

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRUCE W. MILLER

Appeal No. 2001-0120
Application No. 08/695,393

ON BRIEF

Before WINTERS, ADAMS and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9, which are all the claims pending in the application.

Claims 1 and 4 are illustrative of the subject matter on appeal and are reproduced below:

1. A method for treating burns comprising topically administering to a burn area a composition consisting essentially of the combination of:
 - (a) tetracaine, in a concentration of from about 1% to 2% by weight; and
 - (b) sodium lauryl sulfate in a concentration of from about 0.5% to about 5.0% by weight and wherein said combination is administered in a pharmaceutically acceptable carrier for topical administration.
4. A method for treating burns comprising topically administering to a burn area a composition consisting essentially of the combination of:

- (a) an anesthetic selected from the group consisting of esters, amides and ethers; and
- (b) a surfactant selected from the group consisting of anionic, nonionic and cationic surfactants.

The references relied upon by the examiner are:

Partain, III et al. (Partain)	4,946,870	Aug. 7, 1990
Bockow	5,650,157	Jul. 22, 1997
Cassuto et al. (Cassuto)	EP 0 446 225 B 1	Aug. 18, 1991

GROUND OF REJECTION

Claims 1-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bockow.

Claims 1-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cassuto in view of Partain.

We reverse.

DISCUSSION

Bockow:

According to the examiner (Answer, page 4), "Bockow teaches topical compositions for treating burns comprising a local anesthetic, such as tetracaine, benzocaine, or lidocaine ... in a range of from about 0.1% to 5% by weight of the composition...." In addition, the examiner finds (*id.*), "Bockow teaches anionic, cationic, or non-ionic emulsifiers in the topical compositions and cites sodium lauryl sulfate and quaternary ammonium salts as examples."

In response to the examiner's rejection, appellant argues, inter alia, that Bockow does not suggest the combination or use of an anesthetic and surfactant

(including sodium lauryl sulfate) to treat burns. See, Brief, Bridging paragraph, pages 6-7¹. On this record we are compelled to agree with appellant.

As set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. ... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.”

...

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. ... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. ... Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted]

In other words, “there still must be evidence that ‘a skilled artisan ... with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.’” Ecolchem Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075-76 (Fed. Cir. 2000). At best, the prior art relied upon by the examiner mentions the words anesthetic (including tetracaine), surfactant (including sodium lauryl sulfate) and burn. The prior art however, fails to suggest the specific combination of elements set forth in appellant’s claimed invention.

¹ Appellant’s Brief does not contain page numbers. For clarity, we have annotated appellant’s Brief to include page numbers beginning with the first page, page 1, of the Brief.

Specifically, Bockow sets forth a number of different ailments upon which Bockow's topical pharmaceutical preparation may be useful in treating. See col. 13, lines 40-57 and claim 1. Further, in the treatment of "burns, insect bites or stings, sunburn, and the like" Bockow disclose that "[e]xemplary local anesthetics are benzocaine, dibucaine, benzyl alcohol, dibucaine hydrochloride, lidocaine, pramoxine hydrochloride, tetracaine, and tetracaine hydrochloride." Col. 13, lines 58-64. Bockow discloses that adjuvants such as thickeners, emulsifiers, humectants, antibacterials, emollients, etc. may be included in the pharmaceutical preparation "so long as the adjuvants are suitable for topical use and do not disrupt the structure and/or function of the oil composition." Col. 11, lines 45-55. Assuming that a person of ordinary skill would include an adjuvant in the pharmaceutical composition taught by Bockow, and more specifically an emusifier, Bockow discloses an extensive list of possible emulsifiers, one of which is sodium lauryl sulfate. Col. 11, line 66 to Col. 12, line 14.

On this record, it is our opinion that the examiner failed to provide the evidence necessary to establish that a person of ordinary skill in the art would have selected from the extensive number of potential choices set forth in Bockow, the specific elements required by appellant's claimed invention. We remind the examiner, in deciding the question of obviousness under 35 U.S.C. §103, it is not realistic to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such references fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercer, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778

(CCPA 1975). The mere existence in the prior art of individual elements of appellant's invention does not, without more, render the claimed invention prima facie obvious under 35 U.S.C. §103. Instead, there must be evidence that the bringing together of such elements would have been prima facie obvious to a person of ordinary skill in the art.

Accordingly, we reverse the rejection of claims 1-9 under 35 U.S.C. § 103 as being unpatentable over Bockow.

Cassuto in view of Partain:

According to the examiner (Answer, page 4), "Cassuto teaches treating burns by the topical application of a local anesthetic agent such as benzocaine, procaine, or tetracaine at a concentration of 1.5% to 10%...." The examiner relies on Partain (Answer, page 5), to "teach that additives such as sodium lauryl sulfate in topical compositions enhance percutaneous adsorption of the active ingredient."

In response to the examiner's rejection, appellant argues (Brief, page 9), "[t]here is no motivation taught in either Partain or Cassuto for adding sodium lauryl sulfate to tetracaine to treat burns as taught by the present invention." We are compelled to agree with appellant.

Partain is directed to delivery systems comprised of certain aminopolysaccharides including chitosan derivatives and pharmaceutical or therapeutic actives. Col. 2, lines 29-34. We recognize the examiner's arguments at page 8 of the Answer, wherein the examiner points out that "the permeability of most pharmaceuticals is poor due to the barrier properties of the skin" and that "Partain teaches that percutaneous absorption of pharmaceuticals

is enhanced by the addition of a penetration enhancer, and lists sodium lauryl sulfate as a specific example of a penetration enhancer....” However, as Partain discloses (Col. 3, lines 53-60), “[t]he humectant properties of ... chitosan derivatives, applied to skin or mucous membranes, therefore enhance the absorption of the actives into these tissues.”

According to Partain, the inventive delivery systems can contain a large number of pharmaceutical and therapeutic actives that include but are not limited to anti-inflammatory analgesics, antibiotic agents vasodilators, anti-histamines, moisturizing agents, additives for the enhanced percutaneous absorption, etc. Col. 8, line 7 to Col. 9, line 35. We recognize the examiner’s reference to “sodium lauryl sulfate,” among the list of potential additives for enhanced percutaneous absorption. What we do not recognize, nor does the examiner identify, any suggestion to combine an anesthetic with a surfactant in order to treat burns as required by appellant’s claimed invention. For the foregoing reasons, it is our opinion that the examiner’s rejection fails to suggest the specific combination of elements set forth in appellant’s claimed invention.

Accordingly, we reverse the rejection of claims 1-9 under 35 U.S.C. § 103 as being unpatentable over Cassuto in view of Partain

Accordingly, we reverse all of the prior art rejections of record.

REVERSED

Sherman D. Winters)
Administrative Patent Judge)
) BOARD OF PATENT
)

Donald E. Adams)	APPEALS AND
Administrative Patent Judge)	
)	INTERFERENCES
)	
Eric Grimes)	
Administrative Patent Judge)	

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PHILLIP M. WEISS, ESQ.
WEISS & WEISS PC
500 OLD COUNTRY ROAD, SUITE 305
GARDEN CITY NY 11530