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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/038,641	03/02/2011	Jean Krutmann	BITA0104PUSA1	9227
62836	7590	03/24/2020	EXAMINER	
Brooks Kushman P.C. / BERLINER & ASSOCIATES 1000 Town Center, 22nd Floor 22nd Floor Southfield, MI 48075			SIMMONS, CHRIS E	
			ART UNIT	PAPER NUMBER
			1629	
			NOTIFICATION DATE	DELIVERY MODE
			03/24/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JEAN KRUTMANN

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Appeal 2019-000294  
Application 13/038,641  
Technology Center 1600

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Before RICHARD M. LEBOVITZ, JOHN G. NEW,  
RACHEL H. TOWNSEND *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is Request for Rehearing Pursuant under 37 C.F.R. § 41.52 (“Req. Reh’g”) (filed Jan. 27, 2020) of the Decision on Appeal (“Dec.”) (Entered Nov. 26, 2019). We have jurisdiction under 35 U.S.C. § 6(b). The rehearing is DENIED.

## Discussion

In the Decision on Appeal, the Examiner's final rejection of claims 11 and 13 as failing to comply with the enablement requirement was affirmed.

Dec. 2. Claim 11, the only independent claim, is reproduced below.

11. A method for counteracting lung tissue exposure to suspended particulate in a patient in need thereof, comprising administering by inhalation an effective amount of at least one osmolyte selected from ectoine, hydroxyectoine or a pharmacologically compatible salt thereof to the patient.

Appellant filed a Request for Rehearing of the Board's decision to affirm the rejection of the claims. Appellant contends that we misinterpreted claim 11. Specifically, Appellant contends that that "the Board either ignored, defined in isolation, or misinterpreted: (a) 'counteracting,' (b) 'prophylactic effect' and 'exposure,' and (c) 'also suitable for the treatment of diseases.'" Req. Reh'g 2.

In the Decision, we interpreted "counteracting" to mean "having a restraining or neutralizing effect." Dec. 4. Based on this interpretation and the disclosure in the Specification, we found that "counteracting lung tissue exposure to suspended particulate in a patient" by administering one of the recited osmolytes included both disease prevention and disease treatment.

Dec. 5. As explained in the Decision:

When a disease is *treated* by the recited osmolyte, the noxious effects of the particulate are counteracted because their disease-causing effects are neutralized (dictionary definition of "counteract"). The result of administering the osmolyte is to treat the disease and therefore the noxious influence of suspended particulate is counteracted, even if the treatment occurs after the particulate has caused the disease and the treatment treats a secondary result (e.g., tissue injury) of the particulate activity.

Dec. 6.

Appellant did not identify a flaw in this reasoning. Rather, Appellant repeats the same argument about there being a distinction between “prophylactic counteracting and treating” (Req. Reh’g 2) which was addressed in the Decision. Appellant also states:

For example, nowhere in the specification will one find any of the following diseases that the Examiner touted and the Board bought into: on page 4 of the Answer: “asbestosis, silicosis, cystic fibrosis, cancers such as mesothelioma, squamous, small cell lung cancer, etc.” then, “antiangiogenic therapies” on page 5. None of these diseases are ever mentioned in claim 11.

Req. Reh’g 2.

None of these diseases need to be mentioned in the claim. The reason that certain diseases were identified in the Examiner’s Answer and Decision on Appeal was to illustrate that the scope of the claim is broad because it includes “treatment” of any disease. The examples were illustrative to show that many different types of diseases fall within the claim.

Appellant further argues that it “chose to not claim treating but to claim prophylactically counteracting exposure to suspended particulate, a concept not shown by prior art.” Req. Reh’g 2. This argument does not persuade us that there was any misapprehension in the Board’s Decision. The claim, as reproduced above, does not recite the term “prophylactically counteracting.” The claim recites “counteracting lung tissue exposure to suspended particulate in a patient.” The term “prophylactically” does not appear in the claim. Therefore, the claim is not expressly limited to prophylaxis.

The Decision on Appeal explained why we construed the claim to include disease treatment. Appellant did persuasively demonstrate that such

an interpretation of the claim is unreasonable. Appellant attempts to import the word “prophylactic” into the claim, but for the reasons discussed in the Decision on Appeal, we reject this narrow reading of the claim.

Appellant states that, while the Specification mentioned that the claimed osmolytes are suitable for the treatment of diseases, the “only reasonable interpretation is to give the claims the scope actually stated in claim 11, namely that ‘counteract’ is prophylactic, i.e., to prevent disease, not treat it.” Req. Reh’g 3. For the reasons discussed in the Decision, namely that counteracting the noxious effect of particulates when a patient has the disease would result in disease treatment, we do not agree Appellant’s interpretation of the claim is the broadest, most reasonable, one.

#### Disease prevention

The Decision also stated that “even if treatment were excluded, the same rationale [of lack of enablement] applies to disease prevention and other neutralizing effects of the osmolyte.” Dec. 8. We explained that the broad concentration range of the osmolyte covered by the claim, the failure to disclose an effective amount of osmolyte, and the failure to disclose of frequency of administration of the osmolyte, indicates that the guidance in the Specification to achieve the stated purpose of the claims is inadequate to enable the full scope of the claim. Dec. 8. As stated in the Decision:

[T]he only examples (Wands factor 3) disclosed in the Specification are Examples 1 and 2 of making gas and powder inhalants comprising ectoine and hydroxyectoine. Spec. 7. There is no example in which either osmolyte, alone or both combined as in the inhalants of Examples 1 and 2, are used to counteract a particulate in the lung, let alone *prevent* or treat a condition caused by the particulate.

Dec. 8 (emphasis added.)

The Decision also stated that Appellant:

did not explain how this high level of skill [in the art] and the lung studies would enable one of ordinary skill in the art to carry out the full scope of the claim, such as to determine the dosages and frequency of administration to *prevent* inflammation and malignant pulmonary disease.

Dec. 10 (emphasis added).

In sum, the Decision also found the Specification deficient in enabling the prophylactic aspect of the claims.

In light of the above, we conclude that Appellant did not identify in the Request for Rehearing any points that were misapprehended or overlooked in the Decision. Accordingly, the Rehearing is denied.

#### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
11, 13	112	Enablement	11, 13	

DENIED