

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 30

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte DOUGLAS SHANDER,  
GURPREET S. AHLUWALIA, and  
DIANA MARKS-DEL GROSSO

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Appeal No. 2001-0914  
Application No. 08/869,381

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ON BRIEF

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Before STONER, Chief Administrative Patent Judge,  
HARKCOM, Vice Chief Administrative Patent Judge, and  
WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 4, 11, and 22 through 41, all the claims pending in the application.

Claim 1, the only independent claim pending, is representative of the subject matter on appeal and reads as follows:

1. A process of reducing the rate of mammalian hair growth, comprising

selecting an area of skin from which a reduced rate of hair growth is desired; and

applying to said area of mammalian skin a non-depilatory composition including a hair growth reducing effective amount of a sulfhydryl active compound selected from the group consisting of 2,3-dimercapto-1-propanesulfonic acid, 3,3'-thiodipropionic acid, isethionic acid, 3-(methylthio)-propylamine, 3,3'-thiodipropionic acid dilauryl ester, allyl sulfide, DL-methionine-S-methyl-sulfonium chloride, penicillamine disulfide, S-2-aminoethyl-L-cysteine, and diethyldithiocarbamic acid.

Claims 1 through 4, 11, and 22 through 41 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 through 4 and 21 through 31 of U.S. Patent No. 5,411 991 ('991 patent). We affirm.

#### Background

This application is stated to be a continuation of application 08/414,992 which in turn is stated to be a continuation of application 07/995,037. The '991 patent issued from application 07/995,037. Claim 1 of the '991 patent reads as follows:

1. A process of reducing the rate of mammalian hair growth, comprising  
selecting an area of skin from which a reduced rate of hair growth is desired; and  
applying a non-depilatory composition including a hair growth reducing effective amount of a sulfhydryl active compound to said area of mammalian skin, said sulfhydryl active compound penetrating into the hair follicles in said area of mammalian skin to interfere with the formation of new hair causing a reduction in the rate of hair growth from said area of mammalian skin.

As the prosecution unfolded in this application, the examiner instituted the present obviousness-type double patenting rejection based upon the claims of the '991 patent. Appellants did not file a Terminal Disclaimer to overcome this rejection during prosecution nor did appellants contest the merits of the examiner's rejection in the Appeal Brief (Paper No. 23, November 24, 1999). Rather, their position on appeal is there are two policy rationales behind the doctrine of obviousness-type double

patenting and neither rationale applies to the facts of this case. First, appellants argue that any patent issuing from this application will "expire on the same day, twenty years from the filing date of the '991 patent. See 35 U.S.C. § 154 (a) (2)." Appeal Brief, page 3. The second rationale is stated to be designed to "prevent a division of ownership of two patents directed to the same invention." Id. Appellants argue that since ownership is not split between the '991 patent and the present application, the second policy rationale carries less weight. Appeal Brief, page 5.

Upon initial consideration of this appeal, a merits panel remanded the case to the Office of the Deputy Commissioner of Patent Examination Policy for further consideration. As a result, the examiner issued a first Supplemental Examiner's Answer (Paper No. 26, August 30, 2001), setting forth in more detail the facts and reasons why it is appropriate for appellants to file a Terminal Disclaimer to overcome the obviousness-type double patenting rejection.

In response to the first Supplemental Examiner's Answer, appellants filed a Supplemental Appeal Brief (Paper No. 27, February 20, 2002). The case was remanded again to the examiner to consider the Supplemental Appeal Brief. The examiner issued a second Supplemental Examiner's Answer on January 21, 2003 (Paper No. 29). Accordingly, the case is before the Board for a decision on the merits.

#### Discussion

Upon review of the briefing in this appeal, we find ourselves in complete agreement with the position set forth in the Supplemental Examiner's Answer. In view of the complete and thorough explanation as to why it is appropriate for appellants to file a Terminal Disclaimer to overcome the pending obviousness-type double patenting

rejection, we will not burden the record with further comment. Rather, we will simply adopt as our own position the facts and reasons set forth in the first Supplemental Examiner's Answer in support of the obviousness-type double patenting rejection.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

	)	
Bruce H. Stoner, Chief	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Gary V. Harkcom, Vice Chief	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
William F. Smith	)	
Administrative Patent Judge	)	

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