

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD D. HANSON, RAMESH N. PATEL and LASZLO J.
SZARKA

Appeal No. 96-0724
Application No. 07/817,232¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and OWENS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134 from the final rejection of claims 1 through 9 and 11 through 18, all of the pending claims. We reverse and remand to the examiner for further consideration consistent with this decision.

¹ Application for patent filed January 6, 1992.

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The subject matter on appeal, in one aspect, is directed to a process for the selective preparation of certain R-enantiomers or S-enantiomers [halophenyl acylates (esters)] of the formula set forth in appealed claim 1 by treating certain substrates (starting reactants) of the formula set forth in appealed claim 1 with an acylating agent and certain microorganisms or enzymes obtained therefrom also as defined by appealed claim 1. In a second aspect of the invention, the acylates obtained through the reaction of the process of appealed claim 1 are hydrolyzed to selectively produce certain R-enantiomers or S-enantiomers (halophenyl alcohols) by a reaction as set forth in appealed claim 2. Products obtained by the reactions are said to be useful as antipsychotic agents or as intermediates in the preparation thereof (specification, page 4, lines 23-26).

Copies of representative appealed claims 1 and 2 are reproduced in an attached appendix.

The references of record relied upon by the examiner are:

March "Advanced Organic Chemistry" Third Edition, John Wiley and Sons, p. 334-336 (1985)

Inagaki et al. (Inagaki) "Kinetic Resolution of Racemic Benzaldehyde Cyanohydrin via Stereoselective Acetylation

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Catalyzed by Lipase in Organic Solvent" Bull Inst. Chem. Res.,
Vol. 67(3), pp. 132-135 (1989)

Nakamura et al. (Nakamura) "Agric. Biol. Chem." Vol. 54(6)
pp. 1569-1570. (1990)

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Nieduzak et al. (Nieduzak) "Multigram Lipase-Catalyzed Enantioselective Acylation in the Synthesis of the Four Stereoisomers of a New Biologically Active "-ARYL-4-PIPERIDINEMETHANOL DERIVATIVE" Tetrahedron: Asymmetry Vol. 2, No. 2, p. 113-122 (1991)

Wong et al. (Wong) EP 0357009 Feb.
1990.

The appealed claims stand rejected for obviousness (35 U.S.C. § 103) over the above cited references. We cannot sustain the stated rejection.

Essentially, it is the examiner's position that one of ordinary skill in this art would have been motivated to combine the teachings of the cited references "for the use of a particular enzyme for the hydrolysis of an ester or esterification of alcohols" because the prior art enzymes "would be similarly useful and applicable to the analogous process for esterification of alcohols and hydrolysis of esters," as claimed (Answer, page 5).

The problem with the examiner's approach to the obviousness determination here is both factual and legal. Although the examiner has cited prior art references which disclose analogous reactants used to produce analogous

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reaction products, carried out by analogous reactions as claimed, no reference is of record which discloses the particular starting reactants or materials (i.e., the claimed substrates), nor has the examiner explained why reference disclosures of "analogous" substrates utilized in the prior art reaction schemes would have provided a suggestion for the use of the claimed substrates.

It is the examiner's legal position that the mere use of different starting materials, whether novel or known, in a conventional process to produce a product one would expect therefrom, does not render the process unobvious. Further, the examiner contends that once prior art has been cited showing a general reaction to be old in the art, the burden is shifted to appellants to present evidence that a different substituent on a substrate would affect the acylation or hydrolysis reaction disclosed in the prior art. For legal support, the examiner relies on, inter alia, In re Durden, 763 F.2d 1406, 1409 226 USPQ 359, 360-361 (Fed. Cir. 1985). However, as set forth in

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In re Ochiai², 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995), no per se rule exist for holding the subject matter of a process claim obvious simply because the prior art references disclose the same general process using "similar" starting materials. Such an approach, according to Ochiai, "side-steps the fact-intensive inquiry" mandated by 35 U.S.C. § 103. Accordingly, absent a disclosure in the prior art of the particular starting substrates (reactants) utilized in appellants' claimed processes, and an explanation of why it would have been obvious to one of ordinary skill in this art to use such starting materials in a process as claimed, the examiner's rejection must be reversed.

This application is remanded to the examiner to reconsider the obviousness of the claimed invention in view of the present record and U.S. Patent No. 4,605,655 issued to Yevich on August 2, 1986 and U.S. Patent No. 4,994,460 issued to Dextraze on February 19, 1991. The latter patents are cited in appellants' specification as disclosing reaction products,

² The examiner's answer was written prior to the Ochiai decision.

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as claimed by them, which are useful antipsychotic agents or intermediates used in the preparation thereof. See the specification at page 4, lines 23-26. Given the fact that the reaction products produced by the claimed processes herein are known in the art, the examiner should determine whether or not it would have been obvious to synthesize such products utilizing reaction schemes as claimed. As a part of the examiner's analysis, the examiner should factually determine whether or not the claimed starting substrates defined by appealed claimed 1 are known or are obvious prior art materials, consistent with the court's analysis in Ochiai.

In summary, the examiner's stated rejection of the appealed claims is reversed, and this application is remanded to the examiner for further consideration consistent with the above remarks.

REVERSED AND REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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| |) | BOARD OF PATENT |
| JOHN D. SMITH |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| TERRY J. OWENS |) |) |
| Administrative Patent Judge |) | |

jrg

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Serial No. 07/816,232

Judge JOHN D. SMITH

Judge KIMLIN

Judge OWENS

Received: 06 JAN 99

Typed: 07 JAN 99

DECISION:

REVERSAL/REMANDED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1202

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

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