

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. COMMONS
DONALD P. STRIKE and CHRISTA M. LACLAIR

Appeal No. 95-4674
Application 08/095,140¹

ON BRIEF HEARD:

Before JOHN D. SMITH, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner finally rejecting claims 5 through 8, 11, 13, 15 through 20 and 22. Also of record: claim 9 stands objected to; claim 10 stands withdrawn from consideration; and claims 21 and 23 through 33 stand allowed.

The appealed claims stand rejected as constituting an improper Markush group and as being non-enabled by the disclosure under 35 U.S.C. ' 112, first paragraph, enablement (answer, pages 3-4). We have carefully considered the record before us, and based thereon, find that we cannot sustain either of these grounds of rejection. We will consider these grounds of rejection together because the examiner has advanced essentially the same rationale in each ground.

A rejection of a claim to chemical compounds defined in Markush format for encompassing

¹ Application for patent filed July 21, 1993.

unrelated inventions, thus constituting an improper Markush group, is based on judicial precedent and is decided on a case-by-case basis. *In re Harnisch*, 631 F.2d 716, 722-23, 206 USPQ 300, 305-06 (CCPA 1980). The determination of whether unrelated inventions are encompassed by such a claim must take into consideration the *chemical compound as a whole* as well as such factors as whether there is a community of utility, properties and chemical structure and whether the class of compounds defined by the claim is repugnant to scientific classification. *Id.* The initial burden of establishing a *prima facie* case based on an improper Markush group rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), *citing In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.®).

It is well settled that under ' 112, first paragraph, the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification are in doubt, including reasons why the description of the invention in the specification would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation, in order to establish a *prima facie* case under the enablement requirement of the first paragraph of ' 112. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). Thus, in order to make out a *prima facie* case under this section of the statute, more is required than the mere possibility of inclusion of inoperative substances® since it is well settled that the function of the claims is to *point out* the invention and *define* the scope of the monopoly, not to exclude substances which are possibly of no use in practicing the invention.® *In re Sarett*, 327 F.2d 1005, 1019, 140 USPQ 474, 486 (CCPA 1964).

The examiner alleges that the appealed claims constitute an improper Markush group because the specification is enabling only for the compounds exemplified in the Table (specification, page 4) and does not establish that the thousands if not millions of compounds which are chemically disparate® in the absence of a common core essential to the utility alleged herein,® would behave in the same way® (answer, pages 3-4) and then contends that the range of the in-vivo® results shown in the Table are so different that the results across the range of compounds encompassed by the appealed claims are

A definitely unpredictable in the absence of undue experimentation and guidance from the instant specification (answer, pages 5-6). Contrary to the examiner's position (answer, page 5), we must agree with appellants that the chemical compounds defined in the Markush claims, *taken as a whole*, have a common compound core [which is] comprised of a molecule having three carbamate ester groups which are linked through specific groups (brief, page 3). We further find that the assertions as to the scope of objective enablement set forth in the specification with respect to a method for reducing cholesterol absorption (e.g., appealed claim 19) are directed to compounds containing this common core.

Thus, in the absence of analysis demonstrating why the assertions as to the scope of objective enablement set forth in the specification with respect to the Markush groups of the appealed claims are in doubt without undue experimentation, *see generally Wands, supra*, which would be tantamount to demonstrating a lack of a community of utility, properties and chemical structure, the examiner's reasons based essentially on the absence of a common core fail to make out a *prima facie* case that the claims constitute an improper Markush group and are non-enabled under ' 112, first paragraph, enablement. Indeed, the mere allegation that the range of results reported in the Table would suggest a similar range of results, possibly including 0% effectiveness, in the asserted utility across the range of compounds encompassed by the appealed claims in Markush format does not serve such purposes because there is no requirement in ' 112 that *all* of the claimed compounds have the same degree of utility [emphasis ours], *In re Gardner*, 475 F.2d 1389, 1392, 177 USPQ 396, 398 (CCPA 1973), and that *all* compounds must be operative with respect to that utility. *Sarett, supra*.

The examiner's decision is reversed.

Reversed

JOHN D. SMITH
Administrative Patent Judge

CHUNG K. PAK
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

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