

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

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HASSAN M. ELOKDAH, SIE-YEARL CHAI,
and THEODORE S. SULKOWSKI

Appeal No. 1997-1965
Application No. 08/468,482

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

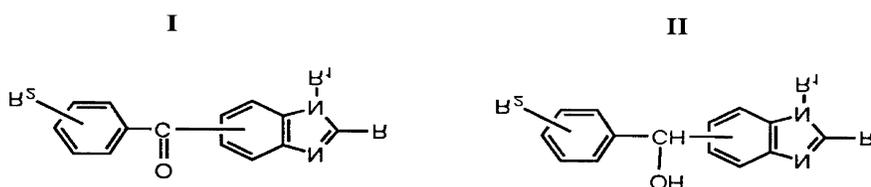
DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 18 through 20.
Claims 2 through 12, 16, and 17, which are the only other claims remaining in the
application, stand allowed.

THE APPEALED CLAIMS

The appealed claims read as follows:

18. A pharmaceutical composition comprising a compound of formula I or II:



wherein

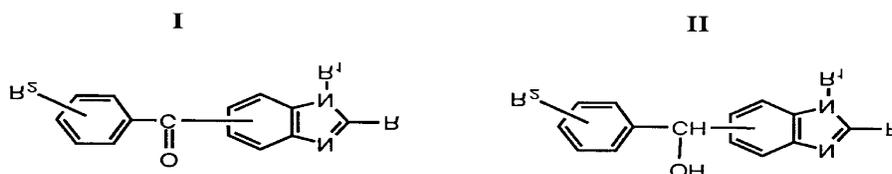
R is alkyl of 1 to 6 carbon atoms, phenyl, benzyl, or substituted phenyl or substituted benzyl, in which the substituents are halogen, hydroxyl, alkoxy of 1 to 6 carbon atoms, trifluoromethoxy or alkyl of 1 to 6 carbon atoms;

R₂ is hydrogen, halogen, alkoxy of 1 to 6 carbon atoms or alkyl of 1 to 6 carbon atoms;

R₁ is hydrogen, alkyl of 1 to 6 carbon atoms, aryl of 6 to 10 carbon atoms, arylalkyl of 7 to 12 carbon atoms, or benzyl substituted with halogen, carboxyl, alkoxycarbonyl of 2 to 6 carbon atoms or aryloxycarbonyl of 7 to 12 carbon atoms,

or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier.

19. A method for treating diseases characterized by excessive smooth muscle cell proliferation in a mammal which comprises administering to that mammal, orally or parenterally, a smooth muscle proliferation inhibiting amount of a compound of formula I or II:



Appeal No. 1997-1965
Application No. 08/466,482

wherein

R is alkyl of 1 to 6 carbon atoms, phenyl or benzyl or substituted phenyl or substituted benzyl, in which the substituents are halogen, hydroxyl, alkoxy of 1 to 6 carbon atoms trifluoromethoxy or alkyl of 1 to 6 carbon atoms;

R₂ is hydrogen, halogen, alkoxy of 1 to 6 carbon atoms or alkyl of 1 to 6 carbon atoms;

R₁ is hydrogen, alkyl of 1 to 6 carbon atoms, aryl of 6 to 10 carbon atoms, arylalkyl of 7 to 12 carbon atoms, or benzyl substituted with halogen, carboxyl, alkoxy carbonyl of 2 to 6 carbon atoms or aryloxy carbonyl of 7 to 12 carbon atoms,

or a pharmaceutically acceptable salt thereof.

20. A method according to Claim 19 wherein said smooth muscle cell proliferation manifests itself as restenosis following angioplasty.

THE REFERENCES

The prior art references relied on by the examiner are:

Harsányi et al (Harsányi)	4,814,329	Mar. 21, 1989
Raeymaekers et al. (Raeymaekers)	4,859,684	Aug. 22, 1989
Aikawa et al. (Aikawa)	5,387,600	Feb. 7, 1995

Gevaert, "Trimethine dyes containing a 5(6)-benzoylbenzimidazole nucleus," Chemical Abstract, Vol. 63: p. 5797b (1965).

Venkataratnam et al. (Venkataratnam), "Studies on formation of 1-aryl-2-aryl-6-benzoylbenzimidazoles from 4-benzoyl-o-phenylene diamine and aromatic aldehydes," Indian Journal of Chemistry, Vol. 29B, Communication No. 2439, pp. 488-90 (1990).

Beilstein Reference (SO) 5-24, BRN# 811699 (1995).

Appeal No. 1997-1965
Application No. 08/466,482

THE REJECTION

Claims 18 - 20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies on Raeymaekers, Venkataratnam, Gevaert, Beilstein, Aikawa, and Harsányi.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' appeal brief and reply brief; (3) the examiner's answer and the communication mailed by the examiner March 19, 1997; and (4) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection.

DISCUSSION

The examiner argues that each primary reference (Raeymaekers, Venkataratnam, Gevaert, and Beilstein) discloses compounds fully meeting compounds I or II recited in claims 18 through 20; that the combined disclosures of these primary references constitute a "generic class of compounds;" and that the "claimed compounds" fall within the generic class of compounds disclosed by the references. Accordingly, the examiner concludes that a person having ordinary skill in the art would have found the "claimed compounds" prima facie obvious (examiner's answer, paragraph bridging pages 7 and 8). We disagree.

First, that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). In Jones, the court specifically rejected the Commissioner's argument that "regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it." In re Jones, 958 F.2d at 350, 21 USPQ2d at 1943. Second, the examiner misapprehends the facts and distorts the record in referring to compounds I and II as "the claimed compounds" (examiner's answer, page 7). Compounds I and II are an essential part of applicants' pharmaceutical composition (claim 18) and method for treating diseases characterized by excessive smooth muscle cell proliferation in a mammal (claims 19 and 20), but the claims before us are not drawn to compounds per se.

Additionally, the examiner relies on Aikawa and Harsányi which are referenced at page 2 of applicants' specification. These patents disclose substituted benzimidazoles, useful for treating diseases characterized by excessive smooth muscle cell proliferation in a mammal. Specifically, Aikawa discloses antihyperlipidemia or aniartherosclerosis agents and Harsányi discloses a method for inhibiting atherosclerosis and thrombus formation, and treating hyperlipoproteinemic diseases. The examiner argues that each primary reference (Raeymaekers, Venkataratnam, Gevaert, and Beilstein) discloses substituted

benzimidazoles fully meeting compounds I or II recited in claims 18 through 20; that each secondary reference (Aikawa and Harsányi) discloses substituted benzimidazoles useful for treating diseases characterized by excessive smooth muscle cell proliferation in a mammal; that the compounds of the primary and secondary references are “closely related” in structure; and that a person having ordinary skill in the art would have attributed to the compounds of each primary reference the properties or utilities disclosed by the secondary references. Accordingly, the examiner concludes that a pharmaceutical composition comprising a compound of Raeymaekers, Venkataratnam, Gevaert, or Beilstein and a pharmaceutically acceptable carrier would have been prima facie obvious. The examiner also concludes that a method for treating diseases characterized by excessive smooth muscle cell proliferation in a mammal by administering to that mammal a smooth muscle cell proliferation inhibiting amount of a compound disclosed by Raeymaekers, Venkataratnam, Gevaert, or Beilstein would have been prima facie obvious (examiner’s answer, pages 8 and 9). We disagree.

First, with respect to the substituted benzimidazoles disclosed by Raeymaekers, Venkataratnam, Gevaert, and Beilstein, which fully meet compounds I and II in claims 18 through 20, the primary references do not disclose or suggest using those benzimidazoles in a pharmaceutical composition or in a method for treating diseases characterized by excessive smooth muscle cell proliferation in a mammal. Rather, the primary references

Appeal No. 1997-1965
Application No. 08/466,482

either disclose no utility whatsoever (Venkataratnam and Beilstein) or disclose that the benzimidazoles in question are intermediates useful in preparing structurally distinct final products (Raeymaekers, and Gevaert). Second, the examiner's position to the contrary notwithstanding, the compounds of the primary and secondary references are not "closely related" in structure. Aikawa does not disclose or suggest benzoyl benzimidazoles or reduction products thereof. Further, the compounds of Harsányi require sulfur at the 2-position of the benzimidazole ring unlike the compounds disclosed by the primary references (Raeymaekers, Venkataratnam, Gevaert, and Beilstein) which are relied on by the examiner. In our judgment, therefore, a person having ordinary skill in the art would not have attributed to the compounds of each primary reference the properties or utilities disclosed by the secondary references.

Appeal No. 1997-1965
Application No. 08/466,482

The examiner's decision, rejecting claims 18 through 20 under 35 U.S.C. § 103, is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HUBERT C. LORIN)	
Administrative Patent Judge)	

Appeal No. 1997-1965
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