

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN D. SHAPIRO

Appeal No. 1995-2464
Application No. 08/068,392¹

ON BRIEF

Before WILLIAM F. SMITH, ELLIS, and ROBINSON, Administrative Patent Judges.
ROBINSON, 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 and 2. Claim 3 stands withdrawn from consideration by the examiner as being drawn to a non-elected invention and is not presented in this appeal.

¹ Application for patent filed May 28, 1993. Related Application 08/396,988, filed March 1, 1995 is currently the subject of an appeal (Appeal No. 1997-3329) pending before this Board. We have considered the two appeals together.

DISCUSSION:

The rejection under 35 U.S.C. § 103

Obviousness is a legal conclusion based on the underlying facts. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1595-97 (Fed. Cir. 1987). Here, the dispositive question is whether one of ordinary skill in this art at the time of the invention would have found the isolated cDNA, which encodes the 470 amino acid human macrophage metalloelastase, obvious from the disclosure of a murine macrophage metalloelastase and the suggestion by Shapiro that a homologous human metalloelastase, not specifically described, could exist and would be desirable to isolate. We agree with the examiner that one skilled in the art could reasonably read the statement in Shapiro (Page 4670, column 1, first full paragraph) that:

. . . we demonstrated that Mme is located on mouse chromosome 9, suggesting that the human homolog of Mme may map to human chromosome 19

as indicating that those skilled in this art would have known of the human macrophage metalloelastase or the DNA which encodes it. However, this interpretation is in contrast with the statement at page 3 of the specification that:

despite the efforts of many investigators, human macrophage elastase activity could not be documented and many doubted its existence.

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The examiner has offered no other evidence in support of the proposition that the human macrophage elastase was known in the prior art at the time of applicant's invention.

Absent evidence establishing that the specific protein was known, it would not have been obvious to use either the methodology of Shapiro or Flier to isolate and characterize the cDNA which encodes an unknown protein.

When we weigh all of the evidence, it is not clear what the situation was at the time of the invention. However, 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). On these circumstances, we are constrained to reach the conclusion that the examiner has failed to provide the evidence necessary to support a prima facie case of obviousness as to the claimed cDNA which encodes for the human macrophage metalloelastase.

Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). Therefore, the rejection of claims 1 and 2 under 35 U.S.C. § 103 is reversed.

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SUMMARY

To summarize, the decision of the examiner to reject claims 1-2 under 35 U.S.C. § 103 is reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
JOAN ELLIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

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