

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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS MICHAEL BARE,
JAMES ROY EMPFIELD,
JANET MARIE FORST,
KEITH JOHN HERZOG,
and
RICHARD BRUCE SPARKS

Appeal No. 2003-0914
Application No. 09/192,713

ON BRIEF

Before WILLIAM F. SMITH, LIEBERMAN, and MILLS, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 47 through 54 which are all the claims pending in this application.

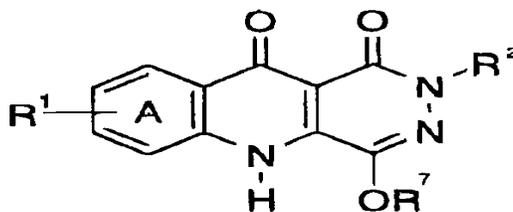
THE INVENTION

The invention is directed to alpha substituted pyridazino quinoline compounds which are fused heterocycles utilized as a pharmaceutical composition and having the formula illustrated in the claimed subject matter below.

THE CLAIM

Claim 47 is illustrative of appellants' invention and is reproduced below:

47. A compound of the formula Ia:



Ia

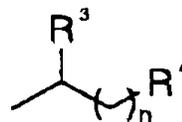
wherein:

R¹ is selected from hydrogen, halo, (C₁-C₄)alkyl and NO₂;

R² is a cycloalkyl moiety of 5-7 carbon atoms, or R² is a group selected from the formulae R^{2'} and R^{2''}



R^{2'}



R^{2''}

wherein:

R^3 is selected from CF_3 , $COOH$, $(C_1-C_6)alkylCOOH$, $(C_1-C_6) alkyl$ and $(C_1-C_6)alkylCF_3$;

n is selected from 0, 1 or 2;

R^4 is selected from $(C_1-C_3)alkyl$ or $(C_0-C_3)alkylphenyl$ wherein said phenyl moiety is substituted with 0, 1, 2, 3, 4 or 5 J moieties where J at each occurrence is selected from halogen, $(C_1-C_4)alkyl$, NO_2 , CN , perfluoro $(C_1-C_3)alkyl$, OH , CF_3 , $(C_2-C_4)alkenyl$, $(C_2-C_4)alkynyl$, or $O-(C_1-C_4)alkyl$;

R^5 is phenyl wherein the phenyl group is substituted with 0, 1, 2, 3, 4 or 5 J moieties where J is as in the definition of R^4 ;

R^6 is selected from hydrogen and $(C_1-C_3) alkyl$;

R^7 is selected from hydrogen and $C(O)(C_1-C_3)alkyl$, and with the proviso that said compound is not 7-chloro-4-hydroxy-2-[1-(N-phenylcarbamoyl)ethyl]-1,2,5,10-tetrahydropyridazino[4,5-b]quinoline-1,10-dione, 7-chloro-4-hydroxy-2-cyclohexyl-1,2,5,10-tetrahydropyridazino[4,5-b]quinoline-1,10-dione, 7-chloro-4-hydroxy-2-(1-methylbenzyl)-1,2,5,10-tetrahydropyridazino[4,5-b]quinoline-1,10-dione, 7-chloro-4-hydroxy-2-(1-methylbutyl)-1,2,5,10-tetrahydropyridazino[4,5-b]quinoline-1,10-dione, 7-chloro-4-hydroxy-2-(1-methyl-2-phenylethyl)-1,2,5,10-tetrahydropyridazino[4,5-b]quinoline-1,10-dione, or 7-chloro-4-hydroxy-2-(1,3-dimethylbutyl)-1,2,5,10-tetrahydropyridazino[4,5-b]quinoline-1,10-dione.

THE REFERENCE OF RECORD

As evidence in support of the obviousness type double patenting rejection, the examiner relies upon the following reference:

Bare et al. (Bare)

5,837,705

Nov. 17, 1998

THE REJECTION

Claims 47 through 54 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Bare, U.S. Patent No. 5,837,705.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner, and agree with the examiner that the rejection of the claims on the grounds of obviousness-type double patenting is well founded. Accordingly, we affirm the rejection.

As an initial matter, it is the appellants' position that, "[c]laims 47 to 54 inclusive are grouped together." See Brief, page 3. Accordingly, we select claim 47 as representative of the claimed subject matter and limit our consideration thereto. See 37 CFR § 1.192(c)(7)(2002).

The Double Patenting Rejection

All proper double patenting rejections rest on the fact that a patent has been issued and a later issuance of a second patent will continue protection beyond the date of expiration of the first patent of the very same invention claimed therein or of a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art. See In re Kaplan, 789 F.2d 1574, 1579-80, 229 USPQ 678, 683 (Fed. Cir. 1986).

Our analysis of the examiner's rejection of claim 47 under the doctrine of judicially created double patenting parallels that for a Section 103 rejection. While the double patenting rejection is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not usually prior art. In re Braat, 937 F.2d 589, 592-93, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985); In re Braithwaite, 379 F.2d 594, 600 n.4, 154 USPQ 29, 34 n.4 (CCPA 1967). When considering whether the claimed subject matter is an obvious variation of the invention defined in the claims of the 5,837,705 patent, the disclosure of the patent may not be used as prior art.

Our analysis of the claims before us necessarily requires a comparison of the claimed subject matter, claim 47, and claim 1 of the '705 patent. We find that claim 1 is directed to six species of the generic compound of claim 47, which species are excluded from the scope of claim 47 by a proviso specifically excluding them. The examiner has found and the appellants do not dispute that the "subject matter differs only in size of alkyl chain at 2-position where instant 'n' can vary from 0-2 from that particularly covered by the '705 patent." See Answer, page 4. We further find that each of the compounds in the '705 patent has a 7-chloro position designated in claim 47 as R¹. In contrast, claim 47 permits R¹ to be halo which is inclusive of chloro, bromo, fluoro and iodo.

The appellants however, argue that, “nothing in the description of the six specific compounds claimed in US ‘705 provides any motivation or suggestion to make anything other than those particular compounds.” See Brief page 7¹. It is agreed that, “an obvious rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. See In re Payne, 606 F.2d 303, 313-14, 203 USPQ 245, 254-55 (CCPA 1979). It is well settled however, that, “[t]he name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.” Id. On the record before us the excluded species of ‘705 differ from the generic formula of the claimed subject matter by the addition or deletion of methylene units, methyl units or the substitution of a halo unit. Each of these distinctions fall within the scope of structural obviousness. Accordingly, we conclude that the closeness of the relationship dictates that the compounds of the claimed subject matter are obvious variations of the compounds of claim 1 of the ‘705 patent.

It is furthermore the appellants position that inasmuch as any patent granted on the instant application will expire on the same day as the ‘705 patent, there is no reason to require a terminal disclaimer as, there is no “[u]njustified or improper extension of the right to exclude.” See Brief, pages 10 -11. Furthermore, the appellants point out that as

¹All references to the Brief are to the Amended Appeal Brief (Paper No. 26).

there is no overlap between the scope of the claimed subject matter and that of the '705 patent, "harassment on the basis of literal infringement by multiple assignees is not an issue in the present circumstances." See Brief, page 12. Accordingly, the appellants argue that the requirement for a terminal disclaimer is unwarranted. We disagree.

The judicially created doctrine of obviousness-type double patenting remains in effect and has not been eliminated by either Congress or any Federal court due to the recent revisions of the patent term provisions of 35 U.S.C. § 154; and, to the extent policy considerations have any bearing, on our decision making authority under 35 U.S.C. § 134. In addition, the policy rationale for the judicially created doctrine of obviousness type double patenting remains notwithstanding the current patent term provisions of 35 U.S.C. § 154.

The amendment in 1995 to 35 U.S.C. § 154 changed in general, the term of an issued patent from 17 years from the date of issue to 20 years from the date of application. The change took effect on June 8, 1995 and applied to utility and plant patent applications filed on or after that date. In 1999, Section 154 was amended again to include limitations on extending the term of certain patents and included a provision that:

No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

Therefore, Congress has, in the providing for the amended statute, specifically provided for in the statute the possibility of a terminal disclaimer being filed in an application filed on or after June 8, 1995.

Of even greater significance, however, is the fact that obviousness-type double patenting is a judicially created doctrine and we are therefore bound to look to our reviewing court for any evidence that the court has signaled the demise of the doctrine. In a recently issued decision, Eli Lilly & Co., Inc. v Barr Labs., Inc., 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001), the court provided evidence in the strongest manner imaginable that the doctrine was alive and well. The court held certain patent claims invalid on the grounds of obviousness-type double patenting. In their opinion, the court repeated its rationale for the doctrine as being, “to prevent unjustified timewise extension of the right to exclude granted by a patent.” Lilly at 251 F.3d 967-68, 58 USPQ2d 1878.

There are yet other compelling reasons for maintaining the requirement of a terminal disclaimer. Initially, the patent term extension provisions of 35 U.S.C. § 154 do not insure as the appellants have recognized, Brief, page 14, that any patent issuing on an application filed on or after June 8, 1995, will necessarily expire 20 years from the earliest filing date or from the earliest filing date for which benefit is claimed. Additionally, the rules of 37 C.F.R. § 1.321 (c)(3) still require that a properly filed terminal disclaimer include a statement that the patent and the application whose term is being disclaimed are

only enforceable for and during the period that the two are commonly owned.

Accordingly, not requiring a terminal disclaimer on the theory that no subsequently issued patent based on the first patent's filing date may be extended beyond twenty years for applications filed on or after June 8, 1995, would nullify the very purpose for which the rule was promulgated.

Finally, as to the issue of multiple harassment, there is a lengthy discussion by the court of a challenge to the requirement for maintaining the common assignment of ownership of two or more patents issuing from a parent and a divisional application wherein the filing of a terminal disclaimer has been required by this Office. See In re Van Ornum, 686 F.2d 937, 948, 214 USPQ 761, 770, (CCPA 1982). The court held that, "we consider it desirable to tie both the termination and the ownership of the two patents together, as required by § 1.321(b), and, seeing no substantial obstacle to doing so, hold it to be a valid regulation." Accordingly, we sustain the decision of the examiner.

DECISION

The rejection of claims 47 through 54 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,837,705 is affirmed.

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

WILLIAM F. SMITH
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

DEMETRA J. MILLS
Administrative Patent Judge

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