

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte CYRUS R. SAFINYA,
HEIDI E. WARRINER, and STEFAN H.J. IDZIAK

Appeal No. 2004-2078
Application No. 09/754,509

ON BRIEF

Before SCHEINER, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-17 and 23-27, which are all the claims pending in the application.

Claims 1 and 5 are illustrative of the claims on appeal and are reproduced below:

1. A lamellar lipid gel comprising:
 - (i) a membrane having a surfactant, lipid, or a combination thereof;
 - (ii) a multifunctional membrane-associating particle (MAP) which anchors to the membrane, and
 - (iii) a membrane bending rigidity reducing reagent.

5. The lamellar gel of claim 1 further comprising Bacteriorhodopsin.

The examiner relies on the following references:

Woodle et al. (Woodle)	5,013,556	May 7, 1991
Kanno et al. (Kanno)	5,374,715	Dec. 20, 1994
Ghyczy et al. (Ghyczy)	5,741,513	Apr. 21, 1998

GROUND OF REJECTION

Claims 1, 3, 4, 6-17 and 23-27 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner relies on the combination of Ghyczy and Woodle.

Claim 5 stands rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the examiner relies on the combination of Ghyczy, Woodle and Kanno.

We reverse.

DISCUSSION

The combination of Ghyczy and Woodle:

According to the examiner (Answer, page 3), “Ghyczy discloses alcoholic aqueous gel compositions containing phospholipids... [but does not] teach the inclusion of [a] polymer-lipid complex in the formulations.” In addition, the examiner finds (Answer, page 4), Woodle teach that the inclusion of membrane-rigidifying components, e.g., a lipid-derivatized polymer, in liposomes increases the circulation time of the liposomes in the bloodstream.

Based on this evidence, the examiner concludes (*id.*), “[i]t would have been obvious to one of ordinary skill in the art to include lipid-PEG [a lipid-derivatized polymer] in the [liposomal gel] compositions of Ghyczy ...” to increase the circulation time of Ghyczy’s liposomal gel compositions. For their part,

appellants assert (Brief, page 10), “Ghyczy or Woodle, alone, or in combination, fail to teach or suggest the claimed invention.” We agree.

As we understand the examiner’s position, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a lipid-derivatized polymer to the liposomal gel composition of Ghyczy to enhance the circulation time of Ghyczy’s liposomal gel composition. The examiner, however, failed to identify any portion of the Ghyczy patent that suggests the use of the liposomal gel composition in the circulatory system. To the contrary, we find that Ghyczy is concerned with compositions for topical preparations. See e.g., Ghyczy, column 1, lines 11-14, emphasis added, “[t]he present invention relates to an alcoholic, aqueous gel-like phospholipid composition and its use. The present invention furthermore relates to topical preparations containing it.” While a person of ordinary skill in the art may possess the requisite knowledge and ability to modify Ghyczy’s liposomal gel composition to include a circulation enhancing agent, the modification is not obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 211 USPQ 1125, 1127 (Fed. Cir. 1984). Here we see no such reason to modify the references as applied.

To establish a prima facie case of obviousness, there must be more than the demonstrated existence of all of the components of the claimed subject matter. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the substitutions required. That knowledge cannot come from the applicants’

disclosure of the invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). On the record before us, we find no reasonable suggestion for combining the teachings of the references relied upon by the examiner in a manner which would have reasonably led one of ordinary skill in this art to arrive at the claimed invention. The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In our opinion, the examiner failed to provide the evidence necessary to support a prima facie case of obviousness.

Accordingly, we reverse the rejection of claims 1, 3, 4, 6-17 and 23-27 under 35 U.S.C. § 103(a) over the combination of Ghyczy and Woodle.

The combination of Ghyczy, Woodle and Kanno:

According to the examiner (Answer, page 5), “Kanno shows that it is common practice in the art to encapsulate ... [bacteriorhodopsin] in liposomes....” While Kanno addresses an additional feature of the claimed invention as set forth in claim 5, Kanno fails to make up for the deficiency in the combination of Ghyczy and Woodle discussed above.

Accordingly, we reverse the rejection of claim 5 under 35 U.S.C. § 103(a)
over the combination of Ghyczy, Woodle and Kanno.

CONCLUSION

The rejections of record are reversed.

REVERSED

Toni R. Scheiner
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

Lora M. Green
Administrative Patent Judge

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MANDEL & ADRIANO
55 SOUTH LAKE AVENUE
SUITE 710
PASADENA CA 91101