

The opinion in support of the decision being entered today  
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DOUGLAS W. DANIELSON, STEVEN S. SCHUEHLE,  
and SHIRISH A. SHAH

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Appeal 2006-3086  
Application 10/260,882  
Technology Center 3600

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Decided: September 6, 2007

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Before DONALD E. ADAMS, ERIC GRIMES, and LORA M. GREEN,  
*Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 2-11 and 13-32, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

## INTRODUCTION

The claims are directed to a pharmaceutical composition. Claim 2 is illustrative:

2. A pharmaceutical composition comprising granular simethicone blended with a processing aid amount of magnesium carbonate in which the ratio of the magnesium carbonate to simethicone contained in the granular simethicone is from about 90:125 to about 115:125.

The Examiner relies on the following prior art references to show unpatentability:

Crowley	US 4,301,149	Nov. 17, 1981
Wehling	US 5,219,574	Jun. 15, 1993
Stevens	US 5,599,577	Feb. 4, 1997

The rejection as presented by the Examiner is as follows:

Claims 2-11 and 13-32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Stevens and either Wehling or Crowley.

We reverse.

## DISCUSSION

The issue in this case is whether it would have been *prima facie* obvious to a person of ordinary skill in the art to formulate a composition comprising a blend of simethicone and magnesium carbonate. Since all claims on appeal require the combination of simethicone with magnesium carbonate we find claim 2 to be representative. Claim 2 is drawn to a pharmaceutical composition comprising two blended components: (a) about

125 parts granular simethicone and (b) about 90-115 parts magnesium carbonate.<sup>1</sup>

Simethicone is available in a liquid, powder, and granulated form; “effective for use as an anti-gas and antiflatulent” (Specification 1: ¶¶ 2-3). Stevens teaches that “[t]he most common dosage formulations for simethicone are combinations of simethicone with various separate antacids. In this dosage formulation it is necessary to separate the simethicone from the antacid to avoid the inactivation of the simethicone” (Stevens, col. 1, ll. 23-27).

A property of magnesium carbonate is that it is capable of acting as an antacid (Specification 2: ¶ 7). In addition, the Examiner finds that magnesium carbonate has been used in the art as a lubricant (Wehling) and filler (Crowley) in the formulation of pharmaceutical compositions into tablets (Answer 4). According to the Examiner, since Stevens, Wehling and Crowley do not teach that magnesium carbonate has the property of being capable of acting as an antacid, this property of magnesium carbonate is irrelevant to the obviousness rejection of record (Answer 5-6). We disagree, “[f]rom the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same.” *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963).

We recognize the Examiner’s assertion that the instant claims are directed to a composition, and not a method for treating gastrointestinal disorders amenable to treatment with simethicone (Answer 5). While this may be true, the Examiner relies on Stevens to teach a pharmaceutical

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<sup>1</sup> More simply the claimed composition comprises about 5 parts granular simethicone and about 3.6-4.6 parts magnesium carbonate.

composition comprising simethicone. Stevens teaches that simethicone is one of the active ingredients in the pharmaceutical composition (Stevens, col. 1, ll. 42-55). Stevens teaches that fillers and lubricants may also be added as excipients in the pharmaceutical composition comprising simethicone (Stevens, col. 5, ll. 35-64). The Examiner relies on Wehling and Crowley for a teaching that it would have been obvious to modify Stevens' composition by using magnesium carbonate as the lubricant or filler (Answer 4). This is, however, exactly what Stevens expressly states that one should not do. Specifically, when formulating an antacid with simethicone "it is necessary to separate the simethicone from the antacid to avoid the inactivation of the simethicone" (Stevens, col. 1, ll. 23-27).

Therefore, the rationale set forth by the Examiner is contrary to the express teachings in the prior art relied upon and would lead to the inactivation of one of the active agents in Steven's composition. As Appellants explain,

if a proposal for modifying the prior art in an effort to attain a claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. See *In re Fritch*, 972 F.2d 1260, 1265 n. 12, 23 U.S.P.Q.2d 1780, 1783 n. 12 (Fed. Cir. 1992).

(Reply Br. 5.) We agree, and the rejection of claims 2-11 and 13-32 under 35 U.S.C. § 103(a) as unpatentable over the combination of Stevens and either Wehling or Crowley is reversed.

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## CONCLUSION

In summary, we reverse the rejection of record.

REVERSED

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PRICE HENEVELD COOPER DEWITT & LITTON, LLP  
695 KENMOOR, S.E.  
P O BOX 2567  
GRAND RAPIDS MI 49501