

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEKSEY ZAKS
and AKIVA T. GROSS

Appeal No. 94-1707
Application 07/345,622¹

ON BRIEF

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges and
McKELVEY, Senior Administrative Patent Judge.

William F. Smith, Administrative Patent Judge.

¹ Application for patent filed May 1, 1989.

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DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 12 through 19 and 29 through 31, all the claims remaining in the application.

Claim 12 is illustrative of the subject matter on appeal and reads as follows:

12. A process for producing omega-3 unsaturated fatty acid enriched 2-monoglycerides, comprising the steps of:

- a) combining an alcohol medium, a triglyceride which is a marine oil containing omega-3 unsaturated fatty acids, a lipase catalyst and an amount of water sufficient to activate the lipase, under conditions sufficient for transesterification to occur between the alcohol and the fatty acids located on the 1- and 3-positions of the triglyceride, thereby producing 2-monoglycerides containing omega-3 fatty acids;
- b) contacting the monoglycerides obtained in (a) with an organic solvent to preferentially dissolve unsaturated monoglycerides therein and reducing the temperature of the solution of monoglycerides to precipitate monoglycerides containing saturated fatty acids, thereby leaving a supernatant containing 2-monoglycerides having omega-3 unsaturated fatty acids that is substantially free of saturated monoglycerides;
- c) separating the precipitate obtained in (b) from the supernatant; and
- d) removing the solvent from the supernatant to obtain 2-monoglycerides enriched in omega-3 unsaturated fatty acids compared to natural marine oils.

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The examiner relies upon the following references:²

Mendy et al. (Mendy)	4,607,052	Aug. 19, 1986
Rubin et al. (Rubin)	4,792,418	Dec. 20, 1988
Sunazaki et al. (Sunazaki) (Japanese Kokai Patent)	6,078,587	May 04, 1985
Choo et al. (Choo) (United Kingdom Patent)	2,188,057	Sep. 23, 1987
Gancet et al. (Gancet) (French Patent)	2,617,501	Jan. 06, 1989
Tanaka et al. (Tanaka) (Japanese Kokai Patent)	1,215,286	Aug. 29, 1989

Borgstrom, "Hydrolysis and Synthesis of Glyceride Ester Bonds Catalyzed by Pancreatic Lipase," Biochim. Biophys. Acta, vol. 84, pp. 228-230 (1964).

Markley, "Techniques of Separation, Part 3, A: Distillation, Salt Solubility, Low Temperature Crystallization," Interscience, pp. 2080-2125 (1964).

Lazar, et al. (Lazar), "Synthesis of Esters by Lipases," World Conference of Emerging Technology of Fats and Oils Industry, pp. 346-354 (1985).

Chemical Abstracts, vol. 109, p. 508 (1988).³

² The examiner apparently relied only upon English language abstracts of the Sunazaki, Gancet and Tanaka patent documents. We have obtained the full text documents and had them translated into the English language. A copy of each translation is enclosed with this decision.

³ The examiner has not retrieved and considered the full text document which is abstracted in this citation.

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The examiner also cites the following reference as “relevant but not relied upon”:

Yongmanitchai et al. (Yongmanitchai), “Omega-3 Fatty Acids: Alternative Sources of Production,” Process Biochemistry, vol. 24, pp. 117-124 (1989).

Finally, the examiner cites a “new reference” for the purpose of reinforcing

“arguments that certain facts are old and well known in the art”:

Pavia et al. (Pavia), “Introduction to Organic Laboratory Techniques a Contemporary Approach,” W. B. Saunders Co., pp. 482-484 (1982).

Claims 12 through 19 and 29 through 31 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over the claims of co-pending Application 07/942,476. Claims 12 through 19 and 29 through 31 stand rejected under 35 U.S.C. § 112, first paragraph, as being non-enabled. Finally, claims 12 through 19 and 29 through 31 stand rejected under 35 U.S.C. § 103 as unpatentable over Lazar in view of Choo, Sunazaki, Gancet, Borgstrom, and further in view of the Chemical Abstract citation, Tanaka, Mendy, Rubin and Markley.

We reverse the rejections based upon obviousness-type double patenting and lack of enablement and vacate the rejection under 35 U.S.C. § 103. We remand the application to the examiner for further consideration.

OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

The referenced co-pending application issued as U.S. Patent No. 5,316,927 (‘927 patent). Thus, the obviousness-type double patenting rejection is no longer provisional. In

stating the rejection on pages 4-5 of the Examiner's Answer,⁴ the examiner determined that the process claimed in the '927 patent uses as one of the starting materials a "triglyceride" while the corresponding starting material in the process claimed in this application is "marine oil." Having made that determination, the examiner concluded that this "starting material [marine oil] is different in degree, it does not differ in kind." Perhaps understanding that more than that statement was needed to establish that the claimed process in this application is an obvious variation of that claimed in the '927 patent, the examiner went on to explain in the paragraph bridging pages 4-5 of the Examiner's Answer why the newly cited reference to Yongmanitchai supports his position. However, the examiner, in citing Yongmanitchai at page 3 of the Examiner's Answer, expressly stated that the "reference is relevant but not relied upon." To be fair to applicant, we will take the examiner at his word when he states that Yongmanitchai is "not relied upon." The examiner's conclusion of obviousness reached in this rejection is bereft of factual support. Accordingly, we reverse the obviousness-type double patenting rejection.

⁴ The Examiner's Answer is incorrectly paginated. Our reference to page numbers in the Examiner's Answer is based upon an assignment of the number 1 to the first page of the document with subsequent pages being assigned the next higher positive integer. The document consists of 19 pages.

ENABLEMENT REJECTION

We reverse this rejection for the well stated reasons which appear on pages 5-6 of the Appeal Brief.

PRIOR ART REJECTION

We vacate this rejection because the statement of the rejection which appears on pages 6-12 of the Examiner's Answer is not susceptible to a meaningful review. The examiner has rejected all of the claims as a group on the basis of a combination of ten references. The examiner has not applied the disclosure of any individual reference to the requirements of any individual claim. Rather, the examiner, in stating the rejection, described the claimed subject matter in a single sentence, tersely described each of the ten references relied upon and reached the following conclusion:

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Lazar et al. in view of Choo et al., Lion Corp., Gancet et al., and Borgstrom and further in view of [Chemical Abstracts], Nippon Oils and Fats, Mendy et al., Rubin et al., and Markley to produce 2-monoglycerides enriched in T-3 fatty acids in reasonably high yields by lipase catalyzed alcoholysis (transesterification) of appropriate triglycerides and purify them by low temperature fractional crystallization. The motivation to produce the 2-monoglycerides is based on their benefit to health and absorption by humans.

The remainder of the statement of the rejection lacks any substance.

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Despite ten references being relied upon and a six page statement of rejection, we can not discern why any single claim pending in this application is considered by the examiner to have been obvious under 35 U.S.C. § 103. The statement of the rejection amounts to no more than the examiner's conclusion that the ten references render the claimed subject matter obvious. A more detailed, fact based explanation is needed. Accordingly, we vacate the rejection.

REMAND

Upon return of the application, the examiner should reconsider his position regarding the obviousness of the claimed invention. If that reconsideration results in the examiner determining that the subject matter of any individual claim on appeal is unpatentable under 35 U.S.C. § 103, the examiner should issue an appropriate Office action stating that rejection. If a further rejection under 35 U.S.C. § 103 is made, we urge the examiner to follow the model set forth in MPEP § 706.02(j). Adherence to this model would result to a more coherent, understandable statement of the rejection.

In reconsidering the patentability of the claimed subject matter under 35 U.S.C. § 103, the examiner should base his analysis on full text, translated documents, not abstracts. Obviousness determinations under 35 U.S.C. § 103 are fact specific. Limiting one's consideration of a document to an abstract when the more fact filled full text document is readily available is improper. Thus, the examiner should consider the

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translations we have obtained of the foreign language patent documents previously relied upon. The examiner should also obtain and have translated the full text patent document which is abstracted in the Chemical Abstracts citation previously relied upon.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01(d) (6th ed., rev.2, July 1996). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED-IN-PART; VACATED-IN-PART; REMANDED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
FRED E. McKELVEY)	
Senior Administrative Patent Judge)	

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David E. Brook
Hamilton, Brook, Smith & Reynolds
Two Militia Drive
Lexington, MA 02173