

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN S. O'BRIEN and  
YASUO KISHIMOTO

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Appeal No. 1999-1260  
Application No. 08/756,031<sup>1</sup>

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HEARD: May 24, 2001

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

SCHEINER, 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 claim 31, the only claim remaining in the application. Claim 31 reads as follows:

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Appeal No. 1999-1260  
Application No. 08/756,031

31. A neural prosaposin receptor protein in isolated or purified form, wherein said receptor is obtainable from a neural tissue P-100 plasma membrane fraction and binds to the peptide shown in SEQ ID NO: 1.<sup>2</sup>

The claim stands rejected under the first paragraph of 35 U.S.C. § 112, “as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art . . . to make and/or use the invention.” Examiner’s Answer, page 4.

We reverse the examiner’s rejection of the claim.

#### DISCUSSION

“The name of the game is the claim,” In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). As always, “[a]nalysis begins with a key legal question -- what is the invention claimed?” since “[c]laim interpretation . . . will normally control the remainder of the decisional process,” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In determining “the invention claimed,” we begin with the proposition that “the language employed [in a claim] must be analyzed - - not in a vacuum, but always in light of the of the teachings of the prior art and of the particular application disclosure as it would be interpreted by

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Appeal No. 1999-1260  
Application No. 08/756,031

one possessing the ordinary level of skill in the pertinent art.” In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971)(footnote omitted).

In its original form, independent claim 31 was directed to “[a] neural prosaposin receptor protein in isolated or purified form,” while dependent claim 33 (canceled by preliminary amendment, paper no. 3, filed November 26, 1996) was directed to a “receptor protein of claim 31” of narrower scope, i.e., one with “a molecular weight of approximately 20 kDa.” Claim 31, in its present form (as amended by another preliminary amendment, paper no. 4, also filed November 26, 1996) is directed to an isolated or purified “neural prosaposin receptor protein,” obtainable from a neural tissue P-100 plasma membrane fraction, which binds a 22 amino acid peptide derived from saposin C. There is no recitation of a molecular weight in claim 31.

The specification as filed also allows for the possibility that there may be more than one “neural prosaposin receptor protein.” For example, according to the specification, “a neural prosaposin receptor protein” is “[p]referably . . . the same protein that can be isolated from a p100 plasma membrane fraction by affinity purification using a neurite growth-inducing peptide contained within the saposin C sequence linked to a solid support, and has a molecular weight of approximately 20 kDa.” Page 8 (emphasis added). Additionally, the specification, at the time of filing, identified “[a] 20 kDa protein

Appeal No. 1999-1260  
Application No. 08/756,031

derived from saposin C. See Example 6, pages 20 and 21. Thus, the specification describes a genus of neural prosaposin receptors, rather than a single protein.

During prosecution, the instant specification was amended to reflect appellants' "determin[ation] that the prosaposin receptor has a molecular weight of about 54 kDa" (Response to Office Action, paper no. 11, filed August 18, 1997). In addition, evidence was introduced to establish that the process described in Example 6, which yielded a neural prosaposin receptor protein of 20 kDa when performed on stored brain tissue, consistently yields a receptor protein of 54 kDa when performed on fresh tissue (Second Declaration of John S. O'Brien, paper no. 12, also filed August 18, 1997).

As a consequence of this, in the final rejection (paper no. 13), the examiner (1) entered an objection to the amendment under 35 U.S.C. § 132 as "introduc[ing] new matter into the disclosure of the invention," as "[n]o 54 kDa protein was contemplated, nor present anywhere within the specification at the time of filing the instant application;"<sup>3</sup> and (2) rejected claim 31 under the first paragraph of 35 U.S.C. § 112 as unenabled by the specification. It is the rejection of claim 31 under section § 112 which is at issue here.

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Appeal No. 1999-1260  
Application No. 08/756,031

[T]he claim encompasses any biologically functional equivalent of a saposin C-binding molecule (i.e., that binds the 22-mer peptide shown in SEQ ID NO: 1), which includes the structurally uncharacterized 20 kDa protein disclosed.

Nevertheless,

[T]he instant specification provides no description or conception of a prosaposin receptor protein of 54 kDa, nor describes a single workable example of a prosaposin receptor protein; thereby, not enabling one skilled in the art on how to make and use any prosaposin receptor protein without undue experimentation to discover what structurally constitutes Applicants' invention that distinguishes this protein from any other different membrane protein (i.e., from a P-100 plasma membrane fraction, as claimed). Applicants' admissions that the 20 kDa protein disclosed in the specification was an "error" indicate that they were not in possession of the claimed invention at the time the instant application was filed, and that the corresponding isolation method did not work; thereby, not fulfilling the requirements of 35 U.S.C. 112, first paragraph, for establishing an enabling disclosure on how to make and use the instant invention.

Appellants, for their part, argue that "[k]nowledge of the correct molecular weight is not required to practice Example 6," that they "have claimed the receptor in functional and process terms," and that "[t]he molecular weight is not recited in the claims" (Brief, page 9). Moreover, appellants argue that (Id., pages 9 and 10)

The skilled artisan would know whether any particular protein fell within the claims by comparing it to the unique prosaposin receptor obtained by eluting neural P-100 plasma membrane protein bound to a saposin C 22-mer affinity column as disclosed in Example 6 of the specification. With regard to how to structurally distinguish the instant invention from any different molecule that may bind to a 22-mer saposin C fragment and yet

Appeal No. 1999-1260  
Application No. 08/756,031

On consideration of the instant disclosure as whole, appellants' arguments notwithstanding, we agree with the examiner that claim 31, as currently written (and as originally filed) encompasses (i.e., describes) a genus of neural prosaposin receptor proteins (which includes the 20 kDa receptor protein identified in Example 6, as well as the 54 kDa receptor protein described in the declaration), rather than a single protein. Nevertheless, given this construction of the claim, the basis of the examiner's rejection evaporates.

Example 6 of the specification describes a process for isolation of a neural prosaposin receptor protein from the plasma membrane fraction of various neural tissues, wherein the "P-100 fraction is applied to an affinity column containing the bound, active 22-mer fragment of saposin C." According to appellants, and as explained in the Declaration of John S. O'Brien, submitted November 26, 1996, the use of stored tissue in the method described in Example 6 yields a neural prosaposin receptor protein of 20 kDa (which binds the 22-mer saposin C fragment), while the use of fresh tissue in the same method yields a neural prosaposin receptor protein of 54 kDa. In our view, the specification enables one skilled in the art to make and use the various members of the claimed genus, including the 20 and 54 kDa proteins discussed on this record.

Appeal No. 1999-1260  
Application No. 08/756,031

that the corresponding isolation method did not work.” Be that as it may, appellants’ “error” in believing that the 20 kDa protein isolated in Example 6 was the “putative” prosaposin receptor (now believed to be the 54 kDa protein isolated from fresh tissue), is not detrimental to the patentability of claim 31, inasmuch as the claim is generic in nature, and not limited to a single neural prosaposin receptor protein. Moreover, as explained in In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971), nothing more than objective enablement is required by the first paragraph of § 112; whether the teachings of the specification are set forth “by the use of illustrative examples or by broad terminology, is of no importance.” Finally, we commend appellants for their candor in clarifying the record.

For the reasons discussed above, in our judgment, the specification provides objective enablement for the subject matter of claim 31. Accordingly, the rejection of

Appeal No. 1999-1260  
Application No. 08/756,031

William F. Smith  
Administrative Patent Judge

Toni R. Scheiner  
Administrative Patent Judge

Demetra J. Mills  
Administrative Patent Judge

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