

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte BENOIT AGNUS and  
ANTOINE BESINS

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Appeal No. 2002-1353  
Application No. 09/268,353

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ON BRIEF

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Before WILLIAM F. SMITH, SCHEINER, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 23-35, all of the claims remaining. Claim 23 is representative and reads as follows:

23. A pharmaceutical composition in the form of a tablet comprising synthetic natural progesterone, and oestradiol, said tablet having an excipient content of no more than 20% by weight based on total dry matter weight of the tablet, said tablet having a disintegration time of less than 15 minutes.

The examiner relies on the following reference:

Gram et al. (Gram)                      WO 95/05807                      Mar. 2, 1995

Claims 23-35 stand rejected under 35 U.S.C. § 103 as obvious in view of Gram.

We reverse.

### Background

The specification discloses that “[d]rugs with a progesterone and oestradiol base in the form of tablets are already on the market. However, all the tablets known to date use synthetic progestagens, which do not have all the therapeutic effects of synthetic natural progesterone and may even have undesirable effects.” Page 2.<sup>1</sup> Thus, “it would be very attractive to have a tablet with a natural progesterone and oestradiol base.” Id.

Formulating a tablet containing synthetic natural progesterone, however, presents certain problems, because “natural progesterone must be used in much stronger dosages than the synthetic progestagens, i.e. 50 to 60 times more of the active principle relative to the tablet containing synthetic progestagens.”

Specification, page 3. Because so much more natural progesterone must be administered, “it is necessary to considerably decrease the excipient content in view of the constraints in size and weight appropriate to tablets.” Id.

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<sup>1</sup> The specification defines “synthetic natural progesterone” to mean “a synthesized progesterone the chemical formula of which corresponds to the ‘natural’ progesterone, such as is found in the female body.” Page 1. “Synthetic progestagens”, by contrast, are “entirely synthetic molecules such as trimegestone, norethisterone and others, the structure of which does not correspond to that of the natural progesterone.” Id.

“[E]xcipients in tablets play various roles. . . . [T]hey are used above all to facilitate the compression of the different ingredients in order to make a tablet having good characteristics of hardness, disintegration and dissolution.” Id. The specification discloses tablets comprising natural progesterone and estradiol and “contain[ing] significantly lower quantities of excipients than tablets of the prior art.” Page 5. Specifically, the tablets contain 20% or less by weight of excipients, relative to the total dry matter of the tablet. See id.

#### Discussion

The claims are directed to tablets comprising synthetic natural progesterone and estradiol, where the tablets have an excipient content of no more than 20% by weight (based on total dry matter weight of the tablet) and a disintegration time of less than 15 minutes.

The examiner rejected the claims as obvious in view of Gram. The examiner characterized Gram as teaching tablets containing progesterone and estradiol. Examiner’s Answer, page 3. The examiner acknowledged that Gram does not teach tablets containing less than 20% by weight of excipients, or tablets having a disintegration time of less than 15 minutes, but concluded that the claimed tablets would have been obvious anyway. See the Examiner’s Answer, page 3:

[T]he formulation of tablets having various disintegration times, amounts of excipients, dissolution profile and hardness is well known in the pharmaceutical art and, thus, is within the level of skill of the ordinary artisan in the art (see for example Gram et al., page 2, paragraph #3; page 8, line 29 – page 10, line) [sic]. The motivation to make tablets having various disintegration times, amounts of excipients, dissolution profile and hardness is based on

the desire to obtain a tablet form that is convenient for oral administration.

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). “It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references.” Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In this case, the examiner has pointed to nothing in the prior art that would have led those skilled in the art to modify the tablets disclosed by Gram in order to reduce the amount of excipients to no more than 20% by weight. As Appellants point out, all of the exemplary compositions disclosed by Gram contain much more than 20% by weight of excipients. According to Appellants, the amount of excipient in Gram’s compositions ranges from 49.4% to 87.5%. See the Appeal Brief, page 5. The examiner does not dispute Appellants’ figures.

In addition, we note that Gram discloses that, in one “preferred embodiment”, the amount of starch per dosage unit is “most preferred from about

21% to about 30% by weight of the dosage unit.” See page 6. Gram teaches that other excipients may be added as diluents, binders, disintegrants, lubricants, buffers, and preservatives. See page 8, line 29, to page 9, line 5. Thus, Gram not only does not suggest lowering the amount of combined excipients to a maximum of 20%, it teaches away from doing so.

It is true that Gram states that “[t]he kind and amount of excipients . . . depends very much on the physicochemical properties of the active compound to be administered and on the desired absorption profile.” This statement provides a general suggestion to vary the amount of excipients. However, the reference must be considered as a whole. “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). The reference by Gram, when read in its entirety and without the benefit of hindsight, would not have suggested modifying its disclosure in the manner recited in the instant claims.

Summary

The prior art relied on by the examiner does not suggest the product of the instant claims. The rejection under 35 U.S.C. § 103 is therefore reversed.

REVERSED

William F. Smith	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Toni R. Scheiner	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Eric Grimes	)	
Administrative Patent Judge	)	

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