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for publication and is not binding precedent of the Board.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. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ULRICH STACHE,
HANS-GEORG ALPERMANN,
WALTER DURCKHEIMER, and
MANFRED BOHN

Appeal No. 2003-1034
Application No. 08/897,455

HEARD: October 23, 2003

Before ADAMS, MILLS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

VACATUR AND REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not susceptible to meaningful review and is thus not in condition for a decision on appeal. Accordingly, we vacate the pending rejection and remand the application to the examiner to consider the issues discussed herein and take appropriate action not inconsistent with the views expressed herein. Lest there be any misunderstanding, the term “vacate” in this context means to set aside or void. When the Board vacates an examiner’s rejection, the rejection is set aside and no longer exists. Cf. Ex parte Zambrano, 58 USPQ2d 1312, 1313 (Bd. Pat. App. & Int. 2001).

BACKGROUND

The claims are drawn to a corticoid 17,21-dicarboxylic ester or corticoid 17-carboxylic ester 21 carbonic ester of a specified formula. Claims 11-17 are pending. Claim 11 is representative of the claims on appeal and is reproduced in the attached appendix.

The Examiner relies upon the following references:

Oughton et al. (Oughton)	3,133,940	May 19, 1964
Bowers et al. (Bowers)	3.201,391	Aug. 17, 1965
Djerassi et al. (Djerassi)	3,201,429	Aug. 17, 1965
Page et al. (Page)	4,655,971	Apr. 7, 1987

Claims 11-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Page. Claims 11, 12 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Djerassi. Claims 11, 12 and 15-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bowers. And finally claims 11, 12, 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Oughton.

VACATUR AND REMAND

The board serves as a board of review, not a de novo examination tribunal. See 35 U.S.C. § 6(b) ("The [board] shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents."). The burden is on the examiner to set forth a prima facie case of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Findings of fact and conclusions of law must be made in accordance with the Administrative Procedure Act, 5 U.S.C. § 706 (A), (E) (1994). See Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact relied upon in making the obviousness rejection must be supported by substantial evidence within the

record. See In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

While we believe that one of the references cited by the examiner, the Djerassi reference, is relevant to the issue of the patentability of the claims, the rejection ignores what appears to be a particularly pertinent teaching of that reference. Thus, we will first focus on the rejection over Djerassi, and then address the rejections over Page, Bowers and Oughton.

Claims 11, 12 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Djerassi. Due to its brevity, the rejection is set forth below:

> Djerassi [ ] teach[es] a generic group of 17,21-diesters of 6α, 16α-dimethyl-4-pregen-17α,21-diol-3,20-diones. The reference teaches acyl groups such as acetyl and phenylpropionyl, the optional double bond in the 1-position and that the compounds exhibit anti-inflammatory and glycogenic activity.
>
> The instant claims differ from the reference by reciting specific species not exemplified by the reference, i.e., compounds wherein R(1) is phenyl which may be substituted as indicated by the claimed invention. However, Djerassi teach[es] a variety of specific acyl groups including phenylroprionyl attached to the 21 position. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the present application to select any of the species of the genus taught by the reference, including those of the instant claims, because he would have the reasonable expectation that any species of the genus would have similar properties, and, thus, the same use as the genus as a whole. The motivation to make the claimed compounds is based on the desire to make additional compounds useful as taught by the prior art.

Examiner's Answer, pages 4-5 (citations omitted).

The examiner's rejection appears to be predicated on the proposition that the description of a genus renders each and every species that are members of the genus obvious. Such a broad per se rule of obviousness, however, is not correct interpretation of the case law. A broad disclosure of a genus does not

render any species that falls within it obvious. See In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992); In re Baird, 16 F.3d 380, 382-83, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). There need be some teaching or suggestion to lead the ordinary artisan to select the claimed compound. See Baird, 16 F.3d at 382, 29 USPQ2d at 1552. The disclosure of phenylproprionates in a long laundry list of acceptable substituents does not, in and of itself, lead one to the claimed compounds.

As noted by the examiner in the response to arguments, however, Djerassi specifically exemplifies a compound having a phenyl group at the 21 position, the 17,21-dienzoates in Example XII. See Examiner's Answer, page 7. Thus the issue becomes does the exemplification of the benzoate at the 21 position, along with the disclosure of the phenylproprionate as one of the possible substituents at the 21 position, fairly suggest the claimed compounds. We find that the issue was not fairly before appellants, as citing to that specific example of Djerassi in the response to arguments in the Examiner's Answer can not be interpreted as being part of the rejection on appeal. See, e.g., In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986) (noting that the court would not condone the presentation of new grounds of rejection for the first time on appeal).

The examiner has thus failed to address relevant teachings of the Djerassi reference in the context of the rejection, and thus the fact finding is incomplete and the issue is not susceptible to meaningful review. Because the rejection failed to rely on those teachings of the Djerassi reference, we vacate the

rejection. The rejection is not reversed, however, because, as we note above, the teachings of that reference appear to be relevant to the patentability of the claimed methods.

We are also vacating the rejections over Page, Bowers and Oughton. With respect to the rejection of claims 11-17 under 35 U.S.C. § 103(a) as obvious over Page, the examiner states:

> Page [ ] generically teach[es] 17,21-dicarboxylic acid esters of 4-pregnen-3,20-dione having an oxo, halogen or a hydroxyl group in the 11-position and substituents in the 6, 9 and 16 positions which include those recited by the claimed invention. The reference teaches the compounds may also contain a double bond in the 1-position and the use of the compounds in the treatment of corticosteroid-responsive dermatosis.
>
> The instant claims differ from the reference by reciting specific species not exemplified by the reference, i.e., compounds wherein R(1) is phenyl which may be substituted as indicated by the claimed invention. However, the generic disclosure of Page suggests most of the substituents of the claimed "Markush" structure including the claimed aralkyl ester group attached to the 21-position. Page discloses compounds of formula (I) wherein R_5 is OC(O)-R'', wherein R'' is an alkyl group of 1 to 16 carbon atoms, a phenyl group or an aralkyl group of 7 to 8 carbon atoms (i.e., -$(CH_2)_{1-2}$-phenyl). Applicant's claimed compound defining R(1) as a phenyl group is thus within the scope of the disclosure of Page [ ]. The motivation to make the claimed compounds is based on the desire to make additional compounds useful in the treatment of corticosteroid-responsive dermatosis as taught by the prior art.

Examiner's Answer, pages 3-4 (citations omitted).

The rejection over Page suffers from the same deficiencies as the rejection over Djerassi. Again, a broad disclosure of a genus does not render any species that falls within it obvious, rather, there need be some teaching or suggestion to lead the ordinary artisan to select the claimed compound. The examiner asserts in the response to arguments that sixteen of the thirty-three

compounds have a 21-ester substituent and that Page teaches that when R5 is RCOO, R is one of three groups, an alkyl group, an aralkyl group or a phenyl group. However, as Page exemplifies only sixteen esters, and as none of the thirty-three compounds exemplified by Page has a phenyl substituent in the 21 position, the reference does not direct one of ordinary skill in the art to the use of the aralkyl group.

Finally, with respect to the rejection over Bowers and the rejection over Oughton, the examiner again concludes:

> [I]t would have been obvious to one having ordinary skill in the art at the time of the present application to select any of the species of the genus taught by the reference including those of the instant claims, because he 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. The motivation to make the claimed compounds is based on the desire to make additional compounds useful as taught by the prior art.

Examiner's Answer, pages 5-6. Thus, the rejection over Bowers and the rejection over Oughton are vacated for the same reasons as set forth above.

FUTURE PROCEEDINGS

Upon remand, the examiner should address the patentability of the claims in accordance with this opinion. The patentability of the pending claims should be addressed in view of the Djerassi reference, as discussed above, and any other reference that the examiner may feel is relevant to the patentability of the claim. If a rejection is made under 35 U.S.C. § 103, we suggest the examiner adhere to the model set forth in The Manual of Patent Examining Procedure (MPEP) § 706.02(j). Use of that model will ensure that the examiner perform the

fact-finding and will require the examiner to perform the needed claim-by-claim analysis of the subject matter of the pending claims.

The case is being returned to the jurisdiction of the examiner for further action. If prosecution is resumed, we state that we are not authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1).

VACATED and REMANDED

Donald A. Adams	)
Administrative Patent Judge	)
	)
	)
	) BOARD OF PATENT
Demetra J. Mills	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
Lora M. Green	)
Administrative Patent Judge	)

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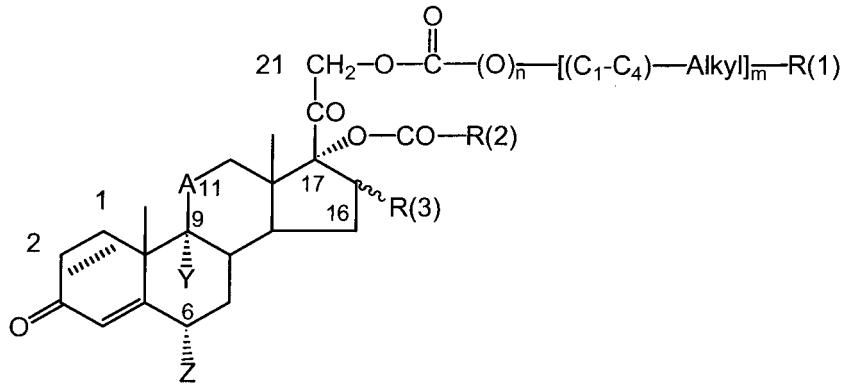
Appendix

11. A corticoid 17,21-dicarboxylic ester or corticosteroid 17-carboxylic ester 21-carbonic ester of the formula I



wherein:

A is CHOH or CHCl in arbitrary steric arrangement, CH_2, C=O or 9(11) double bond,

Y is hydrogen, fluorine or chlorine,

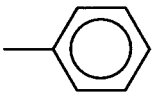
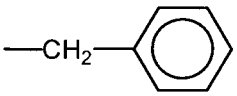
Z is hydrogen, fluorine or methyl,

R(1) is unsubstituted phenyl or phenyl substituted by one to three substituents selected from the group consisting of methoxy, chlorine, fluorine, methyl, trifluoromethyl, acetamino, acetaminomethyl, t-butoxy, t-butyl, 3,4-methylenedioxy, BOC-amino, amino and dimethylamino,

$(C_1\text{-}C_4)$-alkyl is saturated,

n is zero,

m is 1,

R(2) is linear or branched $(C_1\text{-}C_8)$-alkyl,  or  ,

R(3) is hydrogen or α- or β-methyl.