

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

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IRWIN B. WOOD and JAMES GUINLAN

Appeal No. 1997-2828
Application No. 08/087,548

HEARD: February 6, 2001

Before WILLIAM F. SMITH, SCHEINER and MILLS, Administrative Patent Judges.
MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 4-6, 9-11 and 13-18, which are all of the claims pending in this application.

We reverse.

Claims 1, 9 and 16 are illustrative of the claims on appeal and reads as follows:

1. A non-aqueous pour-on, water-fast composition for combatting helminth, acarid or arthropod endo- or ectoparasitic insect infestation or infection of a mammalian quadruped comprising an anthelmintically, acaricidally or an arthropod endo- or ectoparasitically effective amount of a compound selected from the group consisting of LL-F28249 α - λ , a 23-oxo or 23-imino derivative of LL-F28249 α - λ , dissolved or dispersed in a mixture comprising: from about 5.0% to about 20% w/v of an aromatic solvent having a mixed aniline point of from about 13.4°C to about 15.4°C, a Kauri-butanol value between about 90 to about 96 and a specific gravity @ 15.6°/15.6°C of from about 0.872 to about 0.985; from about 1.0% w/v to about 15.0% w/v of PPG-2 myristyl ether propionate; from about 1.0% w/v to about 15.0% w/v of a polybutene having a number average molecular weight o from 320 to 3000 and a Cleveland open cup flash point of from 154°C to 307°C; from 0 to about 2.0% w/v of a dye, an antimicrobial agent, an antioxidant or a mixture thereof; and sufficient quantity of a pharmacologically acceptable oil to total 100% w/v.

9. A method for treating helminth, acarid or arthropod endo- or ectoparasitic insect infection or infestation in a mammalian quadruped which comprises pouring onto the skin or hide of the quadruped to be treated an anthelmintically, acaricidally or arthropod endo- or ectoparasitically effective amount of a composition of Claim 1.

16. A method for treating or controlling psoroptic, chorioptic, sarcoptic or demodectic mange on a mammalian quadruped which comprises pouring onto the skin or hide of the quadruped a non-aqueous pour-on composition of Claim 1 containing a sufficient amount of the compound 23- (O-methyloxime)-LLF28249 α to provide about 0.1 mg/kg to about 5.0 mg/kg of body weight of said compound.

The prior art references relied upon by the examiner are:

Kieran et al. (Kieran)	4,607,050	Aug. 19, 1986
O'Sullivan et al. (O'Sullivan)	4,859,657	Aug. 22, 1989
Maienfish	4,871,719	Oct. 3, 1989
Asato et al. (Asato)	4,916,154	Apr. 10, 1990
Abber	4,925,671	May 15, 1990

Grounds of Rejection

1. Claims 1, 4-6, 9-11 and 13-18 stand rejected under 35 U.S.C. § 103 as unpatentable over O'Sullivan, Asato and Maienfisch in view of Kieran.
2. Claims 1, 4-6, 9-11 and 13-18 stand rejected under 35 U.S.C. § 103 as unpatentable over O'Sullivan, Asato, Maienfisch and Kieran in view of Abber.

DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the noted rejections, we make reference to the examiner's Answer for the complete reasoning in support of the rejection, and to the appellants' Brief for the arguments thereagainst.

In addition, subsequent to the oral hearing of February 6, 2001, we are in receipt of appellants' Paper No. 34, entitled "Letter". As no such paper is provided by our governing Rules of Practice (37 CFR), and no such paper has been requested by this Board, the paper is entitled to and will be given no consideration. Ex parte Cillario, 14 USPQ2d at 1079 (Bd. Pat. App. & Int. 1989). As a consequence of our review, we make the determinations which follow.

Background

The claimed invention is directed to pour-on formulations effective for the control of internal and external parasites, particularly in cattle. The claimed compositions resist wash-off during normal precipitation. Specification, page 2, lines 29-34.

35 U.S.C. § 103

Claims 1, 4-6, 9-11 and 13-18 stand rejected under 35 U.S.C. § 103 as unpatentable over O'Sullivan, Asato and Maienfisch in view of Kieran.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Appellants submit that the examiner has not established a prima facie case of obviousness with respect to the pending claims because there is "absolutely no cited reference which describes any pour-on formulations using polybutene" as claimed. Brief, page 9. The appellants argue that the Advisory Action dated July 16, 1996 (Paper No. 19) reflects the examiner's mistaken belief that the polybutene ingredient is

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present only in claims 6 and 11. However, the polybutene ingredient is specifically listed as an element of all claims, including claim 1. Brief, page 9.

Recognizing this, the examiner entered a new grounds of rejection in the examiner's Answer (page 8), adding the Abber reference to address the polybutene ingredient in the claims. The examiner, however, did not withdraw the pending rejection over O'Sullivan, Asato and Maienfisch in view of Kieran.

In view of the above, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal, as the examiner has provided no argument or evidence of a non-aqueous, pour-on, water-fast composition including a polybutene ingredient, as claimed. Accordingly, we will not sustain the examiner's rejection of Claims 1, 4-6, 9-11 and 13-18 under 35 U.S.C. § 103 over O'Sullivan, Asato and Maienfisch in view of Kieran.

35 U.S.C. § 103

Claims 1, 4-6, 9-11 and 13-18 stand rejected under 35 U.S.C. § 103 as unpatentable over O'Sullivan, Asato and Maienfisch and Kieran in view of Abber.

It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir.

1996) . Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

O’Sullivan is relied on by the examiner for the disclosure of the use of numerous avermectin and milbemycin pesticides for the control of endo-parasites and ecto-parasites. O’Sullivan also discloses the topical application of such compositions. Asato is relied on for the disclosure of “the claim designated compounds as old and well-known for the utility claimed in the instant application in combination with various carriers and excipient.” Answer, pages 8-9. The examiner relies upon Maienfisch for a disclosure of the recited class of compounds in combination with “a plethora of excipient and carriers, and pour-on formulations”. The examiner suggests that the “selection of an appropriate solvent system would have been a simple selection from a group of obvious alternatives available to the skilled artisan.” Answer, page 9.

Kieran describes the use of pour on formulations of avermectins and milbemycins for the control of insects and/or endo-parasites and ecto-parasites. The

compounds may be applied topically to a small area in order to become systemically absorbed to control insect or parasite infections, internally or externally. Answer, page 9.

Finally, the Abber reference is provided by the examiner as evidence of the use of polybutene compounds in formulating compositions for transdermal therapeutic devices. Answer, page 10. The examiner suggests that the prior use of polybutene for transdermal formulations would have motivated the skilled artisan to employ these compounds in other transdermal formulations, and enjoy a reasonable expectation of therapeutic success.

The examiner summarizes his position as follows (Answer, pages 10-11):

The examiner cited prior art teachings setting forth the claimed active ingredients as useful in transdermal drench compositions for the same therapeutic use, and the individual carriers and excipient as old for transdermal use would have motivated the skilled artisan to combine the instant teachings into the claims of the instant application.

The appellants argue that a prima facie case of obviousness has not been established by the examiner as 1) the collective art fails to suggest the non-aqueous solvent system of the invention, 2) the desirability of combining the reference teachings to arrive at the present pour-on formulations is totally missing, and 3) without appellant's claims as a blueprint, the practitioner would not be motivated to make or use the unique oil based, water immiscible pour-on formulations of the LL-F28249 compounds. Reply Brief, page 2.

The appellants point to several insufficiencies in the cited references which support the position of lack of proper motivation to combine the cited references to arrive at the claimed invention. For instance, the appellants argue that Asato specifically teaches utilizing water-soluble solvents and water miscible solvents to prepare pour-on formulations. Appellants also submit that O'Sullivan and Maienfisch fail to describe the particular non-aqueous pour-on formulations claimed as they suggest water emulsion based concentrates which can be used as pour-on formulations.

Similarly, appellants argue that Abber describes a solid, cross-linked, polymerized, pressure sensitive adhesive composed of the combination of a methyl/phenyl siloxane gum, a dimethyl siloxane gum, an organopolysiloxane resin and a catalyst. Abber indicates polybutene resin may be optionally added to the adhesive composition prior to curing to produce greater tack and better adhesion of the polymerization product and provides nitroglycerin as a representative pharmaceutical to be delivered. Column 6, lines 30-33; column 8, Table II. "[T]here is no teaching or suggestion that the polybutene can be used apart from the solid adhesive device in liquid form." Reply Brief, page 4. For this reason, appellants argue that "the description of polybutene in a solid, transdermal device would not motivate the artisan of ordinary skill to employ polybutene in the present case without more direction in the art." Reply Brief, page 5. We agree.

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Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. All the claims under appeal require polybutene. However, this claim element is not suggested by the applied prior art. In that regard, while Abber does teach the use of polybutene in cross-linked, transdermal composition, Abber does not teach or suggest using a polybutene in liquid form as an ingredient of a non-aqueous, pour-on, water-fast composition. To supply these omissions in the teachings of the applied prior art, the examiner made determinations that these differences would have been obvious to an artisan. However, we find these determinations have not been supported by any evidence that would have led an artisan to arrive at the claimed invention.

In our view, the only suggestion for modifying in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

We find it unnecessary to reach the rebuttal evidence of appellant as we find the examiner has not met the burden of setting forth a prima facie case of unpatentability based on obviousness. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir.

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1987). The examiner has not established on the record before us that the cited references both suggest the claimed subject matter and reveal a reasonable expectation of success to one reasonably skilled in the art. It follows that we cannot sustain the examiner's rejections of claims 1, 4-6, 9-11 and 13-18 over O'Sullivan, Asato and Maienfisch and Kieran in view of Abber.

CONCLUSION

The rejections of claims **1, 4-6, 9-11 and 13-18** under 35 U.S.C. § 103 are reversed.

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

REVERSED

WILLIAM F. SMITH))
Administrative Patent Judge))
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TONI R. SCHEINER))
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