

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FABIO ANIMATI,
PAOLO LOMBARDI,
and FEDERICO ARCAMONE

Appeal No. 95-2727
Application 07/699,898¹

ON BRIEF

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

WILLIAM F. SMITH, Administrative Patent Judge.

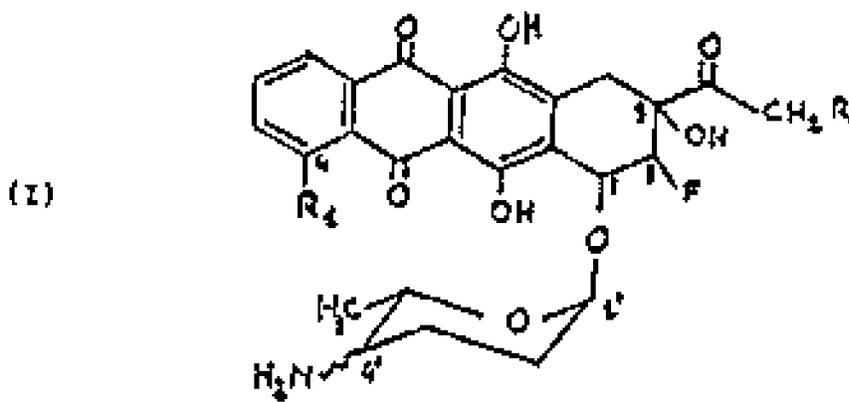
DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 11, 21, 22, and 54 through 56. Claims 12 through 20 and 23 through 53 are pending but have been withdrawn from consideration by the examiner.

¹ Application for patent filed May 14, 1991.

Claims 1², 21, 22, and 54 are illustrative of the subject matter on appeal and read as follows:

1. An 8-fluoroanthracycline-glycoside compound of the formula (I). [sic, :]



where:

R = H, OH, or OR^{''};

R₁ = H, OH, or OCH₃;

R^{''} = CHO-COCH₃ or an acyl residue derived from a carboxylic acid containing up to 6 carbon atoms; and [sic, -] NH₂ indicates that the amino substituent can be in the axial or equatorial configuration; or a pharmaceutically acceptable salt thereof.

21. A pharmaceutical composition comprising a therapeutically effective amount of an anthracyclineglycoside of formula I in accordance with claim 1, or a pharmaceutically acceptable salt thereof, in mixture with a pharmaceutically acceptable diluent or carrier.

² The amendment filed on March 12, 1993 which was approved for entry by the examiner has not been physically entered in the file. The examiner should attend to this matter upon return of the application. The copies of claims 1, 21 and 54 are as these claims were amended in that paper. Also, the copy of claim 1 notes the typographical errors contained in that claim as amended in that paper.

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22. A method of treating a tumor, said method comprising administering to a host afflicted with a tumor an effective amount of an anti-tumor agent which comprises a compound of claim 1.

54. Therapeutic compositions with antitumor activity comprising as active principle a therapeutically effective amount of one or more compounds of formula (I) or their therapeutically acceptable salts as defined in claim 1 in mixture with inert diluents and excipients.

A reference relied upon by both appellants and the examiner is:

Physicians' Desk Reference (PDR), 41st ed., pp. 561-62, 1987.

Upon consideration of the record, the examiner's rejections of claims 1 through 11, 21, 22, and 54 through 56 under 35 U.S.C. § 101 as lacking utility and under 35 U.S.C. § 112, first paragraph, for lack of enablement are reversed. See In re Brana, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

Other Issues

The declaration filed under 37 CFR § 1.132 (Paper No. 7, filed August 10, 1992) makes of record U.S. Patent 4,987,126 to Bargiotti et al. (Bargiotti). Bargiotti was filed on February 10, 1989 and issued on January 22, 1991. Accordingly, Bargiotti is available as prior art under 35 U.S.C. § 102(e). The claimed compounds can be viewed as 8-fluoro analogs of the compounds of Bargiotti. The compounds of Bargiotti are stated to be useful as antitumor agents. See column 6, lines 1-5. See also Tables

1-8 of Bargiotti which set forth in vitro and in vivo data concerning the efficacy of those compounds as antitumor agents.

Upon return of the application, the examiner should review the claimed invention in light of the disclosure of Bargiotti and all other relevant prior art and determine whether one of ordinary skill in the art would have found it obvious to form the 8-fluoro analogs of the compounds of Bargiotti. The examiner should make the results of that determination of record by issuing an appropriate office action. We note in passing that the comparison set forth in the declaration filed under 37 CFR § 1.132 is based upon comparing the efficacy of compounds according to the present invention with doxorubicin, not the compounds of Bargiotti. The compounds of Bargiotti are closer prior art than doxorubicin.

REVERSED

Sherman D. Winters)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
William F. Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Fred E. McKelvey, Senior)	
Administrative Patent Judge)	

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