

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 PETER A. VANDENBERGH, SHIRLEY A. WALKER
and BLAIR S. KUNKA

MAILED

DEC 30 1996

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 94-2059
Application 07/840,503¹

ON BRIEF

Before WINTERS, GRON and WEIMAR, Administrative Patent Judges.
WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision refusing to allow claims 22 and 24-31. Claims 1-21, which are the only

¹ Application for patent filed February 24, 1992. According to appellants, this application is a continuation-in-part of Application 07/492,969 filed March 13, 1990, now abandoned.

Appeal No. 94-2059
Application 07/840,503

other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

Representative Claim

Claim 22, which is illustrative of the subject matter on appeal, reads as follows:

22. A method for producing a bacteriocin in a growth medium which comprises:

(a) culturing live cells of *Lactococcus lactis* NRRL-B-18535 in a growth medium for the cells so as to produce the bacteriocin in the growth medium, and wherein the bacteriocin contains a protein having a molecular weight of about 6000 daltons, is inactivated by protease V and not inactivated by alpha-chymotrypsin, trypsin, lipase, pepsin and lysozyme, wherein the bacteriocin inhibits the growth of bacteria selected from the group consisting of *Staphylococcus aureus*, *Staphylococcus epidermidis*, *Staphylococcus carnosus*, *Pediococcus pentosaceus*, *Pediococcus acidilactici*, *Lactococcus cremoris*, *Lactococcus lactis*, *Leuconostoc mesenteroides*, *Lactobacillus bulgaricus*, *Lactobacillus fermentum*, *Lactobacillus bif fermentans*, *Lactobacillus plantarum* and *Listeria monocytogenes* and has a pH for inhibition between about pH 2 and 8; and

(b) separating the bacteriocin in the growth medium from the cells.

Appeal No. 94-2059
Application 07/840,503

The Reference

The prior art reference cited and relied on by the examiner is:

Geis et al. (Geis), "Potential of Lactic Streptococci to Produce Bacteriocin," Applied and Environmental Microbiology, Vol. 45, No. 1, pp. 205-211 (January 1983).

The Issues

In the final rejection, paper No. 6, pages 2 and 3, the examiner rejected claims 22 and 24-31 under 35 U.S.C. 112, first paragraph, as based on a non-enabling disclosure. At pages 3 and 4 of the final rejection, the examiner further rejected claims 22 and 24-31 under 35 U.S.C. 112, first and second paragraphs. Those rejections have been withdrawn. See the advisory action, paper No. 12, and see the answer, page 2, section (4) entitled "Issues."

The issues remaining for review are: (1) whether the examiner erred in rejecting claims 22², 24 and 26 under 35 U.S.C.

² In the answer, page 3, line 17, the reference to canceled claim 23 constitutes an inadvertent error. See the final
(continued...)

Appeal No. 94-2059
Application 07/840,503

112, second paragraph, as indefinite; (2) whether the examiner erred in rejecting claims 22 and 24-28 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as unpatentable over Geis; and (3) whether the examiner erred in rejecting claims 29-31³ under 35 U.S.C. 103 as unpatentable over Geis.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including Figure 1, and all of the claims on appeal; (2) appellants' brief before the Board; (3) the examiner's answer; (4) the Geis reference; (5) the Vandenberg declaration, filed in parent Application Serial No. 07/492,969 under the provisions of 37 CFR 1.132, executed July 16, 1991; and

²(...continued)
rejection, page 4, line 13.

³ In the answer, page 6, line 3, the reference to canceled claim 32 constitutes another examiner error. See the final rejection, page 5, line 15.

Appeal No. 94-2059
Application 07/840,503

(6) the Vandenberg "supplemental" declaration, filed in this application under the provisions of 37 CFR 1.132, executed March 8, 1993.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 102(b) and 35 U.S.C. 103.

35 U.S.C. 112, Second Paragraph

According to the examiner, claims 22, 24 and 26 are "essential" duplicates. See the answer, page 3, line 21. Manifestly, however, these claims differ in scope and are not duplicates. Each claim differs from the others with respect to the scope of the subject matter sought to be patented. The claims are not identical. Nor is this a situation where the invention is obscured by a large number of claims. Accordingly, a rejection on the ground of multiplicity is improper. See the Manual of Patent Examining Procedure (M.P.E.P.), section 2173.05(n) (6th edition, revision 2, July 1996).

Appeal No. 94-2059
Application 07/840,503

Even assuming arguendo that the claims did not differ in scope, and we hold that they do, nevertheless, the examiner's rejection under 35 U.S.C. 112, second paragraph, would not be sustainable. As stated in Tandon Corp. v. U.S. International Trade Commission, 831 F.2d 1017, 1023, 4 USPQ2d 1283, 1288 (Fed. Cir. 1987) (citation omitted):

At the same time, practice has been long recognized that "claims may be multiplied...to define the metes and bounds of the invention in a variety of different ways." Thus two claims which read differently can cover the same subject matter.

Furthermore, attention is invited to Hormone Research Foundation Inc. v. Genentech Inc., 904 F.2d 1558, 1567 n. 15, 15 USPQ2d 1039, 1047 n. 15 (Fed. Cir. 1990), where the court stated:

It is not unusual that separate claims may define the invention using different terminology, especially where (as here) independent claims are involved.

Simply stated, the examiner has not sustained her initial burden of establishing that claims 22, 24, and 26 are prima facie indefinite within the meaning of 35 U.S.C. 112, second paragraph.

Appeal No. 94-2059
Application 07/840,503

The rejection of those claims under that statutory provision is reversed.

35 U.S.C. 102(b) / 35 U.S.C. 103

In rejecting all of the appealed claims on prior art grounds, the examiner focuses attention on these specific bacteriocin-producing strains disclosed by Geis, namely, *S. lactis* 5D8, 6F3 and 6F5. See particularly the Geis reference, page 207, Table 2; page 208, Table 3; and page 209, Table 4. According to the examiner, "[t]hese strains are indistinguishable from appellants' claimed strain [*L. lactis* NRRL-B-188535]" and "the bacteriocin produced by the strains [those of Geis and appellants] appears to be the same." See the answer, page 4, first full paragraph. The examiner further argues that *S. lactis* 5D8, 6F3 and 6F5 "produce bacteriocins which are not patentably distinct, if not identical, to appellants' bacteriocin" and "the bacteriocins produced by the designated strains ... possess a spectra of inhibitory activity as 'broad' as appellants' claimed

Appeal No. 94-2059
Application 07/840,503

bacteriocin." See the answer, paragraph bridging pages 6 and 7.

We disagree.

To the extent that the examiner's rejection is predicated on 35 U.S.C. 102(b) (claims 22 and 24-28), we find that (1) the prior art strains 5D8, 6F3 and 6F5 are not identical to appellants' strain *L. lactis* NRRL-B-18535, and (2) the bacteriocins produced by strains 5D8, 6F3 and 6F5 are not identical to the bacteriocin recited in appellants' claims. This follows from a comparison of appellants' specification and claims with the Geis disclosure. The claimed method comprises culturing live cells of *L. lactis* NRRL-B-18535 to produce a bacteriocin, wherein the bacteriocin inhibits the growth of a wide spectrum of bacteria including, inter alia, *S. aureus*. In contrast, Geis discloses that the bacteriocins produced from *S. lactis* 5D8, 6F3 and 6F5 possess no activity against *S. aureus*. See the Geis reference, page 209, Table 4. Thus, the prior art strains produce bacteriocins which do not inhibit the growth of *S. aureus* whereas appellants' strain produces a bacteriocin which inhibits

Appeal No. 94-2059
Application 07/840,503

the growth of *S. aureus*. It follows that the method disclosed by Geis is not identical to the claimed method.

In the answer, page 5, first paragraph, the examiner argues that "[t]he negative reaction with *S. aureus* [reported by Geis in Table 4] may be due to differences in assay conditions as well as the specific *S. aureus* strains tested." That assessment, however, is speculation. Where, as here, appellants disclose and claim a method of producing a bacteriocin which inhibits the growth of *S. aureus* and Geis specifically discloses a bacteriocin showing no activity against *S. aureus*, the Geis disclosure does not support a finding of prima facie anticipation or shift the burden of persuasion to appellants to rebut any such prima facie case. See the answer, page 5, second paragraph. The rejection of claims 22 and 24-28 under 35 U.S.C. 102(b) as anticipated by Geis is reversed.

Respecting the rejection of claims 22 and 24-31 under 35 U.S.C. 103, we begin with the statute which requires consideration of the claimed subject matter as a whole. As

Appeal No. 94-2059
Application 07/840,503

stated in M.P.E.P. section 2116.01 (6th edition, revision 2, July 1996), all the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim.

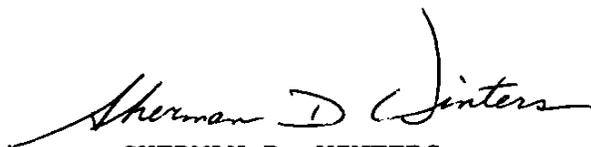
Here, for the reasons previously set forth, the prior art does not establish that strains 5D8, 6F3 and 6F5 are identical to appellants' strain *L. lactis* NRRL-B-18535. The bacteriocins produced by strains 5D8, 6F3 and 6F5 are not identical to the bacteriocin recited in appellants' claims. Furthermore, the Geis reference provides no suggestion which would have led a person having ordinary skill in the art from "here to there," i.e., from the Geis method for producing bacteriocins to the claimed method for producing another bacteriocin. See Ex parte Tanksley, 37 USPQ2d 1382, 1386 (Bd. Pat. App. & Int. 1994). Nor does the examiner rely on any other prior art reference or references which would cure the above-noted deficiency of Geis. The rejection of claims 22 and 24-31 under 35 U.S.C. 103 as unpatentable over Geis is reversed.

Appeal No. 94-2059
Application 07/840,503

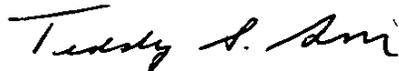
Conclusion

In conclusion, for the reasons expressed in the body of this opinion, we reverse the examiner's rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 102(b) and 35 U.S.C. 103. The examiner's decision refusing to allow claims 22 and 24-31, is reversed.

REVERSED



SHERMAN D. WINTERS)
Administrative Patent Judge)



TEDDY S. GRON)
Administrative Patent Judge)

BOARD OF PATENT
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ELIZABETH C. WEIMAR)
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Appeal No. 94-2059
Application 07/840,503

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