

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 GUNTHER RIESS,
GERHARD SEIBERT
and UDO HEDTMANN

Appeal No. 1997-2742
Application 08/348,815

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 7 through 12, which are all of the claims remaining in the application.

Claims 7 and 9, which are illustrative of the subject matter on appeal, read as follows:

7. A treatment method for controlling H. pylori infection which comprises administering to a patient in need of such treatment an effective amount of moenomycin or a derivative thereof.

9. A pharmaceutical composition which comprises effective amounts of moenomycin

35 U.S.C. § 103

None of the cited references teaches or suggests that moenomycin or its derivatives would be effective against H. pylori infections. The examiner has not established that a person having ordinary skill in the art would have been led from “here to there,” i.e., from the disclosures in Welzel, Huber, and Axon to the pharmaceutical composition and method claims on appeal.

The rejection of claims 7 through 12 under 35 U.S.C. §103 as unpatentable “over Welzel et al. or Huber in combination with Axon” is reversed.

35 U.S.C. §112, FIRST PARAGRAPH

In their specification, appellants establish by in vitro testing that moenomycin A is active against H. pylori strain P22. In further in vitro testing, appellants determine the minimum inhibitory concentration of moenomycin A against H. pylori strains P9, P19, and M84. See the instant specification, pages 11 and 12, Examples 1, 2, and 3.

On the other hand, claims 7, 8, 10 and 11 are drawn to in vivo methods for controlling H. pylori infection in a patient. Independent claim 7 recites

A treatment method for controlling H. pylori infection which comprises administering to a patient in need of such treatment an effective amount of moenomycin or a derivative thereof. [emphasis added]

Likewise, claim 10 recites

A treatment method for controlling H. pylori infection which comprises administering to a patient in need of such treatment a pharmaceutical composition as claimed in claim 9. [emphasis added]

The pharmaceutical composition “as claimed in claim 9” comprises “effective amounts of moenomycin or a derivative thereof combined with one or both of a further active ingredient from the treatment of gastric ulcers or an additional antibiotic together with a pharmacologically acceptable carrier.” Claims 8 and 11 depend from claims 7 and 10, respectively, and are limited to treating gastric ulcers associated with H. pylori infection.

On this record, we find no error in the examiner’s determination that in vitro testing in the specification is insufficient to provide enabling support for claims which define in vivo methods for controlling H. pylori infection. After all, as correctly found by the examiner, “H. pylori is very sensitive to a wide range of antibiotics in vitro. Unfortunately, when used as a treatment in vivo few are effective.” (Axon, page 65, first paragraph). Considering the state of the prior art at the time the invention was made, as reflected in the above-quoted passage

from Axon, we hold that claims 7, 8, 10 and 11 are based on a non-enabling disclosure.

In so holding, we have not overlooked this statement in the specification, page 7, lines 18-20:

Moenomycin is able to penetrate the mucus layer of the gastric mucous membrane and to reach the actual site of residence of the infecting micro-organism.

According to appellants, that statement provides reasonable assurance that moenomycin, when used in vivo, will “reach the actual site of residence of the infecting microorganism” and effectively control H. pylori infection. (Appeal Brief, paragraph bridging pages 7 and 8). We disagree. The flaw with appellants’ argument is that the above-quoted statement in the specification is unsubstantiated by facts or evidence. It stands by itself. Here, the examiner established a prima facie case of non-enablement of claims 7, 8, 10 and 11, and appellants’ mere statement in the specification, unsupported by evidence, does not serve to rebut the prima facie case. Cf. In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (conclusory statements in specification cannot establish patentability).

We also note appellants’ acknowledgment that “[m]oenomycin has not been used until now in human medicine” (specification, page 7, line 13). Under these circumstances,

we believe that more is required to provide enabling support for claims drawn to in vivo methods for controlling H. pylori infection in a patient. Again, it was known at the time the invention was made that "H. pylori is very sensitive to a wide range of antibiotics in vitro. Unfortunately, when used as a treatment in vivo few are effective." (Axon, page 65, first paragraph). On this record, appellants have not established that moenomycin or its derivatives are effective in vivo for controlling H. pylori infection.

The rejection of claims 7, 8, 10 and 11 under 35 U.S.C. §112, first paragraph, is affirmed.

CONCLUSION

In conclusion, the rejection of claims 7 through 12 under 35 U.S.C. § 103 as unpatentable "over Welzel et al. or Huber in combination with Axon" is reversed. The rejection of claims 7, 8, 10 and 11 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure, is affirmed. Accordingly, the examiner's decision is affirmed-in-part.

Appeal No. 1997-2742
Application 08/348,815

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
William F. Smith)	
Administrative Patent Judge)	APPEALS AND
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Hubert C. Lorin)	
Administrative Patent Judge)	

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Finnegan, Henderson, Farabow, Garrett and Dunner
Franklin Square, Suite 700
1300 I Street, N.W.
Washington, DC 20005-3315