

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HEINZ GRIES,
WOLFGANG MÜTZEL,
CHRISTIAN ZURTH, and
HANNS-JOACHIM WEINMANN

Appeal No. 2004-0358
Application No. 08/997,748

ON BRIEF

Before WINTERS, GRON, and SCHEINER, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 94 through 96 and 100 through 118, which are all of the claims remaining in the application.

The Invention

Claims 94 and 95, which are illustrative of the subject matter on appeal, read as follows:

94. A method for imaging the blood stream, comprising administering an NMR

image enhancing agent to a patient in conjunction with an NMR measurement in the blood stream, wherein the agent comprises a physiologically compatible magnetic material in particulate form, complexed with a complexing agent.

95. A method for imaging the blood stream, comprising administering an NMR image enhancing agent to a patient in conjunction with an NMR measurement in the blood stream, wherein the agent comprises a physiologically compatible magnetic material in particulate form, complexed with an alkali-pretreated polysaccharide.

The Prior Art References

In rejecting the appealed claims under 35 U.S.C. § 103(a), the examiner relies on the following prior art references:

Jacobsen et al. (Jacobsen)	4,863,715	Sep. 5, 1989
Suzuki	4,885,537	Dec. 5, 1989
		(filing date Feb. 1, 1989)

The Rejections

Claims 94 through 96 and 100 through 118 stand rejected (1) under 35 U.S.C. § 112, first paragraph, as based on a specification which does not provide adequate, written descriptive support for the invention now claimed; and (2) under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Jacobsen and Suzuki.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief (Paper No. 39) and the Reply Brief (Paper No. 41); (3) the Examiner's Answer (Paper No. 40); (4) the above-cited prior art references; and (5) the Ebert Declaration, filed under the provisions of 37 CFR § 1.132, executed

January 17, 2002.

On consideration of the record, including the above-listed materials, we affirm the examiner's rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a).

35 U.S.C. § 112, first paragraph

According to the examiner, applicants' claims are based on a specification which does not provide adequate, written descriptive support for the invention now claimed. The examiner argues that independent claims 94 and 95 were amended in Paper No. 10, received December 27, 1999, adding the language "a method for imaging the blood stream" (emphasis added). The examiner further argues that applicants' original specification does not describe, explicitly or implicitly, a method for imaging the blood stream. According to the examiner, the specification, as filed, does not convey to any person skilled in the art that applicants were in possession of the subject matter now claimed. We agree.

Having carefully reviewed the original specification, including the "Abstract of the Disclosure," the "Summary of the Invention," the "Detailed Discussion" of the invention, Examples 1 through 27, and claims 1 through 46 (now canceled), we agree with the examiner's finding that applicants' specification does not describe as their invention a method for imaging the blood stream within the meaning of 35 U.S.C. § 112, first paragraph. The specification describes "new magnetic materials useful in medical diagnoses" (page 2, lines 12 and 13, and agents which "meet the large number of

preconditions, e.g., for suitability of contrast media for NMR diagnostics” (page 2, lines 18 and 19). Further, the specification states that “[f]or the first time, well tolerated contrast media are available, inter alia, for the visualization of tumors of the liver and spleen” (page 6, lines 7 through 10). This, however, is not a description of agents suitable for imaging the blood stream or of a method for imaging the blood stream.

Rather, the record makes clear that a description of ferromagnetic particles, used as contrast agents in NMR imaging for producing images of the liver, spleen, or bone marrow, is not tantamount to a description of angiography or of imaging the blood pool. See the above-cited Jacobsen patent and the discussion of Jacobsen in the Ebert Declaration, filed under the provisions of 37 CFR § 1.132, executed January 17, 2002. In their argument on appeal, applicants do not point to any passage or passages in the original specification describing “new magnetic materials useful in medical diagnoses” possessing the characteristics required for use in angiography, i.e., imaging of the blood pool.

In an effort to overcome the rejection under 35 U.S.C. § 112, first paragraph, applicants rely heavily on the following passage in the “Background of the Invention” portion of their specification:

Complexes of magnetite (Fe_3O_4) with dextran or human serum albumin are described, for example, in U.S. Patents 4,101,435 and 4,452,773 and in J. Pharm. Sci., 68, 79 (1979). In water they form stable colloidal solutions which are put to a wide range of uses because of their magnetic properties. Thus, they are suitable, inter alia, as drug carriers (above all as cytotoxic agents in the treatment of tumors), as agents for measurements in the blood stream, as markers in scanning/transmission electron microscopy, for marking and separating cells and biomolecules (e.g., an antigen from a mixture of antigens by using particles bound covalently to the corresponding antibody), as well as for use in the

mechanical sector (e.g., for audio and video tapes). Furthermore, dextran magnetite has been suggested as a relaxant agent for measuring the exchange of water across erythrocyte membranes (Biochem. and Biophys. Res. Comm. 97, 114 (1980), and is generically predicted to be a radiopaque agent in USP 4,101,435. [Specification, page 1, line 11, through page 2, line 2, emphasis added].

Considering the original specification in its entirety, however, including the above-referenced passage, we disagree that the specification provides adequate, written descriptive support for a method for imaging the blood stream now claimed.

Simply stated, it is not apparent from the “Abstract of the Disclosure,” the “Summary of the Invention,” the “Detailed Discussion” of the invention, Examples 1 through 27, or the original claims that applicants were in possession of a method for imaging the blood stream using “new magnetic materials useful in medical diagnoses.” That fact is not changed by the mention of known complexes of magnetite with dextran or human serum albumin in the Background section of the specification. Nor is that fact changed because applicants describe stable colloidal solutions of those complexes in water “which are put to a wide range of uses because of their magnetic properties.” Those uses include, inter alia, “agents for measurements in the blood stream.” Applicants’ position to the contrary, notwithstanding, the original specification does not convey to any person skilled in the art that they were in possession of agents possessing the characteristics required for use in angiography or of a method for imaging the blood stream.

To the extent that applicants’ argument in the Appeal Brief and Reply Brief might be construed to mean that a method for imaging the blood stream, recited in independent claims 94 and 95, would have been obvious by piecing together various

passages in the original specification, not directly related to each other, we invite attention to the following in Lockwood v. American Airlines Inc., 107 F.3d 1565, 1571-1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997):

It is the disclosures of the applications that count. Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.

and

The question [under the written description requirement of 35 U.S.C. § 112, first paragraph] is not whether a claimed invention is an obvious variant of that which is disclosed in the specification.

and

One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious.

See In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975)("[t]hat a person skilled in the art might realize from reading the disclosure that such a step is possible is not a sufficient indication to that person that that step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of § 112.")

The rejection of claims 94 through 96 and 100 through 118 under 35 U.S.C. § 112, first paragraph (written description) is affirmed.

35 U.S.C. § 103(a)

According to the examiner, applicants' claimed method would have been obvious at the time the invention was made to a person having ordinary skill in the art in view of

the combined disclosures of Jacobsen and Suzuki.

In response, applicants' principal argument is that Jacobsen does not teach angiography. Applicants do not argue, or even discuss, the scope and content of Suzuki in their Appeal Brief or Reply Brief. Applicants do not contend that the combination of Jacobsen and Suzuki is improper, or that the combination would not have led a person having ordinary skill to the claimed invention. On this record, we agree with the examiner's conclusion that the subject matter sought to be patented in claims 94 through 96 and 100 through 118 would have been obvious based on the combined disclosures of Jacobsen and Suzuki. See In re Young, 403 F.2d 754, 757, 159 USPQ 725, 728 (CCPA 1968)(“Appellants have failed to appreciate that they cannot show nonobviousness by attacking the references individually where the rejection is based on a combination of references”); and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art”).

In the “Issues” section of their Appeal Brief, applicants state that

these issues [35 U.S.C. § 112, first paragraph, written description, and 35 U.S.C. § 103 (a), obviousness] are inter-related since, if the claims do not contain new matter, and are described in the specification, then they are entitled to priority of at least 1985 and, thus, the rejection under §103 is moot. [Paper No. 39, page 2, last paragraph]

That statement, however, amounts to a non sequitur. Further, it appears that

applicants misapprehend what constitutes a “moot” question and use that term incorrectly in their Appeal Brief.

Even assuming arguendo that amended claims 94 through 96 and 100 through 118 enjoy written descriptive support in the instant specification, nevertheless, it would not follow that “they are entitled to priority of at least 1985.” As stated in In re van Langenhoven, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972),

To be entitled to the filing date of a previously filed application, appellant's application on appeal would have to satisfy the requirements of 35 U.S.C. § 120, among which is the requirement that the subject matter now claimed be disclosed in the manner prescribed by the first paragraph of section 112 in the prior application. Since, to conform to section 112, claimed subject matter must be described in the specification relied upon, subject matter which is first disclosed in a continuation-in-part application is not entitled to the filing date of the parent application. [citations omitted]

Further, “[a]s to given claimed subject matter, only one effective date is applicable” (Id.).

On this record, applicants have not engaged in a claim-by-claim analysis and have not established that any appealed claim is entitled to the benefit of a previously filed application under 35 U.S.C. § 120. In fact, applicants do not mention 35 U.S.C. § 120 in their Appeal Brief. We here note the continuation information provided in Paper No. 15, received February 11, 2000, listing a series of continuation applications and stating, inter alia, that Application No. 07/404,543, filed September 8, 1989, (now abandoned) is a continuation-in-part of Application No. 07/363,303, filed June 7, 1989, which is a continuation-in-part of Application No. 07/102,754, filed September 24, 1987 (now abandoned), which is a continuation-in-part of Application 06/800,840, filed November 22, 1987, (now abandoned). It is not apparent, and applicants have not established, that any appealed claim is entitled to the benefit of a previously filed

application under 35 U.S.C. § 120. Regardless of applicants' suggestion in the "Issues" section of their Appeal Brief, they have not established, on this record, that any appealed claim is entitled to an effective filing date of "at least 1985."

In any event, the § 103 obviousness question is not abstract, academic, deprived of practical significance, or "moot." We believe that applicants misuse that term in the Appeal Brief, page 2, last line.

Applicants argue that "[w]ith respect to the secondary reference [Suzuki], again, it is submitted that the entitlement of the present application to its priority dates obviates this portion of the rejection" (Paper No. 39, page 6, penultimate paragraph). That argument is remarkable for its brevity and lack of clarity. As best we can judge, the usage "again" refers to the above-quoted passage in the "Issues" section of the Appeal Brief, which we have already addressed.

Apparently, applicants' position is that each appealed claim is entitled to the benefit of an effective date earlier than Suzuki's filing date, viz., February 1, 1989, pursuant to the provisions of 35 U.S.C. § 120. According to applicants, therefore, Suzuki does not constitute legally available prior art, and the examiner's rejection, based on a combination of Jacobsen and Suzuki, must fall. We reiterate, however, that applicants do not mention 35 U.S.C. § 120 in their Appeal Brief; that applicants have not engaged in a claim-by-claim analysis; and that applicants have not established that any appealed claim is entitled to the benefit of a previously filed application under 35 U.S.C. § 120.

It is important to note here that the burden of persuasion rests on applicants. Under the provisions of 35 U.S.C. §§ 102(e)/103, the Suzuki patent constitutes legally available prior art as of the February 1, 1989, filing date of Application No. 07/304,477. That filing date precedes applicants' presumed date of invention, i.e., the December 24, 1997, filing of Application No. 08/997,748. Suzuki's filing date also precedes the September 8, 1989, filing of Application No. 07/404,543 (now abandoned), said to be a continuation-in-part of Application No. 07/363,303, filed June 7, 1989, which, according to applicants

is a continuation-in-part of Serial No. 07/102,754, filed September 24, 1987 (now abandoned), which is a continuation-in-part of Serial No. 06/800,840, filed November 22, 1987 (now abandoned), which have as priority applications West German Applications P 34 43 251.5 of November 23, 1984, P 34 43 252 of November 23, 1984 and P 35 08 000 of March 4, 1985. Application Serial Nos. 07/102,754, 06/800,840, P 34 43 251.5, P 34 43 252 and P 35 08 000 are entirely incorporated herein. [Paper No. 15, page 2, emphasis added]

On this record, applicants have not presented a showing under 35 U.S.C. § 120 which would establish that any appealed claim is entitled to the benefit of an effective date earlier than February 1, 1989. See In re Scheiber, 587 F.2d 59, 61, 199 USPQ 782, 784 (CCPA 1978)(“Unlike Rule 131, § 120 operates independently of the prior art, of which it makes no mention, and it expressly requires an earlier application to disclose the claimed subject matter in compliance with 35 U.S.C. § 112, first paragraph. Thus it is entirely appropriate that the showing required under § 120 differs from that required under Rule 131” [emphasis added]). Cf. Kawai v. Metlesics, 480 F.2d 880, 885, 178 USPQ 158, 162 (CCPA 1973), discussing the “right of priority” under 35 U.S.C. § 119 (“the right of priority’ accorded by section 119 can be aptly be described as a

right to prove a date of invention no earlier than the date of the foreign filing” [emphasis in original]).

The rejection of claims 94 through 96 and 100 through 118 under 35 U.S.C. § 103(a) is affirmed.

Conclusion

Accordingly, for the reasons set forth, we affirm the examiner’s prior art and non-prior art rejections of claims 94 through 96 and 100 through 118.

The examiner’s decision 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

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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