

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WERNER A. BAUMGARTNER

Appeal No. 1999-1337
Application No. 08/393,232

ON BRIEF

Before WILLIAM F. SMITH, ADAMS, and MILLS, Administrative Patent Judges.
ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 35-42 and 47-49, which are all the claims pending in the application.

Claim 47 is illustrative of the subject matter on appeal and is reproduced below:

47. A method for the detection of marijuana intake by an individual which comprises:
 - (a) chemically treating a sample of hair from the individual in a manner that releases into solution an analyte characteristic of marijuana intake if present in the hair sample and an interfering substance that may interfere with a marijuana immunoassay;

- (b) filtering the solution through a filter to remove the interfering substance, said filter being characterized by a highly inert and low-binding de-acetylated cellulose membrane capable of removing proteins and peptides having molecular weights in the range of about 5,000 to about 30,000; and
- (c) after the interfering substance has been removed from the digest solution, subjecting a portion of the digest solution to analysis by immunoassay to detect the analyte if present.

The references relied upon by the examiner are:

Ogawa	3,873,682	Mar. 25, 1975
Kung et al. (Kung)	4,963,658	Oct. 16, 1990
Baumgartner ('642)	5,324,642	Jun. 28, 1994
Baumgartner ('703)	07/737,703	filing date Jul. 30, 1991

Kimmel et al. (Kimmel), "The properties of papain," Advances in Enzymology, Vol. 19, pp. 267-334 (1957)

Holmes, "Degradation of human hair by papain Part I: The pattern of degradation," Textile Research Journal, pp. 706-712 (1964)

Baumgartner et al. (Baumgartner), "Detection of drug use by RIA analysis of hair," Clinical Nuclear Medicine, Vol. 10, p. P4 (1985)

Biaglow et al. (Biaglow), "Factors influencing the oxidation of cysteamine and other thiols: Implications for hyperthermic sensitization and radiation protection," Radiation Research, Vol. 100, pp. 298-312 (1984)

Offidani et al. (Offidani), "Drugs in hair: A new extraction procedure," Forensic Science International, Vol. 41, pp. 35-39 (1989)

GROUND OF REJECTION¹

Claims 35-42 and 47-49 stand rejected under 35 U.S.C. § 103 as being unpatentable over Offidani, in view of Baumgartner, Holmes, Kimmel, Biaglow, Ogawa and Kung.

Claims 35-42 and 47-49 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of '642, or claims 1-3, 5, 10, 12-14, 16 and 22-25 of '703 in view of Ogawa and Kung.

We reverse.

DISCUSSION

According to appellant (Brief, page 9-10):

Most of the references cited by the Examiner, i.e., Offidani et al., Baumgartner et al., Holmes, Biaglow et al., the Baumgartner '642 patent and co-pending Baumgartner application S.N. 07/737,703 are cited by the examiner with respect to the base digestion and analysis elements of the claims. However, Applicant does not argue the patentability of those elements of the claims.... Instead, the Applicant seeks the allowance of the pending claims on the basis of the recitation in the claims of a particular type of filter to remove the marijuana interfering substance.... Only the Kung et al. and Ogawa references relate to the filtering of impurities, and thus will be addressed specifically in detail below.

¹ We note the examiner's statement of each ground of rejection omits claim 49. However, the Final Rejection (page 2) clearly states "[n]ewly added claim 49 is rejected for reasons of record...." Therefore, it appears that the omission is a typographical error. Accordingly, the grounds of rejection identified herein include claim 49.

The examiner does not dispute appellant's argument that only Kung and Ogawa relate to the filtering step of appellant's claimed invention.

THE REJECTION UNDER 35 U.S.C. § 103:

According to the examiner (Answer, page 6) Ogawa relates to an immunological method of examining urine and discloses that "it is standard practice to use other urine for a reaction test only after filtering it. Common cellulose filter paper or absorbent cotton may be able to remove the turbidity, but at the same time it is likely to absorb the HCG, too." With regard to Kung, the examiner finds (Answer, page 7) the hydrolyzed product following an enzymatic treatment can be removed "for example, by centrifugation through a membrane with a low molecular weight cutoff (approximately 10,000 or 30,000, such as a Millipore low-volume ultrafiltration device)."

The examiner reasons (Answer, page 8):

One of ordinary skill would have been capable of determining the best filter to use in the particular circumstances, such as the Millipore filters used by Kung et al., even though all of the potentially interfering substances have not yet been identified, since Ogawa provides guidance in the selection of an appropriate filter....

We note, however, as does appellant (Reply Brief, page 3) that the examiner "fails to explain how it was obvious to use the particular type of protein filter recited in the claims." We are not persuaded by the examiner's conclusion that one of ordinary skill in the art would have been capable of determining the best filter to use. We remind the examiner that a conclusion of obviousness over the cited prior art combination must be supported by substantial evidence on the

record. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002).

In our opinion, Ogawa and Kung fail to teach or render obvious the filter step of appellant's claimed invention wherein the filter is "characterized by a highly inert and low-binding de-acetylated cellulose membrane capable of removing proteins and peptides having molecular weights in the range of about 5,000 to about 30,000." See e.g., claim 47, step (b). Furthermore, none of the other references relied upon by the examiner make up for this deficiency.

Accordingly, we reverse the rejection of claims 35-42 and 47-49 under 35 U.S.C. § 103 as being unpatentable over Offidani, in view of Baumgartner, Holmes, Kimmel, Biaglow, Ogawa and Kung.

The obviousness-type double patenting rejections:

According to appellant (Brief, page 11) "the unique use of the filter recited in the claims is not an obvious advance over Applicant's U.S. Patent No. 5,324,642 and copending Application Serial No. 07/737,703...."

We note that the examiner relies on Ogawa and Kung to make up for the deficiencies in '642 and '703 with regard to the filter step of appellant's claimed invention. However, as discussed supra, Ogawa and Kung neither teach nor render obvious the filter step as defined by appellant's claimed invention. Accordingly, we reverse the rejection of claims 35-42 and 47-49 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,324,642, or claims 1-3, 5, 10,

12-14, 16 and 22-25 of co-pending Application No. 07/737,703 in view of Ogawa and Kung.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Donald E. Adams)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Demetra J. Mills)	
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