

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN K. THOTTATHIL,
IVAN D. TRIFUNOVICH,
DAVID J. KUCERA, and
WEN-SEN LI

Appeal No. 1999-0462
Application No. 08/440,291

ON BRIEF

Before WINTERS, ROBINSON, and MILLS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

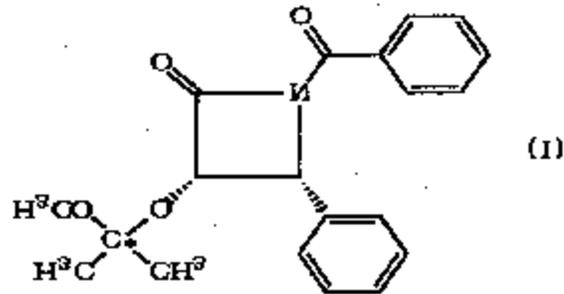
This appeal was taken from the examiner's decision rejecting claims 8, 10 through 16, 18, and 24 through 31, which are all of the claims remaining in the application.

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Representative Claim

Claim 8, which is illustrative of the subject matter on appeal, reads as follows:

with a taxane component of the following formula X:



wherein:

R₁ is (3R-cis)-1-phenylethyl-2-(1-phenylethyl-1-phenylethoxy)-3-phenylethyl-5-
 containing the acid of containing a 3-phenyl of the following formula I'

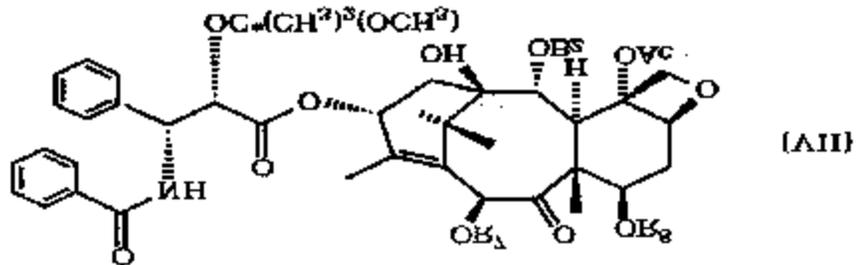
R₂ is hydrogen or a hydroxyl protecting group;

R₃ is hydrogen, alkyl, aryl, or a hydroxyl protecting group; and

Ac is acetyl;

R₄ is benzyl;

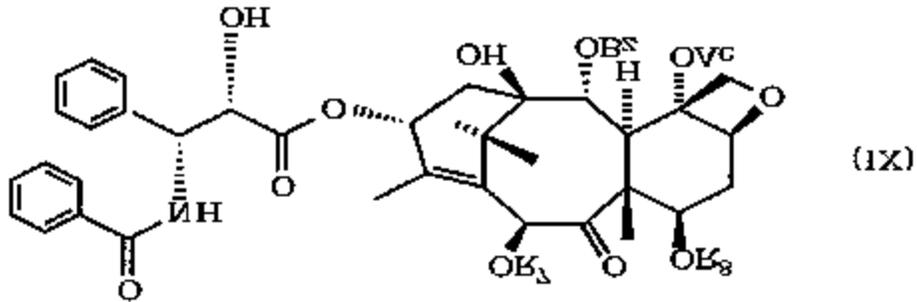
where the carbon atom marked with an asterisk is non-stereocenter;



following formula AII or a salt thereof:

8. A method for the preparation of a substituted-phenyl taxane of the

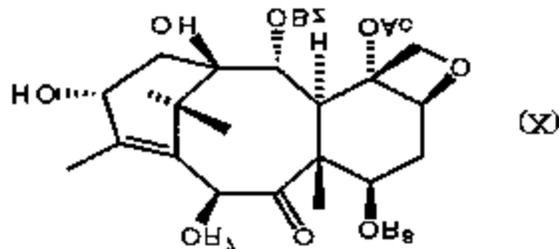
where B_1 , B_2 , B_3 and B_4 are as defined above:



and therefore of the following formula IX:

the formula XII to react with a steroidal compound and a diene-derivative having a group $-OC^*(CH^B_1)^3(OCH^B_2)$ of said compound of a suitable agent; and

where B_1 , B_2 , B_3 and B_4 are as defined above, or said thereof in the presence of



The References

In setting forth the prior art rejection under 35 U.S.C. § 103, the examiner relies on the following references:

Holton

5,175,315

Dec. 29, 1992

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Ross et al. (Ross)

4,526,718

Jul. 2, 1985

The Issue

The issue presented for review is whether the examiner erred in rejecting claims 8, 10 through 16, 18, and 24 through 31 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Holton and Ross.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief; (3) the Examiner's Answer; and (4) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 103.

Discussion

Initially, we agree with appellants that the reaction described by Ross in column 12, lines 27 through 54, bears little relationship to the instantly claimed method (Appeal Brief, page 11). In our judgment, Ross is singularly unhelpful in resolving the question of obviousness under 35 U.S.C. § 103, and we shall not refer to this reference further.

It would appear that the Holton reference, alone, does not constitute sufficient evidence to support a conclusion of obviousness of the claimed invention. Holton does not disclose or suggest a β -lactam starting material having a 1-methyl-1-methoxyethoxy group at the 3 position. Nor does Holton disclose or suggest a sidechain-bearing taxane of formula (VII) having a 1-methyl-1-methoxyethoxy group at the 20 position on the C-13 sidechain. In this regard, the examiner would apparently bring in Greene through the "back door."¹ The examiner does not set forth Greene in the statement of rejection under 35 U.S.C. § 103 but, nevertheless, refers to this reference in the Examiner's Answer, pages 2 and 3. According to the examiner, Greene establishes that appellants' 1-methyl-1-methoxyethyl group is "a well known and conventional hydroxy protecting group." (Examiner's Answer, page 3, last paragraph).

On the particular facts of this case, we find it unnecessary to decide whether the examiner erred in not setting forth Greene in the statement of rejection under 35 U.S.C. § 103. See, In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970) (Where a reference is relied on to support a rejection, whether or not in a "minor capacity," there would appear to be no excuse for not positively including the reference in the statement of the rejection.) Nor shall we pass on the question of prima facie obviousness. For the purposes of this appeal, we shall assume arguendo, without deciding, that the

¹ Greene et al. (Greene), "Protective Groups in Organic Synthesis," 2d ed., pp. 10-12 (John Wiley & Sons, Inc., 1991)

appealed claims would have been prima facie obvious over prior art cited by the examiner. We agree with appellants that uncontroverted evidence of record is sufficient to rebut any such prima facie case.

The “most preferred” hydroxy protecting group described by Holton, 1-ethoxyethyl, contains an asymmetric carbon. In contrast, appellants’ 1-methyl-1-methoxyethyl group at the 3-position of lactam (I) and at the 20 position on the C-13 sidechain of taxane (VII), contains a non-asymmetric carbon. Further, the starting β -lactam of the present claims is a solid prepared in crystalline form in contrast with the “most preferred” ethoxyethyl compound of Holton described as a liquid or “colorless oil” at column 15, lines 37 through 39. Those facts are not controverted by the examiner, nor is the argument, predicated on those facts, that the instantly claimed method gives rise to unexpectedly superior results compared with the closest prior art. (Appeal Brief, pages 7 through 10).²

In conclusion, assuming arguendo that claims 8, 10 through 16, 18, and 24 through 31 would have been prima facie obvious over the cited prior art, we agree with appellants that uncontroverted evidence of record serves to rebut any such prima facie case.

² As stated in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986), if a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. Here, the examiner’s failure to reweigh the prima facie case of obviousness in light of appellant’s rebuttal argument constitutes reversible error.

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For these reasons, the examiner's rejection of the appealed claims under 35
U.S.C. § 103 as unpatentable over the combined disclosures of Holton and Ross is
reversed.

REVERSED

Sherman D. Winters)
Administrative Patent Judge)
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)
) BOARD OF PATENT
Douglas W. Robinson)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
)
Demetra J. Mills)
Administrative Patent Judge)

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