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Paper No. 25

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
UNITED STATES TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL H. SMITH, JAMES R. BRAINARD,
GORDON D. JARVINEN and ROBERT R. RYAN

Appeal No. 93-2361
Application 07/643,092¹

ORDER REMANDING TO EXAMINER

On January 22, 1993, a Reply Brief (Paper No. 24) was filed. The examiner indicated by handwritten note that the Reply Brief was "noted." The Manual of Patent Examining Procedure states in Section 1208.04 that:

The examiner should notify appellant of consideration of the reply brief using form paragraph 12.47.

There is no indication on the record that applicant was notified of the examiner's position.

¹ Application for patent filed January 22, 1991.

Appeal No. 93-2361
Application 07/643,092

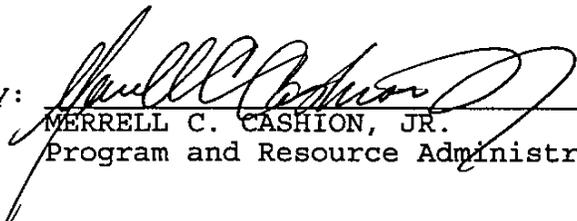
Accordingly, it is

ORDERED that the application is remanded to the Examiner for appropriate notification to applicant and for such further action as may be appropriate.

The application, by virtue of its "special" status, requires immediate action. See Manual of Patent Examining Procedure, § 708.01(d). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:


MERRELL C. CASHION, JR.
Program and Resource Administrator

cc: Richard E. Constant
Assistant General Counsel
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94

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

SEP 27 1995

**PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
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BEFORE THE BOARD OF PATENT APPEALS
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Ex parte PAUL H. SMITH, JAMES R. BRAINARD,
GORDON D. JARVINEN and ROBERT R. RYAN

Appeal No. 93-2361
Application 07/643,092¹

ON BRIEF

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

ELLIS, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2, 4, 5, 10, and 11. The only other claim remaining in the application, claim 12, was objected to by the examiner. The

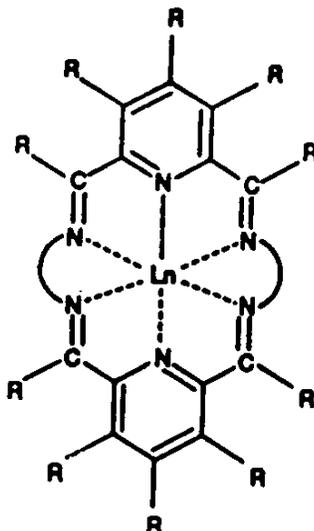
¹ Application for patent filed January 22, 1991. According to applicants, this application is a continuation of Application 07/301,678 filed January 24, 1989, now abandoned.

Appeal No. 93-2361
Application 07/643,092

examiner has indicated that claim 12 will be allowed when rewritten in a form independent of claim 10.

Claim 10 is illustrative of the subject matter on appeal and reads as follows:

10. A method of enhancing contrast of a magnetic resonance image of a living organism by incorporating a contrast agent into the organism, in an amount effective to enhance contrast of the image, prior to forming the image or during formation of the image, where said contrast agent is a paramagnetic lanthanide hexaazamacrocyclic molecule and has the structural formula

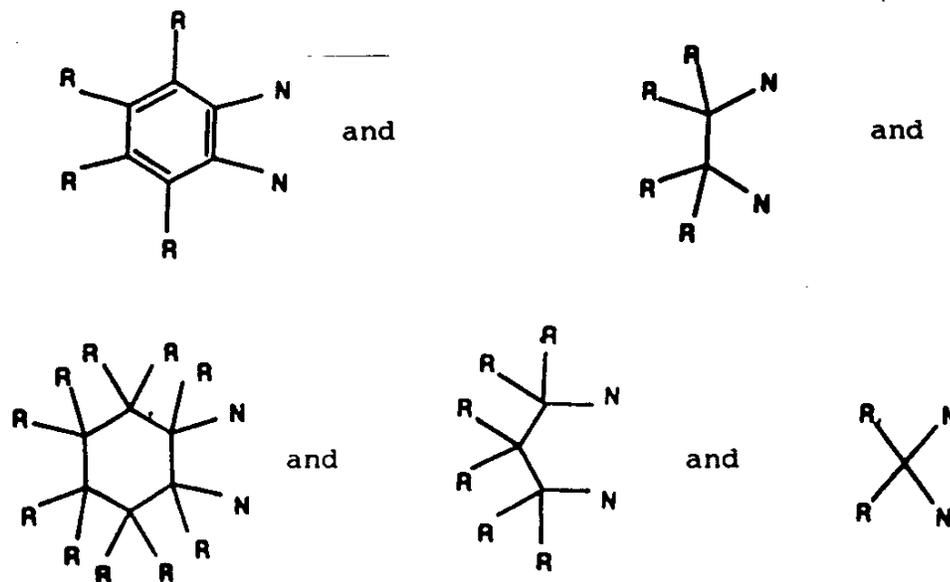


where the symbol 

and the symbol 

Appeal No. 93-2361
Application 07/643,092

denotes a constituent of the contrast agent chosen from a group consisting of five constituents having the structures



and where R represents a hydrogen atom or a substituent group chosen from a class consisting of alkyl, alkoxy, acyl, aroxy, alkylamine, aryl, hydroxy, aryloxy, amine, carboxylate, phosphate, and sulfonate [sic] groups.

The examiner has not relied on any references in making the rejection.

Claims 2, 4, 5, 10, and 11 are rejected under 35 U.S.C. § 112, first paragraph, as being nonenabled.

We have carefully considered the respective positions of the appellants and the examiner and find ourselves in agreement with that of the appellants. Accordingly, we reverse the rejection for the reasons set forth on pp. 5-11 of the Appellants' Brief and only add the following comments.

Appeal No. 93-2361
Application 07/643,092

The examiner's position is best summarized in his statement that the teachings of the specification fail to enable one of ordinary skill in the art "to practice the entire scope of the claimed invention due to the large number of inoperative embodiments and the undue experimentation involved in determining which species work and which species don't work." See the sentence bridging pages 6 and 7 in the Examiner's Answer. We find that there are two important considerations which the examiner has overlooked.

First, it is well established that an applicant may claim the invention as broadly as it is disclosed, absent the examiner establishing a reason as to why one skilled in the art would doubt the objective truth of the statements contained in the specification. *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). See also, *In re Bowen*, 492 F.2d 859, 181 USPQ 48 (CCPA 1974); *In re Dinh-Nguyen*, 492 F.2d 856, 181 USPQ 46 (CCPA 1974). In the case before us, the examiner has proposed several reasons as to why the claimed method may be inoperative; however, he has failed to provide any factual evidence to support these reasons. That is, he has provided no evidence to support statements such as: "one of ordinary skill in the art would expect that employing one or more large carbon containing groups would dramatically alter the physiological properties of the molecule," "solubilities of the compounds would vary greatly

Appeal No. 93-2361
Application 07/643,092

depending upon the amount of carbon substitution," etc. On the other hand, in their response, the appellants have provided two declarations, and corroborated the declarants' statements with references, which demonstrate that the examiner's concerns are unfounded and readily addressed by those skilled in the art.

The second consideration goes to the number of inoperative embodiments alleged, by the examiner, to be encompassed by the claims. It is well established that those combinations or compositions which don't work and which are readily discoverable, will not be used in the appellants' method and, therefore, are not encompassed by the claim. See *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976).

In addition, as stated in *In re Dinh-Nguyen*, *supra*:

Disclosure in the specification sufficient to enable practice of the invention by one skilled in the art, taking into consideration obvious modifications of the reactant ratios of specific examples, is all that is required. It is not a function of the claims to specifically exclude either possible inoperative substances or ineffective reactant proportions. See *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). (Emphasis in original.)

See also, *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789 (CCPA 1974). In the case before us, the declarations demonstrate that one of ordinary skill in this art can readily determine whether or not a composition possesses the essential properties of a magnetic resonance contrast agent by performing three simple assays, two

Appeal No. 93-2361
Application 07/643,092

of the assays are performed in aqueous solution and one uses *in vitro* cell cultures. Therefore, on these facts, we find that it would not require undue experimentation to determine which compositions will be operative in the claimed method.

Finally, we note that the file wrapper does not indicate that a search for the core structure of the paramagnetic lanthanide hexaazamacrocyclic molecule was made in any of the "online" chemical data bases. On return of this file to the examiner we suggest that all available search areas be investigated prior to the allowance of any claims.

The decision of the examiner is reversed.

REVERSED

William F. Smith

WILLIAM F. SMITH
Administrative Patent Judge)

Teddy S. Gron

TEDDY S. GRON
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

Joan Ellis

JOAN ELLIS
Administrative Patent Judge)

Appeal No. 93-2361
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