

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YEHUDA MAZUR,  
GAD LAVINE, DANIEL MERUELO  
and DAVID LAVINE

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Appeal No. 1996-2309  
Application 08/068,379

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HEARD: May 18, 2000

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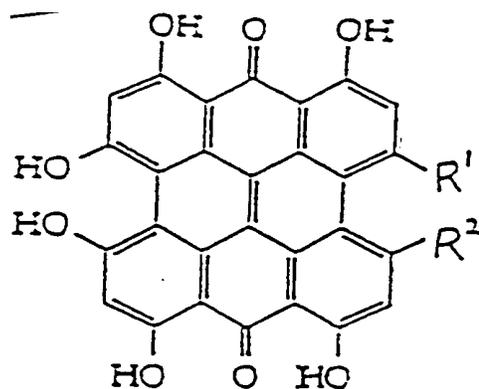
Before WINTERS, ROBINSON, and ADAMS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through

1. A compound having the structure:



wherein  $R^1$  and  $R^2$  are of the formula  $COOR^3$ , chain of which is or more oxygen or sulfur atoms.

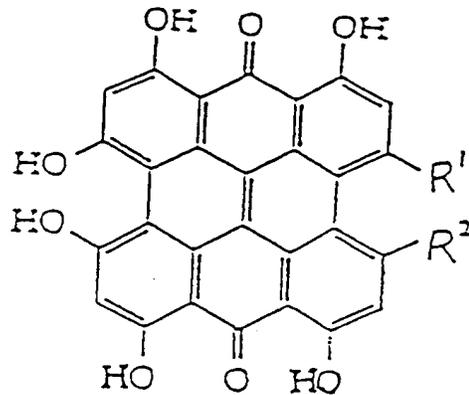
carboxylic acid ester groups in which  $R^3$  is alkyl, the optionally interrupted by one

6. A pharmaceutical composition having antiviral or antiretroviral activity comprising an effective amount of a compound in accordance with claim 1 and a pharmaceutically acceptable excipient.

12. A method for the treatment of viral or retroviral diseases comprising administering to a subject having such a disease an effective amount of a compound in accordance with claim 1.

25. An article of manufacture, comprising:

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wherein R<sup>1</sup> and R<sup>2</sup>  
groups of the  
R<sup>3</sup> is alkyl, the  
interrupted by one  
atoms,

are carboxylic acid ester  
formula COOR<sup>3</sup>, in which  
chain of which is optionally  
or more oxygen or sulfur

wherein said compound is disposed on said surface to contact said fluid no later than when said fluid contacts said surface.

The references relied on by the examiner are:

Meruelo (PCT `438)  
Meruelo (PCT `797)

WO 90/10438  
WO 93/08797

Sept. 20, 1990  
May 13, 1993

The final rejection of claims 25 through 29 under 35 U.S.C. § 112, fourth paragraph, has been withdrawn. See the Supplemental Examiner's Answer, Paper No. 18, mailed January 24, 1996, page 1. The issues remaining for review are: (1) whether

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On consideration of the record, we shall not sustain these rejections.

#### DISCUSSION

In rejecting claims 1 through 24 under 35 U.S.C. § 103, the examiner argues that PCT `438 discloses hypericin dicarboxylic acid having antiviral activity. Hypericin dicarboxylic acid is an analog of hypericin where both methyl groups of the parent compound have been replaced with carboxylic acid groups. According to the examiner, that disclosure is sufficient to establish a prima facie case of obviousness of claims 1 through 5 drawn to hypericin dicarboxylic acid esters as well as composition claims 6 through 11 and 22 through 24 and method claims 12 through 21.

The examiner's position is not without support in the case law. See In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 408 (CCPA 1970)(Molotsky's ethyl ester establishes prima facie case of obviousness of appellant's free acid); and in In re Ward, 329 F.2d 1021, 1023, 141 USPQ 227, 228 (CCPA 1964)(claimed simple esters "might appear to be obvious" in view of prior art alcohols.) Further, on this record, appellants do not contest the prima facie case of obviousness. The question here is whether

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reported in Example 6 of the specification and in the Lavie declaration executed May 3, 1994. Appellants argue, and the examiner does not deny, that these results show an approximately 40-fold improvement in inhibition of reverse transcriptase activity by the methyl ester of the present invention compared with its corresponding free dicarboxylic acid (Appeal Brief, page 14; Reply Brief, pages 6 and 10). The examiner does not specifically address this rebuttal evidence. The examiner does not controvert appellants' argument, based on the evidence, that a representative claimed ester possesses unexpectedly superior antiviral activity compared with its closest prior art acid. On these facts, we agree that objective evidence relied on by the appellants serves to rebut the prima facie case of obviousness.

The rejection of claims 1 through 24 under 35 U.S.C. § 103 as unpatentable over PCT `438 is reversed.

The rejection of claims 1 through 29 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of PCT `438 and PCT `797 stands on similar footing. We shall assume arguendo, without deciding, that the examiner established a prima facie case of obviousness of all of the appealed claims based on the combined disclosures

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Again, we agree that the indirect comparison serves to rebut the examiner's prima facie case of obviousness.

The rejection of claims 1 through 29 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of PCT `438 and PCT `797 is reversed.

In conclusion, we do not sustain either of the examiner's prior art rejections. The examiner's decision, refusing to allow claims 1 through 29, is reversed.

REVERSED

Sherman D. Winters	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Douglas W. Robinson	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Donald E. Adams	)	
Administrative Patent Judge	)	

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