

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte KNOX Van DYKE

Appeal No. 2001-1164
Application No. 08/293,745

ON BRIEF

Before WINTERS, WILLAM F. SMITH, and ADAMS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 66 through 83, 89 through 99, and 105 through 156, which are all of the claims remaining in the application.

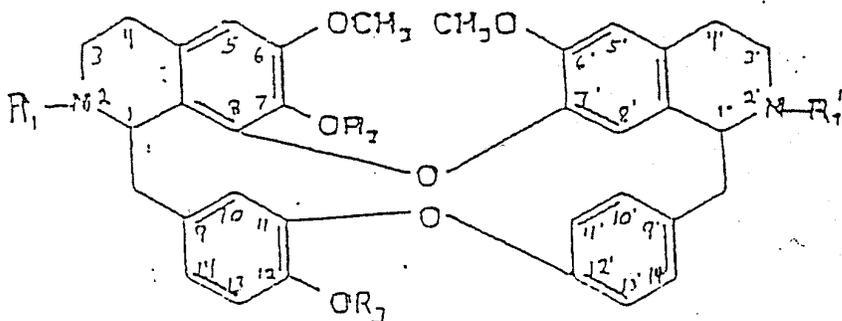
Representative Claim

Claim 66, which is illustrative of the subject matter on appeal, reads as follows:

-66-

A method for treating and thereby reducing drug resistant uterine, ovarian, breast, lymphoma, cartilage/bone, leukemia, liver, abdominal area, lung, cervical, pelvic, adrenal gland, iliac, Hodgkin's disease and thyroid cancers in a patient comprising:

administering to the patient in vivo effective concentration of (1) a compound having the following formula:



where R_1 and R_1' are the same or different short chained carbon based moieties; R_2 is CH_3 or C_2H_5 and R_3 is CH_3 or Hydrogen, and the isomeric configuration at the C-1' chiral carbon location is "S", and (2) at least one principal drug known to be effective for treating whichever of said cancers is being treated, administered sufficiently contemporaneously with said compound that said cancer is exposed to said compound and said principal drug simultaneously.

Th

e Prior Art References

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner relies on the following prior art references:

Kuroda et al. (Kuroda), "Antitumor Effect of Bisbenzylisoquinoline Alkaloids," Chem. Pharm. Bull., Vol. 24, No. 10, pp. 2413-2420 (1976)

Kato et al. (Kato), "Potentiation of Antitumor Activity of Vincristine by the Biscolarine Alkaloid Chepharanthine," JNCI, Vol. 79, No. 3, pp. 527-532 (1987)

Liao, Chemical Abstract No. 93CA"197657u, "Effect of D-Tetrandrine and Thalicarpine,

Antitumor Plant Alkaloids, on HeLaCells" (1980)

Fuska, Chemical Abstract No. 104CA:84939q, "Microbial Transformations of Neoplasm Inhibitors Isolated from Higher Plants" (1986)

Shiraishi et al. (Shiraishi), "Effect of Bisbenzyl-isoquinoline (Biscoclaurine) Alkaloids on Multidrug Resistance in KB Human Cancer Cells," Cancer Research, Vol. 47, pp. 2413-2416 (1987)

Kawashima et al. (Kawashima), "Structure and Hypotensive Activity Relationships of Tetrandrine Derivatives in Stroke-Prone Spontaneously Hypertensive Rats," Gen. Pharmacy, Vol. 21, No. 3, pp. 343-347 (1990)

Merck Index, 10th ed., Abstract Nos. 9056 and 2136, pages 1321 and 304-305 (Windholz et al. (Windholz) ed., Merck & Co., Rahway, NJ (1985))

The Rejection

Claims 66 through 83, 89 through 99, and 105 through 156 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of the Merck Index, Kawashima, Kuroda, Fuska, Liao, the acknowledged state of the prior art, Shiraishi, and Kato.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicant's amended Brief (Paper No. 44) and the Reply Brief (Paper No. 46); (3) the Examiner's Answer (Paper No. 45) and the communication mailed by the examiner October 12, 2000 (Paper No. 47); (4) the above-cited prior art references; (5) the DECLARATION OF DARYL BARNETT, executed August 19, 1994; (6) the SECOND DECLARATION OF DARYL BARNETT, executed October 14, 1995; (7) the

THIRD DECLARATION OF DARYL BARNETT, executed January 8, 1998; and (8) the Van Dyke Declaration, executed March 17, 1992.

On consideration of the record, including the above-listed materials, we reverse the examiner's prior art rejection.

Discussion

Review of the examiner's position in this case has proven difficult. In the amended Brief (Paper No. 44), applicant clearly and unambiguously argues the patentability of claims separately. See the amended Brief, section VII, where applicant sets forth nine groups of claims; and see section VIII E, where applicant presents separate arguments with respect to the patentability of each group of claims. The examiner's position, that applicant "fails to provide any reason why the grouped claims are separately patentable over the prior art of record," is factually incorrect. See the Examiner's Answer (Paper No. 45), page 2, fourth paragraph. Applicant strenuously pursues this point in the Reply Brief (Paper No. 46), pages 1 and 2, disputing the examiner's conclusion with respect to the grouping of claims. In a communication mailed by the examiner October 12, 2000 (Paper No. 47), the examiner states that "[t]he reply brief filed August 1, 2000 has been entered and considered." On this record, however, we have no statement from the examiner responding substantively to applicant's separate arguments with respect to nine groups of claims.

Compounding the examiner's error, with respect to grouping of the claims, is the treatment of rebuttal evidence attached to the Reply Brief. Specifically, applicant has

relied on additional evidence of non-obviousness attached to the Reply Brief, viz., Exhibits 1, 2, 3, and 4. Although it does not appear that applicant made a showing under Rule 195,¹ nevertheless, the examiner has not favored the record with a statement respecting the entry of this additional evidence. The examiner has not stated whether Exhibits 1, 2, 3, and 4 have been entered and considered. If those exhibits have been entered and considered, the examiner has offered no explanation why they do not provide an effective rebuttal of the rejection under 35 U.S.C. § 103.

We are presented in this appeal with a large number of claims of varying scope.

These claims include:

- (1) a method for treating, and thereby reducing, specified drug resistant cancers in a patient;
- (2) a pharmaceutical composition for treating multidrug resistant disease other than tuberculosis;
- (3) a pharmaceutical kit;
- (4) a method for treating a multidrug resistant disease;
- (5) a method for treating, and thereby reducing, multidrug resistant cancer in a patient by potentiating a primary anti-cancer drug to which said cancer exhibits multidrug resistance;
- (6) a method for treating, and thereby reducing drug resistant cancer in a patient; and
- (7) a pharmaceutical composition for reducing specified drug resistant cancers in a patient.

The examiner lumps all of applicant's claims together, rejecting them as a group under 35 U.S.C. § 103 as unpatentable over a combination of seven prior art references

¹ **§1.195 Affidavits or declarations after appeal.**

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

and the acknowledged state of the prior art. The examiner's statement of rejection, however, is short on specifics. As best we can judge, the examiner has not applied the teachings of any reference or references against any individual claim with a reasonable degree of specificity. Conspicuous by its absence from the Examiner's Answer (Paper No. 45), is application of the cited prior art to any individual claim. This is particularly egregious where, as here, applicant has presented extensive argument with respect to nine groups of claims, and relies on extensive evidence of non-obviousness in the record. See the instant specification; the DECLARATION OF DARYL BARNETT, executed August 19, 1994; the SECOND DECLARATION OF DARYL BARNETT, executed October 14, 1995; the THIRD DECLARATION OF DARYL BARNETT, executed January 8, 1998; and the Van Dyke Declaration, executed March 17, 1992.

Having carefully reviewed the Examiner's Answer, we find that the examiner's position with respect to applicant's rebuttal evidence may best be summarized as follows: "[a]bsent claims commensurate with the showing of unexpected benefits, or a showing reasonably commensurate with the instant claims, such claims remain properly rejected under 35 USC 103" (Paper No. 45, page 13). That critique of rebuttal evidence is less than satisfactory because (1) the examiner has not explained with a reasonable degree of specificity why any claim or claims would have been prima facie obvious under 35 U.S.C. § 103 based on the cited prior art; and (2) the examiner has essentially ignored arguments presented in applicant's Appeal Brief pertaining to the separate patentability of nine groups of claims. On this record, we think it fair to say that the examiner's shotgun statement of rejection and broad-brush critique of applicant's rebuttal evidence do not come to grips with the specific categories of claims

and claim limitations presented in this appeal. It is not the rebuttal evidence itself, but rather the shotgun statement of rejection and critique of applicant's rebuttal evidence which are not "commensurate in scope with the claims."

Under these circumstances, absent a statement of rejection and response to applicant's rebuttal evidence permitting meaningful review of the patentability of individual claims, we reverse the rejection of all of the appealed claims under 35 U.S.C. § 103.

The examiner's decision, rejecting claims 66 through 83, 89 through 99, and 105 through 156, is reversed.

REVERSED

)	
Sherman D. Winters)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
William F. Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
Donald E. Adams)	
Administrative Patent Judge)	

Appeal No. 2001-1164
Application No. 08/293,745

Page 8

James A. Mitchell
Price, Heneveld, Cooper, DeWitt & Litton
695 Kenmoor , SE
P.O. Box 2567
Grand Rapids, MI 49501

dem