

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TIMOTHY FISCHER and WALTER SHERMAN

Appeal No. 2007-1027
Application No. 10/134,575

ON BRIEF

| Before ADAMS, MILLS, and LEBOVITZ, 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 5-10, which are all the claims pending in the application.

Claim 5 is illustrative of the subject matter on appeal and is reproduced below:

5. A composition of matter comprising a bile salt in combination with a special stain.

The references relied upon by the examiner are:

New	5,853,748	Dec. 29, 1998
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| Leung et al. (Leung), "Rapid Staining Method for Helicobacter pylori in Gastric Biopsies," J. Histotechnology, Vol. 19, No. 2, pp. 131-132 ([1995](#))

GROUNDS OF REJECTION

Claims 5, 6, and 8-10 stand rejected under 35 U.S.C. § 102(b) as anticipated by New.

Claims 5-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of New and Leung.

We affirm the rejection under 35 U.S.C. § 102(b). We reverse the rejection under 35 U.S.C. § 103.

DISCUSSION

Anticipation:

Claims 5, 6, and 8-10 stand rejected under 35 U.S.C. § 102(b) as anticipated by New. According to appellants the claims stand or fall together. Brief, page 3. Since the claims stand or fall together, we limit our discussion to representative claim 5. Claims 6 and 8-10 will stand or fall together with claim 5.

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37 C.F.R. § 41.37(c)(1)(vii) (July 2006).

Claim 5 is drawn to a composition that comprises (1) a bile salt and (2) a special stain.¹ According to appellants' specification (page 1, lines 14-16), "[s]pecial stains is a term given to a collection of chemically-based stains that have been developed in response to difficult to stain tissue types, unusual diseases, infections diseases or other non-typical situations affecting the tissue." Nevertheless, for the purposes of their disclosure appellants define a "special

¹ We recognize appellants' assertion that an amendment was filed together with the Reply Brief. We note, however, that this amendment was not entered into the record. See Action, mailed June 14, 2005. Accordingly, we have not considered appellants' arguments related to the amendment filed with the Reply Brief.

stain" as "any chemically-based stain useful for histologic analysis that is not an immunohistochemical stain, or an in situ hybridization stain." Specification, page 3, lines 7-9.

New teaches that "[n]eutral red stain is actively taken up by viable cells." New, column 9, line 33. Since New teaches neutral red is a chemically-based stain useful for histologic analysis, and not an immunochemical nor in situ hybridization stain, we find that neutral red stain is a "special stain" within the scope of appellants' claimed invention. We recognize appellants' assertion that neutral red is a pH indicator not a stain. Brief, page 4, footnote 1. However, since New teaches the use of neutral red as a stain (same (column 9, lines 33-41)) we will do the same. We recognize, however, appellants' assertion that while New refers to neutral red as a stain "it is clear from the context [in New] that neutral red is not actually staining the cells as the term is normally used in the histology art." Brief, page 5. According to appellants (id.), "[t]o be 'useful for histologic analysis,' a chemical must have the attribute of permanently attaching itself to some tissue." We are not persuaded by this assertion. We find nothing in appellants' definition of a "special stain" that requires the stain to have the attribute of permanently attaching itself to some tissue. To the contrary, other than defining a "special stain" by what it is not - not an immunohistochemical stain, or an in situ hybridization stain – appellants' definition simply requires the stain to be any chemically-based stain useful for histologic analysis. As New characterizes neutral red as a stain in their study, we find no evidence to suggest

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that it would not be useful for histologic analysis. Accordingly, we are not persuaded by appellants' assertions.

New teaches a method wherein cells are stained with neutral red. New, column 9, lines 37-47. The cells are then treated with different concentrations of bile salt, which includes sodium deoxycholate². New, column 9, lines 47-61. As New explains (column 9, lines 37-41), “[i]n this procedure, . . . cells are first stained and then incubated with test materials and measurements are made to determine the extent to which incubation with test materials has caused the stain to leak out of the cells during exposure.” In this regard, we note that appellants recognize that “[t]he standard test described in New is directed to the uptake and release of a dye referred to as ‘Neutral red’ by live Caco-2 cells during exposure to bile salts.” Brief, page 4, footnote omitted. Accordingly, New teaches a composition of matter which comprises neutral red stain in combination with bile salt and cells. In our opinion this reads on appellants' claimed invention.

Therefore, we affirm the rejection of claim 5 under 35 U.S.C. § 102(b) as anticipated by New. Claims 6 and 8-10 fall together with claim 5. We recognize, however, that our reasoning differs from that of the examiner. Accordingly, we designate our affirmance a new ground of rejection under 37 C.F.R. § 41.50(b).

Obviousness:

Claims 5-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of New and Leung.

² New, column 9, lines 5-6.

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For the reasons discussed above, we find that New teaches a composition comprising a bile salt, a special stain and cells. The examiner relies on Leung to teach “rapid staining methods for the identification of Helicobacter pylori using Alcian Yellow stain. (Answer, page 3.) According to the examiner (Id., page 4), “it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to have incorporated the Alcian Yellow stain for staining H. pylori as taught by Leung et al. with the bile salt composition as taught by New.”

We disagree.

Leung teaches a method for staining H. pylori. Leung's method is set forth on page 132, column 1. As can be seen from Leung's disclosure (id.), the method comprises not only the addition of Alcian Yellow but also toluidine blue and other reagents in a specific sequence of method steps resulting in blue bacteria on a yellow background. Leung, page 131, column 2. Leung does not teach the addition of Alcian Yellow alone, in any willy-nilly manner, or with other reagents not specifically identified in the method. Accordingly, we disagree with the examiner's intimation that a person of ordinary skill in the art would have found it prima facie obvious to combine Alcian Yellow with New's composition with the intent of staining H. pylori. There is no evidence on this record to suggest that the compositions of New and Leung could be combined in the manner suggested by the examiner. Accordingly, we reverse the rejection of claims 5-10 under 35 U.S.C. § 103 as being unpatentable over the combination of New and Leung.

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

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides “[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the examiner’s rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

Should the appellant elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the

examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED-IN-PART: 41.50(b)

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Donald E. Adams)
Administrative Patent Judge)
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) BOARD OF PATENT
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Demetra J. Mills) APPEALS AND
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Richard M. Lebovitz)
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