

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOYCE A. CORTRIGHT

Appeal No. 94-4260
Application 07/849,191¹

RECONSIDERATION

Before WILLIAM F. SMITH, GRON, and ELLIS, **Administrative Patent Judges.**

ELLIS, Administrative Patent Judge.

REQUEST FOR RECONSIDERATION

We have carefully considered the appellant's Request for Reconsideration, but we decline to change our position for the following reasons.

¹Application for patent filed March 11, 1992.

Appeal No. 94-4260
Application 07/849,191

I.

As an initial matter, the appellant points out that the examiner "found the disclosure enabling for a portion of the subject matter claimed." Request for Reconsideration, p. 1. The appellant directs our attention to p. 2 of the office action mailed June 8, 1992 in Paper No. 2.

We acknowledge the examiner's statements in the referenced paper, however, the claims which he indicated would have been enabled by the specification, if the subject matter was limited to application of BAG BALM®, are not now before us. That is, the claims under consideration by the examiner at that time are not the same as the claims now on appeal. Thus, the facts on appeal differ from the facts on which the examiner's decision was based. We also note that the appellant acknowledges that there is a difference in the subject matter now claimed since she has only urged that the examiner found the specification "enabling for a portion of the subject matter claimed."

Since the newly-claimed subject matter differs from that of the original claims, claim 15, we remind the appellant that under the provisions of 37 CFR § 1.196(b), this Board can make, without restriction, a new ground of rejection. Moreover, we point out that even had the examiner withdrawn an enablement rejection to claims directed to the same subject matter as the appealed claims, that rejection can be reinstated at any time during prosecution by either this Board (under § 1.196(b)) or by the examiner.

II.

With respect to claim 1, the appellant's overall position is best summarized as: the procedure described in Example 1 would have enabled one skilled in the art to make and use the claimed method of treatment without undue experimentation.²

² We note the appellant's statement that she "shared her Example 1 findings with two close friends whom she trusted to keep her secret. The two friends applied her Example 1 technique to their own bald spots with the results reported in Examples 2 and 3." Request for Reconsideration, p. 6. The facts of this event are not before us, however, if prosecution of this application is resumed, the appellant should make all these facts of record so that the examiner can consider whether they would affect the patentability of the claimed method.

Appeal No. 94-4260
Application 07/849,191

The appellant has carefully set forth the manner in which she believes the factors articulated by the court in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) for determining undue experimentation, apply to the facts of this case.

We have considered all of the appellant's arguments, however, we find that she has misunderstood the primary reason underlying our rejection. We do not quibble with the method disclosed or the results observed. Rather, with respect to claim 1, the problem is that the claim is directed to a method of treating baldness "to restore hair growth." Restoration means "to return to its original state." Webster's II New Riverside University Dictionary, Houghton-Mifflin Co. (1994). The appellant's reports of "three times as much hair growth as two months earlier," "filling-in some," and "fuzz," are not equivalent to the restoration of the patients' hair growth to its original state. Accordingly, in our view, the specification would not have enabled one skilled in the art to make and use the method, as claimed.

III.

Appeal No. 94-4260
Application 07/849,191

The appellant urges that the method disclosed in Example 1 would have enabled one skilled in the art "to make and use" the method described in claim 15. According to the appellant, since the "invention stimulates hair growth, the papilla are being activated to resume hair growth." Request for Reconsideration, p. 8. The appellant relies on the World Book Encyclopedia to support her position. We have carefully considered all the points raised, but find the appellant's arguments flawed on several accounts.

First, the appellant has failed to establish a correlation between the application of BAG BALM® and the "offsetting the effects of lower levels of male hormone being supplied by the arteries to the papilla of scalp hair follicles." Even if we assume, arguendo, that BAG BALM® reaches the papilla, there is no evidence of record that the resultant hair growth is due to (i) the stimulation of the papilla, and (ii) the offsetting the effects of lower male hormone which is supplied by arteries to the papilla, and not due to some other mechanism(s). The specification merely "surmises" as to the mechanism by which BAG BALM® acts and, in fact, suggests that alternative mechanisms might be

Appeal No. 94-4260
Application 07/849,191

responsible for the resultant hair growth such as "kill[ing] or seriously weaken[ing] any bacteria about or in the papilla and impairing its normal functioning." Specification, p. 4. Thus, the specification indicates that the underlying basis for the observed physiological phenomenon can not be predicted from the results obtained. We point to numerous cases in which claims have been directed to, or encompassed by, a physiological reaction, such as treating a disease or symptom, the subject matter was found highly unpredictable and unpredictability alone provide a reasonable doubt as to the accuracy of broad statements made in support of the enablement of a claim. *In re Fisher*, 427, F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970); *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369-370 (CCPA 1971) ("In the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim.")

Moreover, we note that the specification does not provide a single working example of the invention as described in

Appeal No. 94-4260
Application 07/849,191

claim 15; nor does it provide any guidance as to how to assay for the claimed results. That is, the specification does not provide any assays by which one skilled in the art could determine whether the effects of lower male hormone levels have been offset, or even if BAG BALM® has reached the papilla. Accordingly, we maintain our position that with respect to claim 15, the appellant is "tossing out the mere germ of an idea." *Genentech Inc. V. Novo Nordisk A/S*, 108 F.3d 1361, 1366, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997). The specification "provides only a starting point, a direction for further research." *Id.*

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

DENIED

Appeal No. 94-4260
Application 07/849,191

)	
WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
TEDDY S. GRON)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOAN ELLIS)	
Administrative Patent Judge)	

Joseph B. Taphorn
8 Scenic Drive
Hagan Farms
Poughkeepsie, NY 12603-5521