

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARLA A. HAYNES
and WILSON HARVEY

Appeal No. 95-4890
Application 08/035,002¹

ON BRIEF

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges and McKELVEY, Senior Administrative Patent Judge.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 2 through 9, 11 and 12, which are all of the claims remaining in the application.

¹ Application for patent filed March 22, 1993.

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REPRESENTATIVE CLAIMS

Claims 11 and 12, which are illustrative of the subject matter on appeal, read as follows:

11. A method of treating burns or wounds comprising applying to the surface of the burn or wound an effective amount of an oil-in-water emulsion comprising from 1% to 50% by weight of an oil, from 0.5% to 25% by weight of an insoluble protein and from 25% to 98.5% by weight of water.

12. An ointment for the treatment of burns or wounds comprising an oil-in-water emulsion comprising from 1% to 50% by weight of an oil, from 0.5% to 25% by weight of an insoluble protein and from 25% to 98.5% by weight of water.

THE REFERENCES

As a preliminary matter, we find it necessary to clarify the record respecting the citation of a Japanese reference relied on by the examiner. This reference is Koho No. 60-34923, which is an examined patent application published August 12, 1985, based on Application No. 53-159001 filed December 20, 1978. That same application was "Laid open" June

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25, 1980, as Laid-open Patent Application (Kokai) No. S 55-84167. We shall hereinafter refer to this reference by the name of its lead inventor, namely, Yanagibashi.² For the purposes of this appeal, we have relied on an English Translation of Kokai No. S 55-84167 which was supplied by applicants and is of record. We further observe that the Board obtained an English Translation of Koho No. 60-34923, after this case was appealed. For the sake of completeness, we enclose a copy of the latter translation with this opinion.

In rejecting the appealed claims on prior art grounds, the examiner also relies on U.S. Patent No. 3,435,117, issued March 25, 1969, to Joseph Nichols (Nichols).

THE ISSUE

The issue presented for review is whether the examiner erred in rejecting claims 2 through 9, 11 and 12 under 35 USC § 103 as unpatentable over the combined disclosures of Nichols and Yanagibashi.

² The examiner cites the Yanagibashi reference in the Answer, page 2, last line. Likewise, applicants cite this reference in their Brief before the Board, page 2, last paragraph. Neither citation is correct.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials:

- (1) The instant specification, including all of the claims on appeal;
- (2) Applicants' Brief before the Board;
- (3) The Examiner's Answer; and
- (4) The Nichols and Yanagibashi references relied on by the examiner.

On consideration of the record, including the above-listed materials, we affirm the rejection of claims 2 through 9 and 12. We vacate the rejection of claim 11.

CLAIMS 2 THROUGH 9 AND 12

As stated in the Brief before the Board, page 3, section V, "[f]or purposes of this Appeal, claims 12, and 2-9 are grouped together". Accordingly, for the purposes of this appeal, we shall treat dependent claims 2-9 as standing or falling together with claim 12.

Although the Examiner's Answer is not a model of clarity,

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nevertheless, the examiner invites attention to Example V of Nichols (Answer, pages 3 and 4). Likewise, applicants focus on Example V of Nichols in the Brief before the Board, pages 5 and 6. We agree with applicants and the examiner that the Example V composition of Nichols constitutes the closest prior art with respect to composition claim 12.

In Example V, Nichols discloses an oil-in-water emulsion containing 500 parts by weight liquid petrolatum (oil) where the total composition contains 1,000 parts. That is, the Example V emulsion contains 50% by weight oil which meets the terms of claim 12. Without question, the amount of water in Example V is within the range recited in claim 12 (25% to 98.5% by weight water). The only remaining question is the precise percent by weight of collagen solids contained in the oil-in-water emulsion of Example V.

The collagen dispersion used in Example V is that of Example I of Nichols. In Example I, Nichols discloses the following:

To one hundred parts of a mass of swollen collagen fibrils, prepared as described in Example I of United States Patent No. 3,123,482 is slowly added with

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stirring 640 parts of a dilute solution of lactic acid in water (1.2% lactic acid). The resulting dispersion of swollen collagen fibrils is homogenized and filtered through a 7-mil filter screen.

Thus, to determine the percent by weight of collagen solids contained in the oil-in-water emulsion of Example V, one would have to obtain U.S. Patent No. 3,123,482, review Example I therein, and make an appropriate calculation. On this record, neither applicants nor the examiner have done so.

Be that as it may, there is a factual basis on this record to conclude that the percent by weight of collagen solids in the oil-in-water emulsion of Example V is identical or substantially identical to the percent by weight of insoluble protein recited in claim 12. See column 1, lines 59 through 62 of Nichols, stating that

Preferably, the amount of collagen present in said composition will amount to from about 0.2% to about 0.9% by weight (calculated on the basis of dry collagen solids).

That preferred range brackets the lower end of the range recited in claim 12, i.e., 0.5% by weight of insoluble

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protein. Under these circumstances, it is reasonable to shift the burden of persuasion to applicants to establish that the oil-in-water emulsion of claim 12 patentably distinguishes from the oil-in-water emulsion disclosed by Nichols in Example V. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

Applicants argue that the claim 12 oil-in-water emulsion is intended for use as an ointment for treating burns or wounds, whereas the oil-in-water emulsion disclosed by Nichols in Example V is described as a "laxative product". First, the terms "an ointment for the treatment of burns or wounds" merely set forth the intended use for, or a property inherent in, applicants' composition. Those terms do not differentiate the claimed composition from those known to the prior art, i.e., oil-in-water emulsions containing the same percentages by weight of oil, insoluble protein, and water. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Second, assuming arguendo that the percent by weight of collagen solids in the Example V emulsion of Nichols does not meet the terms of claim 12, nevertheless, it would have been obvious to vary that amount per the teachings in Nichols,

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column 1, lines 59 through 62. In this manner, a person having ordinary skill in the art would have arrived at the subject matter sought to be patented in claim 12 including a percent by weight of insoluble protein at the lower end of the range recited therein (0.5%). In this regard, the motivation to modify a prior art reference to arrive at the claimed subject matter does not have to be identical to that of applicants to establish obviousness. See In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

For these reasons, we affirm the examiner's decision rejecting claim 12 under 35 USC § 103. As previously indicated, claims 2 through 9 fall together with claim 12.

CLAIM 11

As stated in the Brief before the Board, page 3, section V, claim 11 stands alone. Further, at pages 7 and 8 of the Brief, applicants argue claim 11 separately. Accordingly, for the purposes of this appeal, we have treated claim 11 separately.³

³ In the Examiner's Answer, page 2, Section (5), the examiner states that all of the appealed claims are presumed to stand or fall together because applicants fail to

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All of the appealed claims, including claim 11, stand rejected under 35 USC § 103 based on the combined disclosures of Yanagibashi and Nichols. However, the examiner does not present a cogent explanation why the method of treating burns or wounds

defined in claim 11, would have been obvious from a consideration of Yanagibashi and Nichols.

In setting forth the rejection under 35 USC § 103, the examiner states that

it would be [sic, would have been] obvious to one of ordinary skill in the art at the time of the invention, motivated by a reasonable expectation of success, to obtain the [claimed] o/w emulsion because JP-85/034923 [Yanagibashi] discloses water, oil, drug, a protein (gelatin), alginate, etc.; the motivation to substitute one protein with another (gelatin for collagen) is derived from Nichols (column 1, lines 35-44, Examples III and V).

See the Examiner's Answer, paragraph bridging pages 3 and 4.

On its face, that statement of obviousness is directed to the

present reasons supporting the separate patentability of any claim. This is factually incorrect.

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claimed composition, not to the claimed method. In fact, that statement does not mention claim 11.

The only specific reference to claim 11 in the Examiner's Answer is found at page 7. There, the examiner states that

The assertion that claim 11 is directed to a method and is therefore somehow not obvious is not found persuasive. The claimed method is inherent to the claimed composition because "treating burns or wounds" with the o/w emulsion ointments disclosed in the art is within the scope of the cited art. Contrary to the appellants' statement, **no** significant advance in the treatment of burns and wounds has been accomplished. For example, no criticality of the specific concentrations of the claimed ingredients has been established.

The examiner's treatment of claim 11 is incomprehensible.

Apparently, the standard applied by the examiner is that "**no** significant advance in the treatment of burns and wounds has been accomplished" (emphasis in original). That, however, is not the statutory standard of non-obviousness. See 35 USC § 103; Graham v. John Deere Co., 383 U.S. 1 (1966).

In light of the foregoing, it is our judgment that the patentability of claim 11 has not been properly determined on this record and that a justiciable issue has not been presented for review. Accordingly, we vacate the examiner's

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decision rejecting claim 11 under 35 USC § 103 based on the combined disclosures of Yanagibashi and Nichols.

CONCLUSION

For the reasons set forth in the body of this opinion, we affirm the rejection of claims 2 through 9 and 12 under 35 USC § 103 as unpatentable over the combined disclosures of Yanagibashi and Nichols. We vacate the rejection of claim 11 on the same grounds. On return of this application to the examining corps, the examiner should reevaluate the patentability of claim 11 using appropriate legal standards.

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

**AFFIRMED-IN-PART
VACATED-IN-PART**

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