

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 59

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAI-SHUN LIN and WILLIAM H. PRUSOFF

Appeal No. 96-1055
Application 07/727,331¹

ON BRIEF

Before KIMLIN, WEIFFENBACH and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of

¹ Application for patent filed July 3, 1991. According to appellants, the application is a continuation of Application 07/590,031, filed September 28, 1990, now abandoned, which is a continuation of Application 06/911,200, filed September 24, 1986, now abandoned.

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claims 1-5 and 14. Claims 6-13 have been canceled.

THE INVENTION

Appellants claimed invention is directed toward a method for treating a warm blooded animal infected with a retrovirus by administering to the animal a specified compound or pharmaceutical salt thereof. Claim 1 is illustrative and reads as follows:

1. A method for treating warm blooded animals infected with a retrovirus, the method comprising administering to the warm blooded animal an anti-retroviral effective amount of 2',3'-dideoxy 2',3'-didehydrocytidine or a pharmaceutically acceptable salt thereof, either alone or in admixture with a diluent or in the form of a medicament.

THE REJECTION

Claims 1-5 and 14 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an enabling disclosure.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. We therefore do not sustain this rejection.

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Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

Appellants provide on pages 5-9 of their specification guidance as to the dosages and forms for administering the compound recited in their claims. The examiner dismisses this guidance as being boilerplate guidance which is minimal and

insufficient for the breadth of the claims, and argues that the

dosages are speculative (answer, third and fifth pages)². The examiner considers the specification to be merely an invitation to carry out excessive experimentation (answer, sixth page). These arguments are not well taken because they are not supported by the required evidence or sound technical reasoning.

The examiner argues that appellants do not disclose any in vivo data in their specification or provide a correlation between the in vitro data therein and in vivo data (answer, third through sixth pages). This argument is not persuasive because it is directed toward the issue of utility and the examiner has not made a utility rejection. "Office personnel should not impose a 35 U.S.C. 112, first paragraph, rejection grounded on a 'lack of utility' basis unless a 35 U.S.C. 101 rejection is proper." *Manual of Patent Examining Procedure* § 2107(IV) (7th ed., July 1998).

² The pages of the answer are not numbered.

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For the above reasons, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of non-enablement.

OTHER MATTERS

The application includes claim 15 which was copied after final rejection from a patent for purposes of interference (amendment filed February 26, 1993, paper no. 42). The examiner states in the answer (first page) that the amendment in which claim 15 was added was not entered. However, in an advisory action (mailed May 11, 1994; paper no. 44), the examiner indicated that the amendment has been entered, and such entry is shown in the file. In the advisory action, the examiner rejected claim 15 under 35 U.S.C. § 112, first paragraph, on the ground that the specification as filed lacked adequate written descriptive support for the claimed invention. The rejection of this claim is not included in appellants' statement of the issues (brief, page 3) or in the examiner's statement of the rejection in the answer (second page) and, therefore, clearly is not before us. We remand the case to

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the examiner for consideration of the rejection of claim 15.

DECISION

The rejection of claims 1-5 and 14 under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an enabling disclosure, is reversed.

This application, by virtue of its "special status, requires an immediate action. *Manual of Patent Examining Procedure*

§ 708.01(d). It is important the Board be informed promptly of any action affecting the appeal in this case.

REVERSED and REMANDED

	EDWARD C. KIMLIN)	
	Administrative Patent Judge)	
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	CAMERON WEIFFENBACH)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES

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Administrative Patent Judge)

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