Paper No. 25

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES V. PECK,
GEVORK MINASKANIAN
and
JONATHAN HADGRAFT

_____

Appeal No. 1996-2790
Application 08/102,176[1]

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ON BRIEF

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Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and McKELVEY, Senior Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

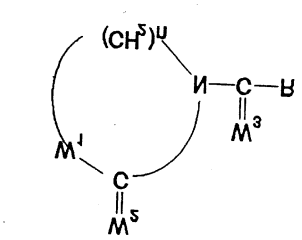
DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 46 through 49, all the claims pending in the application.

[1] Application for patent filed August 4, 1993. According to applicants, this application is a continuation of Application 07/673,016, filed March 21, 1991.

Claims 46 and 48 are representative of the subject matter on appeal and read as follows:

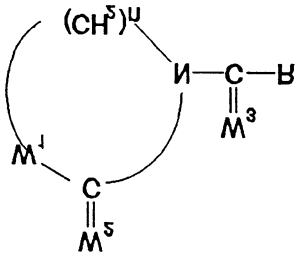
46. A method for decreasing the percutaneous absorption of toxic chemicals through the skin of a mammal in need of said decreasing which comprises applying to the stratum corneum of the skin of said mammal an effective amount to decrease the percutaneous absorption of toxic chemicals of a compound having the formula:



wherein W_1, W_2 and W_3 are each divalent oxygen, n is 2 and R is a straight chain alkyl radical containing 6 to 20 carbon atoms;

wherein when the skin of said mammal is exposed to said toxic chemicals, the penetration of said toxic chemicals through the skin is decreased.

48. A method for increasing the stability of lipid bilayers in mammalian skin in order to decrease passage of bioactive agents through the skin of a mammal in need of said decreasing, said method comprising the step of applying to the stratum corneum of the skin of said mammal an amount effective to decrease passage of bioactive agents through said lipid bilayers of a lipid-bilayer-stability-increasing compound having the formula:



wherein W_1, W_2 and W_3 are each divalent oxygen, n is 2 and R is a straight chain alkyl radical containing 6 to 20 carbon atoms;

wherein when the skin of said mammal is exposed to bioactive agents, the passage of said bioactive agents through the skin is decreased.

The references relied upon by the examiner are:[2]

Smith et al. (Smith)	3,100,180	Aug. 6, 1963
Rajadhyaksha	4,960,771	Oct. 2, 1990
Aungst	5,091,379	Feb. 25, 1992

Claims 46 through 49 stand rejected under 35 U.S.C. § 112, first paragraph (enablement). In addition, claims 46 through 49 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Smith, Rajadhyaksha and Aungst. We reverse.

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[2] The examiner also cites International Publication No.: WO 90/00407 which lists Vithal J. Rajadhyaksha as applicant and inventor. In addition, the document lists U.S. Application 2,18,316, filed July 12, 1998 as a priority application. This application issued as U.S. Patent No. 4,960,771 and is relied upon by the examiner. The examiner has not distinguished between the two patent documents to Rajadhyaksha in making the rejection. We have considered both documents and will simply refer to them collectively as Rajadhyaksha.

DISCUSSION

1. Enablement

In stating the rejection at page 2 of the Examiner's Answer, the examiner first indicates that "the disclosure is enabling only for claims limited as shown below." What appears "below" is the following paragraph:

> A method is claimed, decreasing or blocking passage of bioactive and toxic compounds by applying a compound shown to increase and toxic compounds by applying a compound shown to increase passage of bioactive and toxic compounds. There is no presentation of the conditions, concentrations, compounds or adjuvants required to permit one of ordinary skill in the art to practice this method on living mammals with expectation of the claimed results, yet prior art shows this method with this compound results in penetration (Rajadhyaksha, compound 27).

In reading the paragraph which appears "below," it is not clear how the examiner would have appellants limit the claims. The paragraph is all but incomprehensible.

If we were to make an educated guess as to what is concerning the examiner, it would be that Rajadhyaksha describes the compounds which are used in the claimed method as increasing, rather than decreasing, passage of active agents through the skin of a mammal. In other words, Rajadhyaksha states that the compounds set forth in claims 46-49 operate in a manner opposite that claimed.

In considering this issue, we first note that the claims on appeal are limited to the use of fifteen compounds, i.e., N-[(C_6-C_{20}) straight chain acyl]-2-oxazolidiones.

Rajadhyaksha generically describes these fifteen compounds as increasing rather than decreasing penetration or absorption of active agents through the skin of a mammal. Appellants argue that Rajadhyaksha did not actually test the N-acyl substituted 2-oxazolidinones to which the claims on appeal are now limited, stating at page 11 of the Appeal Brief:

> Appellants tested N-dodecanoyl-2-oxazolidinone in the cell diffusion assay and surprisingly discovered that this compound repeatedly decreased, rather than enhanced, penetration of active agents. The evidence submitted in the application as filed establishes that N-dodecanoyl-2-oxazolidinone decreases penetration of active agents/toxic chemicals as asserted by Appellants. This evidence does not contradict any scientific data disclosed in the Raj patents. Rather, Appellants' results contradict Raj's expectation that N-dodecanoyl-2-oxazolidinone would function equivalently to other heterocyclic ketone derivatives that enhance skin penetration.

The working examples of the present specification provide evidence that a specific compound used in the present invention, N-dodecanoyl-2-oxazolidinone, functions to decrease the penetration or absorption of active agents through the skin of a mammal. In making the enablement rejection, the examiner has not questioned or disputed this evidence. Having accepted this evidence, it became incumbent upon the examiner to explain why one skilled in the art would not expect the same or similar effect to occur through the use of the other fourteen compounds set forth in the claims on appeal. The examiner has not done so.

The rejection under 35 U.S.C. § 112, first paragraph (enablement) is reversed.

2. Obviousness

The examiner has not identified any disclosure in the applied references which would reasonably teach or suggest that the fifteen compounds used in the claimed method would expectedly serve to decrease the absorption or penetration of an active agent through the skin of a mammal. Rather, the only suggestion that the fifteen compounds possess this property is found in appellants' disclosure. Clearly, the examiner's rejection under 35 U.S.C. § 103 is based upon prohibited hindsight. Accordingly, we reverse the obviousness rejection.

The decision of the examiner is reversed.

REVERSED

Sherman D. Winters Administrative Patent Judge	)
William F. Smith Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
Fred E. McKelvey, Senior Administrative Patent Judge	)

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