

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARC R. MAYBERG

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Appeal No. 1997-3010  
Application 08/042,461

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ON BRIEF

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Before WILLIAM F. SMITH, ROBINSON, and SCHEINER, Administrative Patent Judges.

WILLIAM F. SMITH, 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 28 through 31, 34, 38, 39, 47, 49 and 52.



3. Claim 39 stands rejected under 35 U.S.C. 103(a). As evidence of obviousness, the examiner relies on Moskowitz and Urquhart.

We reverse all rejections.

### DISCUSSION

Moskowitz describes a technique for localizing horseradish peroxidase (HRP) by incorporating it into a controlled release polymer (PVA), then applying by “painting” the impregnated polymer onto a cerebral blood vessel, and covering the coated vessel with unimpregnated PVA or pluronics to limit release solely to the interface between the impregnated polymer and the blood vessel (page 463, lines 1-5). The examiner recognizes that Moskowitz does not teach using an agent for the treatment of a vascular disorder. The examiner relies on the following statement found on page 464 of the Moskowitz reference to make the obviousness rejection:

“The simplicity with which these poly(vinyl alcohol) solutions can be ‘painted’ onto blood vessels opens new possibilities for drug localization.”

The examiner concludes from this statement that “although Moskowitz et al’s studies do not involve the method of delivering a drug intended for the treatment of blood vessels, it would be obvious to one of ordinary skill in the art that this method could be used for such from the above teachings.” (Examiner’s Answer, page 4).

Appellant depicts Moskowitz's disclosure as follows:

Moskowitz et al. is directed to defining neuronal connections by using the enzyme horseradish peroxidase ("HRP") to trace nerve fibers that project to cerebral blood vessels (see page 460 of Moskowitz et al.). HRP is applied to cerebral blood vessels in order to minimize uptake of HRP by adjacent nerve endings which do not project to blood vessels and to maximize uptake of HRP by nerve fibers which do project to the blood vessels. HRP is not a drug and has no effect on blood vessels." [Appeal Brief, Paper No. 40, page 4]

The examiner does not dispute this description of Moskowitz. Based on our reading of Moskowitz, we find appellant's description is substantially correct. The claimed invention requires applying a polymer matrix which is impregnated with "an agent for the treatment of a vascular disorder" directly to the external surface of an artery or vein so as to produce "a localized effect on the artery or vein without systemic effect." We do not find in Moskowitz any suggestion or reason to apply a release polymer impregnated with an agent for the treatment of vascular disorder to an artery or vein so as to produce the localized effect on an artery or vein. The examiner contends that it would have been obvious to one of ordinary skill in the art that Moskowitz's method "could be used" for delivering a drug for the treatment of blood vessels. The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

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The decision of the examiner is reversed.

REVERSED

William F. Smith )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
Douglas W. Robinson )  
Administrative Patent Judge ) APPEALS AND  
 )  
 ) INTERFERENCES  
 )  
Toni R. Scheiner )  
Administrative Patent Judge )

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