

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSAN THYS-JACOBS

Appeal No. 95-2220
Application No. 08/059,682¹

HEARD: January 11, 1999

Before KIMLIN, JOHN D. SMITH and SOFOCLEOUS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1 through 12.

The subject matter on appeal is directed to a method for treating premenstrual syndrome (PMS). Specifically, the method requires administering to an individual having symptoms

¹ Application for patent filed May 10, 1993.

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associated with premenstrual syndrome an amount of a combination of calcium and vitamin D which is effective to reduce the symptoms. Claim 1 is representative and is reproduced below:

1. A method for treating symptoms associated with premenstrual syndrome comprising administering to an individual having symptoms associated with premenstrual symptomatology an amount of a combination of calcium and vitamin D effective to significantly reduce said symptoms.

The references of record relied upon by the examiner are:

Thys-Jacobs	4,946,679	Aug. 7,
1990		
Yamato et al. (Yamato)	4,501,738	Feb. 26,
1985		

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Thys-Jacobs in view of Yamato.

We cannot sustain the stated rejection.

It is the examiner's position that the claimed subject matter is prima facie obvious in view of the holding set forth in In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1073 (CCPA 1980) that "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose" [emphasis added].

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That calcium has been used in a method treating individuals having symptoms associated with PMS is not contested by appellant, and is factually established by the disclosures in the Thys-Jacobs reference. However, we agree with appellant that the Yamato reference fails to provide an adequate factual basis to establish that vitamin D has been used to treat individuals having symptoms associated with PMS (i.e., the same purpose). While Yamato teaches that vitamin D may be used to treat patients suffering from hypertension, there is no disclosure of record that hypertension involves a symptom or symptoms associated with PMS. Indeed, appellant correctly points out that hypertension is not a symptom of PMS (brief, unnumbered page 3), and we take official notice² that hypertension is a disease involving high blood pressure while premenstrual tension involves nervousness, mental irritability, and depression preceding menstruation. Further, we find that Yamato's reference to the use of vitamin D dosages for treating "pains" is too general a teaching to suggest the treatment of PMS symptomatology.

² See Stedman's Medical Dictionary, 24th Edition pages 676, 677, and 1417, copyright 1982, copy attached.

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Accordingly, we cannot sustain the stated rejection of the appealed claims.

NEW REJECTION

Pursuant to our authority under 37 CFR § 1.196(b) we state the following new rejection. Claims 1 through 12 are rejected under 35 U.S.C. § 103 over UK Patent 2,169,202 to Barron published July 9, 1986.

Barron discloses a method for treating individuals having severe menstrual symptoms by administering a composition comprising, inter alia, vitamin D and calcium. In discussing the Barron reference at the oral hearing for this appeal, counsel for appellant indicated that menstrual symptoms and PMS symptoms are not identical. However, menstrual symptoms such as intestinal cramping, insomnia, irritability, and tension (Barron at page 1, lines 4-12) are also common PMS symptoms (Specification, page 5, line 31 to page 6, line 1). Accordingly, one of ordinary skill in this art would have recognized from Barron's disclosures that a combined dosage of calcium and vitamin D would be effective to relieve PMS symptoms of a "premenopausal woman experiencing PMS symptomatology" (brief, unnumbered page 2). Indeed, Barron

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discloses at page 2, lines 18-20 that it is advisable to take the prior art composition "a day before the onslaught of the menstrual period." Further, the claimed language "a method for treating symptoms associated with premenstrual syndrome comprising administering to an individual having symptoms associated with premenstrual syndrome symptomatology" does not patentably distinguish the claims from the process of administering a combination of calcium and vitamin D to an individual for relief from menstrual stresses as taught by Barron. Accordingly, based on the disclosures in Barron, the subject matter defined by appealed claim 1 herein would have been obvious within the meaning of 35 U.S.C. § 103.

With respect to appealed claim 2, Barron discloses that calcium carbonate is a preferred form of calcium. With respect to appealed claim 3, Barron prefers a fish oil source of vitamin D which is a cholecalciferol form of vitamin D. See the brief at page 6. Appealed claim 4 calls for administering the composition orally in the form of a tablet in a single daily dose, while Barron prefers (page 1, lines 125 to page 2, line 6) a single daily dose of vitamin D in capsule form and

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calcium carbonate in tablet form. One of ordinary skill in the art, however, would have been led to combine all the ingredients in the tablet form, in our view, motivated by the goal of simplifying the procedure.

Barron's teaching that the range of ingredients utilized in his composition "will be apparent to one skilled in the art" (page 2, lines 37-39) raises a prima facie case of obviousness for the subject matter of appealed claims 5 through 8 and 12. Moreover, Barron also teaches the administering of 5,000 I.U. of vitamin D which would necessarrily be an amount of vitamin D

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"effective to elevate the individual's 25 hydroxyvitamin D level to a level greater than 30-40ng/ml." as required by appealed claim 9.

With respect to appealed claim 11, since Barron fairly suggests administering a combination of calcium and vitamin D to an individual having PMS symptoms, it would have been obvious to administer that composition to alleviate vascular headaches, a common symptom of PMS.

In summary, the examiner's rejection of the appealed claims for obviousness based on disclosures in Thys-Jacobs Yamato is reversed. A new rejection has been stated against the appealed claims for obviousness based on the Barron UK Patent.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant,

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WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	

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MICHAEL SOFOCLEOUS)
Administrative Patent Judge)

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NOTE: A copy of the
Stedman's Medical Dictionary,
pages 676, 677, and 1417
are in the envelope.

JENINE GILLIS

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Serial No. 08/059,682

Judge JOHN D. SMITH

Judge KIMLIN

Judge SOFOCLEOUS

Received: 14 Jan 99

Typed: 14/16 Jan

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99

DECISION: REVERSED; 37 CFR §

1.196(b)

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1614

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

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