁴ See J. Lovett, "Isolation and Enumeration of *Listeria monocytogenes*," 42 *Food Technology* 172-175, Table 4, page 174 (copy attached) as referenced by Blanco.

page 40). As discussed above, Blanco describes a blood agar overlay technique to determine the hemolytic activity of plated selective media. Lee also describes using a blood agar overlay on a streaked LPM agar to screen for hemolytic activity of *L. monocytogenes* (page 1215). Cassiday describes ten direct plating media for isolating and enumerating four strains of noninjured and injured *L. monocytogenes*, wherein the media used a variety of antibiotics and chemicals (para. bridging pages 113-114; para. bridging pages 114-115).

According to the examiner, “[t]he sole difference between the claimed invention and the teachings of Cox et al. is the application of the blood component as part of the mixture rather than as an agar overlay” and Blanco especially suggests the benefits from use of the overlay method, e.g., clearer visualization (answer, page 9). However, as noted above, the claim 5 preamble language “devoid of esculin, [sic] and phenylethanol” and the claim 22 language “consisting essentially of” both preclude the presence of ingredients, e.g., acriflavine (disclosed by Cox), phenylethanol (disclosed by Blanco and Lee) and esculin (disclosed by Blanco), which negatively impact the viability of *L. monocytogenes* (see specification, page 15, lines 1-3; page 4, lines 11-12 and 15-16; page 13, lines 10-12; page 14, line 21; original claims 1, 5, 13, 14 and 21). Rather than specifically addressing the exclusion of these ingredients, the examiner argues that excluding phenylethanol would be expected to result in a medium which was less selective for *L. monocytogenes* because the absence of phenylethanol, an antimicrobial, would allow other contaminating bacteria to survive (answer, pages 10-11). However, the claimed

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invention does not exclude the presence of antimicrobials *per se*, only those which negatively impact the viability of *L. monocytogenes*. Therefore, the examiner's position is not well taken.

The examiner relies on Cassiday for its disclosure regarding optimization of antibiotics concentration and addition of iron to solid media (answer, pages 4-5). The examiner does not point out, and we do not find, where Cassiday addresses the ingredients excluded from claims 5 and 22. Indeed, none of the references positively exclude ingredients excluded by the language of the claimed invention. Thus, we will not sustain the examiner's rejection of claims 5-10 and 22 over Cox taken with Blanco, Lee and Cassiday. Having concluded that the examiner has failed to establish a *prima facie* case of obviousness over Cox, Blanco, Lee and Cassiday, we do not reach the rebuttal evidence discussed at page 6 of appellants' reply brief.

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ADRIENE LEPIANE HANLON
Administrative Patent Judge

CAROL A. SPIEGEL
Administrative Patent Judge

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CAS/kis

THOMAS P. PAVELKO, ESQ.
STEVENS, DAVIS, MILLER &
MOSHER, L.L.P.
1615 L STREET, N.W., SUITE 850
P.O. BOX 34387
WASHINGTON, DC 20043-4387

