

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** JOSEPH A. PICARD, WILLIAM H. ROARK  
and BRUCE D. ROTH

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Appeal No. 95-2879  
Application 08/085,657<sup>1</sup>

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ON BRIEF

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

ELLIS, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of 1, 2, 5 through 8, 10 and 11, the only claims remaining in the application. Claims 3, 4, 9 and 12 have been canceled.

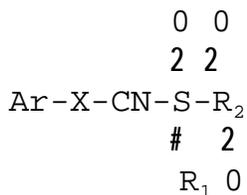
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<sup>1</sup> Application for patent filed July 1, 1993. According to the appellants this application is a continuation of Application 07/776,112, filed October 15, 1991, now U.S. Patent No. 5,254,599, issued October 19, 1993.

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As a preliminary matter, we note the appellants' statement on page 2 of the main Brief, that the claims stand or fall with claim 1. 37 CFR § 1.192(c)(5)(1994); now 37 CFR § 1.192(c)(7). Accordingly, for purposes of this appeal, we will consider the issues as they apply to representative claim 1. Claim 1 reads as follows:

1. A compound of the formula



wherein X is -NH-;

wherein Ar is

(a) phenyl which is substituted by

2, 6 -bis(methylethyl),

2, 4, 6 -trimethoxy, or from one to three substituents selected from:

hydroxy,

nitro,

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-COOH,  
-COOalkyl wherein alkyl has from 1 to 4 carbon atoms and

which is straight or branched, and  
-(CH<sub>2</sub>)<sub>m</sub>NR<sub>3</sub>R<sub>4</sub> wherein m is zero or one, and each R<sub>3</sub> and R<sub>4</sub> is  
hydrogen or a straight or branched alkyl group having 1 to  
4 carbon atoms; or

(b) 1- or 2-naphthyl which is unsubstituted or substituted  
with one to three substituents selected from:  
alkyl having from 1 to 4 carbon atoms and which is straight or  
branched,  
alkoxy having from 1 to 3 carbon atoms and which is straight  
or branched,

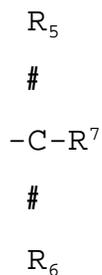
hydroxy,  
fluorine,  
chlorine,  
bromine,  
nitro,  
cyano,  
trifluoromethyl,

-COOH,  
-COOalkyl wherein alkyl has from 1 to 4 carbon atoms and is  
straight or branched,  
-(CH<sub>2</sub>)<sub>m</sub>NR<sub>3</sub>R<sub>4</sub> wherein m, R<sub>3</sub>, and R<sub>4</sub> have the meanings defined  
above;

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wherein  $R_1$  is hydrogen, lower alkyl having from 1 to 4 carbon atoms or benzyl;

wherein  $R_2$  is



wherein each of  $R_5$  and  $R_6$  is hydrogen, methyl or ethyl or  $R_5$  and  $R_6$  together with the carbon atom to which they are attached form

a cyclic group having from 3 to 8 carbon atoms; and  $R_7$  is a straight or branched alkyl group having from 4 to 16 carbon atoms; and pharmaceutically acceptable salts thereof.

The references relied on by the examiner are:

Great Britain (GB `885)	815,885	July 1, 1959
Aumüller et al. (Aumüller) (German Auslegeschrift)	1,075,588	Feb. 18, 1960
McLamore et al. (McLamore)	3,013,072	Dec. 12, 1961



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structurally similar to the compound described in representative claim 1. Answer, p. 4, para. 2. The examiner states that DN '622 and McLamore "show the equivalence of alkyl and phenyl group for the structurally similar compounds." *Id.*, para. 3. The examiner notes that compounds of GB '885 and DN '622 are useful for lowering blood sugar levels. *Id.*, para. 2 and 3. The examiner concludes that

[i]t would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify '885 by introducing phenyl or substituted phenyl group for the alkyl group as taught by NR 93622 [DN '622] and McLamore because the secondary references clearly teach the equivalence of alkyl and aryl groups in the structurally similar compounds, with the reasonable expectation of achieving a successful antidiabetic composition, absent evidence to the contrary [Answer, p. 5, para. 1].

We find this position untenable.

It cannot be gainsaid that the examiner has the burden under § 103 to establish a **prima facie** case of obviousness.

*In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1595, 1598-1600 (Fed. Cir. 1988); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785,

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787-88 (Fed. Cir. 1984). To that end, the examiner must show that some objective teaching or suggestion in the applied prior art, or knowledge generally available in the art, would have led those of ordinary skill to combine the teachings of the references to arrive at the claimed invention. ***Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.***, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996); ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); ***In re Fine, supra; Ashland Oil, Inc. v. Delta Resins & Refractories Inc.***, 776 F.2d 281, 297 n. 24, 227 USPQ 657, 67 n. 24 (Fed. Cir. 1985). It is impermissible for the examiner to use the applicant's specification as an instruction manual or template to piece together the teachings of the prior art. ***In re Dow Chemical Co.***, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Contrary to the examiner's argument, we do not find any teachings in the McLamore reference as to the equivalence of alkyl and phenyl groups, or alkyl and aryl groups. Nor do we find these groups to be adjacent homologs, in the traditional sense of the word, or to be structurally similar. In fact,

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the issue of homologs and structural similarity between the referenced groups has not been raised by the examiner.

Rather,

on this record, we find only assertions and allegations by the examiner that the McLamore reference suggests that alkyl and phenyl (substituted or unsubstituted) groups are equivalent. See, e.g., Answer, sentence bridging pp. 6-7. The examiner has not pointed to any teachings within the patent which support his position or provide any explanation as to why these groups are so similar that it would have been obvious to those of ordinary skill in the art to substitute one for the other in order to arrive at the claimed invention. In addition, we find that the examiner has overlooked the fact that the references must also suggest that the combination of a substituted phenyl and an aliphatic group will result in the compound which is capable of lowering blood sugar levels.<sup>2</sup>

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<sup>2</sup> We note the appellants' arguments throughout the main Brief and Reply Brief that the instant compounds are for reducing cholesterol and, not for reducing blood sugar. We find such arguments to be misguided. It is well established that the motivation to combine references does not have to be identical to that of the patent applicant in order to establish a *prima facie* case of obviousness. *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

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That is, the combined teachings of the references must suggest that a sulfonyl urea which comprises both a substituted phenyl (attached to the -NH) and an aromatic (attached to the SO<sub>2</sub>) would possess the referenced biological property. We find the suggestion for a compound having the claimed limitations only in the appellants' disclosure. Accordingly, we agree with the appellants, that the examiner has relied on impermissible hindsight in making his determination of obviousness. *In re Fritch, supra; Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps"). *W.L. Gore*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that

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which only the inventor taught is used against its teacher"). Since, on this record, the examiner has not provided factual evidence to support his position, we reverse the rejection. A conclusion of obviousness must be based on evidence, not unsupported arguments. *In re Freed*, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Accordingly, the rejection is reversed.

#### ***New Ground of Rejection***

Under the provisions of 37 CFR § 1.196(b), we make the following new ground of rejection.

Claims 1, 2, 5 through 8, 10 and 11 are rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 3 of U.S. Patent 5,254,589 (Picard). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present compound would have been obvious to one of ordinary skill in the art over the method of

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using the same as a pharmaceutical for treating  
arterosclerosis.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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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).

**REVERSED; 37 CFR § 1.196(b)**

	ANDREW H. METZ	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	JOAN ELLIS	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	TERRY J. OWENS	)	
	Administrative Patent Judge	)	

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