

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHI-HUEY WONG

Appeal No. 1999-1331
Application No. 08/547,602

ON BRIEF

Before ROBINSON, SCHEINER, and MILLS, Administrative Patent Judges.
ROBINSON, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellant requests reconsideration (rehearing) of the board's decision entered January 30, 2001, wherein the examiner's rejection of the appealed claims under 35 U.S.C. § 103 was affirmed.

In effect, appellant's request is premised upon assertions that the board failed to consider and properly weigh the evidentiary relevance of Green, failed to disclose a basis for affirming the rejection as to claim 15 and applied an improper standard with regard to appellant's allegation of unexpected cost savings.

We would, initially, note that appellant is correct concerning the typographical error page 4, second sentence which refers to "L-fuculose isomerase" rather the correct term "fucose isomerase."

To the extent that appellant presents arguments with respect to the deficiency of Green as to whether the description should be read as describing a fucose isomerase, we would note that these arguments were not presented in this manner in either the Appeal Brief or the Reply Brief. We would note that appellant had raised a similar argument in the paragraph bridging pages 4-5 of the response filed July 8, 1997 (Paper No. 7). It would appear that this argument was directed to the patentability of at least claim 1, which was pending in the application at that time, and which required the use of a purified L-fucose isomerase. That limitation is not present in the claims currently pending in this application. However, the examiner responded to this argument at pages 3-4 of the Office action of October 20, 1997 (Paper No. 8) stating :

[t]he cell-free extract disclosed by Green is encompassed by the claim language "purified" present in claim 1. It is respectfully submitted that unless it is clear from reading the specification that the word "purified" is intended to have such a meaning, the language "purified" does not mean that the enzyme is purified to homogeneity, or by a particular process, unless the claims so recite. Note that the examples in the specification all use "crude extract" (820 Units/ml) of L-fucose isomerase. See specification at pages 27 (line 6), page 28 (line 11), page 29 (lines 13 and 14). Note also that claim 12 does not recite that the enzyme is purified. Thus, the language "purified" in claim 1 does not distinguish the claimed process from that suggested by the cited prior art.

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Appellant did not renew these arguments, or take issue with the examiner's conclusion stated in the Final Rejection, in either the Brief or Reply Brief. Thus, these arguments are not properly before us. 37 CFR § 1.192(a)(1998)("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown").

As to the basis for affirmation of the rejection of claim 15, we refer to that portion of the decision of January 30, 2001 appearing at page 7, first full paragraph which addresses appealed claim 15, specifically.

As to appellant's arguments concerning the standard applied with respect to the allegation of unexpected cost savings, we are not persuaded that the standard applied in our decision of January 30, 2001 was erroneous. To the extent that appellant would seek to compare the present claimed process to a "hypothetical process" (Request, page 6), it naturally follows that any comparison of cost savings would of necessarily be hypothetical and of little persuasive value. We would remind appellant that as set forth in In re Wright, 999 F.2d 1557, 1563, 27 USPQ2d 1510, 1514-15 (Fed. Cir. 1993), evidence which is in the nature of unsupported conclusory statements as to the ultimate legal question is entitled to little if any weight.

We have carefully reviewed the original opinion in light of appellant's request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our decision. To the extent relevant, appellant's request amounts to a reargument of points already considered by the board.

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