

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM PENDERGAST, SCOTT H. DICKERSON,
JULIUS V. JOHNSON and ROBERT FERONE

Appeal No. 95-2700
Application 07/956,018¹

HEARD: December 8, 1998

Before DOWNEY, KIMLIN and WALTZ, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 17. Claims 1-16, the other claims remaining in the present application, stand withdrawn from consideration pursuant to a restriction requirement. A copy of claim 17 is appended to

¹Application for patent filed January 13, 1993.

Appeal No. 95-2700
Application 07/956,018

this decision.

Appellants' claimed invention is directed to a process for preparing benzoquinazoline thymidylate synthase inhibitors of the recited formula. According to appellants, compounds within the scope of claim 17 find utility in treating breast and colon tumors.

The examiner relies upon the following references as evidence of obviousness:

Kim	4,814,335	March 21, 1989
-----	-----------	----------------

D.J. Brown, "THE PYRIMIDINES", published 1962 by John Wiley & Sons (N.Y.), pages 31-32 and 44-50.

Appealed claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kim and Brown.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find that the prior art cited by the examiner fails to support a *prima facie* case obviousness for the claimed subject matter. Accord-ingly, we will not sustain the examiner's rejection.

The thrust of the examiner's rejections seems to be that the claimed process would have been obvious to one of ordinary

Appeal No. 95-2700
Application 07/956,018

skill in the art because each of Kim and Brown teaches the formation pyrimidines by reacting "the same-type reactants", i.e., β -ketoesters with amidines or guanidines (page 3 of answer). According to the examiner, even though appellants' reactant is an enol, not a β -keto ester, the enol and keto ester are tautomers that exist in equilibrium with each other, such that the claimed reaction with an enol is tantamount to the prior art reaction with the keto ester. In the words of the examiner, "the form involved in the reaction, would shift the equilibrium to producing more of that form until the entire mixture can be converted to product." (page 6 of answer).

We cannot subscribe to the examiner's reasoning for several reasons. First, the examiner has not established on this record that appellants' reactant (V) exists in tautomeric equilibrium with the corresponding keto ester, at least to a sufficiently significant degree that one of ordinary skill in the art would have been motivated to select the claimed enolic form as a substitute for the corresponding β -keto ester. Secondly, even assuming that one of ordinary skill in the art

Appeal No. 95-2700
Application 07/956,018

would have reasonably expected that appellants' reactant (V) exhibits significant tautomerism, the examiner has failed to present evidence that one of ordinary skill in the art would have

expected such a particular enol to react with guanidines and amidines, and what, if any, would have been the expected product. Stated otherwise, there is no evidence of record how an enol of the type claimed reacts with guanidines and amidines². Further-more, neither of the applied references teaches any process for preparing the claimed products, let alone via a process of reacting an enol and a guanidine or amidine. In the absence of any established motive or desire for one of ordinary skill in the art to make the claimed benzoquinazoline thymidylate synthase inhibitor, we must conclude that the examiner has relied upon impermissible hindsight and speculation to support the conclusion of

²Assuming tautomerism exists between the claimed enol and the S-keto ester, it cannot be presumed that guanidines and amidines would not react preferentially with the enol over the S-keto ester.

Appeal No. 95-2700
Application 07/956,018

obviousness.

While a reaction process may be unpatentable even when both the starting material and the product are not disclosed in the prior art, it is well settled that each case must be decided on its own particular facts. In re Durden, Jr. 763 F.2d 1406, 1410, 226 USPQ 359, 361 (Fed. Cir 1985). Also, no *per se* rule exists that a claimed process is obvious if the examiner, as here, shows that the prior art discloses "the same general process

using "similar" starting materials". In re Ochiai 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995). In the present case, as in Ochiai, we find, for the reasons set forth above, that the examiner has not established the obviousness of the claimed process.

In conclusion, based on the foregoing, we are constrained to reverse the examiner's rejection.

REVERSED

MARY F. DOWNEY

)

Appeal No. 95-2700
Application 07/956,018

Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
EDWARD C. KIMLIN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

vsh

Appeal No. 95-2700
Application 07/956,018

Donald Brown
Dike, Bronstein, Roberts & Cushman
130 Water Street
Boston, MA 02109