

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAJES PATEL,
LYLE M. BOWMAN and PENG SHEN

Appeal 1997-2447
Application 08/248,500¹

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
Decision on appeal under 35 U.S.C. § 134

Upon consideration of the primary examiner's rejection of claims 1-18 and 20-24 under 35 U.S.C. § 103 as being unpatentable over Patel, U.S. Patent 5,340,572 (1994), Davis,

¹ Application for patent filed 24 May 1994. The real party in interest is InSite Vision, Inc.

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U.S. Patent 5,192,535 (1993) and Nagy, U.S. Patent 4,960,799 (1990), it is

ORDERED that the rejection is reversed and the application is remanded for further proceedings not inconsistent with the views expressed herein.

FURTHER ORDERED that applicants' request for oral argument has been rendered moot.

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The claims cover an ophthalmic composition having a suspension portion and a solution portion, each containing an active drug. In a light most favorable to the position taken by the examiner, Patel and Davis describe ophthalmic compositions in the form of suspensions. Nagy describes ophthalmic compositions in the form of solutions. The examiner reasons that somehow Patel and Davis probably describe compositions containing both a suspension portion and a solution portion. Needless to say, neither Patel and Davis explicitly describe a suspension/solution composition. It may be that one of the numerous embodiments of Patel and Davis describes a composition inherently containing a suspension portion and a solution portion. The difficulty with the

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examiner's position is that the examiner has not called our attention to that portion of Patel and Davis upon which a proper inherency analysis can be made. More to the point is the fact that the examiner's failure to articulate which embodiment or embodiments "inherently" meet the suspension/solution limitations of claim 1 makes it difficult for applicants to confront the basis for the examiner's rejection. Neither the applicants nor we should have to guess the basis of an examiner's rejection. Compare In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO alleges that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art) (citing In re Yates, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981), both cited by applicants in their reply brief.

We are not finding that Patel and Davis do not inherently describe suspension/solution ophthalmic compositions within the scope of applicants' claims. Rather, we hold that, on this record, the examiner has failed to make out a case of inherency. Likewise, the examiner has failed to sufficiently

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point to the portions of Patel and Davis which might reasonably justify a requirement that applicant present evidence. Compare In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

REVERSED and REMANDED.

_____)	
FRED E. McKELVEY, Senior)	
Administrative Patent Judge)	
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_____)	
RICHARD E. SCHAFER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
_____)	
JAMESON LEE)	
Administrative Patent Judge)	

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