

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANICA MARKOVAC, RICHARD L. KALAMAS  
and MAURICE P. LAMONTAGNE

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Appeal No. 95-4439  
Application No. 08/063,652<sup>1</sup>

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ON BRIEF

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Before WINTERS, HANLON and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed May 20, 1993. According to appellants, this application is a division of Application No. 07/910,498, filed July 8, 1992, now abandoned.

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This appeal was taken from the examiner's decision rejecting claim 18, which is the only claim remaining in the application.

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The appealed claim reads as follows:

-18-

2-Fluoro-9-trimethylsilyladenine.

The references relied on by the examiner are:

Blumbergs et al. (Blumbergs)	5,110,919	May 5, 1992
Kim et al. (Kim) (Japanese Kokai patent application)	2-138184	May 28, 1990

Calley N. Eaton et al. (Eaton), "Convenient Synthesis of 2-Fluoroadenine," 34 Journal of Organic Chemistry no. 3, 747-48 (Mar. 1969)

The issue presented for review is whether the examiner erred in rejecting claim 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kim, Eaton and Blumbergs.

#### DISCUSSION

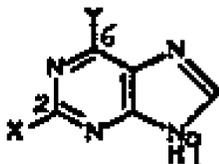
On consideration of the record, including the Examiner's Answer (Paper No. 16) and appellants' "RESPONSE TO NEW GROUND OF REJECTION UNDER 37 CFR 1.193(b)" (Paper No. 18), we reverse the rejection under 35 U.S.C. § 103.

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In setting forth this rejection, the examiner begins with purine compounds (II) disclosed by Kim where Y is an amino group at the 6-position of the ring system and X is hydrogen, amino, or

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mercapto at the 2-position (Kim, English translation, pages 3 and 4).



( II )

The examiner next refers to Kim's trimethylsilylation reaction, where the above-described purine compounds are reacted with hexamethyl disilazane (HMDS) to attach a trimethylsilyl group at the 9-position (Kim, English translation, page 7). As pointed out by the examiner, Kim's trimethylsilyl products differ from the compound of claim 18 because the trimethylsilyl products have hydrogen, amino, or mercapto at the 2-position of the ring system, whereas as the claimed compound has fluorine at the 2-position. The examiner argues that a person having ordinary skill in the art, armed with the disclosures of Eaton and Blumbergs, would have found it obvious to modify the trimethylsilyl products of Kim by replacing hydrogen, amino, or mercapto at the 2-position with fluorine. Therefore, the

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examiner argues, a person having ordinary skill in the art would have arrived at the subject matter sought to be patented in claim 18 in view of the combined disclosures of Kim, Eaton, and Blumbergs. We disagree.

We have no doubt that the prior art could be modified in the manner proposed by the examiner. This can be seen from a review of appellants' specification. The mere fact that the prior art could be so modified, however, would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). On the facts presented, we disagree that there is adequate reason, suggestion, or motivation stemming from the prior art which would have led a person having ordinary skill from "here to there," i.e., from the 2-(hydrogen, amino, or mercapto) products of Kim to the 2-fluoro compound of claim 18.

The Eaton reference, cited in appellants' specification at page 7, lines 7 and 8, discloses a convenient synthesis of 2-fluoroadenine. Blumbergs discloses an 8-step reaction sequence for preparing 2-fluoro-ara-AMP (fludarabine phosphate). See particularly column 2, line 45 through column

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4, line 45 of Blumbergs, illustrating the 8-step sequence. In our judgment, the examiner has impermissibly engaged in a hindsight reconstruction of the claimed invention, using appellants' specification as a blueprint or guide and selecting elements from these disparate references in a piecemeal manner. This the examiner cannot do. See In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). We believe that the proposed modification of Kim's trimethylsilyl products, by replacing 2-(hydrogen, amino, or mercapto) with the 2-fluoro group taught by Eaton or Blumbergs, constitutes the impermissible use of hindsight.

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
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ADRIENE LEPIANE HANLON	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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HUBERT C. LORIN )  
Administrative Patent Judge )

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