

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD C. ORLOWSKI,
SATOSHI HANAMURA,
MASAHIKO MARUMOTO,
KENJI SAKAMOTO and
YOSHIHIRO WAKI

Appeal No. 1995-4370
Application 07/401,432¹

HEARD: September 14, 1999

Before WILLIAM F. SMITH, ELLIS and ROBINSON, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

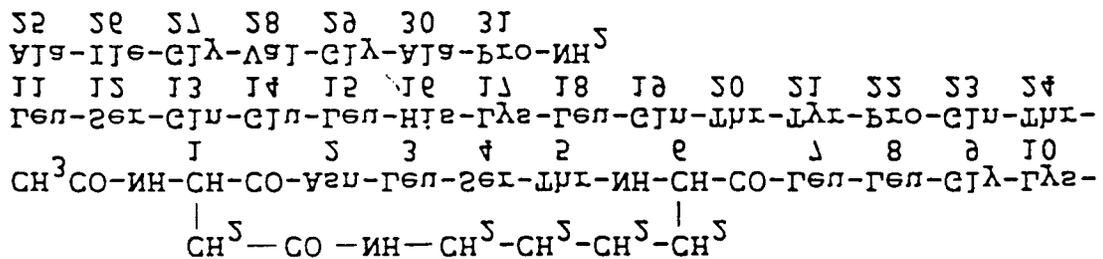
¹ Application for patent filed December 21, 1990.

DECISION ON APPEAL

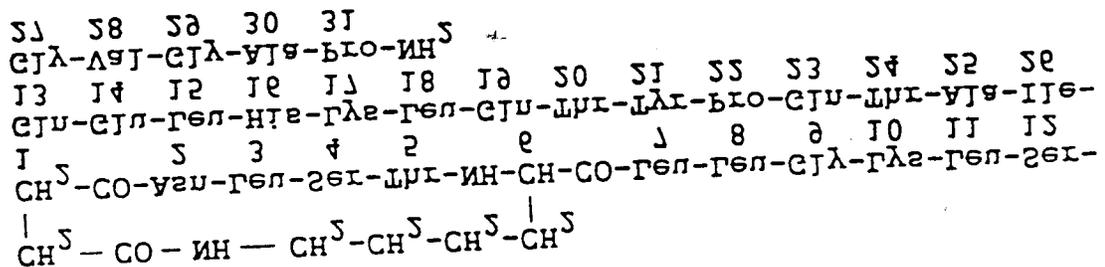
This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 29, 30, 86 and 87, all the claims remaining in the application.

The claims on appeal are reproduced below:

29. A peptide having the following amino acid sequence (SEQ ID NO: 25):



30. A peptide having the following amino acid sequence (SEQ ID NO: 26):



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The references relied on by the examiner are:

Brugger et al. (Brugger)	3,798,203	Mar. 19, 1974
Riniker et al. Riniker)	3,910,872	Oct. 7, 1975
Sakakibara et al. (Sakakibara)	4,086,221	Apr. 25, 1978
Orlowski et al. (Orlowski `386)	4,622,386	Nov. 11, 1986
Orlowski et al. (Orlowski `728)	4,746,728	May 24, 1988
Swiss (Rittel I)	PN 550,774	June 28, 1974
Eur. Pat. App. (Fujii)	0 330 241	Aug. 30, 1989

Rittel et al. (Rittel II), Helvetica Chimica Acta, 104. "Thyrocalcitonin III. Die Synthese des " - Thyrocalcitonins," Vol. 51, pp. 924-28 (1968).

Claims 29, 30, 86 and 87 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Brugger, Riniker, Orlowski I, Sakakibara, Orlowski II, Rittel I, Rittel II and Fujii. We reverse.

DISCUSSION

In deciding patentability issues under 35 U.S.C. § 103, the court observed in Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987) "[a]nalysis begins with a key legal question -- what is the invention claimed?" since "[c]laim interpretation . . . will normally control the remainder of the decisional process." In the present case, each of the claims on appeal requires a calcitonin peptide analog with a defined amino acid sequence and an amide bridge with a specific structure.

According to the examiner, Brugger, Riniker, Orlowski I, Sakakibara, Orlowski II, Rittel I and Rittel II disclose calcitonin analogs which differ from the claimed analogs in that the claimed analogs have “an amide bridge at positions one and six of the peptide sequence as opposed to the disulfide bridge of each of the above-cited prior art,” while “Fujii discloses that a peptide sequence having an amide linkage has a considerably improved stability as compared to the unstable disulfide bridge.” See page 5 of the Answer.

The examiner concludes that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the disulfide bridge in anyone of the peptide sequences of e.g., Brugger with an amide linkage for the advantages taught by Fujii.” See page 5 of the Answer.

In our judgment, the combined disclosures of the references are insufficient to reach the subject matter on appeal. None of the references discloses an analog with the amino acid sequence required by the claims. The statement of the rejection does not acknowledge this fact, much less provide reasons why one skilled in the art would have found it obvious to modify the amino acid sequences of the prior art analogs to arrive at the present analogs. Further, Fujii discloses a number of calcitonin analogs with amide bridges, but there is nothing in the reference, or in the examiner’s reasoning, which

would lead one skilled in the art to substitute amide bridges of the particular structure required by the claims for the disulfide binds of the prior art analogs.

It is well settled that the initial burden of establishing unpatentability rests on the examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Moreover, 35 U.S.C. § 103 requires that obviousness be determined on the basis of the claimed “subject matter as a whole.” Here, the examiner’s decisional process did not begin with a fact-based analysis of what was being claimed. The inevitable result was that the examiner’s conclusion of obviousness was based on less than the entire claimed subject matter. Accordingly, we find that the examiner’s initial burden of establishing a prima facie case of obviousness has not been met, and the rejection of claims 29, 30, 86 and 87 under 35 U.S.C. § 103 is reversed.²

REVERSED

William F. Smith)
Administrative Patent Judge)
Joan Ellis)
Administrative Patent Judge) BOARD OF PATENT
APPEALS AND
INTERFERENCES

² Having determined that a prima facie case of obviousness has not been established, we do not find it necessary to comment on appellants’ arguments at pages 7 through 13 of the Brief regarding unexpected results attributable to the present invention.

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Douglas W. Robinson)
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