

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM ALAN MARRITT

Appeal No. 2003-1010
Application 09/357,393

ON BRIEF

Before KIMLIN, WARREN and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-7, which are all of the claims in the application.

THE INVENTION

The appellant claims a process for producing polyguluronic acids wherein, because an organic base rather than an inorganic base is used to neutralize alginic acid, a solution containing 5 wt% or more of alginic acid is obtained and the polyguluronic

THE REJECTION

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Haug in combination with Doublier and Yamada.

OPINION

We reverse the aforementioned rejection. We need to address only claim 1, which is the sole independent claim.

It is undisputed that Haug, which is discussed in the appellant's specification (page 2, line 16 - page 4, line 26), discloses each step of the appellant's claim 1 except that Haug uses, in the appellant's step (a), an inorganic base rather than an organic base to neutralize the alginic acid (answer, page 4, reply brief, page 3).²

The portion of Doublier relied upon by the examiner discloses that "[t]he less easily soluble polysaccharides are the more hydrophilic ones" (page 289).

The portion of Yamada relied upon by the examiner discloses that alginic acid derivatives include salts of alginic acid and organic bases (col. 12, lines 63-66).

² The appellant states that it is the use of an organic base to neutralize the alginic acid which enables the solution to contain 5 wt% or more of alginic acid and enables the polyguluronic acid to have a degree of polymerization of less than 20 and to be substantially free of mannuronic acid (specification, page 5, lines 1-15).

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For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The examiner argues that in view of Doublrier's disclosure, "one of skill in the art would recognize that neutralization of a polysaccharide with an organic base for the formation of an organic salt would be desired to increase solubility" (answer, page 5). The examiner, however, has not pointed out where Haug teaches that increased solubility of his neutralized alginic acid is desirable. The teaching of that desirability relied upon by the examiner appears to come from the appellant's specification. Also, the examiner has not pointed out where Doublrier discloses a step of rendering a polysaccharide less hydrophillic, much less doing so by reacting a polysaccharide with an organic base. The examiner appears to rely upon the appellant's specification for a disclosure of such a step and for a disclosure of using an organic base in that step.

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The examiner relies upon Yamada only for a teaching that forming an alginate by reacting alginic acid with an organic base is not novel (answer, page 8). Yamada's alginic acid salt is a component of a heat-developable color light-sensitive material (col. 4, lines 16-26). The examiner has not explained why Yamada would have fairly suggested, to one of ordinary skill in the art, reacting alginic acid with an organic base to render the alginic acid less hydrophilic. Nor has the examiner set forth any other reason why one of ordinary skill in the art would have been led by Doublier and Yamada to combine their teachings relied upon by the examiner.

The examiner, therefore, has not carried the burden of establishing that the applied prior art itself would have fairly suggested the appellant's claimed invention to one of ordinary skill in the art. The record indicates that the examiner used the appellant's specification as a template for piecing together the disclosures of the applied prior art to arrive at the appellant's claimed invention, which is improper. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784. Accordingly, we reverse the examiner's rejection.

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DECISION

The rejection of claims 1-7 under 35 U.S.C. § 103 over Haug
in combination with Doublier and Yamada is reversed.

REVERSED

EDWARD C. KIMLIN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

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Sughrue, Mion, Zinn, Macpeak
& Seas
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3202