

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOHN ZENK

Appeal No. 2006-2325
Application No. 10/340,980

ON BRIEF

Before SCHEINER, ADAMS, and LEBOVITZ, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of modulating the metabolism of a dieting mammal comprising administration of a metabolic modulating agent to the dieting mammal wherein the metabolic modulating agent is 7-oxo DHEA or a pro-drug thereof incapable of in vivo conversion to testosterone.

The references relied upon by the examiner are:

Partridge et al. (Partridge)

5,296,481

Mar. 22, 1994

GROUND OF REJECTION

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Partridge.

We reverse.

DISCUSSION

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Partridge.

Claim Construction:

Appellant's claims are drawn to a method of modulating the metabolism of a dieting mammal. See e.g., claim 1. The method comprises administering 7-oxo DHEA¹ to the dieting mammal. Id. As set forth above, appellant's specification (paragraph 5) defines "dieting" as "eating and drinking sparingly with the intent to lose weight." Therefore, as we understand it, appellant's claims are drawn to a method comprising administering 7-oxo DHEA to a mammal who is eating and drinking sparingly with the intent to lose weight.

Partridge:

Appellant concedes that Partridge teaches the administration of 7-oxo DHEA to a human subject with the intent to control weight gain or promote

¹ Or a pro-drug thereof incapable of in vivo conversion to testosterone. See e.g., claim 1.

weight loss. Brief, bridging paragraph, pages 3-4. In addition, appellant does not dispute the examiner's assertion (Answer, bridging sentence, pages 3-4) that Partridge teaches the administration of 7-oxo DHEA to a mammal in the same amount as is required by appellant's invention.

Accordingly, as we understand it, the sole issue before us on appeal is whether the patient population in Partridge describes a patient population species/genus required by appellant's claimed invention. Stated differently, the issue is not whether the administration of 7-oxo DHEA will modulate the metabolism of a mammal who is "eating and drinking sparingly with the intent to lose weight." Instead, the issue is whether Partridge discloses the administration of 7-oxo DHEA to a mammal who is "eating and drinking sparingly with the intent to lose weight." Cf. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1378, 77 USPQ2d 1321, 1328 (Fed. Cir. 2005).

According to appellant (Brief, page 4), Partridge's patient population is different than the patient population required by the instant claims. Specifically, appellant asserts (id., emphasis removed) that paragraph 5 of their specification defines "dieting" . . . as 'eating and drinking sparingly with the intent to lose weight.' In contrast, appellant points out (Brief, page 4), the examiner has taken the position "that a 'dieting mammal' includes humans whose diet is limited due to that individual's personal preferences." According to appellant (Brief, page 4), the examiner's definition of a dieting mammal is different from the definition provided in paragraph 5 of appellant's specification, thus Partridge does not anticipate the claimed invention.

According to the examiner (Answer, page 4), the “obese^[2] patients” treated in Partridge overlap “the dieting mammal” required by appellant’s claimed invention because according to the examiner “obese patients are generally on [a] diet.” There is simply no evidence on this record to support this assertion. In addition, appellant points out (Brief, page 4) that during prosecution the examiner interpreted the term “dieting mammal” as a person or animal “whose diet is limited due to that individual’s personal preferences.” Cf. Final Rejection, mailed September 9, 2004, page 3, where the examiner interprets appellant’s claim term “dieting mammal” as “a person or animal with special or usual preferences of what he/she eats and drinks, the subjects being treated by Partridge et al. encompasses [this] same population.” Again there is no evidence on this record to support this assertion.

The examiner may be correct in that it is theoretically possible that some of Partridge’s patients take 7-oxo DHEA while eating and drinking sparingly with the intent to lose weight. However, since Partridge fails to disclose the administration of 7-oxo DHEA together with a dieting regime, the examiner’s argument is no more than an unsubstantiated theoretical possibility, which is insufficient to support the anticipation rejection of record. Cf. Jansen v. Rexall Sundown, Inc., 342 F.3d 1329, 1344, 68 USPQ2d 1154, 1159 (Fed. Cir. 2003) (“a theoretical possibility or ‘metaphysical doubt,’ ... is insufficient to create a genuine issue of material fact.”)

² The Partridge patent mentions the term “obese” twice, once each in claims 12 and 17. In both instances, Partridge fails to indicate that the “obese subject” is on any type of diet or is eating or drinking sparingly with the intent to lose weight.

On reflection, we find that the examiner failed to meet his evidentiary burdun of establishing a prima facie case of anticipation. Accordingly, we reverse the rejection of claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by Patridge

REVERSED

Toni R. Scheiner)
Administrative Patent Judge)
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