

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN P. ATKINSON

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Appeal No. 1996-3348  
Application 08/139,195

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ON BRIEF

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Before WINTERS, ROBINSON, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 13-15, all the claims pending in the application. Claims 13 and 15 are representative of the subject matter on appeal and read as follows:

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A DNA probe for human membrane cofactor protein hybridizing to and effective to detect the DNA sequence in Sequence Listing I.D. No. 1 when hybridized overnight at 37[°]C in 6 x (0.15 M sodium chloride/0.015 M sodium citrate), 5 x (0.02% BSA/0.02% Ficoll/0.02% polyvinylpyrrolidone)/0.05 M sodium phosphate, pH 6.8, in[] the presence of sonicated herring sperm DNA, followed by washing two times for thirty minutes with 2[]x 0.15 M sodium chloride/0.015 M sodium citrate plus 0.1% SDS at room temperature.

The DNA probe of claim 13 wherein the probe is at least seventeen nucleotides in length.

#### Grounds of Rejection

Initially, we note that the rejection of claim 14 under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form and the rejection of claim 13 under 35 U.S.C. § 102(b) were withdrawn in the Answer (Paper No. 18, mailed May 10, 1996). The remaining rejections on appeal are as follows:

Claims 13-15 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.<sup>1</sup>

Claims 13-15 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

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<sup>1</sup> The objection to the specification and corresponding rejection under 35 U.S.C. § 112, first paragraph raise the same issue. See, MPEP § 2163.06(II) (7<sup>th</sup> ed., rev. 1, February 2000).

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Claims 13-15 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 14, 15, 17 and 18 of copending application Serial No. 07/948,350.

We reverse the rejections under 35 U.S.C. § 112, first and second paragraphs, and we affirm the obvious-type double patenting rejection.

#### DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. We make reference to the Answer for the examiner's reasoning in support of the rejection. We further reference the Brief (Paper No. 17, filed December 29, 1995) for appellant's arguments in favor of patentability.

The rejections under 35 U.S.C. § 112, first paragraph, concerning adequate written support for the claims:

#### Claims 13-15:

The examiner maintains that the limitations added to claim 13, by the amendments filed February 17, 1994 (Paper No. 7) and March 10, 1995 (Paper No. 10) effectively broaden the scope of claim 13 to include subject matter not originally disclosed in the

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specification.<sup>2</sup> Claim 13, as originally filed, was drawn to “[a] DNA probe which contains a portion of the DNA sequence shown in Figure 1 effective to detect the presence of human MCP-encoding DNA.” The examiner states that hybridization conditions now present in the claim 13 were not originally disclosed as “directed to the hybridization of any generic DNA probe that hybridizes to SEQ ID NO:1.” See, Answer, page 3. The examiner finds no disclosure that demonstrates that the phrase “effective to detect” corresponds with “the specific hybridization conditions now in [amended] claim 13 that is directed to generic probe usage.” See, Answer, page 3.

Appellant argues, for a variety of reasons, that the disclosure as originally filed reasonably conveys to those of skill in the art that appellant had possession of DNA probes as now claimed. See, Brief, pages 4-7. We agree.

As set forth in, In re Wright, 866 F.2d 422, 424, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989) (alteration in original):

When the scope of a claim has been changed by

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<sup>2</sup> We note the Preliminary Amendment filed October 20, 1993 (Paper No. 4), page 2, added the phrase “[a]s described in Molecular Cloning. A Laboratory Manual, Sambrook, *et al.*, (Cold Spring Harbor Laboratory Press, 1989), sequences of at least seventeen consecutive nucleotides of” before the words “The cDNA” on page 9, line 32 of the specification. The examiner did not mention this amendment to the specification in his analysis, nor did the examiner object to this amendment under 35 U.S.C. § 132.

amendment in such a way as to justify an assertion that it is directed to a different invention than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the invention of the applicant. . . . The question arises in a variety of situations some of which are catalogued in In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973). As our predecessor court said in that case:

The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. In re Ruschig, *supra*, 54 CCPA [1551]at 1559, 379 F.2d [990]at 996, 154 USPQ [118]at 123. When the original specification accomplishes that, regardless of *how* it accomplishes it, the essential goal of the description requirement is realized.

In deciding the issue, the specification as a whole must be considered.

The specification discloses the invention as “genetic probes.” See, e.g., Specification, page 4. We note that no size or other physical constraint is placed on these probes as described in the “Disclosure of the Invention.” See, Specification, page 3. We recognize that appellant recites probe size and hybridization conditions in both the “Modes of Carrying Out the Invention” and “Example 2.” See, Specification, pages 9, 10 and 11. Admittedly, the specification does not contain language that corresponds identically to the language of the claims on appeal. However, the disclosure describes probes for human membrane cofactor protein effective to detect the DNA sequence in Sequence Listing I.D.

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No. 1 when hybridized under the recited conditions. See, Specification, page 11. After reading the specification, one skilled in the art would not assume that the invention was limited to only a particular set of probes as suggested by the examiner. The tenor of the specification is that a generic invention has been made. See, In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973). On this record, we agree with appellants that the disclosure as originally filed reasonable conveys to those of skill in the art that appellant had possession of DNA probes as now claimed.

Claim 15:

The examiner maintains the position that the specification fails to disclose an upper limit for the claimed probe of “[n]ewly added claim 15 . . . regarding the limitation ‘at least seventeen nucleotides in length’.” See, Answer, pages 5 and 14.

As discussed above, the specification discloses the invention as “genetic probes.” No size or other physical constraint is placed on these probes as described in the “Disclosure of the Invention.” See, Specification, page 3. We recognize that appellant recites probe size and hybridization conditions in both the “Modes of Carrying Out the Invention” and “Example 2.” See, Specification, pages 9, 10 and 11. The lower limit of the probe size is defined by the specification to be a 17-mer. See, e.g., Specification, page 10. Therefore, appellant’s specification does describe as the invention probes of “at least

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17 nucleotides in length” that are effective to detect the DNA sequence in Sequence Listing I.D. No. 1 under specific conditions. See, In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 99 (CCPA 1976) (“[A]ppellants’ specification does describe as their invention processes in which particle size is ‘at least 0.25 mm,’ without upper limit”). On this record, we agree with appellants that the disclosure as originally filed reasonable conveys to those of skill in the art that appellant had possession of DNA probes of at least seventeen nucleotides in length as now claimed.

Accordingly, the rejections of the claims under 35 U.S.C. § 112, first paragraph, are reversed.

The rejection under 35 U.S.C. § 112, second paragraph:

At pages 6 and 15 of the Answer, the examiner is concerned that the word “hybridizing” (1) could include both the probe and its target as a duplex, and/or (2) is suggestive of a method step. We recognize that the claim language is less than clear. However, we do not agree with the examiner’s position that the claims are vague and indefinite.

As set forth in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), 35 U.S.C. §112, second paragraph, requires only that the claims “set out and circumscribe a particular area with a reasonable degree of precision and particularity.”

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The court stated that the claim language must be analyzed “not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art.” When the claim is read by one skilled in this art, in light of the teachings of the prior art and appellant’s disclosure, we agree with appellant that “what is being claimed is a DNA probe which hybridizes to and is effective to detect the recited DNA sequence under specific conditions. The term hybridizing is clearly not intended to refer to a duplex DNA per se, but rather to indicate a property of the claimed DNA probe.” See, Brief, bridging paragraph, pages 8-9. Accordingly, the rejection under 35 U.S.C. § 112, second paragraph, is reversed.

The provisional rejection of claims 13-15 under the judicially created doctrine of obviousness-type double patenting:

Appellant did not address the merits of this rejection. Instead, appellant affirms the intent, at page 16 of the brief, “to file an appropriate terminal disclaimer when the claims are indicated to be otherwise allowable.” Accordingly, we affirm the rejection of the claims under the judicially created doctrine of obviousness-type double patenting.

#### SUMMARY

The rejections of claims 13-15 under 35 U.S.C. § 112, first paragraph and second

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paragraph are reversed. The rejection of claims 13-15 under the judicially created doctrine of obviousness-type double patenting is affirmed.<sup>3</sup>

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<sup>3</sup> We recognize that application Serial No. 07/948,350 serving as the basis for this “provisional” rejection issued on May 7, 1996 as United States Patent No. 5,514,787. Therefore, this rejection is no longer “provisional.”

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

AFFIRMED

SHERMAN D. WINTERS )  
Administrative Patent Judge )  
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DOUGLAS W. ROBINSON) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
) INTERFERENCES  
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DONALD E. ADAMS )  
Administrative Patent Judge )

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