

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATHLEEN A. CLARKSON, EDMUND LARENAS,
SHARON SHOEMAKER and GEOFFREY L. WEISS

Appeal No. 1996-2558
Application 08/152,099¹

HEARD: January 27, 2000

Before OWENS, WALTZ and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION

This is an appeal from the examiner's final rejection of claims 1, 2, 4-7 and 22, which are all of the claims remaining in the application.

¹ Application for patent filed November 15, 1993.

THE INVENTION

Appellants claim a detergent composition comprising recited amounts of at least one surfactant and a fungal cellulase composition, wherein the fungal cellulase composition contains at least 20 wt% of one or more endoglucanase (EG) type components based on the weight of protein in the cellulase composition and is free of all exo-cellobiohydrolase (CBH) I type components. Claim 1 is illustrative and reads as follows:

1. A detergent composition comprising:

(a) from about 1 to 95 weight percent of a surfactant or a mixture of surfactants based on the weight of the detergent composition; and

(b) from about 0.01 to about 5 weight percent of a fungal cellulase composition based on the weight of the detergent composition wherein said cellulase composition comprises at least about 20 weight % of one or more EG type components based on the weight of protein in the cellulase composition and further wherein said cellulase composition is free of all CBH I type components.

THE REFERENCE

Schülein et al. (Schülein) WO 89/09259 Oct. 5,
1989
(PCT application)

THE REJECTIONS

Claims 1, 2, 4-7 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schülein and under 35 U.S.C. § 103 as being obvious over Schülein.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Rejection under 35 U.S.C. § 102(b)

Appellants' claim 1, which is the only independent claim, requires that the fungal cellulase composition is free of all CBH I type components. The examiner argues that Schülein's composition preferably contains at least 90% of an EG type component (page 5, line 35 - page 6, line 2) and that this envisions 100% (answer, page 3). The examiner further argues that Schülein's testing indicated essentially no cellobiohydrolase activity, i.e., below 0.5 PNP-Cel/mg (page 15, lines 11-12), and concludes that the tests indicated a

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complete absence of CBH I type components and that, therefore, appellants' claimed invention is anticipated by Schülein (answer, pages 3-4). The examiner's argument is not persuasive because the examiner has not established that a composition which has "essentially no cellobiohydrolase activity" as disclosed by Schülein is free of all CBH I type components as required by appellants' claim 1. Schülein' composition which has "essentially no cellobiohydrolase activity" could have some CBH I type components present, but in an amount which provides a cellobiohydrolase activity below 0.5 PNP-Cel/mg. Consequently, the examiner has not established that Schülein discloses each element of appellants' claimed composition and, therefore, has not set forth a *prima facie* case of anticipation.

Rejection under 35 U.S.C. § 103

The examiner argues that Schülein teaches that using a cellulase enzyme having a high percentage of EG type components has the advantages of fabric softening and color clarification and that, therefore, one of ordinary skill in the art would have been motivated to use in the composition

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enzymes which are low in CBH I content (answer, page 4). Even if this argument is correct, the examiner has not established a *prima facie* case of obviousness because appellants' claims require a composition which is free of all CBH I type components, not one which is merely low in CBH I content. The examiner has not explained why Schülein would have motivated one of ordinary skill in the art to make a composition which is completely free of all CBH I type components and would have provided such a person with a

reasonable expectation of success in doing so. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988); *In re Longi*, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985). Consequently, the examiner has not established a *prima facie* case of obviousness.

DECISION

The rejections of claims 1, 2, 4-7 and 22 under 35 U.S.C. § 102(b) as being anticipated by Schülein and under 35 U.S.C.

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§ 103 as being obvious over Schülein are reversed.

REVERSED

TERRY J. OWENS)
Administrative Patent Judge)
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)
) BOARD OF PATENT
THOMAS A. WALTZ)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
PETER F. KRATZ)
Administrative Patent Judge)

TJO/PGG
Leslie A. Mooi
Burns, Doane, Swecker & Mathis
The George Mason Building
Washington & Prince Sts., P.O. Box 1404
Alexandria, VA 22313-1404