

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD WON,
MARTIN A. KATZ,
CHUNG H. CHENG,
and SERGIO NACHT

Appeal No. 95-5076
Application 08/079,220¹

ON BRIEF

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

¹ Application for patent filed June 17, 1993. According to appellants, the application is a continuation of application serial no. 07/802,664, filed December 5, 1991; which was a continuation-in-part of application serial no. 07/644,869, filed January 23, 1991, now U.S. Patent No. 5,145,675; which was a continuation of application serial no. 07/334,051, filed April 5, 1989; which was a division of application serial no. 07/091,641, filed August 31, 1987; which was a continuation-in-part of application serial no. 06/810,478, filed December 18, 1985; serial no. 06/846,321, filed March 31, 1986; serial no. 06/896,956, filed August 15, 1986; serial no. 06/925,081, filed October 30, 1986; serial no. 06/925,082, filed October 30, 1986; serial no. 06/932,613, filed November 11, 1986; serial no. 06/933,243, filed November 21, 1986; serial no. 06/936,520, filed December 1, 1986; and serial no. 06/940,754, filed December 10, 1986.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 3, 5, 7 through 12, and 14 through 20, all the claims pending in the application.

Claims 1 and 12 are illustrative of the subject matter on appeal and read as follows:

1. A topical composition comprising solid particles containing a continuous noncollapsible network of pores open to the exterior of said particles, wherein said beads [sic, particles] are composed of a copolymer consisting of cross-linked monoethylenically unsaturated monomers and polyethylenically unsaturated monomers having a cross-linking density from 20% to 80% and are spherical in shape and have an average diameter of about one micron to about 100 microns, have a total pore volume of about 0.01 cc/g to about 4.0 cc/g, have a surface area of about 1 m²/g to about 500 m²/g, and have an average pore diameter of about 0.001 micron to about 3.0 microns wherein said monomers are free from reactive functionalities, and an impregnant comprising retinoic acid retained inside said pores in an amount effective to promote skin repair.

12. A method for topically applying retinoic acid to an epidermal region, said method comprising applying to said epidermal region a topical composition comprising solid particles containing a noncollapsible, continuous network of pores open to the exterior of said particles, wherein said beads [sic, particles] are composed of a copolymer consisting of cross-linked monoethylenically unsaturated monomers and polyethylenically unsaturated monomers having a cross-linking density from 20% to 80% and are spherical in shape and have an average diameter of about one micron to about 100 microns, have a total pore volume of about 0.01 cc/g to about 4.0 cc/g, have a surface area of about 1 m²/g to about 500 m²/g, and have an average pore diameter of about 0.001 micron to about 3.0 microns wherein said monomers are free from reactive functionalities, and an impregnant comprising retinoic acid retained inside said pores in an amount effective to promote skin repair, wherein presence of the retinoic acid within the pores reduces irritancy when compared to application of the same amount of free retinoic acid without loss of skin repair promotion activity.

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The reference relied upon by the examiner is:

Won (Won №25)	4,690,825	Sep. 1, 1987
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The references discussed by this merits panel are:

Won (Won №75)	5,145,675	Sep. 8, 1992
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Physicians' Desk Reference (PDR), 38th ed., Medical Economics Company, Inc., Oradell, NJ, pages 1437-38 (1984)

Claims 1 through 3, 5, 7 through 12, and 14 through 20 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over the claims of Won №25. We reverse. In addition, we raise other issues which the examiner should consider upon return of this application.

Obviousness-type Double Patenting Rejection

The sole reason given in support of the rejection is set forth at page 2 of the Examiner's Answer as follows:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is generic with respect to the polymer and the patent is generic with respect to the active agent.

Upon consideration of the record in this application, we reverse the obviousness-type double patenting rejection based upon the claims of Won N825. See In re Kaplan, 789 F.2d 1574, 1577, 229 USPQ 678, 681 (Fed. Cir. 1986)(domination, by itself, does not rise to “double patenting”).

Other Issues

1. Effective filing date of claims

The examiner has not determined whether the claims on appeal are entitled to the benefit of an earlier filing date under 35 U.S.C. § 120. As seen from footnote 1 above, many of the parent applications are stated to be continuation-in-part applications. Upon return of the application, the examiner should determine the effective filing date of the claims and ensure that the prior art has been properly evaluated based upon that determined date.

2. Won N825

Neither appellants nor the examiner have recognized during the prosecution and examination of this application that Won '825 is prior art under 35 U.S.C. § 102(e). Won '825 is an United States patent filed on October 4, 1985, i.e., prior to the earliest effective filing date that the claims on appeal may be entitled to under 35 U.S.C. § 120. Why the

examiner and appellants limited their consideration of this reference to obviousness-type double patenting grounds is not apparent.

Won N825 indicates that dermatological agents may be used as the active agent in that invention (column 3, lines 54-55). PDR provides evidence that retinoic acid was a well known dermatological agent prior to the earliest filing date to which the present claims may be entitled. Upon return of the application, the examiner should consider Won N825 as a prior art reference in conjunction with references such as PDR and determine the patentability of the subject matter on appeal under 35 U.S.C. § 103.

3. Won N675.

Won N675 issued from one of the stated parent applications. Whether it is prior art against the present claims will not be apparent until the examiner determines the effective filing date of the claims on appeal. What is apparent, however, is that Won N675 presents a significant issue of obviousness-type double patenting. The claims of Won N675 are directed to a method of preparing a delivery system for an active substance which comprises forming solid porous particles as in Won N825, followed by the impregnation of those particles with an active substance. As seen from claim 12 of Won N675, the active substance may be a retinoid. PDR establishes that at the time of the present invention one of ordinary skill in the art would have found it obvious to use retinoic acid as the retinoid in

the claimed process of Won '675. Thus, it appears that claim 12 of Won '675 and the claims on appeal can be considered to be obvious variants.² What is not clear is whether in the welter of parent applications, there was a restriction requirement under 35 U.S.C. § 121 which would preclude a double patenting rejection.

Upon return of the application, the examiner should review Won '675, PDR, and any other relevant prior art and determine whether a double patenting rejection is proper. In so doing, the examiner should review the parent applications and determine whether a double patenting rejection, otherwise proper, would not be proper because of a previous restriction requirement.

4. Adequacy of search.

A significant aspect of the present invention is the provision of a controlled released or sustained released formulation of retinoic acid. Appellants have based patentability of the claimed invention on that feature, comparing the claim formulation with the prior art

² To the extent appellants would urge that the respective sets of claims are directed to two different statutory classes and, thus, double patenting would not be proper, we refer to the recent decision in *In re Lonardo*, ___ F.3d ___, 43 USPQ2d 1262, 1268 (Fed. Cir. 1997). Therein the court determined that double patenting was proper between claims directed to a device and claims directed to a method of using the device stating "the claimed structure of the device suggests how it is to be used and that use thus would have been obvious." Here, claim 12 of Won '675 results in the formation of a product, which on this record, falls within the products required by the claims on appeal when retinoic acid is used as the retinoid.

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Retin-A® (PDR) formulation in a declaration of record filed under 37 CFR § 1.132. Conspicuous by its absence is any entry in the administrative file under “SEARCH NOTES” which would indicate that the examiner has searched the computerized data bases available to the Patent and Trademark Office. It is not clear from this record that the examiner has performed a search which would be expected to uncover prior art which would teach or suggest providing retinoic acid in a controlled release formulation. Upon return of the application, the examiner should ensure that a proper and complete prior art search has been performed.

The decision of the examiner is reversed.

REVERSED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
William F. Smith)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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