

From: [redacted email address] **On Behalf Of** Gene Quinn
Sent: Saturday, February 26, 2011 6:44 PM
To: KSR_Guidance
Subject: Example 4.12 teaching point

The first sentence of the teaching point reads: "It is not necessary to select a single compound as a "lead compound" in order to support an obviousness rejection." The last paragraph of the text relative to Example 4.12 explains: "It should be noted that the lead compound cases do not stand for the proposition that identification of a single lead compound is necessary in every obviousness rejection of a chemical compound."

While it may or may not be true that the lead compound cases do not require the identification of a single lead compound, this is not found anywhere in P&G v. Teva, which is the case that lends the teaching point for Example 4.12. In P&G v. Teva the Federal Circuit explained: "The trial court disagreed and concluded from the evidence that a person of ordinary skill in the art would not have identified 2-pyr EHDP as a lead compound for the treatment of osteoporosis. We need not reach this question because we conclude that even if 2-pyr EHDP was a lead compound, the evidence does not establish that it would have been obvious to a person of ordinary skill at the time of the invention to modify 2-pyr EHDP to create risedronate."

Thus, P&G v. Teva never addresses the question of lead compounds and it seems inappropriate to insert a teaching point into a case that has nothing to do with the point being taught. It would be more helpful to explain why, using cases addressing lead compounds, why a single lead compound need not be identified.

-Gene

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Eugene R. Quinn, Jr.
US Patent Attorney (Reg. No. 44,294)
Office: 703-740-9835
Direct: 703-999-1130
Firm: <http://legalteamusa.com/>
Blog: <http://www.IPWatchdog.com>
LinkedIn: <http://www.linkedin.com/in/ipwatchdog>
Twitter: <http://twitter.com/ipwatchdog>

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