

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUN HAGINAKA, HIROO WADA,
HIROYA FUJIMA and TOSHINOBU MIWA

Appeal No. 96-4150
Application 08/201,740¹

ON BRIEF

Before JOHN D. SMITH, WEIFFENBACH and OWENS, *Administrative Patent Judges*.

WEIFFENBACH, *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 6-9, 11 and 12. Claim 10, the only other claim remaining in the application, has been objected to and is not before us for consideration. We reverse.

¹ Application for patent filed February 25, 1994. According to appellants, the application is a division of Application 07/795,862 filed November 18, 1991, now abandoned.

The claims on appeal are directed to a method of resolving a mixture of optical isomers comprising the step of contacting the mixture with a separating agent comprising an ovomucoid bonded to a carrier wherein the molecular structure of the ovomucoid has been partially modified by glutarization, diolation or acylation. The examiner rejected the appealed claims under 35 U.S.C. § 103 over the combined teachings of Miwa (U.S. Patent No. 5,030,354), Kitayma (U.S. Patent No. 4,830,921) and Cozzette (U.S. Patent No. 5,063,081).

We have carefully considered the respective positions advanced by appellants and the examiner. We find ourselves in agreement with appellants that the applied prior art fails to establish a *prima facie* obviousness of the claimed subject matter. While Miwa discloses a method of separating optical mixtures with a separating agent comprising ovomucoid bonded to a carrier, neither Miwa nor Kitayma or Cozzette teach or suggest modifying the molecular structure of the ovomucoid to be used for separating optical isomers by glutarization, diolation or acylation. In his answer, the examiner finds that it would have been obvious to use a cross-linking agent such as glutaraldehyde to solve a stability problem referred to at col.1, line 64 to col. 2, line 3 of Miwa. We do not agree. Miwa refers to the deteriorative effect of solvent on separating agents such as albumin and orosomucoid. We find no suggestion or teaching that solvents have a deteriorating effect on ovomucoid, let alone a suggestion of using a glutaraldehyde as a cross-linking agent to modify ovomucoid.

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Accordingly, for the reason given above, the decision of the examiner is reversed

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CAMERON WEIFFENBACH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

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