

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID COOKE, MARTINE DEBET,
MICHAEL J. GIDLEY, STEPHEN A. JOBLING, RICHARD SAFFORD,
CHRISTOPHER M. SIDEBOTTOM, and ROGER J. WESTCOTT

Appeal No. 2003-1918
Application No. 08/945,722

ON BRIEF

Before GARRIS, OWENS, and TIMM, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-14,
17, 18, 20-22 and 64.¹

¹ Our inspection of the application file record reveals a failure to clerically process entry of the amendment filed November 20, 2001, the amendment filed October 26, 2001 and the amendment filed June 25, 2001 even though the examiner had indicated entry with respect to each of these amendments. This

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The subject matter on appeal relates to a starch having an amylose content of at least 35%. Further details of this appealed subject matter are set forth in independent claims 1 and 64, a copy of which taken from the appellants' brief is appended to this decision.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Elizer	3,887,752	Jun. 3, 1975
Whetzel et al. (Whetzel)	3,888,739	Jun. 10, 1975
Jewell et al. (Jewell)	5,344,663	Sep. 6, 1994

Claims 1-14, 17, 18, 20, 21 and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Elizer, and claims 1-14, 17, 18, 20-22 and 64 (i.e., all appealed claims) are correspondingly rejected as being unpatentable over Elizer in view of Jewell.²

failure should be rectified upon return of the subject application to the jurisdiction of the Examining Corps.

² On page 4 of the brief under the heading "Grouping of Claims," the appellants state that they "consider each claim under appeal herein to be separately patentable." However, neither the brief nor the reply brief contains any argument regarding features recited in the dependent claims on appeal. We here remind the appellants that, in order to obtain separate consideration of commonly rejected claims, the appellants must state that the claims do not stand or fall together and must present arguments why the commonly rejected claims are separately patentable. Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991). Because the appellants have presented no arguments as to why their dependent claims are separately patentable, these

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Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning these rejections, we refer to the brief and reply brief and to the answer for a complete exposition thereof.

OPINION

For the reasons which follow, we will sustain each of the above noted rejections.

With respect to each of the rejections before us, the appellants implicitly concede that the "Superlose"-based starch of Elizer contains the amylose content required by the appealed independent claims but argue that "such starch would not fall within the present invention as it is not a starch 'comprising granules extracted from a potato plant'" (brief, page 6).

This argument is unpersuasive with respect to independent claim 64 since this claim is not limited to "a starch 'comprising granules extracted from a potato plant'" (id.). See In re Self, 671 F.2d 1344, 1348-49, 213 USPQ 1, 5 (CCPA 1982).

Although independent claim 1 contains the limitation in question, the appellants' argument also is unpersuasive with respect to this claim. Concerning this limitation, the

claims will stand or fall with independent claims 1 and 64.

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appellants state that "[t]he claims must be read from the view from one skilled in the art in light of the specification" and contend that "[o]ne skilled in the art would interpret this phrase [i.e., the claim 1 phrase "comprising granules extracted from a potato plant"] as meaning that the starch is in its natural state, that of granules" (reply brief, page 2). This last mentioned contention is not well founded.

There is a heavy presumption that a claim term carries its ordinary and customary meaning. Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1327, 65 USPQ2d 1385, 1394 (Fed. Cir. 2003). The ordinary and customary meaning of the appealed claim 1 term "granule" is "a small grain or pellet: PARTICLE" (Webster's II, New Riverside University Dictionary, 1984). In light of the aforementioned presumption, it is appropriate that we interpret claim 1 including the claim term "granules" pursuant to this meaning.

As previously stated, the appellants contend that the claim 1 phrase "starch comprising granules extracted from a potato plant" should be interpreted "as meaning that the starch is in its natural state, that of granules" (reply brief, page 2). This is incorrect. The claim contains no such limitation, and it would be inappropriate to read such a limitation into the claim

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from the appellants' specification. Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d at 1325, 65 USPQ2d at 1393; E.I. Dupont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 985 (1988). It is here appropriate to emphasize that, while claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims. Sjolund v. Musland, 847 F.2d 1573, 1581, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988).

Further in this regard, our study of the subject specification reveals that the high amylose content starch product of the appellants' disclosed invention is not limited to starch in its natural state as the appellants seem to believe. For example, page 15 of the specification contains the following disclosure:

In yet another aspect the invention provides high (35% or more) amylose starches which generate paste viscosities greater than those obtained from high amylose starches from maize plants after processing at temperatures below 100°C. This provides the advantage of more economical starch gelatinisation and pasting treatments through the use of lower processing temperatures than are currently required for high amylose starches from maize plants.

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This disclosure evinces that the invention described in the specification includes a high amylose starch resulting from gelatinisation and pasting treatments of the type which (according to the appellants) produce the "Superlose" product referred to in the Elizer patent.

With the foregoing in mind, we now proceed to assess whether appealed independent claim 1, when properly interpreted, encompasses the starch product of Elizer. As correctly indicated by the examiner and not contested by the appellants, patentee's product includes potato-derived starch, namely, "Superlose" having an amylose content within the here claimed range (e.g., see lines 14-25 in column 3). Moreover, patentee expressly describes his starch product as a granular solid (see lines 63-66 in column 5). This description supports the examiner's position that the starch of Elizer is in the form of granules as required by appealed claim 1.

The examiner's position is further supported by his citation to the Whetzel patent which describes "Superlose" as a granular material (see the paragraph bridging columns 4 and 5). In this regard, the appellants urge that "[a] reading of the [Whetzel] specification by one skilled in the art of starch would lead to the clear understanding that the Patentee does not mean starch

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granules, but that the starch solution has been dried in the form of particles" (brief, page 8). Even assuming the appellants are correct, however, the fact remains that the ordinary and customary meaning of the claim term "granules" includes "particles" as previously indicated.

It is well settled that, during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). When appealed independent claim 1 is so interpreted, it is clear that the starch granules defined thereby do not distinguish over the Superlose-based starch granules of Elizer. The contrary views expressed in the briefs and in the § 1.132 declaration of record are not well taken because they are based on an overly narrow and thus incorrect interpretation of appealed independent claim 1.

In summary, the appellants' arguments are irrelevant with respect to appealed independent claim 64 and are unpersuasive with respect to appealed independent claim 1. We shall sustain, therefore, the examiner's section 103 rejection of claims 1-14, 17, 18, 20, 21 and 64 as being unpatentable over Elizer and his corresponding rejection of claims 1-14, 17, 18, 20-22 and 64 as being unpatentable over Elizer in view of Jewell.

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The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris)	
Administrative Patent Judge)	
)	
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Terry J. Owens)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Catherine Timm)	
Administrative Patent Judge)	

BRG:tdl

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APPENDIX

1. A starch comprising granules extracted from a potato plant, said starch having an amylose content of at least 35%, as judged by the iodometric assay method of Morrison & Laignelet.

64. A starch obtainable from a plant having characteristics altered by a method selected from the group consisting of

(a) introducing into the plant a portion of a nucleotide sequence encoding an effective portion of a class A starch branching enzyme (SBE) obtainable from potato plants to complement the branching enzyme mutation in E coil KV 832 cells and which is active when expressed in E. coli in the phosphorylation stimulation assay operably linked to a suitable promoter active in the plant so as to affect the expression of a gene present in the plant;

(b) introducing into the plant a portion of a nucleotide sequence encoding an effective portion of a class A starch branching enzyme (SBE) obtainable from potato plants operably linked to a suitable promoter active in the plant so as to affect the expression of a gene present in the plant, wherein the nucleotide sequence is operably lined in the anti-sense orientation to a suitable promoter active in the plant;

(c) introducing into the plant a portion of a nucleotide sequence encoding an effective portion of a class A starch branching enzyme (SBE) obtainable from potato plants operably linked to a suitable promoter active in the plant so as to affect the expression of a gene present in the plant, wherein the introduced sequence comprises at least one region selected from the group consisting of a 5' untranslated region, a 3' untranslated region, and a coding region of the potato SBE class A SBE operably linked in the sense orientation to a promoter active in the plant;

(d) introducing into the plant a portion of a nucleotide sequence encoding an effective portion of a class A starch branching enzyme (SBE) obtainable from potato plants operably linked to a suitable promoter active in the plant so as to affect the expression of a gene present in the plant further comprising introducing into the plant one or more further sequences;

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(e) introducing into the plant a portion of a nucleotide sequence encoding an effective portion of a class A starch branching enzyme (SBE) obtainable from potato plants operably linked to a suitable promoter active in the plant so as to affect the expression of a gene present in the plant further comprising introducing into the plant one or more further sequences operably linked in the anti-sense orientation to a suitable promoter active in the plant; and

(f) introducing into the plant a portion of a nucleotide sequence encoding an effective portion of a class A starch branching enzyme (SBE) obtainable from potato plants operably linked to a suitable promoter active in the plant so as to affect the expression of a gene present in the plant further comprising introducing into the plant a portion of a class B SBE nucleotide sequence;

wherein the portion is effective to complement the branching enzyme mutation in E coli KV 832 cells and which is active when expressed in E. coli in the phosphorylation stimulation assay, and the starch has an amylose content of at least 35% as judged by the iodometric assay method of Morrison & Laignelet.