

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIANG C. DONG, MICHAEL H. DEALEY,
TERRY L. BURKOTH, PATRICK S. L. WONG, JERRY D. CHILDERS
and BRIAN L. BARCLAY

Appeal No. 95-2281
Application 07/964,548¹

ON BRIEF

Before WEIFFENBACH, PAK and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claim 40, which is the only claim remaining in the application.

¹ Application for patent filed October 21, 1992. According to appellants the application is a division of Application 07/804,137, filed December 6, 1991, now patent no. 5,200,195, issued April 6, 1993.

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Ayer discloses a dosage form which includes a wall which comprises a semipermeable composition and which defines a compartment (col. 3, lines 23-27 and 31-36), 5 mg to 300 mg of a drug composition in the compartment (col. 4, lines 19-21), a push composition in the compartment for pushing the drug from the dosage form (col. 5, lines 10-17), at least one exit port in the dosage form for delivering the drug from the dosage form (col. 3, lines 19-22 and 27-30), and 0 to 10 mg of hydroxypropylmethylcellulose, which is a hydrophilic polymer (specification, page 17, lines 5-9), in the compartment (col. 4, lines 57-59).

The phrase "means for causing the hydrophilic polymer to precipitate comprising the drug" in appellants' claim is interpreted in light of the corresponding structure, material, or acts described in appellants' specification, and equivalents thereof. See *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(in banc). The means disclosed in appellants' specification for causing the hydrophilic polymer to precipitate are electrolytes and nonelectrolytes which serve as dehydrating agents which lower the critical solution temperature of the hydrophilic polymer (specification, page 10, line 6 - page 11, line 4).

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The examiner points out that Ayer discloses a fluid removable polysaccharide (answer, page 2). Appellants' nonelectrolytes include saccharides (specification, page 10, line 35 - page 11, line 2). However, the polysaccharide in the Ayer dosage form is in the wall and functions in forming the exit means (col. 5, lines 37-43). The examiner has not explained, and it is not apparent, why such a polysaccharide would cause the hydrophilic polymer in the compartment to precipitate.

The examiner argues that Ayer and appellants both use hydroxypropylmethylcellulose, and that one would expect similar ingredients to have similar properties (answer, page 3). The deficiency in this argument is that the examiner has not established that the compositions of Ayer and appellants include similar ingredients, i.e., that they both contain a means for causing the hydrophilic polymer to precipitate.

The examiner points out that Ayer discloses a viscous solution-suspension, and argues that a suspension is suggestive of a precipitation (answer, page 3). This argument is not well taken because the suspension referred to by Ayer is a suspension of the drug caused by the presence of polyethylene oxide having two specified molecular weight ranges (col. 4, lines 30-51). There is no teaching that the hydroxypropylmethylcellulose

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precipitates. Polyethylene oxide is not among the dehydrating agents disclosed by appellants (specification, page 10, line 6 - page 11, line 2), and the examiner has not explained why Ayer's polyethylene oxide would cause precipitation of the hydroxypropylmethylcellulose.

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

DECISION

The rejection of claim 40 under 35 U.S.C. § 103 as being unpatentable over Ayer is reversed.

REVERSED

CAMERON WEIFFENBACH)	
Administrative Patent Judge)	
)	
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)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

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