

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK BEHR, ALEXANDRE KUPFERBERG,
MARCEL MERSEL, and ALAIN PRIVAT

Appeal No. 2000-2007
Application 09/063,784

HEARD:
January 8, 2002

Before WINTERS, WILLIAM F. SMITH, and GRIMES Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 22, 23, 25-28, 30-32, 34-37, and 39. Claims 24, 29, 33 and 38 are pending and have been indicated to be free of rejection by the examiner. These are the only claims remaining in the application. Claims 22, 23, 31 and 32 are representative of the subject matter on appeal and read as follows:

22. Pharmaceutical composition comprising a therapeutically effective amount of a drug of at least one C3 monoester of 7 β -hydroxycholesterol selected from the group consisting of the palmitate, oleate, hexenoate, decenoate and arachidonate,

incorporated into a liposome and/or combined with a phospholipid and/or a ganglioside, and a pharmaceutically acceptable vehicle.

23. A method of using a pharmaceutical composition according to claim 22, said pharmaceutical composition having a cytotoxic activity, comprising administering the composition to mammals over a period of time for the treatment of disease involving cells having a high proliferative potential.

31. Pharmaceutical composition comprising a therapeutically effective amount of a drug of a least one C3-OH ether of 7 β -hydroxycholesterol selected from the group consisting of ethers of palmitic, oleic, hexenoic, decenoic and arachidonic acid, incorporated into a liposome and/or combined with a phospholipid and/or a ganglioside, and a pharmaceutically acceptable vehicle.

32. A method of using a pharmaceutical composition according to claim 31, said pharmaceutical composition having a cytotoxic activity, comprising administering the composition to mammals over a period of time for the treatment of diseases involving cells having a high proliferative potential.

The reference relied upon by the examiner is:¹

Kupferberg et al. (Kupferberg), "Effect of 7 β -hydroxycholesterol on astrocyte primary cultures and derived spontaneously transformed cell lines: cytotoxicity and metabolism." Biochimica et Biophysica Acta, 1013, pp 231-238 (1989)

Claims 22, 23, 25-28 and 30 stand rejected under 35 U.S.C. § 102(b) as anticipated by Kupferberg and claims 31, 32 34,35, 36, 37, 39 stand rejected under 35 U.S.C. § 103(a) as obvious over Kupferberg. We reverse.

DISCUSSION

Both rejections can be quickly decided. All claims on appeal require that the active agent be "incorporated into a liposome and/or combined with a phospholipid and/or a ganglioside." Nowhere in the Examiner's Answer does the examiner point out

¹ The examiner discusses a reference identified as McMurry in the paragraph bridging pages 4-5 of the Examiner's Answer. As stated in In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970) "[w]here 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." Accordingly, we have not considered McMurry in deciding the issues presented in this appeal.

where Kupferberg teaches or suggests incorporating the metabolite described in that reference into a liposome or combining the metabolite with a phospholipid or a ganglioside as required by the claims on appeal.

Where as here, the examiner's consideration of the patentability of the claims is based upon less than the subject matter of the claims as a whole, the examiner's rejections are legally in error and cannot be sustained.

The decision of the examiner is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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