

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRI E. BODDE, JOHANNA A. BOUWSTRA,
MARIA H. PONEC, FERDINAND SPIES,
KLAUS SANDROCK, and
JOHANNES BRUSSEE

Appeal No. 1995-1303
Application 08/004,603

HEARD: March 22, 2001

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

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision under 35 U.S.C. § 134 from the final rejection of claims 1 through 7, all the claims in the application. Claim 1 is representative of the subject matter on appeal and reads as follows:

1. 1-Oleyl-azacycloheptan-2-one.

The references relied upon by the examiner are:

Minaskanian et al	4,920,101	April 1990
Rajadhyaksha	4,415,563	November 1983
Francoeur et al	4,959,365	September 1990

Claims 1 through 7 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the examiner relies upon Minaskanian, Rajadhyaksha and Francoeur. We reverse.

Discussion

We initially note that the Examiner's Answer is difficult to review since the examiner refers us to Paper No. 8 for a statement of the rejection. However, Paper No. 8 indicates that the claims are rejected for "the reasons of record." The only statement of a rejection we find in the case is the first office action where the examiner states:

The instant compound, composition and use is generically taught by Minaskanian et al. in column 2, line 30. The corresponding saturated compound is taught by Rajadhyaksha in column 2, line 5. Francoeur et al. teaches the use of compositions containing the compounds of the two primary references along with various unsaturated acid[s], including oleic acid, as epithelial membrane permeability enhancing agents. One skilled in the art would expect a compound which shows the structure of oleic acid and the structure of the compounds of the two primary references to possess similar epithelial membrane permeability enhancing properties. The substitution of the oleic chain from oleic acid for the corresponding saturated C₁₈ alkyl group one [sic, on] the azocycloheptan-2-one of the primary references would be expected to produce a compound with the instant properties and use given the teaching of Rajadhyaksha. The combination renders the instant claims prima facie obvious absent a showing of unexpected properties.

The examiner's position presupposes that it would have been obvious to focus on the C₁₈ derivatives of Rajadhyaksha or Minaskanian. However, that supposition is open to question. The Examiner's Answer was mailed September 9, 1994. The court issued its opinion in In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) in January 1994. Therein, the court stated "the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992)." Baird, 16 F.3d at 382, 29 USPQ2d at 1552. In light of this precedent, which issued

prior to the entry of the Answer, the examiner was under the burden of establishing why it would have been obvious to focus on the C₁₈ derivatives of Rajadhyaksha or Minaskanian. The examiner does not provide any analysis in the Examiner's Answer in this regard.

Be that as it may, we disagree with the examiner's conclusion that Francoeur would have suggested to one of ordinary skill in the art to focus on the oleic derivative of Minaskanian or substitute an oleic chain for the corresponding saturated C₁₈ alkyl group in Rajadhyaksha. Francoeur is directed to pharmaceutical compositions for the topical administration of lipophilic pharmaceutical agents. To this end, the pharmaceutical agent is blended with a solvent system comprising certain 1-alkylazacycloheptan-2-ones and specified cis-olefin compounds. The examiner has correctly determined that oleic acid is the preferred cis-olefin compound of Francoeur. However, the examiner has considered that disclosure of Francoeur in isolation rather than in light of the entire disclosure.

Francoeur describes the combined use of 1-alkylazacycloheptan-2-ones wherein the alkyl moiety has from 8 to 16 carbon atoms with oleic acid. We find that disclosure to be significant as it supports the conclusion that at the time of the present invention workers in this field viewed oleic acid as a stand-alone component in compositions containing 1-alkylazacycloheptan-2-ones, not as a basis to select or modify specific 1-alkylazacycloheptan-2-ones. The examiner has not adequately explained why Francoeur's disclosure of using oleic acid as a stand-alone component of a composition which also includes 1-alkylazacycloheptan-2-ones wherein the alkyl moiety has from 8 to 16 carbon atoms aids would have suggested the claimed compound to the extent it is described in Minaskanian. Considering the alternative rejection premised upon

Rajadhyaksha, suffice it to say the examiner has not explained with adequate specificity why it would have been obvious to one of ordinary skill in the art to modify the saturated chain of the compounds of that reference with the specific unsaturated chain required by the claims on appeal. Again, oleic acid is used as a stand-alone compound in the composition of Francoeur.

The decision of the examiner is reversed.

REVERSED

William F. Smith
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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