

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 HUMBERTO B. ARZENO and DAVID J. MORGANS, JR.

Appeal No. 94-2062
Application 07/870,841¹

ON BRIEF

Before WEIFFENBACH, ELLIS and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of

¹ Application for patent filed April 20, 1992. According to appellants, the application is a continuation of Application 07/094,220, filed September 8, 1987, now abandoned, which is a continuation-in-part of Application 06/905,827, filed September 10, 1986, now abandoned.

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claims 19-27, which are all of the claims remaining in the application.

THE INVENTION

Appellants claim a method for the selective amidination of a diamino compound having a particular generic formula to an "-amino-**T**-guanidino compound by reacting the diamino compound with a formamidinesulfonic acid of a specified generic formula. Claim 19 is illustrative and is appended to this decision.

THE REFERENCES

Patchett et al. (Patchett) (European patent application)	0 012 401	Jun. 25, 1980
Alhede et al. (Alhede) (British patent)	1 587 258	Apr. 1, 1981

THE REJECTION

Claims 19-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alhede alone or in combination with Patchett.

OPINION

We have carefully considered all of the arguments

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advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, this rejection will be reversed.

Alhede discloses a method for producing guanidines by reacting formamidinesulfonic acids with primary monoamines (page

1, line 39 - page 2, line 20). The formamidinesulfonic acids differ from those recited in appellants' claim 19, but appellants state that they do not assert that this difference is a patentable distinction (brief, page 4). Appellants argue that the patentable distinction lies in the difference between the amine reactants and the products of appellants and those of Alhede. See *id.*

The examiner argues (answer, page 6):

A chemical process with a predictable outcome and otherwise obvious is not rendered unobvious simply because either or both the starting material and the product are novel. In re Durden, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985). As such, appellants' use of an analogous diamine reactant in the otherwise old amidination process is not, in and of itself, sufficient to render the herein-claimed process unobvious.

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The examiner reached his conclusion of obviousness of appellants' claimed invention based on a *per se* rule that use of a new starting material in a prior art process or making a new product by such a process would have been obvious to one of ordinary skill in the art. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir.

1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." The court further stated:

Mere citation of *Durden*, *Albertson*, or any other case as a basis for rejecting process claims that differ from the prior art by their use of different starting materials is improper, as it sidesteps the fact-intensive inquiry mandated by section 103. In other words, there are not "*Durden* obviousness rejections" or "*Albertson* obviousness rejections," but rather only section 103 obviousness rejections.

In re Ochiai, 71 F.3d at 1570, 37 USPQ2d at 1132.

When an examiner is determining whether a claim should be rejected under 35 U.S.C. § 103, the claimed subject matter as

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a whole must be considered. See *Ochiai*, 71 F.3d at 1569, 37 USPQ2d at 1131; *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). The subject matter as a whole of process claims includes the starting materials and product made. When the starting and/or product materials of the prior art differ from those of the claimed invention, the examiner has the burden of explaining why the prior art would have motivated one of ordinary skill in the art to modify the materials of the prior art process so as to arrive at the claimed invention. See *Ochiai*, 71 F.3d at 1570, 37 USPQ2d at 1131. The examiner asserts that "[i]t is clear from the disclosure in Alhede that amines generally may be reacted with the sulfonic acid derivatives to form guanidines", but does not explain why the disclosure of the use of primary monoamines would have suggested, to one of ordinary skill in the art, the use of compounds having two primary amine groups, particularly compounds which have the structure recited in appellants' claim 19 and which undergo a selective reaction as recited in that claim.

The examiner further argues (answer, page 7):

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It is reasonable to expect that compound (II) [sic, compound (III) in appellants' claim 19] would preferentially react with a primary amino group particularly in situations where A is a bulky peptidyl residue, for example. The Patchett reference appears to support the examiner's holding that one of ordinary skill in the art would have expected a primary amino group to be more reactive with a sulfonyloxy group containing compound than a secondary amino group.

This argument is not relevant to appellants' claimed method. The "A" group referred to by the examiner does not appear in appellants' claims, and appellants' diamino compound has no secondary amino group.

For the above reasons, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness of appellants' claimed invention over Alhede.

The examiner relies upon Patchett as evidence that reaction of a formamidinesulfonic acid with a compound's primary amino groups is preferred over reaction with secondary amino groups (answer, pages 5 and 7). This argument is not well taken because the diamino compound in appellants' claims

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does not include a secondary amino group. Thus, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness of appellants' claimed invention over the combined teachings of Alhede and Patchett.

We note that the claims in the parent application, 07/094,220, were finally rejected, as in the present case, under 35 U.S.C. § 103 over Alhede alone or in view of Patchett, and that the rejection was affirmed by the Board (Appeal No. 90-1038). Unlike the present case, the claims in the parent case permit the diamino compound to include a secondary amine, and do not require selectivity to one primary amino group over a second primary amino group. Also, in the parent case the Board relied upon U.S. 4,656,291 to Maryanoff et al., which is not applied in the present case. Moreover, in the parent case, the Board relied upon *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985), but did not have the benefit of the court's discussion of *Durden* in *Ochiai* and *Brouwer, supra*. For these reasons, the Board's decision in the parent case is not controlling as to the present case.

DECISION

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The rejection of claims 19-27 under 35 U.S.C. § 103 as being unpatentable over Alhede alone or in combination with Patchett is reversed.

REVERSED

CAMERON WEIFFENBACH)	
Administrative Patent Judge)	
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JOAN ELLIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
TERRY J. OWENS)	
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