

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte ANDRE CLAUSSNER, LUCIEN NEDELEC, DANIEL PHILIBERT
PATRICK VEN DE VELDE, FRANCOIS NIQUE and JEAN-GEORGES TEUTSCH

Appeal No. 2001-1221
Application No. 08/442,957

HEARD: July 9, 2002

Before WINTERS, SCHEINER and ADAMS, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15 and 19, the only claims remaining in the application. The claims on appeal are reproduced in the Appendix accompanying this opinion.

The references relied on by the examiner are:

Teutsch et al. (Teutsch)	4,912,097	Mar. 27, 1990
Loozen	5,272,140	Dec. 21, 1993

The claims stand rejected as follows:¹

- I. Claim 15 under 35 U.S.C. § 103 as unpatentable over Teutsch.
- II. Claim 15 under 35 U.S.C. § 103 as unpatentable over Loozen.
- III. Claim 19 under 35 U.S.C. § 103 as unpatentable over Loozen.

DISCUSSION

¹ Several rejections of the claims under 35 U.S.C. § 103 were withdrawn in the Examiner's Answer, and claim 19 was newly rejected over Loozen.

According to the examiner (Answer, page 4)

Teutsch [teaches] a genus of 19-nor steroid compounds having a keto group in the 3-position and double bonds in the 4 and 9 positions and a substituted phenyl group at the 11-position (cols. 1-6). The 11-phenyl group of the compounds are substituted with an alkynyl group of 2 to 8 carbon atoms which may be substituted with a hydroxy group (col. 1, lines 43-47). The 17-position substituents include those of the claims (col. 2). The compounds are taught to have antiprogestomimetic and antiglucocorticoid activities.

Similarly (id., page 5)

Loozen teaches a genus of 19-nor steroid compounds having a keto group in the 3-position and double bonds in the 4 and 9 positions. The compounds have a homocyclic or heterocyclic aryl group in the 11-position substituted with a hydrocarbon group of 1-10 carbon atoms which is substituted with oxo and/or hydroxyl groups (col. 1 to col. 2, line 9). The compounds are taught to have antiprogestinic activity (Col. 1, lines 27-29).

Further according to the examiner (id., pages 4, 5, and 6), each of the claims differs from the prior art

by reciting a more limited genus than the reference having an organic radical, which may be arylene, attached to the 11-position through a carbon atom which terminates in a CH₂OH group. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those of the claims having the hydroxy group attached to the terminal carbon of the 11-position substituent, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole.

There would appear to be no dispute that the claimed species and subgenus are encompassed by the generic 19-nor steroid formulas described in Teutsch and Loozen.

Nevertheless, without conceding that the claimed compounds would have been prima facie obvious over the prior art, appellants argue that the references “describe final products which have a particular pharmacological activity which is completely non-analogous to Applicants’ pharmacological activity,” thus, “the decision of [In re Magerlein, 602 F.2d 366, 202 USPQ 473 (CCPA 1979)] is pertinent to the present

situation wherein the CCPA held ‘Property of an end product may, under appropriate circumstances, be considered in the determination of the non-obviousness of the claimed intermediate.’” Brief, page 6. The examiner responds that appellants have not shown “that the claimed compounds, which are intermediates to patented compounds having antiproliferative activity, have any [sic, no?] known utility other than as intermediates, and that appellants “have not demonstrated, through direct comparison, that the claimed compounds possess unexpectedly superior antigluocorticoid, antigestagenic and/or antiprogestiometric properties to the closest prior art compound.” Examiner’s Answer, page 7.

In our view, these arguments are premature, as we find that the examiner’s initial burden of establishing a prima facie case of obviousness for the claimed invention has not been met.

The examiner’s position appears to be, quite simply, that each and every species encompassed by the references would have been obvious per se. While the proposition that “there is nothing unobvious in choosing ‘some’ among ‘many’ indiscriminately” has a certain appeal, In re Lemin, 332 F.2d 839, 841, 141 USPQ 814, 815 (CCPA 1964), our reviewing court has repeatedly indicated, in these or similar words, that “reliance on per se rules of obviousness is legally incorrect and . . . is simply inconsistent with section 103.” In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995); see also In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). Moreover, “[t]he fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.” In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994).

Several considerations are relevant to the determination of whether a species or

subgenus would have been obvious over a description of a genus encompassing the species or subgenus. Merely by way of example, the size of a genus relative to a claimed species or subgenus may have a bearing on the determination. A very broad genus, without more, may weigh against a determination that a species or relatively narrow subgenus is obvious over the genus; even a relatively small genus does not create an automatic presumption of obviousness - there must still be some reason, stemming from the prior art, to select the claimed species or subgenus, see, e.g., In re Baird, 16 F.3d at 382, 29 USPQ2d at 1552; In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992), (although, a very small genus may actually anticipate each member of the genus, see In re Petering, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

A related consideration is whether the prior art highlights any “typical,” “preferred,” or “optimum” species within the genus. Highlighted species different from those claimed may weigh against a determination of obviousness. In re Baird, 16 F.3d at 382, 29 USPQ2d at 1552. On the other hand, typical, preferred, or optimum species structurally similar to those claimed may be evidence supporting a determination of obviousness. In re Dillon, 919 F.2d 688, 696, 16 USPQ2d 1897, 1904 (Fed. Cir. 1990).

Yet another consideration is the disclosure of any useful properties of the prior art compounds. “[T]he lack of any disclosure of useful properties may indicate a lack of motivation to make related compounds,” or, more to the point here, a lack of motivation to select a species or subgenus from a disclosed genus, weighing against a determination of obviousness. See In re Dillon, 919 F.2d at 698, 16 USPQ2d at 1906.

With the exception of asserting that “any of the species of the genus would have similar properties” as the prior art genus, the examiner has addressed none of these

factors. In our judgment, the examiner's rejections are improperly based on a per se rule of obviousness, rather than on any reason or suggestion in Deutsch or Loozen to select the claimed species and subgenus from the generic formulas described therein. Accordingly, the examiner has not established a prima facie case of obviousness, and the rejections of claims 15 and 19 are reversed.

REVERSED

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Sherman D. Winters)	
Administrative Patent Judge)	
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Toni R. Scheiner)	APPEALS AND
Administrative Patent Judge)	
)	INTERFERENCES
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)	
Donald E. Adams)	
Administrative Patent Judge)	

Charles A. Muserlian
Bierman and Muserlian
600 Third Avenue
New York, NY 10016

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APPENDIX