

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARTMUT BEUG,
MAX L. BIRNSTIEL,
MATTHEW COTTEN, ERNST WAGNER
and HARALD KANDOLF

Appeal No. 1996-1005
Application 07/947,982

HEARD: March 7, 2000

Before WILLIAM F. SMITH, GRON and SPIEGEL, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 67, 69, 71, 73 through 80, 96, 97, 99 and 104 through 106, all the claims remaining in the application. Claims 67 and 96 are representative of the subject matter on appeal and read as follows:

further relies upon Simons. Finally, claims 104 through 106 stand rejected under 35 U.S.C. § 103. In addition to the evidence of obviousness set forth in the first sentence of this paragraph, the examiner relies upon Pardridge. We reverse.

DISCUSSION

The claims on appeal are directed to a polynucleotide molecule and a pharmaceutical preparation containing as an active component one or more of the claimed polynucleotide molecules. As set forth in claim 67, the polynucleotide molecule has two components. First, the claim requires a polynucleotide molecule coding for a tRNA. Second, the claim requires a polynucleotide molecule coding for a ribozyme. The second polynucleotide molecule must be located between A- and B-boxes of the first polynucleotide molecule.

All of the rejections depend primarily upon the examiner's interpretation of Jennings. In reviewing this aspect of the examiner's position, we find the examiner has read the reference too broadly. We first point out that the specification of this application describes a broader invention which may be termed generic to that now claimed in claim 67. In relevant part, the broader invention only required as the second polynucleotide molecule a "DNA coding for RNA-inhibiting RNA." See, e.g., original claim 1. There are at least two specific embodiments described in the specification of this application of "DNA coding for RNA-inhibiting RNA," i.e., antisense RNA and RNA coding for a ribozyme. See, e.g., original claims 2 and 4. Jennings is directed to the antisense RNA aspect of the invention described in the specification of the application and is cited by applicants in the paragraph bridging pages 6-7 of the specification. However, during prosecution of this application, the claims were narrowed to their present state and are now strictly limited to the second embodiment

wherein the second polynucleotide molecule is one which codes for a ribozyme. The examiner's position began to fall apart when the claims were narrowed.

The examiner describes Jennings at page 4 of the examiner's answer as suggesting "using the pol III promoters in tRNA molecules specifically to express any RNA-inhibiting RNA." The examiner amplifies this thought in the paragraph bridging pages 8-9 of the answer where in responding to appellants' arguments the examiner states that "the teachings of Jennings that a pol III promoter is useful to express an antisense RNA would have suggested to the ordinary skilled artisan that it would have also been useful to express another type of RNA-modifying RNA known in the art, i.e., a ribozyme." However, the examiner has not referred to any facts of record in support of these assertions.

In our view, the examiner has not properly established that one of ordinary skill in the art would have read Jennings in this broad manner. Simply put, we find no factual support for the examiner's assertion that one of ordinary skill in the art would have found it obvious to modify the teachings of Jennings by using a polynucleotide sequence encoding a ribozyme for one encoding antisense RNA. Conclusions of obviousness must be based upon facts, not generalities. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968); In re Freed, 425 F.2d 785, 788, 165 USPQ 570, 571 (CCPA 1970). Absent a fact-based explanation from the examiner, it appears that the only reason for making such a substitution comes from appellants' disclosure of the present invention, not from Jennings or any of the additional references relied upon by the examiner. This is, of course, improper hindsight.

Accordingly, all rejections must be reversed.

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The decision of the examiner is reversed.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
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Teddy S. Gron)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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Carol A. Spiegel)	
Administrative Patent Judge)	

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