

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

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE LOESCHER, JOHN EVERARD
and REBECCA GRUMET

Appeal No. 1999-1708
Application 08/731,320

ON BRIEF

Before WINTERS, ROBINSON and MILLS, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1-6, 13 and 14, which are the subject of this appeal. Claims 7-12 have been withdrawn from consideration by the examiner.

We reverse.

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Claim 1 is illustrative of the claims on appeal and reads as follows:

1. An isolated and purified DNA encoding mannose-6-phosphate reductase (M6PR) as set forth in SEQ ID NO:1.

The reference relied upon by the examiner is:

Everard et al. (Everard), "Cloning of mannose 6-phosphate reductase from celery," Hort. Science, Vol. 30, No. 4, pp. 898 (1995)

Ground of Rejection

Claims 1-6, 13 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Everard.

DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the noted rejection, we make reference to the examiner's Answer for the examiner's reasoning in support of the rejection, and to the appellants' Brief and Reply Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the determinations which follow.

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35 U.S.C. § 102

Claims 1-6, 13 and 14 stand rejected under 35 U.S.C. § 102 as anticipated by Everard.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. In re Oelrich, supra; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

The examiner argues that (Answer, page 3):

Everard *et al.* disclose the cloning of mannose 6-phosphate reductase (M6PR) from celery. They teach the construction of cDNA library prepared from poly(A)-RNA extracted from newly, fully expanded leaves and the isolation of a specific M6PR-specific clone, ... They also teach the screening of the cDNA library with M6PR-specific antisera, ...

The examiner acknowledges that Everard does not disclose the DNA of SEQ ID NO:1, but indicates that the invention remains anticipated because the nucleic acid sequence of SEQ ID NO:1 is an "intrinsic property of the gene taught by the reference".

While appellants readily admit that the cDNA nucleotide sequence encoding M6PR is an intrinsic property of the gene, they argue that Everard does not enable the claimed DNA sequence as it does not disclose the claimed DNA sequence. Reply Brief, page 9. Appellants argue that, at best, Everard teaches that a cDNA clone was isolated that produced a polypeptide capable of reacting with an antibody made against authentic M6PR.

A reference does not "describe" an invention within 35 USC 102, and thus is not an anticipation of the invention, unless that single reference contains sufficient disclosure to put the invention in the hands of the public. In re Outtrup, 531 F.2d 1055, 189 USPQ 345 (CCPA 1976); In re Coker, 59 CCPA 1185, 463 F.2d 1344, 175 USPQ 26 (1972); In re

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Sheppard, 52 CCPA 859, 339 F.2d 238, 144 USPQ 42 (1964); and In re Brown, 51 CCPA 1254, 329 F.2d 1006, 141 USPQ 245 (1964).

We do not agree with the examiner that Everard places in the hands of the public the DNA sequence of SEQ ID NO:1.

In the present case, while the reference discloses that a cDNA clone was isolated which produced a polypeptide capable of reacting with an antibody made against authentic M6PR, Everard does not particularly or inherently describe the specifically claimed DNA sequence. At best, Everard, may suggest the probability or possibility that a DNA of the claimed sequence exists, as one of a large number of the degenerate DNA sequences which could possibly code for the M6PR gene. Compare In re Bell, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993). Thus, Everard cannot and does not anticipate the claimed DNA sequence of SEQ ID NO:1.

Nor do we find the disclosure of Everard to constitute sufficient evidence of the claimed invention to shift the burden of proof to appellants to provide evidence that the M6PR protein sequence described in Everard is not encoded by the claimed sequence. Under appropriate circumstances the PTO can require an applicant to establish that a prior art product does not necessarily possess the characteristics of the claimed product when the prior art and claimed products are identical or substantially identical. See, In re

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Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Here, the examiner has not provided sufficient evidence to reasonably establish that the cDNA of the reference is identical or substantially identical to that which is claimed.

In our view, for the reasons set forth above, the examiner has failed to set forth a prima facie case of anticipation.

CONCLUSION

In view of the above, the rejection under 35 U.S.C. § 102 in view Everard is reversed.

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

REVERSED.

Sherman D. Winters
Administrative Patent Judge

Douglas W. Robinson
Administrative Patent Judge

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