

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte LISA YURCHAK, ROBERT DOBBERSTEIN  
and LINDA S. HEIST

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Appeal No. 2004-0973  
Application No. 09/898,155

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ON BRIEF

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Before SCHEINER, ADAMS 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 16-25, which are all of the claims pending in this application.

Claim 16 is illustrative of the claims on appeal and reads as follows:

16. An orally administered sleep inducing antacid composition comprising from about 100 mg to about 2000 mg of at least one antacid, and about 300 mg to about 1000 mg of at least one sleep inducing compound wherein the amount of sleep inducing compound is based upon a concentrated extract containing not less than 0.5% of the essential oil of the respective sleep inducing compound.

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The prior art references relied upon by the examiner are:

Hoffman	6,346,283	Feb. 12, 2002
Shlyankevich	5,569,459	Oct. 29, 1996
Night Song, Product, NutraSource, Inc., <a href="http://www.nutrasource.com">www.nutrasource.com</a> ,		7/11/2000

#### Grounds of Rejection

Claims 16, 17 and 19-25 stand rejected under 35 U.S.C. 102(e) as anticipated by Hoffman.

Claims 16 and 18 stand rejected under 35 U.S.C. 103(a) as obvious in view of Hoffman.

Claims 16 -25 stand rejected under 35 U.S.C. 103(a) as obvious in view of Shlyankevich.

Claims 16 -25 stand rejected under 35 U.S.C. 103(a) as obvious in view of Night Song.

We affirm the anticipation and obviousness rejections in view of Hoffman, and reverse the remaining rejections.

#### Claim Grouping

According to appellants, the “claims on appeal may be grouped as one.” Brief, page 2. Therefore, we select claim 16 as representative of the claims on appeal. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

35 U.S.C. § 102(e)

Claims 16, 17 and 19-25 stand rejected under 35 U.S.C. 102(e) as anticipated by Hoffman.

According to the examiner, Hoffman teaches a composition that contains 1000 mg. of calcium carbonate and 250, 500, or 1000 mg. of valerian extract (see column 13, lines 42-48). The valerian extract contains at least 0.5% active ingredients (see column 9, lines 58-60). Answer, page 3.

The examiner admits that the reference does not specifically teach that the composition functions as a sleep inducing antacid compound. Id. The examiner argues that since the composition of the reference is the same as the claimed composition, the reference composition would inherently have to have the same side effects if applicant's invention functions as claimed. Id.

It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."). A composition claim reciting a newly discovered property of an old alloy did not satisfy section 102 because the alloy itself was not new. Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985) and In re Pearson,

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494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Moreover, “[M]ere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable.” In re Zierden, 411 F.2d 1325, 1328, 162 USPQ 102, 104 (CCPA 1969). No provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product. In re Benner, 174 F.2d 938, 942, 82 USPQ 49, 53 (CCPA 1949).

Therefore, we agree with the examiner that the composition of claim 16 is known and disclosed in Hoffman. The discovery of a new property or use for this composition, such as its use as a sleep inducing antacid, even when this property and use are unobvious from prior art, can not impart patentability to claims to the known composition. The rejection of claims 16, 17 and 19-25 under 35 U.S.C. 102(e) for anticipation in view of Hoffman is affirmed.

#### 35 U.S.C. 103(a)

Claims 16 and 18 stand rejected under 35 U.S.C. 103(a) as obvious in view of Hoffman.

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). It is well-established that 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

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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).

It is the examiner's position that (Answer, page 4):

this [Hoffman] reference discloses a composition that contains valerian and calcium carbonate. However, the reference does not specifically teach adding the ingredients together in all the amounts claimed. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize.

We agree with appellants that the examiner has provided sufficient evidence to support a prima facie case of obviousness. Appellants have indicated for the record in the Brief that the claims stand or fall together. We have selected claim 16 as the representative claim. We have found herein that claim 16 is anticipated in view of Hoffman. Anticipation being the epitome of obviousness, we also affirm the rejection of the claims under 35 U.S.C. § 103 as being obvious in view of Hoffman. See In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). The rejection of the claims for obviousness in view of Hoffman is affirmed.

### 35 U.S.C. 103(a)

Claims 16 -25 stand rejected under 35 U.S.C. 103(a) as obvious in view of Shlyankevich. Claims 16 -25 stand rejected under 35 U.S.C. 103(a) as obvious in view of Night Song.

Shlyankevich

It is the examiner's position that Shlyankevich (Answer, page 4):

discloses a composition that contains valerian, calcium carbonate, and vitamins... Vitamins are considered by the examiner to be encompassed by the limitation "supplements." However, US '459 does not specifically teach adding the ingredients together in the amounts claimed. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ.

We do not find that the examiner has presented a *prima facie* case of obviousness in view of Shlyankevich. We agree with appellants that "the amount of sleep inducing compound disclosed is 10-80 mg (col. 5, line 20). No amount of optimization of this 10-80 mg amount, either for the purpose of controlling estrogen production or for any other purpose, would produce a formulation containing at least 300 mg of a sleep-inducing compound, as is presently claimed." Brief, page 3.

Furthermore, patent examiners, in relying on what they assert to be general knowledge to negate patentability on the ground of obviousness, must articulate that knowledge and place it of record, since examiners are presumed to act from the viewpoint of a person of ordinary skill in the art in finding relevant facts, assessing the significance of prior art, and making the ultimate determination of the obviousness issue. Failure to do so is not consistent with either effective administrative procedure or effective judicial review, examiners cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which they rely. See In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d

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1430, 1433-1434 (Fed. Cir. 2002). Thus, it is improper to rely on the “common knowledge and common sense” of a person of ordinary skill in art to find an invention obvious over a combination of prior art references, since the factual question of motivation to select and combine references is material to patentability, and cannot be resolved on subjective belief and unknown authority. In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002).

We do not find the examiner has provided evidence to support his position that one of ordinary skill in the art would have optimized Valerian to greater amounts in view of the disclosure of Shlyankevich. The rejection of claims 16-25 over Shlyankevich is reversed.

#### Night Song

Similarly, Night Song discloses a composition comprising 800 mg. from Valerian root and 60 mg of calcium carbonate. We do not find the examiner has provided evidence to support his position that one of ordinary skill in the art would have optimized calcium carbonate to greater amounts in view of the disclosure of Night Song. The rejection of claims 16-25 over Night Song is reversed.

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### CONCLUSION

The rejection of claims 16, 17 and 19-25 under 35 U.S.C. 102(e) as anticipated by Hoffman is affirmed. The rejection of claims 16 and 18 under 35 U.S.C. 103(a) as obvious in view of Hoffman is affirmed.

The rejection claims 16-25 under 35 U.S.C. 103(a) as obvious in view of Shlyankevich is reversed.

The rejection of claims 16 -25 under 35 U.S.C. 103(a) as obvious in view of Night Song is 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).

AFFIRMED

TONI R. SCHEINER  
Administrative Patent Judge

DONALD E. ADAMS  
Administrative Patent Judge

DEMETRA J. MILLS  
Administrative Patent Judge

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