

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAZIEL LURIE

Appeal No. 2000-1751
Application 08/530,264

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

1. Representative Claim

Claim 6 is representative of the subject matter on appeal and reads as follows:

6. Method for the treatment of androgenetic alopecia, which comprises administering to a human in need of said treatment, an effective amount of relaxin.

2. Improper Examiner's Answer

The claims on appeal stand rejected under 35 U.S.C. § 112, first paragraph (enablement). The examiner states at page 2 of the Examiner's Answer that the claims are rejected for the reasons "given in Papers Nos. 9 and 13." Manifestly, the statement of rejection is improper.

As set forth in the Manual of Patent Examining Procedure (MPEP) § 1208, an examiner may only incorporate in the answer a statement of a ground of rejection by reference to a single previous Office action, stating that the answer "should not refer, either directly or indirectly to more than one prior Office action."

3. Enablement Issue

In an attempt to understand the examiner's position, we have reviewed Paper No. 9 where the rejection originated. In relevant part, the only reason given by the examiner is that "no enablement is seen for the highly incredible method of use of 'prevention' [sic] ... androgenetic alopecia." No further facts or reasons are supplied in support of that conclusion.

"By now it is well settled that the examiner bears the initial burden of providing reasons why a supporting disclosure does not enable a claim." In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Merely stating that a claim is directed to a so-called incredible use does not discharge the examiner's burden of providing facts and reasons as to why the specification does not enable the claim.

Upon return of the application, the examiner should take a step back and review the merits of the matter using the proper legal standards.

4. Other Documents

We draw the examiner's attention to US Patent No. 5,811,395 (Schwabe) and US Patent No. 6,075,005 (Lurie). Each patent claims the use of relaxin and/or a relaxin analog to treat hair loss or androgenetic alopecia. While neither patent appears to be prior art to the claims on appeal, they provide evidence that at some point in time, the USPTO determined that use of relaxin and/or relaxin analogs to treat hair loss or androgenetic alopecia is not an incredible utility. In considering these documents, the examiner should also take into account that Lurie appears to be issued to the present applicant. As such, double patenting issues may arise.

5. Appeal Conference

We note that the record does not reflect that this application was subject to an appeal conference prior to forwarding the case to the board. We understand that it is now the policy of the USPTO to conduct an appeal conference prior to forwarding a case to the board. Upon return of the application, if the examiner believes that the claims on appeal are unpatentable, we believe it would be helpful if an appeal conference is convened.

6. Future Proceedings

We state that we are not authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1).

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Bruce H. Stoner, Jr., Chief
Administrative Patent Judge

Gary V. Harkcom, Vice Chief
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

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