

93-2867

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PATENT OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

**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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* LEON W.M.M. TERSTAPPEN  
AND LOUIS J. PICKER

Appeal No. 93-2867  
Application 07/669,142<sup>1</sup>

ON BRIEF

Before SCHAFER, *Vice Chief Administrative Patent Judge*, and  
WILLIAM F. SMITH and ELLIS, *Administrative Patent Judges*.

ELLIS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the refusal of the examiner to allow claim 1. The other claims remaining in the application, claims 2 through 18, have been indicated as being directed to a non-elected invention and, therefore, stand withdrawn from further consideration by the examiner.

<sup>1</sup> Application for patent filed March 14, 1991. According to applicants, the application is a continuation-in-part of Application 07/517,101, filed May 1, 1990.

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Claim 1 reads as follows:

1. A substantially pure population of T lymphocyte precursor cells said cells being characterized as CD34<sup>+</sup>, CD7<sup>+</sup> and Leu 8<sup>+</sup>.

The reference relied on by the examiner as evidence of obviousness is:

Loken et al. (Loken)                      5,047,321                      Sep. 10, 1991

Claim 1 stands rejected under 35 U.S.C. § 103 as unpatentable over Loken.

Having carefully studied the respective positions of the appellants and the examiner, we find ourselves in substantial agreement with that of the appellants. Accordingly, we reverse the rejection for the reasons set forth on pp. 3-6 of the Brief and only add the following comments.

As developed in the Appeal Brief, Loken describes a multi-dimensional approach to cell analysis and the use of at least one fluorescently labelled monoclonal antibody. However, the patent fails to teach or suggest the use of CD34, CD7, and Leu 8 antibodies to identify a T lymphocyte precursor cell. Rather, Loken teaches the use of fluorescent techniques which can be measured "from cells that incorporate a nucleic acid stain or which may be measured from cells bearing surface markers which are labelled with monoclonal antibodies conjugated directly or indirectly to fluorochromes." See col. 2, lines 4-9. The cells

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reasonable expectation of success in producing the claimed invention." See the Answer, p. 4, lines 1-9. We find this position untenable.

The mere fact that the methodology for isolating the present cell population was known, and the screening agents were commercially available, does not necessarily provide a basis for selecting a heretofore unknown T lymphocyte precursor cell. Loken gives no guidance as to the expected characteristics of any T lymphocyte precursor cell and, therefore it follows that he does not provide any expectation of the successful isolation of the present cell population. Accordingly, absent a teaching or suggestion as to even the existence of a T cell line which is characterized as being CD34<sup>+</sup>, CD7<sup>+</sup>, and Leu 8<sup>+</sup>, we find that the examiner has not established that the claimed invention would have been obvious to one of ordinary skill in the art at the time the present application was filed. Instead, it appears that the examiner is confusing the level of skill in the art with the teachings of the prior art. *In re Kratz*, 592 F.2d 1169, 1175, 201 USPQ 71, 76 (CCPA 1979), ("[T]here is a difference between somehow substituting skill in the art for statutory prior art, as the PTO attempts here, and using that skill to interpret prior art.").

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Since we find no basis in the prior art for selecting the present T cell population, the rejection under 35 U.S.C. § 103 is reversed.

The decision of the examiner is reversed.

*Richard E. Schafer*  
Richard E. Schafer, Vice Chief )  
Administrative Patent Judge )

*William F. Smith*  
William F. Smith )  
Administrative Patent Judge )

*J. Ellis*  
Joan Ellis )  
Administrative Patent Judge )

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