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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID E. EDGREN, GURDISH K. BHATTI,
ZAHEDEH HATAMKHANI and PATRICK S. -L. WONG

Appeal No. 1996-3159
Application No. 08/068,480

ON BRIEF

Before, STONER, Chief Administrative Patent Judge and DOWNEY and WILLIAM F. SMITH, Administrative Patent Judges.

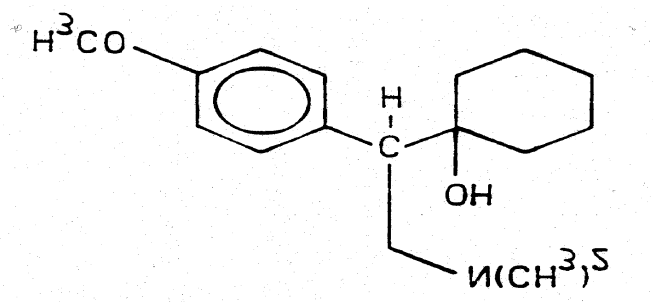
WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claim 4, the only claim remaining in the application. Claim 4 reads as follows:

4. A method for administering a drug to the gastro-intestinal tract of a human, wherein the method comprises:

(a) admitting orally into the human a dosage form comprising a drug of the formula:



which drug possess antidepressant therapy and the dosage form comprises a member selected from the group consisting of a sustained-release dosage form and a controlled-release dosage form; and,

(b) administering the drug from the dosage form over an extended period of time in a therapeutically responsive dose to produce the antidepressant therapy.

The reference relied upon by the examiner is:

Theeuwes et al. (Theeuwes) 3,916,899 Nov. 04, 1975

Claim 4 stands rejected under 35 U.S.C. § 102(b) as

anticipated by Theeuwes. We reverse.

Discussion

As set forth in RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." (citation omitted). The active agent required by claim 4 on appeal is known by the name venlafaxine. The examiner's statement of the rejection as it appears at page 3 of the examiner's answer reads:

> Theeuwes '899 teaches a control release device (abstract). Oral administration is disclosed (column 12, lines 10-13). Drugs without limitation are disclosed (column 15, lines 33-35), including psychic energizers (column 15, line 64). Venlafaxine is well-known in the pharmaceutical art as an anti-depressant.

The examiner has correctly determined that Theeuwes

describes a method of administering a drug to a human in a sustained-release or controlled-release form. The examiner also correctly determined that the active agent which may be admin-istered in Theeuwes can be broadly a drug and specifically a

"physic energizer." Where the examiner's case falls apart, however, is in his attempt to account for the requirement in claim 4 that the active agent is venlafaxine.

In stating the rejection, the examiner only mentions that venlafaxine is a known anti-depressant. This is correct. (See page 10, line 22 - page 11, line 15 of the specification). However, the fact that venlafaxine may be a known anti-depressant does not mean that Theeuwes describes its use as the active agent in the controlled-released or sustained-released dosages of that invention. Manifestly, the examiner has not established that Theeuwes mentions venlafaxine by name. Nor has the examiner begun to establish

that Theeuwes describes venlafaxine under the "principles of inherency." The open ended description of active agents in Theeuwes which includes drugs in general and "psychic energizers" specifically does not mean that Theeuwes describes each and every possible compound which meet those descriptions. Absent a fact-based explanation from the examiner as to why

Theeuwes describes the subject matter of claim 4 in its entirety, we find that the examiner has not properly established a prima facie case of anticipation.

The decision of the examiner is reversed.

REVERSED

BRUCE H. STONER, JR.)

Chief Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
MARY F. DOWNEY	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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WILLIAM F. SMITH	)	
Administrative Patent Judge	)	

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