

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** FUMIYASU HIRAI and NOBUTAKA TANI

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Appeal No. 95-2484  
Application 07/948,470<sup>1</sup>

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HEARD: JUNE 7, 1999

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Before WILLIAM F. SMITH, ELLIS and ROBINSON, ***Administrative Patent Judges.***

ELLIS, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

This an appeal under 35 U.S.C. § 134 from the final rejection of claims 43 through 48, all the claims pending in the application.

Claims 43 and 46 are illustrative of the subject matter on appeal and read as follows:

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<sup>1</sup> Application for patent filed September 22, 1992. According to the appellants, this application is a continuation of Application 07/272,960, filed November 18, 1988.



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Margulis et al. (Margulis), "DIALOG file 155 abstract, Accession No. 86019544, "Clinical effectiveness of the method of extracorporeal heparin precipitation of plasma proteins (selective plasmapheresis) in patients with immune complex pathology"<sup>2</sup>

Homma et al. (Homma), "Comparison of Selectivity of LDL Removal by Double Filtration and Dextran-Sulfate Cellulose Column Plasmapheresis," ***Atherosclerosis***, Vol. 60, pp. 23-27 (1986)

**BIO-RAD** Price List L, "Chromatography Electrophoresis Immunochemistry Molecular Biology HPLC," pp. 49-67 (Jan. 1986)

The claims stand rejected as follows:

I. Claims 43 through 48 stand rejected under 35 U.S.C. § 101 as lacking patentable utility.

II. Claims 43 through 48 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an adequate written description or an enabling disclosure of the invention.

III. Claims 43 through 45, 47 and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rubinow in view of Homma.

IV. Claim 46 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rubinow and Homma, in further view of the Bio-Rad catalog.

We have given careful consideration to the record before us which includes, ***inter alia***, the appellants' main brief (Paper No. 37) and Reply Brief (Paper No. 41), the

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<sup>2</sup> The examiner has relied on an abstract from an electronic database. However, the date the abstract was publically available on line is not of record in the file.

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examiner's Answer (Paper No. 39) and supplemental Answer (Paper No. 42), as well as the three declarations of Mr. Hirai (attachments to Paper Nos. 9 and 14; and Paper No. 20), and we find ourselves in substantial agreement with the findings of facts and conclusions of law set forth in the appellants' briefs. Accordingly, we **reverse** all the rejections for the reasons set forth therein. We comment only briefly.

With respect to the § 103 rejections, we agree with the appellants that there is nothing in the applied prior art of record which would have suggested the claimed method to one of ordinary skill in the art. The examiner alleges that it would have been obvious to treat those patients of Rubinow who have both hypercholesterolemia and amyloidosis with the hypercholesterolemia dextran-sulfate cellulose column plasmapheresis technique described by Homma. However, we find no evidence of record that patients having systemic amyloidosis are likely to be afflicted with **familial** hypercholesterolemia, a genetic disorder. Thus, treatment of the latter group of patients does not teach or suggest treatment of the former. Nor is there any evidence of record that the amyloid proteins removed from serum using the appellants' method fall within the types of lipoproteins which are selectively removed using the method of plasmapheresis taught by Homma. Thus, in our view the removal of serum amyloid proteins using dextran-sulfate cellulose column plasmapheresis from a patient afflicted with amyloidosis differs from, and is not suggested by, the removal of low density

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lipoproteins from patients having *familial* hypercholesterolemia using substantially the same method.

As to the § 101 rejection, we find that the examiner has proffered several theories as to why he believes one skilled in the art would question the objective truth of the statement of utility. Some of these theories are said to be based on the teachings of various references; i.e., Kato, Margulis and Lehninger. However, we find that the examiner has not applied the legal standard correctly. Since of the cited references, Lehninger does not teach patients having the claimed disease; i.e., amyloidosis, and Kati and Margulis, do not teach the appellants' method of treating amyloidosis, there is no evidence of record that one skilled in the art would have arrived at the same conclusions as the examiner. Thus, although proffered under the guise "scientific reasoning," the examiner's theories are undeniably speculative.

The decision of the examiner is reversed.

**REVERSED**

WILLIAM F. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
JOAN ELLIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
DOUGLAS W. ROBINSON	)	
Administrative Patent Judge	)	

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