

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte YAKOV GLUZMAN and MICHAEL OSTRANDER

---

Appeal No. 94-0432  
Application 07/839,728<sup>1</sup>

---

ON BRIEF

---

Before WINTERS, GRON, and PAK, Administrative Patent Judges.  
GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

---

<sup>1</sup> Application for patent filed February 19, 1992.  
According to applicants, this application is a continuation of  
Application 07/547,889, filed July 3, 1990, now abandoned.

Appeal No. 94-0432  
Application 07/839,728

This is an appeal from an examiner's final rejection of Claims 1, 4, 7, 9-11 and 14-16, all claims pending in this application. Claims 1, 4, 7, 9-11 and 14-16 stand rejected under 35 U.S.C. § 103, as being unpatentable in view of the combined teachings of Marquez et al. (Marquez), U.S. 4,968,690, patented November 6, 1990, filed Jan. 19, 1989; Chemical Abstracts (Eriksson<sup>2</sup>), Vol. 112, 18103b (1989); Chemical Abstracts (Yokata), Vol. 113, 184252q (1990); Chemical Abstracts (Webb), Vol. 109, 23303j (1988); and Chemical Abstracts (Kraus), Vol. 113, 147783t (1990).<sup>3</sup>

---

<sup>2</sup> The examiner cited Eriksson et al. (Eriksson II), U.S. 4,665,062, patented May 12, 1987, in the listing of prior art of record on page 2 of the Examiner's Answer, as illustrating the state of the art. There appears to be some confusion as to whether appellants' claims stand finally rejected over the cited prior art teaching including Eriksson I (C.A. 112, 18103b (1989), cited above), or Eriksson II (U.S. 4,665,062). The confusion is apparent from appellants' references to the description of phosphonoformic acid in Eriksson II (Appellants' Brief, p. 2, last three lines; Appellants' Reply Brief, p. 4, l. 4-13) and the examiner's statement that "[t]he Eriksson et al reference does not mention phosphonoformic acid" (Examiner's Answer, p. 7, l. 8-9). We have considered the merits of the examiner's rejection in view of the teaching of Eriksson I and Eriksson II.

<sup>3</sup> The examiner has rejected appellants' claims in view of the published abstracts of four journal articles. The

Appeal No. 94-0432  
Application 07/839,728

The examiner clearly erred in stating that "claims 1, 4, 7, 9-11 and 14-16 stand or fall together because appellant's [sic] brief does not include a statement that this grouping of claims does not stand or fall together" (Examiner's Answer, p. 2). To the contrary, see the express statement that "the claims do not stand or fall together" at page 3 of Appellants' Brief.

For purposes of this appeal, we need only consider the examiner's rejection as it applies to Claim 1. Claim 1 reads:

1. A method for controlling or treating RNA viral infections and not DNA viral infections in plants or animals, said method comprising: administering to said plants or animals an RNA-terminating amount of 3'-deoxyribocytosine, 3'-deoxyribouracil, 3'-deoxyribo-guanine or combinations thereof.

We have considered all the evidence and arguments in favor of patentability and all the evidence of record to the contrary. We have attempted to decipher the examiner's explanations, arguments and support in this case to no avail.

---

articles themselves are not of record, and we have not retrieved them.

We have considered the merits of the examiner's rejection as based

on the four cited abstracts. Lest there be any doubt, we abhor examiners' rejections of appellants' claims based on abstracts

of publications when the publications themselves are retrievable.

Appeal No. 94-0432  
Application 07/839,728

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "The PTO has the burden under section 103 to establish a *prima facie* case of obviousness." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). We hold that the examiner in this case has not made out a prima facie case of unpatentability under 35 U.S.C. § 103 in view of the applied prior art.

It is our considered opinion that any further comment in this case by this panel would belabor the record with criticism. Suffice to say that Appellants' Reply Brief filed November 15, 1993 (Paper No. 29) soundly rebutted many of the findings and arguments made in the Examiner's Answer. In a Letter dated August 25, 1995 (Paper No. 32), a Primary Examiner stated,

"The reply brief filed November 15, 1993 has been entered and considered but no further response by the Examiner is deemed necessary." We respond in kind to the case of unpatentability established by the examiner in this case and summarily reverse

Appeal No. 94-0432  
Application 07/839,728

the rejection of Claims 1, 4, 7, 9-11 and 14-16 under 35  
U.S.C.

§ 103 based on the record before us.

REVERSED

	Sherman D. Winters	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Teddy S. Gron	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Chung K. Pak	)	
	Administrative Patent Judge	)	

Elizabeth M. Barnhard  
American Home Products Corp.  
Patent Law Department - 2B  
One Campus Drive  
Parsippany, NJ 07054