

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 PATRICK S.L. WONG,
FELIX THEEUWES,
ATUL D. AYER,
and ANTHONY L. KUCZYNSKI

Appeal No. 94-1982
Application 07/862,665¹

ON BRIEF

Before SCHAFER, Vice Chief Administrative Patent Judge, and William F. Smith and Gron, , Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ Application for patent filed April 1, 1992. According to appellants, the application is a continuation of Application 07/576,042, filed August 31, 1990, now Patent No. 5,156,850.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 18 through 25, all the claims in the application.

Claim 21 is illustrative of the subject matter on appeal and reads as follows:

21. A method for administering a drug to the gastrointestinal tract of a warm-blooded animal, which method comprises:

(a) admitting an osmotic device into the gastrointestinal tract of the warm-blooded animal, said device comprising:

(1) a compartment;

(2) a wall that surrounds and forms the compartment, said wall comprising a composition that is permeable to the passage of fluid;

(3) a first composition in the compartment, said first composition drug-free for producing a drug-free interval prior to the administration of drug from the compartment;

(4) a second composition in the compartment comprising a dose amount of a drug for producing a therapeutic effect, said drug a member selected from the group consisting of drugs that act on peripheral nerves, adrenergic receptors, cholinergic receptors, nervous system, skeletal muscles, cardiovascular system, smooth muscles, blood circulatory system, synaptic sites, neuroeffector junctional sites, endocrine system, hormone systems, immunological system, reproductive system, skeletal system, autocoid systems, alimentary systems, excretory systems, inhibitory of autocoid systems, inhibitory of aptitudes and histamine systems of the warm-blooded animal;

(5) a third composition in the compartment that expands in the presence of fluid that enters the device; and

(6) exit means in the wall for connecting the exterior of the device with the compartment;

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(b) imbibing fluid into the compartment thereby causing the third composition to expand and push against the second composition; and

(c) administering the second composition comprising the drug after the first drug-free composition is released from the device.

The reference relied upon by the examiner is:
Wong et al. (Wong) 4,783,337 Nov. 8, 1988

The statement of the rejection which appears at pages 2-3 of the Examiner's Answer does not identify the claims, statutory basis, or references relied upon in rejecting the claims on appeal. We will assume on the basis of page 3 of the Final Rejection that the examiner intended to reject claims 18 through 25 under 35 U.S.C. § 103 as unpatentable over Wong. We reverse this rejection.

As a final requirement, all of the claims on appeal require either (1) "administering a second composition comprising the drug after the first drug-free composition is released from the device," e.g., claim 21, or (2) "administering the dose of drugs from the drug composition after at least some of the first drug-free composition is released from the compartment," e.g., claim 23. The examiner's rejection simply fails to come to grips with this aspect of the claimed invention. In relevant part the examiner states at pages 3-4 of the Examiner's Answer:

Wong does not specifically describe a method for delaying delivery of a drug, followed by delivery of the drug. However, it is the position of the Examiner that the Wong device actually is a delayed drug delivery device,

given that, after ingestion of the device, there is a time delay of drug delivery while the osmopolymer imbibes fluid. There is no drug delivery until this occurs. The desirability of having such a 'delay' is alluded to by Wong in reciting that the osmotic device can deliver active agent a controlled rate and for a particular time period (column 3, lines 58-64).

It is not apparent on what basis the examiner has determined that Wong administers a second composition which comprises the drug after the first drug-free composition is at least partially released from the compartment as required by the claims on appeal.

The decision of the examiner is reversed.²

REVERSED

Richard E. Schafer, Vice Chief Administrative Patent Judge))))))	
William F. Smith Administrative Patent Judge)))))	BOARD OF PATENT APPEALS AND INTERFERENCES
Teddy S. Gron Administrative Patent Judge)))	

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² We note in passing that claim 19 appears to be an improper dependent claim. Claim 19 purports to "replace" the drug of claim 18 with a new drug. If appellants truly intend to "replace" the drug of 18 with a second new drug, then claim 19 does not further limit claim 18 as required by the statute.

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Palo Alto, CA 94303-0802