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for publication in a law journal and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte CHRISTOPHER J. DUTTON, STEPHEN P. GIBSON
and SHIH-JEN E. LEE

_____

Appeal No. 1999-0676
Application No. 08/465,625

_____

ON BRIEF

_____

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

WINTERS, Administrative Patent Judge.

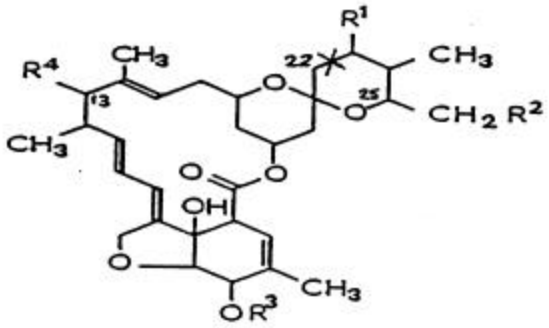
DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 5, 8, and 10 through 12, all of the claims remaining in this application

REPRESENTATIVE CLAIM

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A compound having the formula:

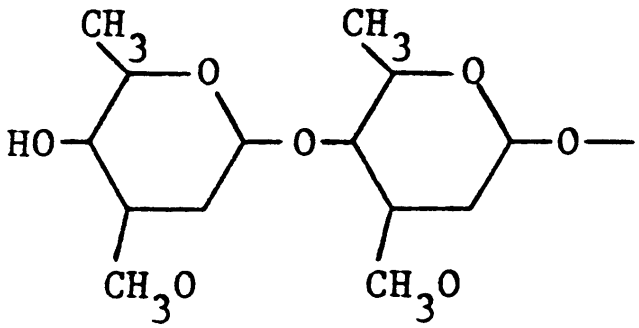


wherein X represents a single or a double bond; R^1 is H or OH; provided that when X is a single bond, R^1 is H or OH, and when X is a double bond, R^1 is absent;

R^2 is H, C_1-C_8 alkyl, C_2-C_8 alkenyl, C_2-C_8 alkynyl, alkoxy-alkyl or alkylthioalkyl containing from 1 to 6 carbon atoms in each alkyl or alkoxy group, wherein any of said alkyl, alkoxy alkenyl or alkynyl groups may be substituted by one or more halo atoms or a C_3-C_8 cycloalkyl or C_5-C_8 cycloalkenyl group, either of which may be substituted by methylene or one or more C_1-C_4 alkyl groups or halo atoms; or a 3 to 6 membered oxygen or sulphur containing heterocyclic ring which may be saturated, or fully or partially unsaturated and which may be substituted by one or more C_1-C_4 alkyl groups or halo atoms; or a group of the formula SR^5 wherein R^5 is C_1-C_8 alkyl, C_2-C_8 alkenyl, C_2-C_8 alkyny1, C_3-C_8 cycloalkyl, C_5-C_8 cycloalkenyl, phenyl or substituted phenyl wherein the substituent is C_1-C_4 alkyl, C_1-C_4 alkoxy or halo, or a 3 to 6 membered oxygen or sulphur containing heterocyclic ring which may be saturated, or fully or partially unsaturated and which may be substituted by one or more C_1-C_4 alkyl groups or halo atoms;

R^3 is hydrogen or methyl;

and R^4 is H or a 4' – (alpha-L-oleandrosyl)-alpha-L-oleandro-syloxy group of the formula



with the proviso that when R^4 and R^1 are both H and the double bond is absent, R^2 is not H or CH_3.

REFERENCE

The prior art reference relied on by the examiner is:

Gibson et al. (Gibson)	5,089,480	Feb. 18, 1992

THE REJECTION

Claims 1 through 5, 8, and 10 through 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Gibson. The previously entered rejection of claim 12 under 35 U.S.C. § 112, first paragraph, has been withdrawn (examiner's answer, page 2, section (6)).

DELIBERATIONS

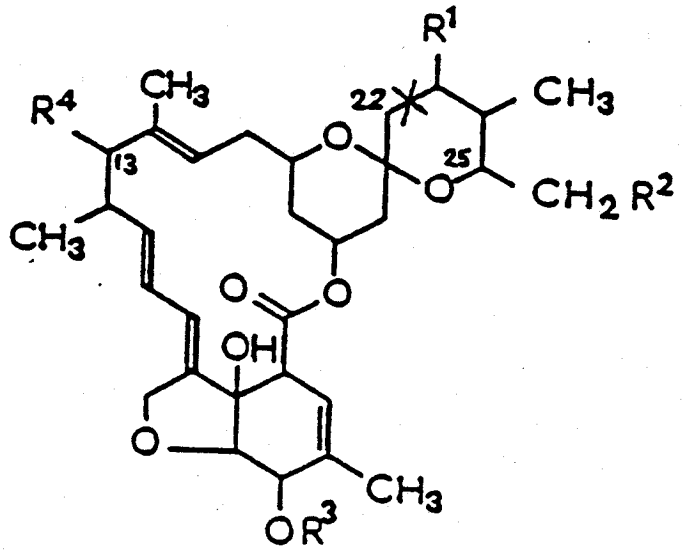
Our deliberations in this matter have included evaluation and review of the following materials:

1. the instant specification, including all of the claims on appeal;
2. the appeal brief received December 12, 1996 (Paper No. 11);
3. the examiner's answer mailed March 3, 1997 (Paper No. 12); and
4. the above-cited reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 USC § 103.

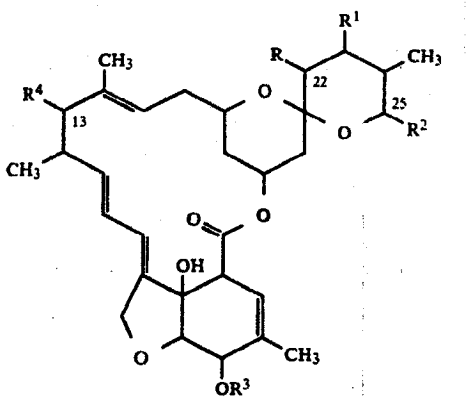
DISCUSSION

Appellants' invention relates to compounds having the formula:

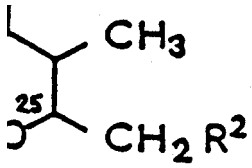
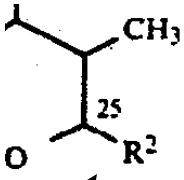


where the definitions of variables are set forth in the specification, pages 2 through 4. According to appellants, the claimed compounds are "novel avermectin derivatives… wherein the C-25 substituent is linked by an unbranched (primary) carbon atom" (specification, page 2). These compounds "are highly active antiparasitic agents having particular utility as anthelmintics, ectoparasiticides, insecticides and acaricides" (id.).

Gibson discloses compounds having the formula:



where the definitions of variables are set forth in col. 2, line 19 to col. 3, line 4. Like appellants' compounds, Gibson's compounds also have "particular utility as anthelmintics, ectoparasiticides, insecticides and acaricides" (col. 1, lines 49-53). However, Gibson specifies that the R^2 substituent at position 25 must be alpha-branched (col. 2, line 22). Gibson states that "[a]lpha-branched means that the carbon atom attached to the 25-ring position is a secondary carbon atom linked to two further carbon atoms" (col. 2, line 52-55). Appellants' compounds differ from Gibson's compounds in that appellants' R^2 substituent is linked to the 25-ring position via a methylene group (CH_2). The following pictorial illustrates the difference:

Appellants' 25-ring position	**Gibson's 25-ring position**
	
methylene group	no methylene group

According to the examiner,

> [S]ince the groups at the 25-position encompassed by the instant claims are isomers of the groups disclosed by the reference, a person having ordinary skill in the art at the time of the instant invention would have been motivated to modify the reference's compounds so that the same do no [sic] contain alpha-branching at the 25-position because such a person would have expected the resulting compounds to possess antiparasitic activity (examiner's answer, page 4, lines 4 through 8).

Appellants argue that Gibson provides "no motivation whatsoever to prepare compounds which do not have an alpha-branched group (i.e., a secondary carbon atom) bonded to the C-25 position" (appeal brief, page 9). Appellants also argue that the examiner's position is unsupported and a result of "hindsight combining the teachings [of appellants] with those of Gibson" (id.). Appellants conclude that the examiner failed to carry the burden of establishing a *prima facie* case of obviousness.

We agree with appellants, and therefore reverse the examiner's rejection.

In the answer mailed March 3, 1997 (Paper No. 12), the examiner does not expressly refer to or cite legal precedent. Nevertheless, in setting forth the rejection under 35 USC § 103, the examiner apparently relies on the proposition of law that chemical isomers can give rise to a prima facie case of obviousness (examiner's answer, page 4, lines 4 through 8). In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979) ("[a]n obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties"). If this be the case, we note that In re Payne has a second prong that must be considered. The prior art must be enabling. In re Payne, 606 F.2d 303, 314, 203 USPQ 245, 255 (CCPA 1979) ("[r]eferences relied upon to support a rejection under 35 U.S.C. § 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public.").

Here, Gibson specifies that the R_2 substituent at position 25 must be alpha-branched. The dispositive question is: can one skilled in the art arrive at the claimed invention, based on Gibson's disclosure alone? We answer that question in the negative. Gibson's disclosure is limited to a fermentation process involving an avermectin or milbemycin producing organism (Abstract; col.1, lines 41-62; col. 3, lines 8-19; col. 4, lines 16-49; col. 5, lines 35-50). That process provides a compound having an alpha-branched R_2 substituent at position 25 (Abstract; col.2, lines 1-33). We have carefully reviewed

Gibson's disclosure in its entirety, but find no disclosure or suggestion of a process for preparing the claimed compound having a primary carbon atom at position 25. Thus, Gibson does not place the claimed invention in the possession of the public and, therefore, does not constitute an enabling disclosure.

Additionally, we invite the examiner's attention to the decision by another merits panel of the Board in parent application 07/647,674, Appeal No. 93-1807 (Paper No. 35, mailed March 20, 1997). There, the Board reversed a rejection of claims directed to the method of making the instantly claimed compounds. That rejection was based on Gibson et al., EP 0 214 731, published March 18, 1987. According to appellants, EP 0 214 731 is "the counterpart of U.S. application Serial No. [06/]886,867, filed July 16, 1986" (specification, page 1, lines 22-24). U.S. Patent No. 5,089,480, the reference relied on here, is a continuation-in-part of Application No. 06/886,867. Thus, the decision in parent application 07/647,674 is consistent with our position that Gibson does not constitute an enabling disclosure, i.e., does not put a person having ordinary skill in possession of the claimed invention.

CONCLUSION

The examiner's decision, rejecting claims 1 through 5, 8, and 10 through 12 under 35 U.S.C. § 103, is reversed.

REVERSED

Sherman D. Winters Administrative Patent Judge	)
William F. Smith Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
Toni R. Scheiner Administrative Patent Judge	)

SW/dym

GREGG C BENSON
PFIZER, INC.
EASTERN POINT ROAD
GROTON, CT 06340