

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD W. NICHOLSON

Appeal No. 1996-2229
Application 08/196,748

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 1 through 4, which are all of the claims in the application.

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

1. LTC₄ synthase, in substantially free form, having a molecular weight of 18 kDa as determined on silver stained SDS-polyacrylamide denaturing gel.

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The references relied on by the examiner are:

Yoshimoto et al. (Yoshimoto)(SS), "Isolation and Characterization of Leukotriene C₄ Synthetase of Rat Basophilic Leukemia Cells," 80 Proc. Natl. Acad. Sci., USA, 8399-8403 (1985).

Yoshimoto et al. (Yoshimoto)(RR), "Properties of Highly Purified Leukotriene C₄ Synthase of Guinea Pig Lung," 81 J. Clin. Invest., 866-71 (1988).

Söderström et al. (Söderström)(TT), "Leuktriene C₄ Synthase: Characterization in Mouse Mastocytoma Cells, 187 Methods in Enzymology, 306-12 (1990).

Söderström et al. (Söderström)(U), "On the Nature of Leukotriene C₄ Synthase in Human Platelets," 294 Archives of Biochemistry and Biophysics, 70-74 (1992).

In the Appeal Brief, page 6, appellant relies on the following

reference:

Nicholson et al. (Nicholson), "Purification of Human Leukotriene C₄ Synthase from Dimethylsulfoxide-Differentiated U937 Cells," 209 Eur. J. Biochem., 725-34 (1992).

Claims 1 through 4 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1 through 4 also stand rejected under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over

Söderström (U), Yoshimoto (RR), Yoshimoto (SS), or Söderström (TT).

On consideration of the record, we reverse the examiner's rejection under 35 U.S.C. § 112, second paragraph. We remand the rejections under 35 U.S.C. § 102 or, in the alternative, 35 U.S.C. § 103.

CLAIM INTERPRETATION

As stated in Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987), the decisional process en route to a conclusion under 35 U.S.C. § 103 begins with a key legal question -- what is the invention claimed? The decision maker is required to view the claimed invention as a whole. 35 U.S.C. § 103. Claim interpretation, in light of the specification, claim language, other claims, and prosecution history, is a matter of law and will normally control the remainder of the decisional process.

Independent claim 1 reads as follows:

1. LTC₄ synthase, in substantially free form, having a molecular weight of 18 kDa as determined on silver stained SDS-polyacrylamide denaturing gel.

Giving that claim its broadest reasonable interpretation consistent with the specification, we conclude that the claim is

drawn to purified LTC₄ synthase where the enzyme is purified to homogeneity. See particularly, these passages in the specification: Abstract of the Disclosure; Summary of the Invention, page 2, lines 13-16; and Example 1 at page 21, where a single polypeptide of 18 kDa is obtained on silver stained SDS-polyacrylamide denaturing gels.

In our judgment, claim 1, read in light of the application disclosure, reasonably apprises those skilled in the art that appellant's invention is LTC₄ synthase purified to homogeneity and substantially free of other contaminants. That is the broadest reasonable interpretation of the claim language "LTC₄ synthase, in substantially free form, having a molecular weight of 18 kDa as determined on silver stained SDS-polyacrylamide denaturing gel."

35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1 through 4 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite in view of the phrase "in substantially free form." This rejection is reversed. For the reasons already discussed, we conclude that appellant's claims are drawn to LTC₄ synthase purified to homogeneity, having a molecular weight of

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18 kDa as determined on silver stained SDS-polyacrylamide denaturing gel, and substantially free of other contaminants. The claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore,

439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

35 U.S.C. §§ 102/103

Claims 1 through 4 stand rejected under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over Söderström (U), Yoshimoto (RR), Yoshimoto (SS), or Söderström (TT). In entering these rejections, the examiner does not designate any particular passage or passages relied on in the cited references. See 37 CFR § 1.104(c)(2), which states:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. [emphasis added]

This the examiner has not done. Nor does the appellant discuss specific portions or passages of the cited references. For this

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reason, the briefings on appeal are incomplete and the prior art rejections are not ready for a disposition on appeal.

In the Appeal Brief, page 6, appellant relies on the Nicholson reference as evidence of non-obviousness. The examiner, however, does not counter with any argument or response. This constitutes procedural error and, again, leaves the Board with incomplete briefings on appeal. As stated in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986),

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. [citation omitted]

This the examiner has not done.

On return of this application to the examining corps, we recommend that the examiner reevaluate the patentability of claims 1 through 4 on prior art grounds. If the examiner adheres to the position that appellant's claims are anticipated by or, in the alternative, obvious over Söderström (U), Yoshimoto (RR), Yoshimoto (SS), or Söderström (TT), the examiner should issue an

appropriate Office action setting forth the basis for that position. In so doing, the examiner should designate "as nearly as practicable" the particular part or passage of each prior art reference relied on.

37 CFR § 1.104(c)(2). Further, the examiner should provide a substantive response to appellant's reliance on Nicholson as evidence of non-obviousness. See the Appeal Brief, page 6. Further, in reevaluating the patentability of claims 1 through 4 on prior art grounds, the examiner should consider the proper interpretation of those claims as discussed in the first section of this opinion.

We remand this application to the examiner to reevaluate the patentability of claims 1 through 4 in light of the foregoing discussion. On the surface, it would appear the Yoshimoto (RR) constitutes the closest prior art in this case. This follows from the examiner's argument that Yoshimoto (RR) describes a 91-fold purification of LTC₄ synthase (Examiner's Answer, page 7) and appellant's similar description of that reference in the Appeal Brief, page 5. Therefore, on return of this application, we recommend that the examiner pay particular attention to Yoshimoto (RR). The examiner should explain why the subject matter sought to be patented in claims 1 through 4, properly

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interpreted, would have been obvious over Yoshimoto (RR), including a discussion of the most relevant passage or passages in that reference.

CONCLUSION

The rejection of claims 1 through 4 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejections of claims 1 through 4 under 35 U.S.C. §§ 102/103 are not ready for a disposition on appeal.

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We remand this application so that the examiner may reevaluate the patentability of claims 1 through 4 on prior art grounds in light of the foregoing discussion.

REVERSED and REMANDED

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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)	
Hubert C. Lorin)	
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