

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte RUDOLF HELLER

Appeal No. 2003-1716
Application No. 09/946,205

ON BRIEF

Before WINTERS, GRON, and MILLS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 7, all of the claims pending in this application.

Representative Claim

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A tablet which comprises (i) carvedilol or a pharmaceutically acceptable salt thereof, (ii) hydrochlorothiazide or a pharmaceutically acceptable salt thereof, and (iii) at least one pharmaceutically acceptable additive.

The Prior Art Reference

The prior art reference relied on by the examiner is:

Lukas-Laskey et al. (Lukas-Laskey) (PCT Application)	WO 96/24348	Aug. 15, 1996
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The Rejections

Claims 1 through 5 stand rejected under 35 U.S.C. § 102(b) as described by Lukas-Laskey.

Claims 1 through 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lukas-Laskey.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the appealed claims; (2) applicant's Appeal Brief (Paper No. 10); (3) the Examiner's Answer (Paper No. 11); (4) the above-cited Lukas-Laskey reference; and (5) the file wrapper in parent Application No. 09/447,872, now U.S. Patent No. 6,403,579.

On consideration of the record, including the above-listed materials, we affirm each of the examiner's prior art rejections.

Discussion

Initially, we note applicant's statement that "[c]laims 1-7 are presented for appeal. Claims 1-7 stand or fall together with respect to the rejection made by the Patent Office" (Paper No. 10, page 3). Accordingly, for the purposes of this appeal, we shall treat dependent claims 2 through 5 as standing or falling together with independent claim 1 in considering the rejection under 35 U.S.C. § 102(b). We shall treat dependent claims 2 through 7 as standing or falling together with independent claim 1 in considering the rejection under 35 U.S.C. § 103(a).

Section 102

Lukas-Laskey discloses a method for decreasing the mortality of patients suffering from congestive heart failure. According to the Lukas-Laskey method, a specified carbazole compound, preferably carvedilol, is administered "in conjunction with one or more other therapeutic agents, said agents being selected from the group consisting of angiotensin converting enzyme (ACE) inhibitors, diuretics, and cardiac glycosides" (page 1, lines 17-20). Lukas-Laskey identifies a preferred diuretic, hydrochlorothiazide, at page 6, lines 11 and 12 ("the preferred diuretics of the present invention are hydrochlorothiazide furosemide or torasemide or any pharmaceutically acceptable salts thereof").

Further, Lukas-Laskey discloses that pharmaceutical compositions

including carvedilol, alone or in combination with ACE inhibitors, or diuretics, or cardiac glycosides may be administered to patients according to the present invention in any medically acceptable manner, preferably orally [page 6, lines 27-30].

In another passage, Lukas-Laskey states that

Alternatively, these compounds may be encapsulated, tableted or prepared in a [sic] emulsion or syrup for oral administration.

Pharmaceutically acceptable solid or liquid carriers may be added to enhance or stabilize the composition, or to facilitate preparation of the composition. Liquid carriers include syrup, peanut oil, olive oil, glycerin, saline, ethanol, and water. Solid carriers include starch, lactose, calcium sulfate dihydrate, terra alba, magnesium stearate or stearic acid, talc, pectin, acacia, agar or gelatin. The carrier may also include a sustained release material such as glyceryl monostearate or glyceryl distearate, alone or with a wax. The amount of solid carrier varies but, preferably, will be between about 20 mg to about 1 g per dosage unit. The pharmaceutical preparations are made following the conventional techniques of pharmacy involving milling, mixing, granulating, and compressing, when necessary, for tablet forms; or milling, mixing and filling for hard gelatin capsule forms. [page 7, lines 18-29; emphasis added]

On these facts, we agree with the examiner's finding that Lukas-Laskey describes the invention recited in claim 1 on appeal, viz., a tablet comprising carvedilol or a pharmaceutically acceptable salt thereof; hydrochloro-thiazide or a pharmaceutically acceptable salt thereof; and at least one pharmaceutically acceptable additive. Accordingly, we agree that Lukas-Laskey establishes a prima facie case of anticipation of claim 1, and that the burden of persuasion shifted to applicant to rebut the prima facie case.¹

Applicant's sole argument on appeal is that Lukas-Laskey constitutes a non-enabling reference. As stated in In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985):

It is well settled that prior art under 35 U.S.C. § 102 (b) must sufficiently describe the claimed invention to have placed the public in possession of it. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. It is not, however, necessary that an invention disclosed in a

¹ For a discussion of "prima facie case of anticipation" and the introduction of evidence sufficient to rebut a prima facie case, see In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

publication shall have actually been made in order to satisfy the enablement requirement. [footnote and case citations omitted]

We also invite attention to the following passage in In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962):

We think it is sound law . . . that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.

According to applicant, Lukas-Laskey does not sufficiently describe the tablet recited in claim 1 "to have placed the public in possession of it." We disagree.

Applicant's position to the contrary, notwithstanding, we find that Lukas-Laskey imparts ample knowledge to persons skilled in the art instructing them how to prepare a tablet comprising (i) carvedilol or a pharmaceutically acceptable salt thereof, (ii) hydrochlorothiazide or a pharmaceutically acceptable salt thereof, and (iii) at least one pharmaceutically acceptable additive, e.g., a solid carrier such as lactose or magnesium stearate. Note particularly the passages in Lukas-Laskey referenced by the examiner at page 6, line 27 through page 7, line 29.

In support of his argument that Lukas-Laskey constitutes a non-enabling reference, applicant refers to the following passages in the specification, page 2, lines 13 through 27:

The combination of a β -blocker with a diuretic has been used successfully for treating cardiac and circulatory disorders such as hypertension, angina pectoris, cardiac insufficiency and illnesses associated therewith. Many studies have investigated the advantages of combination therapy using carvedilol and hydrochlorothiazide (e.g. Widmann et al., 1990, Eur J Clin Pharmacol 38 (2):143-146; van der Does et al., 1990, Eur J Clin Pharmacol 38 (2): 147-152; McTavish et al., 1993,

Drugs 45(2): 232:258). In all of these studies, the two active substances carvedilol and hydrochlorothiazide were sequentially administered in the form of individual tablets. A fixed combination of the two active substances could not be realized until the present invention.

A combined product was not earlier developed because the two active substances, carvedilol and hydrochlorothiazide, have different solubilities and, when granulated together, gave end products with inadequate active substance release and bioavailability. Thus, it was problematic to provide the two active substances as a combination preparation, such as a tablet. An object of the invention is to provide a solution to these problems.

Those passages, however, do not establish that persons skilled in the art had tried, but failed, to prepare a tablet comprising carvedilol, hydrochlorothiazide, and at least one pharmaceutically acceptable additive. The above-quoted passages in the "Background of the Invention" section of applicant's specification do not mention any efforts to prepare a tablet containing active substances and "at least one pharmaceutically acceptable additive."

Further, the above-quoted passages in applicant's specification, although somewhat cryptic, suggest that carvedilol and hydrochlorothiazide were granulated together to give end products. This suggests, at the time applicant's invention was made, that tablets containing carvedilol and hydrochlorothiazide could be formed. That the end products referenced in the specification at page 2, line 25, had "inadequate active substance release and bioavailability," does not mean to say that end products were not formed. Moreover, claim 1 on appeal does not require that applicant's tablet be a pharmaceutically acceptable solid dosage form combination preparation; nor does claim 1 require that applicant's tablet have any specified degree of active substance release or bioavailability.

That "[a] combined product was not earlier developed," as stated in the

specification, page 2, line 23, is unclear, but may mean that a combined product was not commercially developed because it was perceived to have inadequate active substance release and bioavailability. But that does not constitute evidence that Lukas-Laskey is a non-enabling reference. That does not constitute evidence that persons skilled in the art, given the disclosure of Lukas-Laskey, could not prepare a tablet comprising the active ingredients recited in claim 1 and "at least one pharmaceutically acceptable additive."

We are mindful that the subject application is a divisional of Application No. 09/447,872, filed November 23, 1999, now U.S. Patent No. 6,403,579. In the '579 patent, the PTO issued claims drawn to applicant's process for producing a solid dosage form pharmaceutical combination preparation containing carvedilol, or a pharmaceutically acceptable salt thereof, and hydrochlorothiazide, or a pharmaceutically acceptable salt thereof. However, merely because the PTO issued claims drawn to applicant's process in the '579 patent, it does not follow that Lukas-Laskey constitutes a non-enabling reference. Again, applicant's position to the contrary, Lukas-Laskey sufficiently describes the tablet recited in claim 1 "to have placed the public in possession of it."

All in all, we find that the evidence in favor of patentability relied on by applicant does not outweigh the evidence against patentability relied on by the examiner. On this record, applicant has failed to adduce evidence sufficient to rebut the examiner's prima facie case of anticipation of claim 1. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b) as described by Lukas-Laskey. As previously indicated, dependent claims 2 through 5 fall together with independent claim 1.

Section 103

From the preceding discussion, it can be seen that Lukas-Laskey describes the invention recited in claim 1 within the meaning of 35 U.S.C. § 102(b). As stated in In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974), "lack of novelty in the claimed subject matter, e.g., as evidenced by a complete disclosure of the invention in the prior art, is the 'ultimate or epitome of obviousness'" (citation omitted). On this basis, we affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Lukas-Laskey.

Again, in responding to the rejection under 35 U.S.C. § 103(a), applicant's sole argument is that Lukas-Laskey constitutes a non-enabling reference (Paper No. 10, page 7). We disagree with that argument for reasons already discussed.

Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Lukas-Laskey. As previously indicated, dependent claims 2 through 7 fall together with independent claim 1.

Other Issue

One further matter warrants attention. In the event of further prosecution of the subject matter of this application, e.g., in a re-filed application, we recommend that the examiner determine whether any claim in the application defines merely an obvious variation of an invention disclosed and claimed in U.S. Patent No. 6,403,579, issued June 11, 2002. If the answer to that question is yes, "a terminal disclaimer is required to prevent undue timewise extension of monopoly." In re Vogel, 422 F.2d 438, 442, 164 USPQ 619, 622 (CCPA 1970).

In particular, we invite attention to a comparison of instant claim 1 with claims 1 and 7 in the '579 patent:

Instant Claim 1

1. A tablet which comprises (i) carvedilol or a pharmaceutically acceptable salt thereof, (ii) hydrochlorothiazide or a pharmaceutically acceptable salt thereof, and (iii) at least one pharmaceutically acceptable additive.

Claims 1 and 7 in the '579 Patent

1. A process for producing a solid dosage form pharmaceutical combination preparation containing carvedilol, or a pharmaceutically acceptable salt thereof, and hydrochlorothiazide, or a pharmaceutically acceptable salt thereof, which comprises:

a) forming a press mass containing a carvedilol, or pharmaceutically acceptable salt thereof, granulate and a hydrochlorothiazide carvedilol [sic] or pharmaceutically acceptable salt thereof, granulate, the two granulates each having a granulate moisture content between about 6% and about 20% and a bulk density between about 0.1 g/ml and about 1.5 g/ml, the granulate moisture content and the bulk density of the two granulates not varying from each other by more than about 30% and

b) compressing the press mass to form the solid dosage form pharmaceutical combination preparation.

7. A pharmaceutically acceptable solid dosage form combination preparation containing carvedilol, or a pharmaceutically acceptable salt thereof, and hydrochlorothiazide, or a pharmaceutically acceptable salt thereof, prepared by a process that comprises:

a) forming a press mass containing a carvedilol, or pharmaceutically acceptable salt thereof, granulate and a hydrochlorothiazide carvedilol [sic] or pharmaceutically acceptable salt thereof, granulate, the two granulates each having a granulate moisture content between about 6% and about 20% and a bulk density between about 0.1 g/ml and about 1.5 g/ml, the granulate moisture content and the bulk density of the two granulates not varying from each other by more than about 30%; and

b) compressing the press mass to form the solid dosage form pharmaceutical combination preparation.

Based on a perusal of the file wrapper in Application No. 09/447,872, now U.S. Patent No. 6,403,579, it does not appear that the examiner entered a restriction

requirement under the provisions of 35 U.S.C. § 121.

Conclusion

In conclusion, we sustain the examiner's rejection of claims 1 through 5 under 35 U.S.C. § 102(b) as described by Lukas-Laskey. We also sustain the rejection of claims 1 through 7 under 35 U.S.C. §103(a) as unpatentable over Lukas-Laskey. In the event of further prosecution of the subject matter of this application, we recommend that the examiner determine whether any claim or claims should be rejected under the judicially created doctrine of obviousness-type double patenting over the claims in U.S. Patent No. 6,403,579.

The examiner's decision is affirmed.

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

AFFIRMED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	APPEALS AND
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