

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1997-1816
Application No. 08/178,269

ON BRIEF

Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11, 14 and 17-19. Claims 12, 13, 15, 16 and 20, the other claims remaining in the present application, have been withdrawn from consideration as being directed to a non-

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elected invention. A copy of illustrative claim 1 is appended
to this decision.

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The examiner relies upon the following references as evidence of obviousness:

Frost et al. (Frost)	5,034,401	Jul. 23, 1991
Chenard (Chenard '343)	5,185,343	Feb. 09, 1993
Chenard (Chenard '723)	5,306,723	Apr. 26, 1994 (§ 102(e) date Nov. 6, 1992)

Appellant's claimed invention is directed to novel neuroprotective 2-(4-hydroxypiperidino)-1-alkanol derivatives of the recited formula. The claimed compounds find utility in treating stroke, traumatic injury to the brain and spinal cord and neuronal degenerative diseases, such as senile dementias.

Appealed claims 11, 14, 17 and the quinolyl compounds of claims 1-10, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Frost in view of Chenard '343. The same claims also stand rejected under 35 U.S.C. § 103 as being unpatentable over Frost in view of Chenard '723. In addition, the same claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Chenard '723 in view of Frost.

We consider first the examiner's rejection over Frost in view of Chenard '723. The examiner recognizes that the difference between the compounds of Frost and the claimed compounds is that "Frost's R⁴ is hydrogen while the claimed

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compounds have an OH at this position" (page 5 of Answer). However, the examiner reasons that since Chenard '343 discloses compounds similar in structure to those of Frost having the same utility wherein H and OH are interchangeable at the 4-position of the heterocyclic ring, it would have been obvious for one of ordinary skill in the art to substitute an OH group at the R⁴ position of Frost.

Appellant maintains that the examiner has improperly focused only on the 4-position of the piperidinyl moiety while ignoring "all the other differences which exist between Frost's compounds and Chenard's compounds in an effort to make out a *prima facie* case of obviousness" (page 25 of principal brief). In particular, appellant contends "Frost also does not even suggest combining the benzo-fused moieties disclosed as part of his compounds with the type of moieties disclosed by Chenard." Also, appellant submits that "Chenard does not teach or suggest combining portions of their compounds with the benzo-fused moieties disclosed by Frost" (page 25 of principal brief).

Appellant's argument goes to the heart of the examiner's position that the compounds of Frost and Chenard '343 are

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close in chemical structure. Indeed, the compounds of Chenard '343 do not possess the benzo-fused moieties of Frost. Significantly, while we find appellant's argument to be a valid one, we have searched in vain for any response or refutation of this argument in the Examiner's Answer or Supplemental Answer. Consequently, inasmuch as the examiner has not established that the difference in chemical structure between the compounds of Frost and Chenard '343 pointed out by appellant would not militate against modifying the 4-position of Frost in the manner proposed by the examiner, we are constrained to find that the examiner has not established a *prima facie* case of obviousness over the combined teachings of Frost and Chenard '343.

We now turn to the examiner's rejections based upon the combined teachings of Frost and Chenard '723. We cannot sustain these rejections because Chenard '723 is not an effective prior art reference against the present application, which has an effective filing date of July 17, 1991. The effective § 102(e) date of Chenard '723 is November 6, 1992. While the examiner suggests that she is actually relying upon PCT Publication WO 91/17156, the effective prior art date of

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this reference is November 14, 1991, not the priority date of the international publication. The examiner's attention is directed to MPEP § 1895.01(E) (7th ed., July 1998).

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In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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TERRY J. OWENS)	
Administrative Patent Judge)	

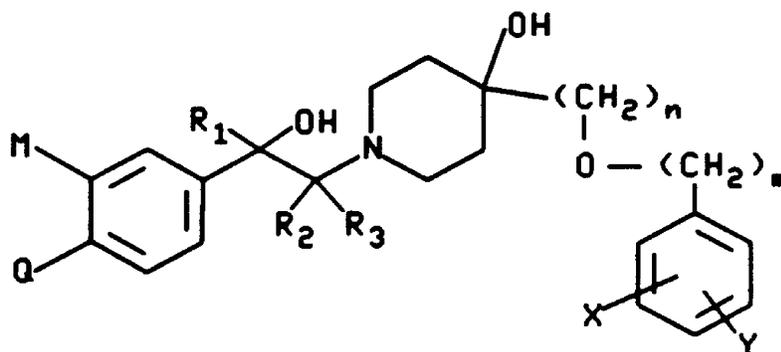
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Gregg C. Benson
Pfizer Inc.
Eastern Point Road
Groton, CT 06340

APPENDIX

1. A compound of the formula:



(I)

and the pharmaceutically-acceptable salts thereof; wherein R₁, R₂ and R₃ are each selected from the group consisting of hydrogen, alkyl having 1 to 6 carbons, phenyl and substituted phenyl, wherein the substituent on said substituted phenyl is selected from the group consisting of hydroxy, alkyl having 1 to 4 carbons, chloro, bromo, fluoro, trifluoromethyl, amino, nitro and alkoxy having 1 to 4 carbons;

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or R_1 and R_2 when taken together form a methylene, ethylene, propylene or butylene group;

m is 0 to 2;

n is 1 or 2;

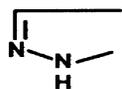
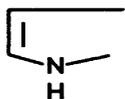
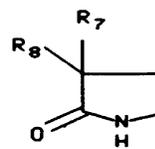
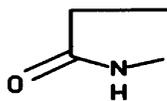
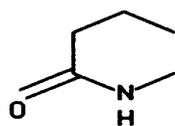
X and Y are each selected from the group consisting of hydrogen, chloro, bromo, fluoro, trifluoromethyl, alkoxy having 1 to 4 carbons, alkyl having 1 to 4 carbons, hydroxy, amino, nitro and substituted phenoxy, wherein the substituent on said substituted phenoxy is selected from the group consisting of hydrogen, hydroxy, alkyl having 1 to 4 carbons, chloro, bromo, fluoro, trifluoromethyl, nitro, amino and alkoxy having 1 to 4 carbons;

M and Q are each selected from the group consisting of hydrogen, hydroxy, amino, chloro, bromo, fluoro, trifluoromethyl, nitro, alkyl having 1 to 4 carbons, alkoxy having 1 to 4 carbons, N,N-dialkylamino having 1 to 4 carbons in each of said alkyls, N-alkylamino having 1 to 4 carbons, NHCOR_4 , NHCOOR_5 and NHSO_2R_6 ; wherein R_4 is selected from the group consisting of hydrogen, alkyl having 1 to 6 carbons, phenyl and substituted phenyl, wherein the substituent on said substituted phenyl is selected from the group consisting of

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hydroxy, chloro, bromo, fluoro, trifluoromethyl, amino, nitro, alkyl having 1 to 4 carbons and alkoxy having 1 to 4 carbons; and wherein R_5 and R_6 are each selected from the group consisting of alkyl having 1 to 6 carbons, phenyl and substituted phenyl, wherein the substituent on said substituted phenyl is selected from the group consisting of hydroxy, chloro, bromo, fluoro, trifluoromethyl, amino, nitro, alkyl having 1 to 4 carbons and alkoxy having 1 to 4 carbons; or M and Q when taken together form a divalent radical Z, wherein Z is selected from the group consisting of

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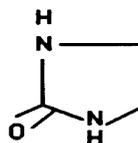
where

and

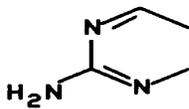
each

selected

from



and



;

wherein R₇

R₈ are

hydrogen

or methyl

groups.

group consisting of hydrogen and methyl.