

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD B. SILVERMAN,
RYSZARD ANDURSZKIEWICZ,
PO-WAI YUEN,
DENIS M. SOBIERAY,
LLOYD C. FRANKLIN,
and MARK A. ACHWINDT

Appeal No. 1999-1437
Application No. 08/732,065

ON BRIEF

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

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claim 38, which is the only claim pending in the application.

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The appealed claim reads as follows:

38¹. An isolated individual enantiomeric isomer of the formula (S)-2-(2-methylpropyl)-1,4-butanedioic acid, 4-(1,1-dimethylethyl)ester.

The reference relied upon by the examiner is:

Handa	4,996,358	Feb. 26, 1991
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Ground of Rejection

Claim 38 stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies on Handa.

We reverse for reasons set forth herein.

Discussion

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims and to the respective positions articulated by the appellants and the examiner. We make reference to the Examiner's Answer of September 4, 1998 (Paper No. 17) for the examiner's reasoning in support of the rejections and to the appellants' Appeal Brief, filed May 14, 1998 (Paper No. 15), and Reply Brief, filed November 9, 1998 (Paper No. 18), for the appellants' arguments thereagainst.

Background

¹ Claim 38 was amended in a Response filed December 29, 1997 (Paper No. 11) which the examiner indicated would be entered (Paper No. 12) upon the filing of a Notice of Appeal. That amendment has not been officially entered into the record of the application.

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Claim 38 is directed to the isolated enantiomeric S-isomer of the formula (S)-2-(2-methylpropyl)-1,4-butanedioic acid, 4-(1,1-dimethylethyl)ester. It would appear that the applicants added the terminology "isolated" in order to distinguish the presently claimed compound from a mixture which would possibly include other isomeric forms. (Applicants' Response of December 29, 1997, page 3). Thus, we understand it to be appellants' intent to limit the claimed subject matter to the isolated isomeric form of the butanedioic acid ester of claim 38. This compound is disclosed as being an intermediate useful in the preparation of certain amine derivatives which are disclosed as being useful in the treatment of certain seizure disorders. (Specification, Chart II, compound 105 at page 47 and pages 4-5).

The rejection under 35 U.S.C. § 103

The examiner's rejection of claim 38 depends, solely, on the teachings of Handa.

The examiner relies on Handa as disclosing (Answer, page 3):

the compound 4-tert butyl hydrogen 2(RS)-isbutylsuccinate [sic] (note line 4 of column 12) which is the racemic mixture containing the instantly claimed compound. The reference also generically teaches the claimed compounds, [sic] note the compounds of formula III of column 6 and note lines 36-49 of column 3.

The examiner acknowledges that "[t]he reference does not specifically exemplify the instant compound." (Id.) However, the examiner urges that (Answer, sentence bridging

pages 3-4):

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the generic teaching indicates to one of ordinary skill in the art that species falling within the generic disclosure, including the instantly claimed compound, would possess the prior art use. It is well within the skill of the artisan to select among the alternatives of the references to afford compounds possessing the prior art use, . . . (Citation omitted.).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicants. Id. In order to meet that burden the examiner must provide a reason, based on the prior art, or knowledge generally available in the art as to why it would have been obvious to one of ordinary skill in the art to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, n.24, 227 USPQ 657, 667, n.24 (Fed. Cir.), cert. denied, 475 U.S. 1017 (1986).

On the record before us, the examiner has not met the initial burden of establishing why the prior art, relied on, would have led one of ordinary skill in this art to arrive at the specific stereo isomer presently claimed. While acknowledging that "the Handa et al. reference discloses a racemic compound 4-tert.butyl hydrogen 2(RS) - isobutylsuccinate . . .," appellants urge that Handa (Brief, page 12):

does not disclose [the] individual enantiomeric isomer[] claimed herein, nor does it suggest a separation of a racemic mixture to obtain the present invention as claimed.

We agree. What is missing from the examiner's statements and evidence in support of the rejection of the claim on appeal is a teaching or suggestion to be found in the prior art which would have reasonably led those of ordinary skill in this art to the claimed invention. Handa discloses a racemic mixture of an isobutylsuccinate which corresponds to the claimed butanedioic ester of the claim and is also an intermediate in the preparation of a final product. However, this final product is not the same as that disclosed in the present application. The racemic mixture of isobutylsuccinate is disclosed as being an intermediate in the preparation of certain hydroxylamine bearing amino acids which are disclosed as useful as collagenase inhibitors. The examiner urges that Example 13 part (E) and (F) disclose the (R)-isomer of the claimed compound and "[o]ne would clearly be motivated to prepare and use the optically active isomers of 4-tert.butyl hydrogen 2-isobutylsuccinate to obtain the products having the same optically active center." However, the (R)-isomer disclosed in Example 13 is not derived by isolating it from a racemic mixture, which might suggest the existence of the S-isomer isolated from the (R)-isomer. The (R)-isomer is synthesized in a process wherein the starting material is an (R)-isomer. (Column 15, lines 33-34). Further, the examiner has pointed to nothing in Handa which would suggest the need or desire to produce any product which would require the presence or use of an isolated (S)-isomer of the compound in question.

Thus, the examiner has pointed to no facts or provided any substantive evidence which would have directed or led one of ordinary skill in this art to isolate this particular S-

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isomer from the racemic mixture described by Handa. Further, the examiner has offered nothing which would establish that the reference is enabling for a process which would yield the isolated S-isomer in question. See In re Hoeksema, 399 F. 2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). Thus, the examiner has fail to establish that one of ordinary skill would have been led to modify the explicit teaching of the reference in a manner to arrive at the claimed invention since the prior art does not suggest the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In re Fritch, 972 F.2d 1260, 1266, n.14, 23 USPQ2d 1780, 1783-84, n.14 (Fed. Cir. 1982). In the absence of such evidence, the only suggestion to isolate the (S)-isomer for use in appellants' process is provided by appellants' disclosure of the invention. However, use of this information as a basis for establishing a prima facie case of obviousness, within the meaning of 35 U.S.C. § 103, would constitute impermissible hindsight. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modifications required. That knowledge can not come from the applicant's invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Thus, on this record, the examiner has not provided those facts or evidence which would reasonably support a conclusion that the claimed subject matter would have been prima facie obvious within the meaning of 35 U.S.C. § 103. Where the examiner fails to

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establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). Therefore, the rejection of claim 38 under 35 U.S.C. § 103 is reversed.

Summary

The rejection of claim 38 under 35 U.S.C. § 103 as unpatentable over the teachings of Handa is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. SMITH)	
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