

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK F. MCCARTY

Appeal No. 1997-2830
Application 08/440,362

ON BRIEF

Before WINTERS, MILLS and GRIMES, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U. S. C. §134 from the examiner's final rejection of claims 1-5, which are all of the claims pending in this application.

We reverse.

Claim 1 is illustrative of the claims on appeal and reads as follows:

1. A method for reducing hyperglycemia and stabilizing the level of serum glucose in humans comprising administering between about 1,000 and 10,000 micrograms per day of chromium as synthetic chromic tripicolinate to a human in need thereof.

The prior art reference relied upon by the examiner is:

Boynton et al. (Boynton) 5,087,623 Feb. 11, 1992

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's Answer (Paper No. 11, August 12, 1996) for the examiner's complete reasoning in support

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of the rejection, and to the appellant's Brief (Paper No. 10, June 28, 1996) for the appellant's argument thereagainst. As a consequence of our review, we make the determinations which follow.

DECISION ON APPEAL

Claims 1-5 stand rejected under 35 U.S.C. § 103 as unpatentable for obviousness in view of Boynton.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that

would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

In the present case, the examiner indicates that Boynton establishes evidence of the administration of chromic tripicolinate for reducing hyperglycemia and stabilizing the level of serum glucose in a human by oral or parenteral administration. The examiner relies on a general teaching in Boynton that chromic tripicolinate is non-toxic up to a dose of 156 gm to support for his position that it would be obvious to administer chromic tripicolinate in a dosage range of between about 1,000 and 10,000 micrograms per day of chromium as synthetic chromic tripicolinate, as claimed (Claim 1). Answer, page 2.

We find the examiner's reliance upon the toxicity values for chromic tripicolinate described in Boynton to support the obviousness of the claimed invention to be misplaced. A fair reading of Boynton is that chromic tripicolinate can be administered to reduce hyperglycemia and stabilize the level of serum glucose in a dosage of about 10 to about 500 micrograms a day. Boynton, column 4, lines 44-68. Boynton also suggests that lesser amounts of chromic tripicolinate may be required for uses such as the prophylactic function of preventing or reducing serum lipids, total serum cholesterol and LDL

cholesterol, and the therapeutic function of alleviating the symptoms of maturity-onset diabetes. Boynton, column 5, lines 44-50.

While we agree with the examiner that Boynton establishes evidence of the application of chromic tripicolinate to reduce hyperglycemia and stabilize the level of serum glucose in a human, we find that the disclosure of Boynton is limited to administration of chromic tripicolinate in a dosage range “corresponding to about 10 to about 500 micrograms” of chromium tripicolinate per day. Boynton, column 4, lines 45-69.

In our view the examiner has failed to provide evidence which establishes a prima facie case of unpatentability based on obvious, as we do not find that the examiner has established that Boynton describes or suggests administration of a chromic tripicolinate dosage range of between about 1,000 and 10,000 micrograms per day of chromium as synthetic chromic tripicolinate to **reduce hyperglycemia and stabilize the level of serum glucose in humans.**

We find it unnecessary to reach the rebuttal evidence of appellant as we find the examiner has not met the burden of setting forth a prima facie case of unpatentability based on obviousness. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), In re Geiger, 815 F.2d 686, 688, 2

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USPQ2d 1276, 1278 (Fed. Cir. 1987). Based on the record and evidence before us, the rejection of claims 1-5 for obviousness under 35 U.S.C. § 103 is reversed.

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CONCLUSION

The rejection of claims 1-5 under 35 U.S.C. § 103 is reversed.

REVERSED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Eric Grimes)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Demetra J. Mills)	
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