

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACQUES ANTOUN

Appeal No. 1997-2198
Application 08/262,953¹

ON BRIEF

Before KIMLIN, GARRIS and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of

¹ Application for patent filed June 21, 1994. According to appellant, the application is a continuation-in-part of Application 07/863,795, April 6, 1992; which is a continuation-in-part of Application 07/609,392, filed November 5, 1990, now U.S. Patent No. 5,102,916 issued April 7, 1992; which is a continuation-in-part of Application 07/547,460, filed July 3, 1990, now abandoned.

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claims 1-12 and 20-25, and refusal to allow claims 13-18 as amended after final rejection. These are all of the claims remaining in the application.

THE INVENTION

Appellant claims a composition and method for treating alopecia areata or male pattern baldness. Claims 1, 8 and 13 are illustrative and read as follows:

1. A pharmaceutical composition comprising 0.143%-3.93% by weight starch, 1.00%-23.8% by weight of a compound comprising boron, .625%-15.8% by weight of a compound comprising zinc, and 69.4%-97.8% water.

8. A pharmaceutical composition, consisting essentially of:

starch, a compound comprising boron, compound comprising zinc, and water.

13. A method of treating alopecia areata or male pattern baldness in a person in need of such treatment comprising:

topically administering to the person in need of treatment a therapeutically effective amount of a pharmaceutical composition comprising a compound comprising zinc, a compound comprising boron, and a suitable carrier for topical application of the pharmaceutical composition, the suitable carrier being a mixture of starch and water.

THE REFERENCES

Brodbeck et al. (Brodbeck) 992,937 May 23, 1911

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Ercoli et al. (Ercoli)	2,652,355	Sep. 15, 1953
Gibson	5,015,470	May 14, 1991

THE REJECTIONS

Claims 13-18, 20 and 24 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an enabling disclosure. The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-12 over each of Brodbeck, Ercoli and Gibson, and claims 13-18 and 20-25 over Gibson.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Rejection under 35 U.S.C. § 112, first paragraph

Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is

inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

The examiner argues that "a method for treating alopecia areata or male pattern baldness", recited in the preambles of claims 13 and 24, encompasses alopecia areata in general, alopecia totalis, alopecia universalis and male pattern baldness, and that appellant's specification does not enable treating all of these conditions (answer, pages 8 and 10). The examiner, however, does not explain why there is reason to

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doubt the truth of the statements in the specification that the invention is effective for treating alopecia areata or male pattern baldness, and provide the required supporting evidence or reasoning. Consequently, we reverse the rejection under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 103

The examiner argues that Brodbeck discloses at page 2, column 1, fourth full paragraph that the composition can contain water (answer, page 4). Page 2, column 1 of Brodbeck, however, does not have a fourth paragraph. Because all of appellant's claims require water and the examiner has not properly explained where Brodbeck discloses or would have fairly suggested, to one of ordinary skill in the art, including water in the disclosed nursery powder composition, the examiner has not carried his burden of establishing a *prima facie* case of obviousness over this reference of the

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invention recited in any of appellant's claims.²

The examiner argues that Ercoli discloses a composition containing boric acid, zinc oxide and starch (answer, page 4). The examiner, however, does not explain where Ercoli discloses or would have fairly suggested, to one of ordinary skill in the art,

use of water in combination with these components. Thus, the examiner has not established a *prima facie* case of obviousness over this reference.

The examiner argues that one of ordinary skill in the art would have arrived at the ratios of components recited in appellant's claims, in view of Brodbeck or Ercoli, through no more than routine experimentation (answer, page 4). The examiner does not explain, however, and it is not apparent,

²Appellant states that in this rejection the examiner may be referring to Keil, U.S. Patent No. 2,289,125 (brief, page 4). Because this reference is not included in the statement of the rejection it is not properly before us and, therefore, is not relied upon in reaching our decision. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

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why optimizing Brodbeck's nursery powder composition or Ercoli's fungicidal agent would produce the relative component proportions recited in appellant's claims, which appellant has found to be proper for a composition directed toward a different use, i.e., treating alopecia areata or male pattern baldness.

The examiner argues that Gibson discloses in examples 19-24 a composition containing starch, boric acid and zinc oxide (answer, page 4). The compositions in these examples, however, are powders and do not contain water. Other compositions disclosed by Gibson contain water. The examiner, however, has not explained why Gibson would have fairly suggested, to one of ordinary skill in the art, use of starch, boric acid and zinc oxide in combination with water.

The examiner argues, regarding claim 8, that appellant should have considered the references in combination (answer, page 9). The examiner, however, has provided no argument regarding how the combined teachings of the references would have fairly suggested, to one of ordinary skill in the art,

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the invention recited in any of appellant's claims.

For the above reasons, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness of the invention recited in any of appellant's claims.³

DECISION

The rejections of claims 13-18, 20 and 24 under 35 U.S.C. § 112, first paragraph, enablement requirement, and the

³The examiner states (answer, page 10) that he has not considered the declaration of Jacques Antoun filed on August 28, 1995 after the final rejection. Because this declaration has not been considered by the examiner, we have not relied upon it in reaching our decision.

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rejections under 35 U.S.C. § 103 of claims 1-12 over each of
Brodbeck, Ercoli and Gibson, and claims 13-18 and 20-25 over
Gibson, are reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
TERRY J. OWENS))
Administrative Patent Judge)	

TJO/PGG

Seth M. Nehrass
Garvey, Smith, Nehrass & Dooby

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L.L.C.
3838 N. Causeway Blvd.
Suite 3290
Matairie, LA 70002