

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte RONALD M. EVANS, RICHARD J. LIN,  
and LASZLO NAGY

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Appeal No. 2001-1411  
Application No. 08/966,876

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ON BRIEF<sup>1</sup>

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Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-15, 17 and 18, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of treating a subject with a neoplastic disease, said method comprising co-administering to said subject an amount of

an inhibitor of a co-repressor and

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<sup>1</sup> Pursuant to appellants request (Paper No. 20, received October 10, 2000) an oral hearing for this appeal was scheduled for February 21, 2002. However, we note appellants waived (Paper No. 22, received December 6, 2001) their request for oral hearing. Accordingly, we considered this appeal on Brief.

a ligand for a member of the steroid/thyroid superfamily of receptors,  
effective to ameliorate the symptoms of said neoplastic disease  
wherein said inhibitor is not sodium butyrate.

The references relied upon by the examiner are:

Evans et al. (Evans) <sup>2</sup>	6,387,673	May 14, 2002
Morioka et al. (Morioka)	JP 60149520 A	August 7, 1985

Chen et al. (Chen), "Retinoic Acid is Required for and Potentiates Differentiation of Acute Promyelocytic Leukemia Cells by Nonretinoid Agents," Blood, Vol. 84, No. 7, pp. 2122-2129 (1994)

Taunton et al. (Taunton), "A Mammalian Histone Deacetylase Related to the Yeast Transcriptional Regulator Rpd3p," Science, Vol. 272, pp. 408-411 (1996)

#### GROUNDINGS OF REJECTION

Claims 1, 3-15, 17 and 18 stand rejected under 35 U.S.C. § 103 as obvious over Chen in view of Taunton and Morioka.

Claims 1 and 5 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Evans.

We reverse the rejection under 35 U.S.C. § 103 and affirm the rejection under the judicially created doctrine of obviousness-type double patenting.

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<sup>2</sup> The Answer refers to Application No. 08/846,881, instead of the Patent No. of the Evans patent. We note, however, that Evans was not issued at the time the Answer was written. Given the issuance of the Evans patent the obviousness-type double patenting rejection which relies on Evans is no longer provisional.

## DISCUSSION

### The rejection under 35 U.S.C. § 103:

The claimed invention requires that an inhibitor of a co-repressor and a ligand for a member of the steroid/thyroid superfamily of receptors be co-administered to a subject. As the examiner recognizes (Answer, page 5), Chen teach “the sequential combination of RA<sup>[3]</sup> and ... butyrates led to synergistic induction of differentiation and terminal differentiation.” We also recognize Chen’s conclusion (page 2128, column 1), “sequential combination differentiation therapy may be suitable for clinical evaluation in newly diagnosed patients with APL<sup>[4]</sup> or in cases refractory to current treatment programs.” The examiner has not identified, and we find no statement in Chen wherein RA and a co-repressor (e.g. a butyrate) are co-administered as is required by the claimed invention. Taunton and Morioka, relied upon by the examiner to teach the substitution of Trichostatin A or Trapoxin for sodium butyrate in Chen’s method, fail to make up for this deficiency in Chen.

Therefore, we disagree with the examiner’s statement (Answer, page 9), “[i]t is clear that the prior art suggests the combination of the same two substances as claimed for the treatment of the same condition as claimed.” Instead, what is clear from Chen is that RA and a co-repressor are administered sequentially. Therefore, contrary to the examiner’s position, the idea of combining RA and a co-repressor does not flow logically from their having been individually taught in the prior art. See Answer, page 10.

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<sup>3</sup> Retinoic acid.

<sup>4</sup> Acute promyelocytic leukemia.

Accordingly, we reverse the rejection of claims 1, 3-15, 17 and 18 under 35 U.S.C. § 103 as obvious over Chen in view of Taunton and Morioka.

The obviousness-type double patenting rejection:

Claims 1 and 5 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Evans. In response, appellants state (Brief, page 5), they “will address this issue after all other issues in this case have been resolved and the claims are otherwise in condition for allowance (e.g., by cancellation of one of the sets of conflicting claims, by submission of a Terminal Disclaimer, or such other action as deemed appropriate).”

We interpret this statement to mean that appellants concede to the rejection set forth by the examiner. Accordingly, we affirm the rejection of claims 1 and 5 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Evans.

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  
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