

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 95-4435
Application No. 07/833,146¹

ON BRIEF

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

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 3 through 7, 10 through 14, 22 and 23. Claims 15 through 21, which are the only other claims

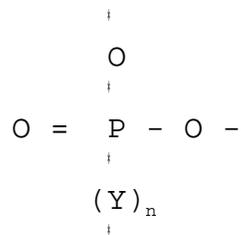
¹ Application for patent filed February 10, 1992.

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remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

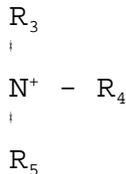
Claim 22, which is illustrative of the subject matter on appeal, reads as follows:

22. An oligonucleotide wherein at least one nucleotide unit of said oligonucleotide [sic, oligonucleotide] includes a phosphate moiety having the following structural formula:



A⁻ - CH - M⁺, wherein n is 0 or 1; and
Y is:

(Z)_p-R₁, wherein R₁ is a hydrocarbon, p is 0 or 1, and Z is oxygen, sulfur, or NR₂, wherein R₂ is hydrogen or a hydrocarbon; M⁺ is:



wherein each of R₃, R₄, and R₅ is hydrogen or a hydrocarbon, and each of R₃, R₄, and R₅ may be the same or different, and A⁻ is selected from the group consisting of COO⁻, SO₃⁻, and PO₃²⁻.

As stated in the Examiner's Answer, page 2, sections (7) and (8), the examiner does not rely on any prior art of

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record, nor does the examiner cite or rely on new prior art, in rejecting the claims on appeal.²

The issue presented for review is whether the examiner erred in rejecting claims 3 through 7, 10 through 14, 22 and 23 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure.

DISCUSSION

We shall not sustain this rejection.

We have carefully considered the position of the examiner, as set forth in the Examiner's Answer, but find that such is based on clearly erroneous fact-finding. For example, the examiner states that "[w]hen, as in this case, the only utility in the specification is in the treatment of humans, the claimed compounds are held to the same standard of enablement as said method of treatment claims" (Examiner's Answer, page 5, first paragraph of section (10) Response to Arguments, emphasis added). Compare the following statement in the specification, page 7, lines 1 through 6:

² The record copy of the Examiner's Answer is not paginated. For the sake of convenience, we have numbered the pages running from 1 through 8.

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The oligonucleotides may be used in vitro or in vivo for modifying the phenotype of cells, or for limiting the proliferation of pathogens such as viruses, bacteria, protists, Mycoplasma species, Chlamydia or the like, or for inducing morbidity in neoplastic cells or specific classes of normal cells.

Manifestly, the specification describes in vitro utilities, contrary to the examiner's characterization. Where, as here, a legal conclusion of non-enablement is based on clearly erroneous fact-finding, the legal conclusion cannot stand.

Furthermore, the Examiner's Answer is internally inconsistent and procedurally flawed. In the Answer, page 2, sections (7) and (8), the examiner states that no prior art of record is relied on, nor is any new prior art cited or relied on in rejecting the appealed claims. Nevertheless, in the Examiner's Answer, paragraph bridging pages 6 and 7, and in the first full paragraph of page 7, the examiner makes reference to the "Uhlmann et al." publication. In the Examiner's Answer, the examiner does not provide a citation for "Uhlmann et al.," nor is it clear from the record just what this publication is. Apparently, the examiner does rely on it. This, in and of itself, constitutes reversible error.

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Finally, appellants rely on seven publications cited and submitted with the Information Disclosure Statement accompanying their Appeal Brief. In the Examiner's Answer, page 7, first full paragraph, the examiner states that these publications have been "fully considered." Nevertheless, in the communication mailed July 22, 1996 (Paper No. 22), the examiner states that "[t]he references listed on the Information Disclosure Statement filed August 5, 1994 along with the Brief have not been considered" (emphasis added). Again, the examiner's position is inconsistent and procedurally flawed.

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
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HUBERT C. LORIN)	

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