

The opinion in support of the decision being entered today is not binding precedent of the board

Paper 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH P. STEINER and GREGORY S. HAMILTON,

Appeal 2003-1107
Application 09/878,225¹

Before: WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and MCKELVEY, Senior Administrative Patent Judge.

MCKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

The appeal is from a decision of a primary examiner rejecting claims 37-72. We affirm.

A. Findings of fact

The record supports the following findings by at least a preponderance of the evidence. To the extent any finding is a conclusion of law, the finding may be treated as a conclusion of law.

¹ Application for patent filed 12 June 2001. The application is said to be a division of application 09/089,831, filed 3 June 1998, now U.S. Patent 6,274,602 issued 14 August 2001. The real party in interest is said to be GPI NIL Holdings, Inc. (Appeal Brief, Paper 11, page 1).

1. Claims 37-72 are pending on appeal (Appeal Brief, Paper 11, page 2 and Appendix).

2. According to applicants, "[f]or the purpose of this appeal only, the claims stand or fall together for each ground of rejection ***" (Appeal Brief, page 2).

3. Pursuant to 37 CFR § 1.192(c)(7)(2002), we select independent claim 37 and decide the appeal solely on the basis of claim 37.

4. Claim 37 reads as follows:

A pharmaceutical composition which comprises:

- (i) an effective amount of a heterocyclic compound having one nitrogen heteroatom, which has a substituent attached to said nitrogen [hetero]atom of the heterocyclic ring,² which is -C(W)-C-(Y)-, wherein W and Y are independently selected from the group consisting of O [oxygen], S [sulfur], CH₂, and H₂, and which compound is additionally substituted with a thioester or ketone substituent attached to any carbon atom of the heterocyclic ring,³ provided that said thioester or ketone substituent is not an N-oxide of said thioester or ketone substituent; and
- (ii) a pharmaceutically acceptable carrier.

² Strictly speaking, there is no antecedent for the language "the heterocyclic ring". Moreover, the language would appear to be unnecessary since "said nitrogen [hetero]atom" necessarily refers to "one nitrogen heteroatom".

³ With respect to the language "the heterocyclic ring", see n.2.

5. A more complete understanding of the heterocyclic compound can be had by reference to Formula I on page 12 of the specification, where for example, when X is oxygen [O] and Z is -CH₂-, the "XZR₁" moiety would be a ketone attached to a carbon atom between the nitrogen [N] and B atom on the heterocyclic ring.

6. The pharmaceutical compositions are said to be useful "for treating alopecia and promoting hair growth" (specification, page 1, lines 13-14).

7. The examiner finally rejected the claims on appeal as being unpatentable under 35 U.S.C. § 103 over PCT application WO 97/31898.⁴

8. The examiner also finally rejected the claims on appeal as being unpatentable under 35 U.S.C. § 103 over Hamilton, U.S. Patent 5,786,378.⁵

9. The examiner found that the PCT application "discloses compounds of the instant composition and that they

⁴ The PCT application was published on 4 September 1997. Accordingly, at least for the purpose of this appeal, the PCT application is prior art under 35 U.S.C. § 102(a) assuming for the purposes of this appeal that applicants are entitled under 35 U.S.C. § 120 to the benefit of their parent application. In the Appeal Brief, applicants do not contest the prior art status of the PCT application.

⁵ The patent issued 28 July 1998 based on an application filed 25 September 1996. The patent names Gregory S. Hamilton and Jia-He Li as inventors. Accordingly, the patent is to "another" vis-a-vis the applicants named in the application on appeal. Hamilton is therefore facially prior art under 35 U.S.C. § 102(e). In the Appeal Brief, applicants do not contest the prior art status of the Hamilton patent. Moreover, we note that applicants have not sought to invoke the provisions of 35 U.S.C. § 103(c). It may be that the application which matured into the Hamilton patent and the application on appeal were not originally owned by the same entity. In this respect, we note that the Hamilton patent identifies its assignee as being GPI Nil Holdings, Inc.; the address to which communications in the application on appeal have been addressed identifies Guilford Pharmaceuticals. We express no views on whether facts exist for invoking 35 U.S.C. § 103(c) in this case.

may be used in pharmaceutical compositions" (Final Rejection, Paper 8, page 3; Examiner's Answer, Paper 12, page 4). We construe the examiner's finding, as applied to claim 37, to be that the PCT application describes compounds within the scope of claim 37 and that those compounds may be used in combination with a pharmaceutically acceptable carrier.

10. The examiner's findings are supported by substantial evidence.

11. The PCT application describes compounds having the general formula M-L-Q, where the M moiety falls within the scope of the heterocyclic compounds mentioned in claim 37 (PCT application, page 3). The Q moiety also falls within the scope of the heterocyclic compounds of claim 37.

12. The compounds described by the PCT application are said to be useful in combination with a "pharmaceutically acceptable carrier or excipient" (PCT application, page 42, line 17).

13. The PCT application goes on to say that the compounds may be administered or applied in the form of an ointment, a lotion or a cream (PCT application, page 45, lines 5-7).⁶

14. The examiner found that Hamilton "discloses compounds that are the compounds of the instant compositions of

⁶ The mode of administration described in the PCT application is essentially the same as that described by applicants (see specification, page 37).

*** [claim] 37 ***" (Final Rejection, Paper 8, page 2, Examiner's Answer, page 3).

15. The examiner also found that Hamilton discloses

(1) "that the compounds may be administered in compositions" (Final Rejection, Paper 8, page 2) and

(2) "a pharmaceutical composition *** comprising these compounds" (Examiner's Answer, page 3).

16. The examiner's findings are supported by substantial evidence.

17. Hamilton describes compounds within the scope of claim 37 (see, e.g., the formula at col. 3, lines 1-9).

18. The compounds described by Hamilton are said to be useful in combination with a "pharmaceutically-acceptable carrier, adjuvants and vehicles" (col. 12, lines 34-35).

19. The PCT application goes on to say that the compounds may be administered as "topical formulations" (col. 13, lines 24-29).

20. In what can be characterized at best as a half-hearted effort, applicants in the Appeal Brief (Paper 11, pages 3-4) argue as follows with respect to the examiner's rejection based on the PCT application:

According to the Examiner, *** [the PCT application] discloses compounds of some of the rejected claims and their use in compositions. Office action of 5/7/2, p. 3, ll. 1-8.

Even if these findings were true,⁷ they themselves would not establish a prima facie case of obviousness. As already noted, a prima facie case requires a desirable reason to modify a reference to reach the claimed invention.

But in this rejection conspicuously absent from the record is any reason to modify the teachings of *** [the PCT application] to include, e.g., "an effective amount of a heterocyclic compound" of the claimed invention. Therefore, the rejection is improper and should be reversed.

21. The examiner provided a complete answer to applicants' argument by referring in the Examiner's Answer (Paper 12, page 4, line 1) to page 42 of the PCT application. There described are "pharmaceutical compositions comprising a therapeutically *** effective amount of the compound and a pharmaceutically acceptable carrier or excipient" (PCT application, page 42, lines 15-17).⁸

22. Applicants in the Appeal Brief (Paper 11, page 3) argue as follows with respect to the examiner's rejection based on the PCT application:

According to the Examiner, *** [Hamilton] discloses compounds of some of the rejected claims and their use in compositions. Office action of 5/7/2, p. 2, ll. 14-17. Even if these findings were true,⁹ they themselves would not establish a prima facie case of obviousness. Neither urging

⁷ In the Appeal Brief, applicants do not explain why "these findings" are wrong or otherwise are not supported by the evidence.

⁸ We believe applicants' sole argument for reversal with respect to the PCT application borders on frivolous. In this respect, we note that no reply brief was filed to respond to the Examiner's Answer.

⁹ See n.7.

a reference is modifiable nor implying one of ordinary skill in the art would modify a reference to reach the claimed invention establishes a prima facie case. MPEP § 2143.01. The prima facie case requires a desirable reason to modify a reference to reach the claimed invention. Id.

Yet in this rejection conspicuously absent from the record is any reason to modify the teachings of *** [Hamilton] to include, e.g., "an effective amount of a heterocyclic compound" of the claimed invention. Therefore the rejection is improper and should be reversed.

23. The examiner provided a complete answer to applicants' argument by referring in the Examiner's Answer (Paper 12, page 3, line 1) to col. 14, lines 6-16 of Hamilton. There Hamilton states:

The present invention also relates to a pharmaceutical composition comprising:

- (i) a neurotrophically effective amount of the compound of formula I, II, III or IV, and
- (ii) a pharmaceutically acceptable carrier.

24. The examiner also called attention to columns 2-14. Col. 12, line 4 also describes the use of a neurotrophically effective amount of a compound of formula I, II, III or IV. A neurotrophically effective amount is a "an effective amount" of a compound.¹⁰

¹⁰ We believe applicants' sole argument for reversal with respect to Hamilton also borders on frivolous. In this respect, we again note no reply brief was filed to respond to the Examiner's Answer.

B. Discussion

Resolution of the appeal does not require an extended discussion. Applicants explicitly acknowledged that for the purpose of the appeal all the claims stand or fall together as to both rejections on appeal. Pursuant to Rule 192, we therefore elect to consider the broadest and only independent claim--Claim 37. In our view, both the PCT application and Hamilton describe compositions within the scope of Claim 37. Hence, those claims are not patentable under 35 U.S.C. § 103. See, e.g., In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 646 (CCPA 1974) (anticipation is epitome of obviousness).

Applicants make only one argument on appeal, viz., that neither prior art reference describes an effective amount of a heterocyclic compound. However, we have found that the examiner had a complete answer to that argument pointing to specific reference to a portions of the prior art. See Findings 21 and 23.

We are at a loss to understand why such a half-hearted effort has been made by applicants in connection with this appeal. Apart from the fact that applicants do not seem to really care about the outcome here, the need to have considered the appeal by the examiner and this board has not been what can be described as an efficient use of resources for the administration of appellate justice within the Patent and Trademark Office.

C. Decision

Upon consideration of the appeal, and for the reasons given,
it is

ORDERED that the decision of the examiner rejecting
claims 37-72 is affirmed.

FURTHER ORDERED that no time period for taking any
subsequent action in connection with this appeal may be extended
under 37 CFR § 1.136(a) (2003).

AFFIRMED

_____)
SHERMAN D. WINTERS)
Administrative Patent Judge)
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WILLIAM F. SMITH)
Administrative Patent Judge)
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FRED E. McKELVEY, Senior)
Administrative Patent Judge)

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