

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM H. WOLLER and DAVID P. JONES

Appeal No. 95-2179
Application No. 07/994,536¹

HEARD: November 2, 1998

Before WINTERS, WILLIAM F. SMITH and WALTZ, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 13, which are all of the claims in this application.

¹ Application for patent filed December 21, 1992.

Appeal No. 95-2179
Application No. 07/994,536

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1.

A wound dressing composition consisting essentially of:
from about 40 percent to 80 percent by weight of blended glycerin polyacrylate clathrate [sic, clathrate], and;
from about 10 percent to 50 percent of glycerin as a compatible,
non toxic [sic, nontoxic] polyhydric alcohol.

The reference relied on by the examiner is:

Georgalas et al. (Georgalas) 4,837,019 June 6, 1989

The issue presented for review is whether the examiner erred in rejecting claims 1 through 13 under 35 U.S.C. § 103 as unpatentable over Georgalas.

OPINION

We shall not sustain this rejection.

First, 35 U.S.C. § 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. § 103, the examiner should set forth (1) the relevant teachings of the prior art relied on, (2) the difference or differences in the

Appeal No. 95-2179
Application No. 07/994,536

claim over the applied reference, (3) the proposed modification of the applied reference necessary to arrive at the claimed subject matter, and (4) an explanation why a person having ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. See Manual of Patent Examining Procedure (MPEP) § 706.02(j) (7th ed., July 1998), setting forth the contents of a 35 U.S.C. § 103 rejection. The examiner has not followed that format here.

According to the examiner, Georgalas discloses each component of appellants' wound dressing composition but does not disclose appellants' percentages of ingredients. As stated by the examiner,

Georgalas does not disclose applicant's [sic, applicants'] percentages of ingredients, however, one of ordinary skill in the art would have been motivated to experiment with varying ratios of ingredients in order to optimize expected beneficial results. [Examiner's Answer, page 3, lines 4 through 7].

Manifestly, that statement of rejection does not comply with MPEP § 706.02(j). The statement does not explain how a person having ordinary skill in the art would have been led from "here to there," i.e., from the skin treatment composition and

Appeal No. 95-2179
Application No. 07/994,536

method for treating burned skin disclosed by Georgalas to the wound dressing composition and method of treating superficial wounds

claimed by the appellants. Therefore, on procedural grounds alone, we reverse the rejection under 35 U.S.C. § 103.

Second, the examiner discounts appellants' contribution, stating that "one of ordinary skill in the art would have been motivated to experiment with varying ratios of ingredients in order to optimize expected beneficial results." This appeal, however, is not about "optimization." The portion of Georgalas relied on by the examiner discloses at most about 20 percent by weight of Lubrajel, whereas independent claims 1 and 12 recite "about 40 percent to 80 percent by weight" or "40 to 80 percent by weight" of blended glycerin polyacrylate clathrate. Independent claim 7 recites "about 40 to 80 percent by weight of blended glycerin polyacrylate."² This leaves a significant difference between the upper limit disclosed by the prior art (about 20 percent by weight of Lubrajel) and the lower limit recited in the appealed claims

² For the purposes of this appeal, the examiner argues, and appellants do not disagree, that "blended glycerin polyacrylate clathrate" or "blended glycerin polyacrylate" reads on Lubrajel.

Appeal No. 95-2179
Application No. 07/994,536

(about 40 percent by weight of blended glycerin polyacrylate clathrate recited in claim 1; about 40 percent by weight of blended glycerin polyacrylate recited in claim 7; and 40 percent by weight of blended glycerin polyacrylate clathrate recited in claim 12). In this appeal, the examiner has not accounted for that difference and cannot do so merely by referring to "optimization." The examiner has not established that the cited prior art provides guidelines or direction which would have led a person having ordinary skill to the claimed subject matter, including the amount of blended glycerin polyacrylate clathrate or blended glycerin polyacrylate. For this reason too, we reverse the rejection under 35 U.S.C. § 103. Cf. In re Sebek, 465 F.2d 904, 907, 175 USPQ 93, 95 (CCPA 1972) (while it may ordinarily be the case that the determination of optimum values for the parameters of a prior art process would be at least prima facie obvious, that conclusion depends on what the prior art discloses with respect to those parameters. Where the prior art disclosure suggests the outer limits of the range of suitable values, and that the optimum resides within that

Appeal No. 95-2179
Application No. 07/994,536

range, the determination of optimum values outside that range may not be obvious).

Where, as here, the examiner has not established a prima facie case of obviousness, we find it unnecessary to discuss the Rule 132 Declaration of David P. Jones, executed September 10, 1993, or the Supplemental Rule 132 Declaration of David P. Jones, executed February 1, 1994.

OTHER ISSUES

On return of this application to the Examining Corps, we recommend that the examiner step back and reevaluate patentability in light of the following issues.

First, it would not appear that claims 5, 6 and 10 particularly point out and distinctly claim the subject matter which the applicants regard as their invention. 35 U.S.C. § 112,

Appeal No. 95-2179
Application No. 07/994,536

second paragraph. Dependent claim 5 does not recite a wound dressing composition of claim 4 wherein the preservative component is selected from the group consisting of methylparaben, propylparaben, imidurea, diazolidnyl urea, and quaterium 15. Rather, claim 5 recites "[t]he preservative component of claim 4 wherein said component is selected from the group consisting of: methylparaben, propylparaben, imidurea, diazolidnyl urea, and quaterium 15" (emphasis added). The difference in the preamble "a wound dressing composition" and "the preservative component" is significant because it would appear that claim 5 defines only one component of the overall composition, namely, the preservative component. The same infirmity applies to claims 6 and 10.

Second, as a matter of claim interpretation, it is unclear whether appellants' glycerin polyacrylate reads on Lubrajel. Based on our review of the specification, it appears that glycerin polyacrylate is a clathrate derived from glycerin and acrylic acid polymer (specification, page 6, last paragraph). Lubrajel is a clathrate formed by the reaction of glycerin and methylmethacrylate (Georgalas, column 2, lines 52 and 53). It would appear, therefore, that (1) appellants' glycerin

Appeal No. 95-2179
Application No. 07/994,536

polyacrylate is based on acrylic acid whereas Lubrajel is
based

Appeal No. 95-2179
Application No. 07/994,536

on methacrylic acid, and (2) these components are related but mutually exclusive. On return of this application to the Examining Corps, we recommend that the examiner determine whether glycerin polyacrylate does or does not include Lubrajel.

Third, if glycerin polyacrylate reads on Lubrajel, it would appear that the examiner has overlooked anticipatory prior art. We refer to the Georgalas disclosure of Blend II, containing approximately 62 percent by weight Lubrajel and approximately 38 percent by weight glycerin (Georgalas, column 7, lines 20 through 25). The Blend II ingredients are apparently mixed together first, before they are added to Blend I during preparation of the skin treatment composition in EXAMPLE 1 of Georgalas (column 7, lines 64 and 65). We also refer to U.S. Patent No. 4,781,923 issued November 1, 1988, to Pellico. EXAMPLE 4 of that patent contains 5.6 parts by weight Lubrajel, 5.6 parts by weight glycerin, and 1.0 parts by weight hydrogen peroxide. In other words, in EXAMPLE 4, Pellico discloses a composition containing approximately 46 percent by weight Lubrajel, approximately 46 percent by weight

Appeal No. 95-2179
Application No. 07/994,536

glycerin, and approximately 8 percent by weight hydrogen peroxide.

On return of this application to the Examining Corps, we recommend that the examiner reevaluate patentability of the

Appeal No. 95-2179
Application No. 07/994,536

claimed subject matter in light of the Georgalas disclosure of Blend II and the Pellico disclosure of an antiseptic gel in EXAMPLE 4.

Fourth, if the examiner determines that glycerin polyacrylate does not read on Lubrajel, nevertheless, it would appear that these ingredients are closely related. Again, we recommend that the examiner reevaluate patentability of the claimed subject matter in light of the Georgalas disclosure of Blend II and the Pellico disclosure of an antiseptic gel in EXAMPLE 4. If the examiner determines that glycerin polyacrylate and Lubrajel are structurally related, but not identical, the foregoing passages of Georgalas and Pellico would nevertheless be relevant in evaluating the patentability of claims 1 through 13 even if those passages do not constitute anticipatory prior art within the meaning of 35 U.S.C. § 102.

CONCLUSION

In conclusion, we reverse the examiner's rejection of claims 1 through 13 under 35 U.S.C. § 103. On return of this application to the Examining Corps, we recommend that the examiner step back and reevaluate patentability of the claimed subject matter in light of the issues outlined above.

Appeal No. 95-2179
Application No. 07/994,536

We express our concern and dismay that an examiner in the United States Patent and Trademark Office would forward to appeal a case in this state of disrepair. The single rejection presented on appeal is clearly erroneous. A number of substantive issues have not been addressed. We point out that the Board of Patent Appeals and Interferences is an appellate tribunal, not charged with the responsibility of examining patent applications de novo. On these facts, we can only reverse the single rejection presented and return this case to the Examining Corps with a recommendation that the application be thoroughly and properly examined, taking into account the "other issues" outlined in this opinion.

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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WILLIAM F. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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THOMAS A. WALTZ)	

Appeal No. 95-2179
Application No. 07/994,536

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Appeal No. 95-2179
Application No. 07/994,536

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