

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNST BEUTLER, LEUKA FAVRE-GALLIAND,
JOHANN ILLI and ANDREAS SUTTER

Appeal No. 95-1151
Application No. 07/965,202¹

HEARD: May 8, 1998

Before WINTERS, HANLON and WEIMAR, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This appeal is from a decision of the primary examiner rejecting claims 11 through 31 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Donikian (French Patent Application No. 2,073,279), Broome et al. (The

¹ Application for patent filed October 23, 1992.

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Australian Journal of Dairy Technology, Dec. 1982, pages 139-42), Bosworth (U.S. Patent No. 1,450,836), and Klupsch (U.S. Patent No. 4,435,432). Claims 32 through 34, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

On consideration of the record, including applicants' Appeal Brief (Paper No. 12), the Examiner's Answer (Paper No. 13), the Reply Brief (Paper No. 16), and the Supplemental Reply Brief (Paper No. 19), it is

ORDERED that the examiner's decision rejecting claims 11 through 31 is reversed.

Independent claim 11 requires the use of "a strain of L. helveticus which exclusively forms lactic acid L(+)." Manifestly, the prior art relied on by the examiner is insufficient to support a conclusion of obviousness of claims containing that limitation. The cited prior art does not disclose or suggest a strain of L. helveticus which exclusively forms lactic acid L(+). Accordingly, the cited prior art does not reach applicants' claimed process requiring

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the use of that strain or the claimed product containing that strain.

One further point warrants attention. On return of this application to the Examining Corps, we recommend that both applicants and the examiner consider the following passage in the specification, page 5, lines 13 through 20:

In each embodiment of the process according to the invention, the S. thermophilus strain(s) may be selected, for example, from the strains marketed for the production of yogurts or isolated from yogurts. The L. helveticus strain may be selected for its ability to exclusively form lactic acid L(+), for example from the strains marketed for the production of cheese or acidified [sic] milk or isolated from cheeses or acidified milks. [Emphasis added.]

Does this mean to say that a strain of L. helveticus which exclusively forms lactic acid L(+) was known in the art at the time applicants' invention was made? Do applicants acknowledge that the recited strain of L. helveticus which exclusively forms lactic acid L(+) was a known strain, marketed for the production of cheese or acidified milk at the time their invention was made? In our judgment, these questions are relevant to the patent-ability of applicants' claimed subject matter and should be explored, in the first instance, by the examiner.

REVERSED

