

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEREMIAH MILNER

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Appeal No. 1995-4434  
Application No. 07/988,023<sup>1</sup>

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed December 9, 1992. According to appellant, this application is a division of Application No. 07/335,750, filed April 10, 1989; which is a continuation-in-part of Application No. 07/157,720, filed February 19, 1988; which is a division of Application No. 06/891,342, filed July 31, 1986; which is a continuation-in-part of Application No. 06/699,088, filed February 7, 1985; which is a continuation-in-part of Application No. 06/569,760, filed January 10, 1984; all which have been abandoned.

Appeal No. 1995-4434  
Application No. 07/988,023

This appeal was taken from the examiner's decision rejecting claim 1. Claims 3 through 15, which are the only other claims remaining in the application, stand allowed.

Claim 1 reads as follows:

1. An aqueous peritoneal dialysis composition sterile and free from pyrogens which is used for introduction into the abdominal cavity for removal of water and waste products by dialysis across the peritoneal membrane comprising a water soluble glucose polymer mixture derived from the hydrolysis of starch containing at least 36.7% by weight of glucose polymers having a degree of polymerization (D.P.) of more than 12 glucose units, said glucose polymer mixture being present in the peritoneal dialysis composition as an osmotic agent and said peritoneal dialysis composition having an osmolality of about 265 to 378 mOsm/kg. [Emphasis added].

The reference relied on by the examiner is:

Silk et al. (Silk)                      WO 82/03329                      Oct. 14, 1982  
(International patent application)

The issue presented for review is whether the examiner erred in rejecting claim 1 under 35 U.S.C. § 103 as unpatentable over Silk.

On consideration of the record, we shall not sustain this rejection.

#### DISCUSSION

We first invite attention to parent Application No. 07/335,750 filed April 10, 1989 (Paper No. 15), where another

Appeal No. 1995-4434  
Application No. 07/988,023

merits panel of this Board evaluated the patentability of appellant's aqueous peritoneal dialysis composition (Appeal No. 91-1972 mailed September 16, 1992). The previous Board panel affirmed-in-part the examiner's decision rejecting claims 1 through 14 on prior art grounds. Silk was the sole reference relied on in the previous appeal.

Instant claim 1 differs from claim 1 in the previous appeal in view of the recitations "sterile and free from pyrogens" and "said peritoneal dialysis composition having a osmolality of about 265 to 378 mOsm/kg" added to the instant claim. We have evaluated patentability anew in light of the new claim language presented.

The claimed aqueous peritoneal dialysis composition is "sterile and free from pyrogens." That recitation is a positive limitation in the claim and, in our judgment, Silk does not constitute sufficient evidence to support a conclusion of obviousness of a claim containing that limitation. For the reasons succinctly stated in appellant's main brief, pages 11 and 12, the examiner has not established that there is adequate reason, suggestion, or motivation stemming from the cited prior art which would have led a person having ordinary skill to

Appeal No. 1995-4434  
Application No. 07/988,023

modify Silk's compositions by making them sterile and free from pyrogens.

The examiner's decision is reversed.

REVERSED

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

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Appeal No. 1995-4434  
Application No. 07/988,023

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