

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASA HARU ITO, KUNITOSHI MATSUNOBU,
MASANORI UONO, SUSUMU KANEMAKI and KYOICHI KOBASHI

Appeal No. 1998-1880
Application No. 08/423,865

HEARD: April 26, 2001

Before WILLIAM F. SMITH, SCHEINER and ADAMS, 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 1-5. Pursuant to a Restriction Requirement¹ claims 6-10 were withdrawn from consideration as directed to a non-elected invention.

¹ Paper No. 4, mailed February 23, 1996.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of examining a patient to determine whether said patient is infected with Helicobacter pylori, which comprises steps of collecting gas in the gastric cavity of said patient, and then measuring amounts of ammonia and organic amines in the gas.

The reference relied upon by the examiner is:

Hamilton

4,947,861

Aug. 14, 1990

GROUND OF REJECTION

Claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, as lacking a correlation step in the method for determining infection.

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamilton.

We reverse.

DISCUSSION

In reaching our decision in this appeal, we considered appellants' specification and claims, in addition to the respective positions articulated by the appellants and the examiner. We make reference to the examiner's Answer², and the examiner's Supplemental Answer³ for the examiner's reasoning in support of the rejections. We further reference appellants' Brief⁴, and appellants' Reply Brief⁵ for the appellants' arguments in favor of patentability.

² Paper No. 13, mailed May 20, 1997.

³ Paper No. 16, mailed September 15, 1997.

⁴ Paper No. 12, received March 27, 1997.

⁵ Paper No. 14, received July 22, 1997.

THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH:

As set forth in Amgen Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991):

The statute requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” A decision as to whether a claim is invalid under this provision requires a determination whether those skilled in the art would understand what is claimed. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985) (Claims must “reasonably apprise those skilled in the art” as to their scope and be “as precise as the subject matter permits.”).

Furthermore, claim language must be analyzed “not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art.” In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

According to the examiner, claim 1, and claims 2-5 which depend from claim 1, are indefinite because “[c]laim 1 is directed to a method of determining infection but lacks any such step. An added correlating step is suggested.”

According to appellants’ specification (page 3) “the inventors have energetically studied and investigated to find out that there is a close correlation between the intragastric ammonia concentration and H.p.-infection, and by measuring the concentration, information on the present activity of H.p. at the time of examination can be obtained...” Furthermore, appellants’ specification discloses (page 15), as a conclusion to example 1, that “[i]t has been made apparent that higher ammonia concentrations are detected for H.p.-infected patients in comparison with those for healthy individuals.”

Appellants' argue (Brief, bridging paragraph, pages 12-13) that the examiner "has not identified any subject matter for which those skilled in the art would have any difficulty determining whether the subject matter falls inside or outside the literal scope of the claims." In response, the examiner argues (Answer, page 7) that [i]t is the examiner's position that merely measuring ammonia and organic amines alone does not determine if an infection is present and some correlation of the data obtained is required to make a diagnosis."

While the examiner may prefer that appellants include a correlation step, in our opinion, when the claims are read in light of appellants' specification those skilled in the art would understand what is claimed. Accordingly, we reverse the examiner's rejection of claims 1-5 under 35 U.S.C. § 112, second paragraph.

THE REJECTION UNDER 35 U.S.C. § 103:

"The name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). In considering the issues raised in this appeal, we point out that "analysis begins with a key legal question – what is the invention claimed?" since "claim interpretation . . . will normally control the remainder of the decisional process." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987).

In this case, the claimed method comprises the steps of (1) collecting gas in the gastric cavity of a patient and (2) measuring amounts of ammonia and organic amines in the gas. As set forth in In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

With regard to the first step:

Appellants' specification discloses (page 4) that:

A number of ways have been presented in order to collect the intragastric gas; one is a method of collecting the gas directly by use of a cannula.

...

For the purpose of collecting the intragastric gas, it has now been found to be advantageous to lead the gas to the oral cavity with the aid of a vomiting-reflexive belching....

Appellants' specification also discloses (page 2) Hamilton's prior art method of diagnosing H.p. infection. According to appellants' specification (id.) in Hamilton's method:

the detection has been made based on [the] theory that if urea is administered to a person infected with H.p., at least some portion of ammonia generated by the activity of H.p. is absorbed into the blood stream, passes through the liver without being broken down there, and is delivered to expired air at the alveoli of the lungs.

Appellants' specification discloses (page 3) that:

[A]n application of the [Hamilton] method for the actual diagnosis is quite difficult or impossible from the view point of sensitivity, since almost all part of [sic] ammonia absorbed into the blood stream will be broken down by the liver and only a trace amount thereof shall appear in the breath sample.

The examiner recognizes that the appealed "claims differ from Hamilton in that they specify collecting gas in the gastric cavity whereas Hamilton teaches

collecting expired gas.” Notwithstanding this difference the examiner finds (Answer, page 5) that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to collect gas in the gastric cavity because Hamilton teaches ammonia is produced in the gastric cavity after ingestion of urea. One desiring to detect the presence of H. pylori would then be taught the presence of ammonia in the gastric cavity is indicative of the presence of H. pylori irrespective of how it is collected.

The examiner reaffirms this position in his Supplemental Answer (page 2) stating that “[i]t is the examiner’s position that collecting the same gas from any site where that same gas is known to be found is rendered obvious by a known method of collecting the same gas from any known site.

In response, appellants’ argue (Reply Brief, bridging paragraph, pages 1-2) that the examiner “has not established that it would have been obvious to modify the disclosure in Hamilton by collecting gas from the gastric cavity rather than collecting expired gas.” We agree. While a person of ordinary skill in the art may possess the requisite knowledge and ability to modify the protocol taught by Hamilton, the modification is not obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 211 USPQ 1125, 1127 (Fed. Cir. 1984). Here we see no such reason to modify Hamilton to obtain the claimed method which requires obtaining and measuring the amounts of ammonia and organic amines in gastric cavity gas that has not traversed the circulatory system to be expired in alveolar air. With regard to the examiner’s unsupported conclusion (Supplemental Answer, page 2) that it would be obvious to collect gas from any site where it is known to be found, we remind the examiner that, selective hindsight is no

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more applicable to the design of experiments than it is to the combination of prior art teachings. In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

With regard to the second step:

Appellants' claimed invention requires that the amount of both ammonia and organic amines in gastric gas are measured. According to appellants' specification (page 4) "[t]he gas collected from the gastric cavity is led to a sensor to measure total amount of ammonia and organic amines, because of that the gas consists primarily of ammonia, but organic amine gases shall possibly present therein, and the sensor detects the amines in addition to ammonia."

The examiner's rejection is directly solely to the detection of ammonia. "The test of obviousness vel non is statutory. It requires that one compare the claim's 'subject matter as a whole' with the prior art 'to which said subject matter pertains'" [emphasis added]. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). In this case, when comparing the claimed subject matter as a whole with the cited prior art, the examiner failed to provide a teaching or reason why one would detect organic amines in addition to ammonia in gastric gas, as provided for in the claimed invention. As a result the examiner failed to address all the limitations of the claimed invention. We remind the examiner, as set forth in In re Antonie, 559 F.2d 618, 621, 195 USPQ 6, 8 (CCPA 1977), "[j]ust as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a whole, and not some part of it, which must be

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obvious under 35 U.S.C. § 103. Cf. In re Papesch, 50 CCPA 1276, 315 F.2d 381, 137 USPQ 43 (1963).”

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For the reasons set forth supra, the examiner failed to provide the evidence necessary to support a prima facie case of obviousness. Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Accordingly, we reverse the rejection of claims 1-5 under 35 U.S.C. § 103 as being unpatentable over Hamilton.

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Having determined that the examiner has not established a prima facie case of obviousness, we find it unnecessary to discuss the Ito Declaration executed November 1996, relied on by appellants to rebut any such prima facie case.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TONI R. SCHEINER)	
Administrative Patent Judge)	APPEALS AND
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