

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK DEBRAUWERE, JEAN-MARIE MATHIAS
and INDRAJIT PATEL

Appeal No. 1996-2963
Application 07/952,427

ON BRIEF

Before GARRIS, OWENS and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-22 and 31. Claims 23-30 have been indicated as allowable by the examiner in the final rejection mailed April 03, 1995. The examiner (answer, page 2) withdrew the outstanding rejections involving claim 32, the only other

claim pending in this application.

BACKGROUND

Appellants' invention relates to a steam sterilizable apparatus that includes a container or tube having an inner surface that may be made of non-PVC plastic material and a methylene blue solution contained therein or otherwise associated therewith. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced below.

16. A steam sterilizable system for housing a body fluid and inactivating a pathogen that may be contained within the system comprising:

a container having a therapeutically effective amount of a methylene blue solution that has a pH of less than or equal to 6.3.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Measells et al. (Measells) 1991	5,066,290	Nov. 19,
Meruelo et al. (Meruelo) 22, 1992	5,149,718	Sep.
Woo et al. (Woo) 1994	5,356,709	Oct. 18,

(filed May 14, 1992)

Mohr et al. (Mohr¹)
21, 1991
(German Patent)

DE 3930510

Mar.

Claims 1-7, 9 and 11-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mohr in view of Meruelo. Claims 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mohr in view of Meruelo and Measells. Claim 31 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mohr in view of Woo.

OPINION

We have carefully reviewed the specification, claims and applied prior art, including all of the arguments advanced by the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejection of claims 1-7, 9 and 11-22 over Mohr in view of Meruelo and the § 103 rejection of claims 8 and 10 over the same references further in view of Measells are well founded, but not the § 103 rejection of claim 31. Accordingly, we will sustain the examiner's rejections of

¹ All subsequent references in this opinion to Mohr are references to the English language translation of the published German Offenlegungsschrift of record.

claims 1-22 under 35 U.S.C. § 103 as being unpatentable over the respectively applied prior art for substantially those fact findings and conclusions set forth in the answer and as further discussed below. However, we will not sustain the examiner's § 103 rejection of claim 31. Our reasons follow.

Rejection of Claims 1-7, 9 and 11-22

Appellants have not grouped the claims separately with respect to this ground of rejection, nor have appellants provided arguments for the separate patentability of the claims in accordance with 37 CFR §§ 1.192(c)(7) and (c)(8)(iv)(1995). Therefore, we need only consider the propriety of the examiner's rejection of independent claim 16, which we select as a representative claim for purposes of deciding this appeal with respect to this ground of rejection.

See 37 CFR § 1.192(c)(7) (1995); *In re Nielson*, 816 F.2d 1567, 1571, 2 USPQ2d 1525, 1527 (Fed. Cir. 1987); *In re Wood*, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Representative claim 16 is drawn to a steam sterilizable system including "a container having a therapeutically effective amount of a methylene blue solution that has a pH of

less than or equal to 6.3." The representative claim² does not explicitly require that any portion of the container is constructed of a non-PVC material.

Mohr (page 4) describes a method for inactivating viruses using a dye such as methylene blue in the treatment of blood in a blood bag. Mohr teaches a pH value between 5 and 8, preferably between 6 and 8 (Mohr, pages 4 and 5), a disclosed pH value overlapping the claimed range. Hence, as explained by the examiner (answer, page 4), Mohr discloses a steam sterilizable container (blood bag) containing an amount of methylene blue solution corresponding to the herein claimed therapeutically effective amount. According to the examiner (answer pages 4 and 5), it would have been obvious to one of ordinary skill in the art to select a methylene blue solution with a pH corresponding to the herein claimed pH value of less than or equal to 6.3 in light of Mohr's disclosure of using pH value ranges that are inclusive of pH values below 6.3. We agree.

² We note that appealed claim 18, likewise, does not specify non-PVC material notwithstanding the argument of appellants to the contrary (brief, page 10).

It is well settled that the disclosure of a range in the prior art which substantially overlaps a claimed range is generally sufficient in and of itself to render the claimed range *prima facie* obvious. See *In re Woodruff*, 919 F.2d 1575, 1577-1578, 16 USPQ2d 1934-1937, 1936 (Fed. Cir. 1990); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). This is especially true here, where one having ordinary skill in the art would have been led to employ a pH value corresponding to the claimed pH values by simply following the preferred range teachings of Mohr. Discovering the optimum or workable ranges through routine experimentation is within the ambit of one of ordinary skill in the art. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Appellants (brief, pages 11-13) argue that Mohr does not recognize or address the problem of the potential loss of viral inactivation agent (methylene blue) into plastic material during steam sterilization and the use of non-PVC plastic with the methylene blue at the claimed pH as a

solution. Along this vein, appellants assert that the examiner's rejection is premised on an "obvious-to-try" standard.

We do not consider those arguments convincing. In our view, appellants' contentions are of little probative value since the appealed subject matter, with which we are concerned here, is not directed to a particular steam sterilization process or, for that matter, as illustrated by representative claim 16, non-PVC plastic material. Additionally, even if the subject matter at issue herein were limited to containers constructed of non-PVC plastic material, the use of such materials for the blood bag of Mohr would have been obvious to one of ordinary skill in the art in light of the teachings of Meruelo (column 3, lines 22-30 and column 7, lines 42-47) regarding the use of glass or other non-PVC material, as available construction materials for forming containers for holding and treating blood and other biological fluids with antiviral compounds as explained by the examiner (answer, pages 5-7). While Meruelo (column 7, lines 42-68) does disclose PVC plastic as one of the available plastic materials for use in forming blood bags that are sterile as argued by

appellants, other inert plastic materials such as polyethylene are also taught as available options as discussed above.

It is not necessary for a finding of obviousness, that the prior art references provide all of the specific reasons as disclosed by appellants for doing what is herein claimed. See *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). Furthermore, all of the utilities or benefits of the claimed invention need not be explicitly disclosed by the prior art references to render the claimed subject matter unpatentable under section 103. See *In re Dillon*, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir. 1990) (*in banc*), *cert. denied*, 500 U.S. 904 (1991)). Therefore, in light of the reasons set forth above and in the answer, we will sustain the examiner's § 103 rejection of claims 1-7, 9 and 11-22.

Rejection of Claims 8 and 10

Appellants identify separately rejected claims 8 and 10 as a grouping of claims and indicate a desire for the patentability of claims 8 and 10 to be considered apart from

the independent claim (claim 6) on which they ultimately depend (brief, page 7). However, appellants have not furnished separate substantive arguments for claim 10. Rather, appellants merely describe the contents of claim 10 (brief, pages 14 and 15). We therefore limit our discussion to claim 8. *See In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7) and (c)(8)(1995).

The examiner relies on Measells in addition to the Mohr and Meruelo references discussed above as evidence of the obviousness of the subject matter at issue with respect to this rejection. According to the examiner (answer, page 8),

[i]t would have been obvious to one of ordinary skill in the art to provide the multi-layer tube construction of Measells et al. in Mohr et al. in view of Meruelo et al. in order that the tube would have both strength and resistance to tackiness after heat sterilization, no plasticizers, and would minimize migration of materials into the contents of the container, as taught by Measells et al. (col. 2, lines 48-61).

Implicit in the examiner's rejection is the finding that it would have been obvious to use a tube as taught by Meruelo (answer, page 6) and Measells (answer, page 8) in Mohr for use with the blood bag container as taught by Meruelo (column 3,

lines 40-43 and column 7, lines 26-41).

Appellants do not specifically dispute the above-identified findings of the examiner as to the obviousness of using a multi-layer tube construction in Mohr based on the combined teachings of the applied references. Rather, appellants argue that the combined references fail to teach the claimed subject matter for substantially similar reasons as argued with respect to the examiner's rejection of claims 1-7, 9 and 11-22 as discussed above. Since we find ourselves in agreement with the examiner's position for the reasons expressed in the answer and above, we will not further burden the record with reiterating why we consider appellants' arguments unconvincing.

Accordingly, we will sustain the examiner's § 103 rejection of claims 8 and 10.

Rejection of Claim 31

Our disposition of the examiner's § 103 rejection of claim 31 based on the combined teachings of Mohr and Woo is another matter. According to the examiner (answer, page 9),

it would have been obvious to construct Mohr's container with the materials disclosed by Woo including using a "blend of polypropylene, styrene-ethylene-butylene-styrene (SBS) and ethylene vinyl acetate (EVA)...."

According to appellants (brief, pages 16 and 17), however, Woo does not disclose or suggest forming an inner surface portion of a container sidewall with SBS in a manner corresponding to the claimed container, rather Woo discloses forming an intermediate tie layer therewith. We observe that the examiner does not specifically address appellants' arguments regarding this rejection in the answer. Moreover, the disclosure of Woo (see, e.g., column 3, lines 10-49) appears to generally support appellants' viewpoint. Hence, on this record, we will not sustain the examiner's § 103 rejection of claim 31.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-7, 9 and 11-22 under 35 U.S.C. § 103 as being unpatentable over Mohr in view of Meruelo and to reject claims 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Mohr

in view of Meruelo and Measells is affirmed. The decision of the examiner to reject claim 31 under 35 U.S.C. § 103 as being unpatentable over Mohr in view of Woo is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

Appeal No. 1996-2963
Application 07/952,427

Page 13

pfk/ki

Appeal No. 1996-2963
Application 07/952,427

Page 14

Bradford R. L. Price
Baxter International Inc.
Route 120 and Wilson Road
Round Lake, Illinois 60075