



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMI CHEMICALS AND EXTRACTS, LTD.,
Appellant

Appeal 2007-3482
Reexamination Control 90/007,327
Patent 5,804,596
Technology Center 3900

Decided: February 2, 2009

Before CAROL A. SPIEGEL, ROMULO H. DELMENDO, and
ERIC GRIMES, *Administrative Patent Judges*.¹

SPIEGEL, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellant requests rehearing under 37 C.F.R. § 41.52 of the Decision on Appeal mailed December 13, 2007 ("BPAI Decision"). Appellant argues that the Decision was based on a new claim interpretation not previously

¹ Administrative Patent Judges Teddy S. Gron and Adriene Lepiane Hanlon participated in our 13 December 2007 Decision but Judge Gron has retired and Judge Hanlon is unavailable. Accordingly, Administrative Patent Judges Eric Grimes and Romulo H. Delmendo have replaced them on this panel. *Cf. In re Bose Corp.*, 772 F.2d 866, 869 (Fed. Cir. 1985).

presented to Appellant during prosecution, thereby constituting a new ground of rejection (RR² 1). Appellant argues it is entitled to a full and fair opportunity to respond to the alleged new ground of rejection (RR 1-2). "To this end, Appellants respectfully request reopening of prosecution under 37 C.F.R. § 41.50(b)(1) and remand of the case to the Examiner, so that Appellants may amend the claims and otherwise respond to the outstanding rejections in a manner consistent with the new claim construction adopted by the Board" (RR 2). (Prosecution after a final decision of the Board can only be reopened under 37 C.F.R. § 41.50 in reexamination proceedings. *See* 37 C.F.R. §§ 1.114, 1.114(e)(5), and 1.198.) We conclude that our affirmance of the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) does not amount to a new ground of rejection.

Claims 1 and 5, the only independent claims on appeal, are illustrative of the subject matter on appeal and read (emphasis added):

1. A method of promoting lean body mass in a human individual in need thereof, comprising administering to the individual a lean body mass *promoting* effective amount of forskohlin.
5. A method of *shifting the proportion between lean body mass and adipose tissue in favor of lean body mass* in a human individual in need thereof, comprising administering to the individual a proportion shifting effective amount of forskohlin.

Findings of fact set forth in this Decision are supported by a preponderance of the evidence of record.

² Request For Rehearing Under 37 C.F.R. § 41.52 filed 25 September 2008 ("RR").

I. Procedural History

- [1] U.S. Patent 5,804,596 ("the 596 patent") issued on September 8, 1998 with eight claims.
- [2] A request for *ex parte* reexamination of the 596 patent was filed by the patent owner (Appellant) on December 1, 2004, and assigned reexamination control number 90/007,327.
- [3] An Order granting reexamination of all of the claims of the 596 patent was mailed on February 4, 2005.
- [4] The reexamination proceeding progressed to a point where, on December 23, 2005, an Office action was mailed, in which all of the claims then pending in the reexamination, claims 1-34, were finally rejected.
- [5] An improper Request for Continued Examination (RCE) with an amendment, affidavit, drawings, and translation, was filed on February 23, 2006. On March 9, 2006, Appellant was notified that the amendment was improper because it failed to comply with 37 C.F.R. § 1.530(d)-(j). Another response was filed on March 20, 2006.
- [6] In a decision mailed April 6, 2006, the improper RCE papers were returned to Appellant and the amendment was placed in the file for consideration by the Examiner as a response to the final rejection.
- [7] The Examiner mailed an advisory action on April 21, 2006, stating that the response to the final rejection had been considered but did not overcome all of the rejections and that the amendment would be entered upon filing an appeal.

- [8] The final rejection was appealed. An Appeal Brief was filed on June 27, 2006. An Examiner's Answer was mailed on November 7, 2006. A Reply Brief was filed on January 5, 2007.
- [9] After an oral hearing on October 17, 2007, the BPAI Decision was mailed on December 13, 2007. In the BPAI Decision, the rejection of claims 31 and 32 under 35 U.S.C. § 112, first paragraph, was reversed, but the rejections of (a) claims 1, 5, 9, 10, and 31-34 under 35 U.S.C. § 102(b) as anticipated by Kazuo, (b) claims 1, 5, 11, 12, and 31-34 under 35 U.S.C. § 102(b) as anticipated by Greenway III or Greenway IV, and (c) claims 1-34 under 35 U.S.C. § 103(a) as obvious over Kazuo were sustained.
- [10] On February 11, 2008, Appellant filed a petition under 37 C.F.R. § 1.182 requesting continued examination of the 596 patent, which included a supplemental amendment seeking to cancel claims 5-8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, and 34 and to replace the terms "promoting" or "promotes" in claims 1 and 31, respectively, with "increasing" or "increases." Concurrently, Appellant filed a notice of appeal to the U.S. Court of Appeals to the Federal Circuit for review of the Decision.
- [11] On March 6, 2008, the Office of Patent Legal Administration granted the petition under 37 C.F.R. § 1.182.
- [12] On March 28, 2008, the Office of Patent Legal Administration mailed a decision vacating its March 6, 2008 decision, stating it lacked jurisdiction and referring the matter to the Office of the Solicitor.

- [13] On April 3, 2008, Appellant filed a motion requesting a limited remand from the Federal Circuit to the Office for the purpose of allowing the Office to decide Appellant's February 11, 2008 petition.
- [14] On May 29, 2008, the Federal Circuit granted Appellant's motion for limited remand. The Federal Circuit's order stated that the "motion for a limited remand is granted for the purpose of allowing the Board to consider" Appellant's position.
- [15] On June 9, 2008, Appellant and the USPTO jointly moved under Federal Circuit Rule 27(1) for reconsideration of the Court's May 29, 2008 order, requesting that the Court clarify its order to specify that the remand was to the USPTO rather than to the Board.
- [16] On July 17, 2008, the Court issued an order granting the parties' motion for reconsideration and clarifying that the "case is remanded for the limited purpose of allowing the PTO to consider Sami Chemicals' petition."
- [17] On July 28, 2008, the Office of the Solicitor denied Appellant's petition under 37 C.F.R. § 1.182 because prosecution can only be reopened after a final decision by the Board under 37 C.F.R. § 41.50 in reexamination proceedings. *See* 37 C.F.R. §§ 1.114, 114(e)(5), and 1.198. The Solicitor concluded Appellant had directed its petition to the wrong entity.
- [18] Concurrently, the Board *sua sponte* ordered the applicable rules waived and gave Appellant sixty days from July 28, 2008 in which to file a request for rehearing under 37 C.F.R. § 41.52 of the BPAI Decision of December 13, 2007.

[19] Appellant timely filed its request for rehearing on 25 September 2008.

II. Request for Rehearing

[20] Appellant summarized its request for reconsideration as follows:

Appellants request rehearing under 37 C.F.R. § 41.52 and submit that the Board issued a new ground of rejection in the Decision on Appeal. Appellants submit that the new ground of rejection is based on a new claim interpretation not previously presented to Appellants during prosecution. Appellants submit that they are entitled to a full and fair opportunity to respond to the new ground of rejection. To this end, Appellants respectfully request reopening of prosecution under 37 C.F.R. § 41.50(b)(1) and remand of the case to the Examiner, so that Appellants may amend the claims and otherwise respond to the outstanding rejections in a manner consistent with the new claim construction adopted by the Board. (RR 2.)

[21] Four claim terms were construed by the Board in the BPAI Decision - --"promoting," "administering," "effective amount," and "human individual in need thereof" (BPAI Decision 7-10).

[22] The Board found the ordinary meaning of "promoting" is to further or help bring into being and that the language, "[a] method of promoting lean body mass," of claim 1 was unambiguous on its face (BPAI Decision 7).

[23] The Board

broadly interpret[ed] "promoting" lean body mass, consistent with the '596 specification, as

"furthering or bringing about" lean body mass.
"Promoting" lean body mass is not limited solely to "increasing" lean body mass, but also encompasses furthering lean body mass by maintaining lean body mass; reducing body fat relative to lean body mass; inducing cAMP mechanisms; and, improving absorption of nutrients and their preferential incorporation into lean body mass. (BPAI Decision 8).

[24] Appellant contends that during prosecution "both the Appellants and the Examiner presumed the term 'promoting' in claim 1 meant 'increasing'" (RR 4).

[25] However, according to the Background of the Invention section of the '596 patent, prior art

weight control means do not take into account the importance of maintaining or increasing the lean body mass in the process of weight loss. (Spec. 1:58-60).

. . . By maintaining or increasing the lean body mass while simultaneously reducing body fat, the weight loss regimen would serve the general purpose of improving the overall health of the individual.

Maintaining or increasing the lean body mass (for example, skeletal muscles) is one of the important considerations for any weight loss strategy because lean body mass determines the rate of metabolism and the body's thermogenic response to food, and food induced thermogenesis and the metabolic rate, in turn, control body weight by an increased metabolism of body fat. (Spec. 2:3-13).

[26] The '596 patent describes the invention as

. . . shift[ing] the proportion between lean body mass and adipose tissue in favor of lean body mass in order to restore the ideal physiological proportions between lean and fat body mass . . . (Spec. 3:37-41).

. . . the present inventors believe that the invention increases the lean body mass by stimulating the enzyme adenylate cyclase (AC), with a resulting increase in the levels of cAMP. The increase[d] levels of cAMP in the tissues correspond well to enhancing the thermogenic response to food. An increase in the thermogenic response to food, in turn, improves absorption of nutrients and their preferential incorporation into lean body mass. Thus, the formation of lean body mass is promoted. (Spec. 3:45-53)

[27] According to Appellant, "[b]y focusing on the maintenance of lean body mass during dieting, the present inventors have made a significant advance in approaches to weight management" (App. Br.³ 4).

[28] Further according to Appellant, prior art "weight control programs do not take into account the importance of maintaining or increasing lean body mass in the process of weight loss. . . By maintaining or increasing the lean body mass while reducing body fat, the present invention serves the general purpose of improving the overall health of the individual" (App. Br. 4).

³ Brief on Appeal filed 27 June 2006 ("App. Br.").

- [29] Appellant argues that "[t]he distinctions of a 'lean body mass promoting effective amount' or a 'proportion shifting effective amount' of forskohlin, and the administration to a 'human individual in need thereof' . . . distinguish the invention not only from the art cited in the initial prosecution of the '596 patent, but also from the art currently cited by the Examiner" (App. Br. 5-6).
- [30] Appellant presented essentially the same patentability arguments against claims 1 and 5 (App. Br. 17, 24, and 27).
- [31] The Examiner found, in part, that claims 1 and 5 are anticipated under 35 U.S.C. § 102(b) over the same references, i.e., Kazuo, Greenway III, or Greenway IV (Ans.⁴ 4-8).
- [32] For example, the Examiner stated "[t]he Greenway references have clearly shown that the forskohlin-treated thigh loses more girth than the control thigh . . . Lean body mass has the ordinary meaning of the mass of the body minus fat. Accordingly, reduction of thigh girth, which is indicative of localized fat reduction, would translate to promotion of localized lean body mass" (Ans. 22).
- [33] Appellant does not dispute the reasonableness of the Board's claim construction or dispute its holding that (i) claims 1, 5, 9, 10, and 31-34 are unpatentable under § 102(b) as anticipated by Kazuo, (ii) claims 1, 5, 11, 12, and 31-34 are unpatentable § 102(b) as anticipated by Greenway III or Greenway IV, and (iii) claims 1-34 are unpatentable under § 103(a) as obvious over Kazuo.

⁴ Examiner's Answer mailed 7 November 2006 ("Ans.").

III. Discussion

Appeal to the Board is from a decision of the Examiner, not from the reasons upon which such decision is based. Apparently, it is Appellant's position that whenever the Board sets forth a claim construction that was not expressed in the same words by the Examiner, it follows that the claim construction constitutes a new ground of rejection. We disagree.

The criterion of whether a rejection is considered "new" in a decision by the Board is whether Appellant has had a fair opportunity to react to the thrust of the rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). Here, we agree with the Examiner's basis for rejecting (a) claims 1, 5, 9, 10, and 31-34 under 35 U.S.C. § 102(b) as anticipated by Kazuo, (b) claims 1, 5, 11, 12, and 31-34 under 35 U.S.C. § 102(b) as anticipated by Greenway III or Greenway IV, and (c) claims 1-34 under 35 U.S.C. § 103(a) as obvious over Kazuo. We also agree with the Examiner that Appellant has not provided sufficient evidence on this record to establish that the subject matter defined in claims 1-34 is patentable over the prior art. The Examiner reviewed Appellant's evidence, as did we (*see* BPAI Decision 12-16 and 18-20). The basic thrust of the rejection by the Examiner and the Board was the same, and we believe that Appellant has had a fair opportunity to react to those rejections.

In particular, the Examiner (FF 31-32) and the '596 patent specification (FF 25-26) both suggest that promoting lean body mass is not limited to increasing lean body mass, but also encompasses maintaining lean body mass while decreasing adipose tissue and that increasing lean body mass may further enhance promoting lean body mass. Indeed, the fact that

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the Examiner rejected claims 1 and 5 together under § 102(b) suggests that she deemed a method of promoting lean body mass (claim 1) and a method of shifting the proportion between lean body mass and adipose tissue in favor of lean body mass (claim 5) to be the same method discussed in the prior art, i.e., Kazuo and the Greenway references (FF 31). Moreover, the Examiner indicates in her discussion of the Greenway references that body mass is the sum of lean body mass plus body fat and, thus, reduction of fat would translate into promotion of lean body mass (FF 32). Thus, it reasonably appears the Examiner broadly interpreted "promoting" lean body mass to not only include increasing lean body mass as argued by Appellant, but also to include reducing body fat relative to lean body mass. Therefore, it appears on its face that the Examiner and the Board were all construing "promoting" in a similar manner consistent with the '596 patent specification.

Therefore, we will not designate our affirmance as constituting a new ground of rejection under 37 C.F.R. § 41.50(b).

IV. Conclusion

Appellant's request for rehearing has been granted to the extent that the BPAI Decision on Appeal mailed December 13, 2007 has been reconsidered in light of Appellant's arguments. However, the request is denied because we decline to modify the BPAI Decision in any respect.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. §§ 1.550(c) and 41.52(b).

REHEARING DENIED

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