

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DER-YANG LEE and CHIH-MING CHEN

Appeal No. 1997-2236
Application 08/341,478¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, Administrative Patent Judges, and McKELVEY, Senior Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-6, all of the claims in the application.

¹ Application for patent filed November 17, 1994.

Claim 1 is representative of subject matter on appeal and reads as follows:

1. A delayed-pulse controlled release pharmaceutical tablet which comprises:
 - (a) from 20 to 60 wt. % of a low molecular weight hydroxypropyl cellulose having a number average molecular weight of 70,000 to 90,000;
 - (b) from 4 to 10 wt. % of a high molecular weight hydroxypropyl cellulose having a number average molecular weight of 1,100,000 to 1,200,000;
 - (c) a pharmacologically acceptable amount of a medicament; and
 - (d) an inert solid diluent.

The references relied upon by examiner are:

Schor et al. (Schor '172)	4,369,172	Jan. 18, 1983
Schor et al. (Schor '393)	4,389,393	Jun. 21, 1983
Edgren et al. (Edgren)	4,871,548	Oct. 3, 1989
Lui	5,009,895	Apr. 23, 1991

Claims 1-6 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Schor '172, Schor '393, Edgren or Lui. We reverse.

DISCUSSION

All of claims on appeal require, inter alia, a low molecular weight hydroxypropyl cellulose and a high molecular weight hydroxypropyl cellulose. As explained in the statement of the rejection on pages 3-4 of the examiner's answer, each of the references relied upon by the examiner describes the use of hydroxypropylmethyl cellulose, not hydroxypropyl cellulose. These compounds are separate and distinct entities. The

statement of the rejection on pages 2-4 of the answer does not explain why one of ordinary skill in the art would have found it obvious to use hydroxypropyl cellulose, as required by claims on appeal, instead of the hydroxypropylmethyl cellulose used in each of the references. Indeed, the only acknowledgment which appears in the examiner's answer that the references are directed to a different compound than that required by the claims on appeal appears in the sentence bridging pages 4-5 wherein the examiner states "[t]here is no evidence of record that delivery of a pharmaceutical compound from a formulation comprising [hydroxypropyl cellulose] is substantially different, superior or unexpected from a formulation which comprising [hydroxypropylmethyl cellulose]."

By the terms of the statute, the determination of obviousness under 35 U.S.C. § 103 must be premised upon the "subject matter as a whole" of a given claim. Here, the evidence of obviousness relied upon by the examiner is directed to the use of hydroxypropylmethyl cellulose, not hydroxypropyl cellulose as required by the claims on appeal. Clearly, the examiner has not considered the subject matter as a whole in determining the obviousness of the subject matter of the claims on appeal. It is well established that the initial burden of establishing reasons of unpatentability rests on the examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Here, the examiner put the cart before the horse in requiring that appellants establish that using hydroxypropyl cellulose in the claimed invention results in a "different, superior or

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unexpected" formulation than one which comprises hydroxypropylmethyl cellulose. The examiner's conclusion of obviousness is clearly in error.

The decision of the examiner is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	
WILLIAM F. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
FRED E. McKELVEY)	
Senior Administrative Patent Judge)	

wfs/ki

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