

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN A. GIEDLIN

Appeal No. 95-0371
Application 07/965,304¹

ON BRIEF

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and
McKELVEY, Senior Administrative Patent Judge,

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 12, all the claims in the application. Claims 1, 4, 7 and 10 are illustrative of the subject matter on appeal and read as follows:

¹ Application for patent filed October 23, 1992.

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1 through 12 also stand rejected under 35 U.S.C. § 103 as unpatentable over the Chemical Abstracts citation of Priebe in view of Paulson. We reverse the non prior art rejections and vacate the prior art rejections. In addition, we remand the application for the examiner to consider other issues.

DISCUSSION

1. Utility

The sole reason given by the examiner for rejecting claim 7 under 35 U.S.C. § 101 is set forth in the paragraph bridging pages 3-4 of the examiner's answer and reads as follows:

“[t]he claim reads on effecting physiological precesses [sic] that are not directly related to any disease pathology.”

Suffice it to say that we have no idea what the examiner means by this statement.

Furthermore, the examiner cites at page 4 of the examiner's answer in support of this rejection the following case “Splendor form Brassiere, Inc. v. Rapid-American Corp., 187 USPQ 158 (CCPA 1975).” Turning to that volume and page, we find no such case. However, a case styled in the manner stated by the examiner is found at 187 USPQ 151. The decision reported therein is that of a United States District Court, not the Court of Customs Patent Appeals as stated by the examiner. In that case, the district court raised on its own motion a question of utility under 35 U.S.C. § 101 stating,

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187 USPQ at 156: “if a patented invention fails to achieve the one advantage over the prior art which the patent specification asserts for it, it can hardly be said to be ‘useful’ as required by 35 U.S.C. § 101.” If in fact, this is the case the examiner intended to cite, it is not at all clear what relevance it has to the subject matter and issues at hand.

We can only express our dismay that an examiner would forward such a rejection to this board. The resources of this board and for that matter appellants should not have to be spent in reviewing such work. By statute, this board serves as a board of review. 35 U.S.C. § 7 (b) (“The [board] shall . . . review adverse decisions of examiners upon applications for patents”) In essence, the examiner has not presented a rejection which is susceptible of a meaningful review.

The rejection of claim 7 is reversed.

2. Enablement

For reasons unclear from this record, the examiner only rejected claims 1, 4 and 5 as being non-enabled by the specification. From the reasons set forth for this rejection on pages 4-5 of the examiner’s answer, it is not apparent why those reasons would not also apply to the remaining claims on appeal.

Be that as it may, the examiner has failed to properly establish that one skilled in the art would doubt the objective truth of the enabling statements set forth in the specification of this application. This is the examiner’s initial burden. In re Marzocchi, 439 F.2d 220,

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223, 169 USPQ 267, 369 (CCPA 1971). The statement of the rejection amounts to only a recitation of unsupported conclusions on the part of the examiner. The examiner's consideration of this issue does not appear to take into account either the prior art or the relevant legal standards. Again, the examiner's rejection is not susceptible to a meaningful review.

The rejection of claims 1, 4 and 5 is reversed.

3. Prior Art Rejections

Both prior art rejections are premised upon a Chemical Abstracts citation of Priebe. To the extent the full text article may not have been readily available to the examiner at the time the first action was mailed on January 14, 1993, it was available as of April 14, 1993, since appellants cited the full text Priebe article and supplied a copy thereof in the Information Disclosure Statement filed on that date (Paper No. 3).

Why the examiner would continue to rely upon an abstract when the more fact filled full text article is presented to him is not understood. Prior art rejections are fact specific. Where as here, the examiner relies upon an abstract of a full text article and the full text article is supplied to the examiner, we will not spend the scarce resources of this board in determining whether the abstract provides a sufficient basis for concluding that a claimed invention is anticipated under 35 U.S.C. § 102 or rendered obvious under 35 U.S.C. § 103. Those determinations must be made on the basis of the full text article.

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Accordingly, we vacate the two prior art rejections which are premised upon the Priebe abstract.

REMAND

1. Full Text Priebe Article

Upon return of the application, the examiner should consider the full text Priebe article. If the examiner remains of the opinion that the claims on appeal are either anticipated or rendered obvious on the basis of this full text article, the examiner should issue an appropriate Office action setting forth such rejections. If the examiner determines that the full text Priebe article anticipates any claim or claims on appeal, that Office action should set forth a detailed analysis in support of the rejection including, at the least, page, column, and line citations to the full text article where the examiner believes each claim requirement is described. If the examiner believes that Priebe is useful as evidence of obviousness under 35 U.S.C. § 103, we urge the examiner to use the model set forth in The Manual of Patent Examining and Procedures (MPEP) § 706.02(j) for making rejections under this section of the statute.

2. Boldt and Carrera

The active agent used in the present invention is fludarabine-5'-monophosphate (fludarabine). Boldt describes the administration of fludarabine to humans. While it does not appear that the humans involved in the work reported by Boldt were suffering from an autoimmune disease, the reference may be relevant in determining the patentability of claims such as 4 and 10 which are directed to administering this active ingredient to

humans which are not suffering from an autoimmune disease. Rather, claims 4 and 10 are directed to administering fludarabine to humans in general in order to prevent or prophylactically treat an autoimmune disease. Depending upon whether the amount of fludarabine administered to the humans in Boldt would be considered an effective amount for the purposes of this invention, Boldt may anticipate claims such as claims 4 and 10. See In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ 1934, 1936 (Fed. Cir. 1990) (“It is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable.”)

Upon return of the application, the examiner should determine whether the amounts of fludarabine administered in Boldt fall within the metes and bounds of the “effective amount” required by claims such as claims 4 and 10. If so, the examiner should then determine whether or not Boldt constitutes an anticipation of these claims.

Carrera is relevant for its discussion of the use of 2-chloro-deoxyadenosine in the treatment of rheumatoid arthritis (an autoimmune disease). Of most significance, is the disclosure in the last full paragraph of the left hand column of page 1486 of Carrera which appears to indicate that fludarabine may function in a similar manner to the active agent under investigation.

Upon return of the application, the examiner should consider the full text of Carrera and determine whether or not it suggests that fludarabine would be useful in treating

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rheumatoid arthritis as Carrera suggests 2-chloro-deoxyadenosine is. If so, the examiner should issue an appropriate office action which sets forth such a rejection. We would again urge the examiner to use the model for obviousness rejections set forth in MPEP 706.02(j).

REVERSED-IN-PART, VACATED-IN-PART, REMANDED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
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WILLIAM F. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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