

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 MARTIN COLE, THOMAS T. HOWARTH
and CHRISTOPHER READING

Appeal No. 98-1486
Application 08/417,628¹

HEARD: MAY 3, 1999

Before GARRIS, OWENS and LIEBERMAN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed April 6, 1995. According to appellants, the application is a continuation of Application 07/749,482, filed August 15, 1991, which is a continuation of Application 07/210,339, filed June 23, 1988, now abandoned, which is a continuation of Application 05/569,007, filed April 17, 1975, now abandoned.

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This is an appeal from the examiner's final rejection of claims 35 and 36, which are all of the claims remaining in the application.

THE INVENTION

Appellants' claimed invention is directed toward solid pharmaceutically acceptable salts of clavulanic acid. Appellants state that salts of clavulanic acid enhance the effectiveness of β -lactam antibiotics against many β -lactamase producing bacteria (specification, page 1, lines 5-7). Claim 35 is illustrative and reads as follows:

35. A solid pharmaceutically acceptable salt of clavulanic acid.

THE REFERENCE

Eli Lilly & Co. (Lilly) 1,315,177 Apr. 26,
1973

THE REJECTIONS

Claims 35 and 36 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 37 and 41 of copending Application 08/418,055 and over claims 36, 37 and 41-45 of copending

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Application 08/417,625. Claims 35 and 36 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Lilly.

OPINION

Appellants do not challenge the provisional obviousness-type double patenting rejections. We therefore summarily affirm these rejections. As for the rejection under 35 U.S.C. § 103, we have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that this rejection is not well founded. We therefore do not sustain the rejection under 35 U.S.C. § 103.

The examiner argues that because clavulanates were known to be antibiotics, it would have been obvious to one of ordinary skill in the art to use them in conventional form for administration (answer, page 4). This argument is not convincing because the examiner has not established that clavulanates were known in the art to be among Lilly's "other antibiotic substances" or to have any other use. Thus, it is not apparent why one of ordinary skill in the art would have

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been motivated to isolate them in solid form. The record indicates that the motivation relied upon by the examiner comes solely from appellants' specification. Hence, the examiner used

impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

Appellants argue that any clavulanic acid present in Lilly's fermentation broth would have been in solution and not in solid or crystalline form (brief, page 23). The examiner has not responded to appellants' argument, and it is not apparent from the record why any salts of clavulanic acid which are present in Lilly's fermentation broth would be in solid or crystalline form.

For the above reasons, we do not sustain the examiner's

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rejection under 35 U.S.C. § 103.

DECISION ON APPEAL

The provisional rejections of claims 35 and 36 under the judicially-created doctrine of obviousness-type double patenting over claims 37 and 41 of copending Application 08/418,055 and over claims 36, 37 and 41-45 of copending Application 08/417,625 are affirmed. The rejection of claims 35 and 36 under 35 U.S.C. § 103 over Lilly is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)
Administrative Patent Judge)
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TERRY J. OWENS) BOARD OF

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PATENT

Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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PAUL LIEBERMAN)	
Administrative Patent Judge)	

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