

The opinion in support of the decision being entered today is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte Moeckel et al.¹

Appeal No. 2006-3234
Reexamination No. 90/006,410

HEARD: 9 January 2007

Before TORCZON, LANE, and TIERNEY, Administrative Patent Judges.

LANE, Administrative Patent Judge.

DECISION ON APPEAL-37 CFR § 41.50

I. Statement of the case

¹ According to patentee, the real party in interest is Alpharma Inc., the assignee of Roche Diagnostic GmbH. (Appeal Brief (“Brief”) at 2).

The patent under reexamination is US patent 5,955,106, issued on 21 September 1999 from application 08/793,753, filed 14 March 1997. ('106).²

In her rejections of claims 1-138, all the pending claims, the examiner relies upon the following references:

(1) Red List, Pharmaceutical Directory of the BPI (German Federal Association of the Pharmaceutical Industry) (1993). (Red List)

(2) Abdallah, et al., STP Pharma, 41(1), 1998, 15-20. (Abdallah).

(3) Evenstad, US 5,126,145, issued on 30 June 1992 from application 07/536,184, filed 11 June 1990. (Evenstad).

(4) Otaya, et al., Ann. Repts. Shionogi Rserach Labs. (1) (1954), 462-64. (Otaya).

(Examiner's Answer ("Answer") at 3-4).

The examiner also relies upon a declaration from Bernd Schneider, said to be an employee of Medice Arzneimittel Pütter GmbH & Co. KG. (Schneider declaration).

Claims 1-4, 8-11, 20-23, 30-38, 40, 41, 45, 68, 69, 72, 73, 82-101, 104, and 105 are rejected under 35 USC §102(b) as being anticipated by the Red List. (Answer at 4).

Claims 1-33, 37-59, 62-94, 96, 97, 100-122, and 127-138 are rejected under 35 USC § 103(a) as being obvious over Abdallah in view of Evenstad. (Answer at 5), while claims 34-36, 60, 61, 95, 98, 99 and 123-126 are rejected under 35 USC § 103(a) as being obvious over Abdallah and

² The application is said to have been filed under 35 USC § 371 on 14 March 1997, based on PCT/EP/03610, filed 14 September 1995 (published as WO96/08243 on 21 March 1996).

Evenstad “as applied to claims 1-33, 37-59, 62-94, 96, 97, 100-122 and 127-138 and further in view of Otaya et al.” (Answer at 3).

We affirm the rejection made under 35 USC § 102(b). We also affirm the rejection made under 35 USC § 103(a) in view of Abdallah, Evenstad and Otaya but, because the examiner did not specifically apply Otaya in rejecting claims 1-33, 37-59, 62-94, 96, 97, 100-122, and 127-138, we designate the rejection of those claims as a new ground of rejection. 37 CFR 41.50(b).

II. Findings of fact

The record supports the following findings of fact by at least a preponderance of the evidence.

1. Claim 1 reads as follows:
Pharmaceutical composition comprising metformin as the active substance and a hydrocolloid forming retarding agent, wherein the pharmaceutical composition has a residual moisture content of about 0.5-3% by weight.
2. Claim 1 is representative of claims 1-138.
3. The Appellant’s brief does not include a statement that or reasons why the rejected claims do not stand or fall together as to each rejection.³
4. Metformin hydrochloride is called metformin in the ‘106 disclosure. (‘106 at 1:4-6).

³ Moreover, in its reply brief, the appellant did not take issue with the examiner’s statement that “the appellant’s brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof.” (Answer at 3).

5. Polyvinylpyrrolidone is disclosed and claimed as a “hydrocolloid forming retarding agent.” (‘106 at 3:20-33 and e.g., claim 4).
6. According to the ‘106 disclosure “[t]he retarded tablets according to the invention release metformin in a controlled manner over a time period of 0.5-10 hours preferably over 4 hours.” (‘106 at 5:31-33).
7. Claim 1 does not contain a limitation requiring “controlled release” over a particular time frame.
8. The level of skill in the art is reflected by the prior art relied upon by the examiner in rejecting the claims and the other prior art of record.

Red List

9. The examiner rejected claims 1-4, 8-11, 20-23, 30-38, 40, 41, 45, 68, 69, 72, 73, 82-101, 104, and 105 under 35 USC §102(b) as being anticipated by the Red List. (Answer at 4).
10. The Red List is a German publication and is said to be a list of pharmaceutical products “on sale and in use in Europe.” (Brief at 5).
11. The Red List discloses the product “Mediabet” as a tablet containing “metformin-HCl” (metformin) as well as “auxiliary ingredients” including “polyvidone [polyvinylpyrrolidone]”.
12. There is no evidence before us indicating that Mediabet was ever on sale or in use in the United States.
13. Based on the Schneider declaration, we find that:

- a. Schneider has been employed by the manufacturer of Mediabet tablets since October of 1972 and was familiar with the Mediabet preparation. (Schneider declaration at page 1 and ¶ 1).
 - b. As of 26 February 1993, the tablet core of Mediabet contained, in addition to metformin, soluble polyvinylpyrrolidone. (Schneider declaration at ¶ 3).
 - c. “Before tableting, the pharmaceutical composition of MEDIABET was adjusted to a residual moisture content of no more than 2.0 weight % (measured as drying loss) [and that] [t]he residual moisture content also exceeded a lower threshold of 0.5%...”. (Schneider declaration at ¶3).
14. Our own review of the Schneider declaration in combination with the Red List shows a slight difference between the formulation of Mediabet reported by Schneider and that reported by the Red List.
 15. For example, Schneider reports that the coating of the metformin tablet contained “methylhydroxy propyl cellulose” while the Red List reports a “methyl cellulose” component. (Schneider declaration at ¶5 and Red List at entry 11 081).
 16. Appellant does not note these differences nor argue that the differences between the reported compositions of Mediabet would affect residual moisture content.
 17. Appellant has not directed us to evidence establishing that tableting would affect residual moisture content.

Abdallah

18. Abdallah discloses controlled release metformin tablets containing methyl cellulose made using coprecipitation technique. (Abdallah at 16).
19. Alkyl celluloses, including methyl cellulose particularly, are disclosed and claimed as “hydrocolloid forming retarding agents” in the ‘106 patent. (‘106 at 3:20-33 and e.g., claims 6 and 7).
20. Abdallah reports that methyl cellulose is “a hydrophilic polymer” and a “hydrocolloid” (Abdallah at 18).
21. Abdallah does not disclose the residual moisture content of its prepared tablets.

Otaya

22. The examiner rejected claims 34-36, 60, 61, 95, 98, 99 and 123-126 under 35 USC § 103(a) as being obvious over Abdallah, Evenstad, and Otaya. (Answer at 7).
23. Appellants do not argue any of these rejected claims, which primarily recite limitations regarding capping, separately from any other rejected claim.
24. Claim 35, for example, reads as follows:
The composition of claim 1, wherein compression of the admixture into tablets is without large losses from capping.
25. An “object” of the ‘106 invention is to “solve the problem of capping.” (‘106 at 1:52-55).

26. The '106 disclosure lists “inadequate or excessive moisture content of the granulate” as a possible cause of capping. (‘106 at 2:2-7).
27. Otaya also recognizes a link between moisture content and capping.
28. Otaya “found that capping depended on the amount of moisture and could be almost completely eliminated.” (Otaya at 1).
29. Otaya discloses that “it is a well-known fact that when a medicine is made into a tablet by a stamping machine, in nearly all cases a binding agent is added to the formation” and that “even if a binding agent is added, capping often occurs.” (Otaya at 1).
30. Otaya describes an “experiment” where the drug sulfamin was made into tablets. (Otaya at 1).
31. Otaya used sulfamin tablets having various moisture contents in the range of .24% to 1.25%. (Otaya at 4, Table 2).
32. Otaya concluded that “[g]ranule moisture is an important cause of capping[,]...the greater the stamping pressure, the stronger the capping tendency;...[t]here is no correlation between hardness and capping;...[and] the size of sulfamin crystal particles had little effect on capping”. (Otaya at 4).
33. Otaya does not disclose a tablet containing metformin.

Evenstad

34. Evenstad teaches tablets formed by a wet granulation technique using an aqueous solvent, hydroxypropyl cellulose for

controlling drug release, and a water soluble drug such as niacin. (Evenstad at 1:63-2:42).

35. Evenstad discloses that “the hydrophobic component blend, the sustaining hydroxypropyl methylcellulose, and the medicament are granulated using the binding agent solution to a final moisture level of less than about 7 percent, preferably less than about 5 percent.” (Evenstad at 5:42-46).
36. Evenstad does not disclose tablets containing metformin.

Vilkov declarations

37. Appellant submitted two declarations of Dr. Zalman Vilkov.
38. Dr. Vilkov identified himself as an employee of “Purepac Pharmaceutical Co., a subsidiary of Alpharma Inc.”, said to be Appellant’s real party in interest. (Vilkov declaration at ¶ 1 and Brief at 2).
39. In the first declaration, Dr. Vilkov testified as follows:
- a) In tablets with a relatively high proportion of active agent, the tableting characteristics of the active agent, as opposed to the excipient (such as a hydrocolloid-forming polymer), dominate. Metformin exhibits very poor tableting characteristics, including poor compressibility and a high tendency to cap.

(Vilkov declaration at ¶ 9).

- b) Pharmaceutical formulation is a very unpredictable art. Every active agent and excipient has unique tableting properties. Data pertaining to one active agent and type of excipient does not necessarily apply to a different active agent and type of excipient. Modifying one tablet parameter can further more affect more than one tablet property in an unpredictable way. As a result,

one of ordinary skill in the art would not look to sources examining optimum moisture content levels for a different active agent in order to determine the appropriate moisture content for an extended release metformin product.

(Vilkov declaration at ¶ 9).

c) Abdallah discloses that the wet granulation technique was successful with the following water insoluble polymers [including] ethyl cellulose. These polymers, as described in Abdallah, are framework-forming agents used in an organic solvent-based wet granulation process. These polymers do not form hydrocolloids.

(Vilkov declaration at ¶ 4).

40. In the second Vilkov declaration, Dr. Vilkov discusses testing where he “reproduced Example 1 of the ‘106 patent.” (Second Vilkov declaration at ¶ 1).
41. The tested tablets were said to have been formulated using metformin, hydroxypropyl methylcellulose, povidone, purified water and magnesium stearate and then compressed using various levels of compression force. (Second Vilkov declaration at ¶¶ 2-4).
42. The “results and observations” section of the testing showed “capping” at all levels of compression force for tablets having a residual moisture content of .49%, but “no capping” at all levels of compression force for tablets having residual moisture contents of 1%, 2%, and 2.25% . (Second Vilkov declaration at ¶ 4).

43. Tablets having a residual moisture content of 3% were said either to be “soggy tablets” (at 10kN compression force) or to show “capping” (at 20kN compression force). (Second Vilkov declaration at ¶ 4).
44. Tablets having a residual moisture content of 4% were said to be “soggy tablets” which “broke on compression”. (Second Vilkov declaration at ¶ 4).

III. Legal Principles

We read the claims in view of the specification. A limitation may not be read into a claim from the specification, but it is appropriate to look to the specification to define a limitation already in the claim. Elekta Instr. S.A. v. O.U.R. Sci. Int'l, Inc., 214 F.3d 1302, 1307, 54 USPQ2d 1910, 1913 (Fed. Cir. 2000).

35 USC § 102(b)

“A person shall be entitled to a patent unlessthe invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States” 35 USC § 102(b).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A single embodiment of more broadly claimed subject matter constitutes a description of the invention for anticipation purposes. Vas-cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "[A]fter the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellant to 'prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.'" In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971)."

35 USC § 103(a)

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 USC § 103(a).

In considering whether claims are patentable under 35 USC § 103(a) we consider the scope and content of the prior art, the differences between the prior art and the claims at issue, the level of ordinary skill in the pertinent art and any secondary considerations that would bear upon obviousness. Graham v. John Deere, 382 US 1, 16 (1966).

One of these secondary considerations is evidence of unexpected results. To be persuasive, the showing of unexpected results must be

commensurate in scope with the claimed subject matter. In re Peterson, 315 F.3d 1325, 1330-31, 65 USPQ2d 1379, 1383 (Fed. Cir. 2003).

Unpredictability within an art may be considered in determining if there is a reasonable expectation of success. However, a reasonable, not an absolute, expectation of success is all that is required for obviousness.

“[O]bviousness cannot be avoided simply by a showing of some degree of unpredictability in the art so long as there was a reasonable probability of success.” Pfizer v. Apotex, ---F.3d ---, 2007 WL 851203 (Fed. Cir. 2007).

Expert testimony may be submitted by affidavit in response to a rejection. 37 CFR §1.132. However, an expert’s testimony will be given little or no weight unless the testimony is supported by facts. In re Etter, 756 F.2d 852, 860, 225 USPQ 1, 6 (Fed. Cir. 1985). Argument of counsel cannot take the place of evidence lacking in the record. Estee Lauder Inc. v. L’Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1609, 1615 (Fed. Cir. 1997).

IV. Analysis

35 USC § 102(b)

We understand the examiner’s rejection under 35 USC §102(b) over the Red List to be based on the “printed publication” and not the “public use” of Mediabet. Thus, we are unpersuaded by Appellant’s arguments that Mediabet has not been shown to have been publically used or sold in the United States. (Brief at 5).

Claim 1 is directed to a pharmaceutical composition containing metformin and a hydrocolloid forming retarding agent wherein the composition has a residual moisture content of about 0.5-3% by weight.

According to the Red List, Mediabet is a film-coated tablet containing metformin and polyvinylpyrrolidone, the latter of which is identified as an

“auxiliary ingredient.” Appellant discloses and claims polyvinylpyrrolidone as a hydrocolloid forming retarding agent within the scope of claim 1. Thus polyvinylpyrrolidone, on its face, appears to meet the claim limitation of “hydrocolloid forming retarding agent.”

Appellant argues that “various substances such as polyvinylpyrrolidone and methylhydroxypropyl cellulose may or may not act as hydrocolloid forming retarding agents, depending on factors such as molecular weight and/or viscosity of the specific grade that is used.” (Brief at 6). Appellant directs us to the following statement in the Handbook of Pharmaceutical Excipients, Fourth Edition (2003), p 296:

High viscosity grades [of hydroxypropylmethylcellulose] may be used to retard the release of drugs from a matrix at levels of 10-30% w/w in tablets and capsules.

It is Appellant’s burden to show that the polyvinylpyrrolidone of Mediabet is not a “hydrocolloid forming retarding agent” within the meaning of claim 1. This statement, which is not directed to polyvinylpyrrolidone, does not show that the polyvinylpyrrolidone of Mediabet cannot act as a hydrocolloid retarding agent within the meaning of claim 1. Furthermore, Appellant has not pointed out where, within claim 1, there is a requirement for polyvinylpyrrolidone having a particular molecular weight or viscosity.

Appellant argues that the Red List “does not teach that the MEDIABET tablets were an extended release product” and that the product specifications found in the Schneider declaration indicate that “[u]nquestionably, this release profile [of Mediabet] is that of an immediate release product.” (Brief at 6). Appellant has not explained why we should

construe its claim 1 as requiring a particular release rate. While the '106 disclosure states that the tablets of the invention release metformin "over a period of .5-10 hours" a release limitation is not found in the pharmaceutical composition of claim 1.⁴ While we construe a claim in view of the specification, we will not add a limitation to a claim where that limitation appears only in the specification. We also do not find that the specification gives a special definition of the term "hydrocolloid forming retarding agent" that would result in the term requiring the claimed composition to have a particular release rate.

As noted by the examiner, the Red List does not identify the residual moisture content of Mediabet. However, Schneider's declaration indicates that the product known as Mediabet had a pre-tableting residual moisture content of "no more than 2.0 weight % (measured as drying loss) [and that t]he residual moisture content also exceeded a lower threshold of 0.5%..." Appellant does not take issue with this portion of the Schneider declaration.

We find that the examiner has met her burden of showing a sufficient basis to support a determination that Mediabet would inherently have the residual moisture content required by claim 1. Given this showing, it is Appellant's burden to show that Mediabet does not inherently possess the claimed residual moisture content.

Appellant argues, but has not directed us to evidence sufficient to show, that the pre-tablet composition of Mediabet "could be altered by additional drying steps or by the use of additional excipients, such as a

⁴ We note that the Schneider declaration contains a record of a test of Mediabet showing a required release of the active ingredient at a rate of ">70% in 30 min" and a finding of a "95.75%" release in 30 minutes.

coating” so that the residual content of the actual Mediabet tablet would not fall within the claimed range of 0.5-3% by weight. (Brief at 5). We are not persuaded by the unsupported arguments of Appellant and find these arguments insufficient to rebut the examiner’s showing of inherency. Moreover, appellant’s argument is inconsistent with its own specification which reports adjusting residual moisture content to within the claimed range prior to tableting. (See, e.g., ‘106 at 5:13-19 and example 1 at 6:28-32).

We note that our own review of the Schneider declaration in combination with the Red List, shows a slight difference between the formulation of Mediabet reported by Schneider and that reported by the Red List. Appellant does not argue that the differences between the reported compositions of Mediabet would affect residual moisture content.

Given the close similarity between the formulation of Mediabet reported by Schneider and that reported by the Red List, we find that the Schneider declaration provided the examiner with a sufficient basis to support her determination of inherency. Thus, we do not find that the slight difference we found negatively affects the examiner’s showing of inherency.

The examiner’s rejection of claims 1-4, 8-11, 20-23, 30-38, 40, 41, 45, 68, 69, 72, 73, 82-101, 104, and 105 under 35 USC §102(b) is AFFIRMED.

B. 35 USC 103(a)

The examiner relies upon Abdallah in rejecting all the claims under 35 USC § 103(a). Abdallah teaches a tablet containing a mixture of metformin and methyl cellulose. Abdallah does not disclose the residual moisture content of the mixture. Appellant concedes that the methyl cellulose found

in tablets of Abdallah acts as a “hydrocolloid forming extended release agent.” (Brief at 8).

Like Appellant, Otaya recognizes that capping is a problem in the tablet making art. Otaya reported that “capping depended on the amount of moisture and could be almost completely eliminated.” (Otaya at 1).

Thus, at the time of the present invention, one skilled in the art would have known:

- (1) how to make tablets containing metformin and a hydrocolloid forming retarding agent,
- (2) that capping is a problem in tablet making, and
- (3) that a way to reduce capping is to adjust the moisture level.

Given this knowledge, it would have been obvious to one having ordinary skill in the tablet art to select a moisture content for the prior art metformin tablets that would solve the problem of capping. In this case obviousness flows from the “normal desire of scientists or artisans to improve upon what is already generally known.” In re Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382.

Appellant concedes that methyl cellulose is a “hydrocolloid forming extended release agent” but argues that Abdallah discloses a coprecipitation, not a wet granulation, technique to be used in forming the methyl cellulose containing tablets. However, since the representative claims are not limited to a particular process of making and Appellant has not argued any claim separately, we do not find this argument persuasive.⁵

⁵ We note that the examiner also directed us to Abdallah’s teaching of ethyl cellulose, used in a wet granulation technique, for a teaching of a “hydrocolloid forming retarding agent”. However, as Abdallah notes,

Appellant's argument that Otaya is directed to a tablet that does not contain metformin and one which does not contain a hydrocolloid forming extended release agent is not persuasive. The rejection is not one of anticipation. Otaya is relied upon to show that one skilled in the art of tablet making would have known that moisture content is a variable that must be controlled in order to avoid capping and not for the general teaching of metformin tablets.

The Vilkov declarations

1. Unpredictability

We note Dr. Vilkov's testimony regarding the unpredictability of the art of pharmaceutical formulation where Dr. Vilkov states that:

Pharmaceutical formulation is a very unpredictable art. Every active agent and excipient has unique tableting properties. Data pertaining to one active agent and type of excipient does not necessarily apply to a different active agent and type of excipient. Modifying one tablet parameter can furthermore affect more than one tablet property in an unpredictable way. As a result, one of ordinary skill in the art would not look to sources examining optimum moisture content levels for a different active agent in order to determine the appropriate moisture content for an extended release metformin product.

Dr. Vilkov has not provided us with a specific discussion of why one skilled in the art would not have expected metformin tablets to perform similarly to Otaya's sulfamin tablets when it comes to capping, i.e., Dr. Vilkov has not explained why one skilled in the art having Otaya at hand

“[e]thyl cellulose is insoluble in water whatever the pH.” (Abdallah at 17). Dr. Vilkov's testimony that ethyl cellulose is insoluble and not a hydrocolloid forming polymer is consistent with Abdallah on this point.

would not have found it obvious to adjust moisture levels until a level sufficient to eliminate capping is found. Dr. Vilkov's conclusory statement that pharmaceutical formulation is "very unpredictable" is insufficient to persuade us that the one skilled in the art would not have had a reasonable expectation of successfully controlling capping by optimizing residual moisture content.

2. *Unexpected results*

As noted by the examiner, the testing presented in the second Vilkov declaration does not show unexpected results for the full scope of the claimed subject matter. Claim 1, from which claim 35 depends, cites a residual moisture content of 0.5-3%. According to the "results and observations" section of the Second Vilkov declaration, tablets having a residual moisture content of 3% yielded tablets that were "soggy" and showed "capping". Thus, unexpected results were not demonstrated for the full scope of the claim. Moreover, Dr. Vilkov tested a composition having a particular "hydrocolloid forming retarding agent" (hydroxypropyl methylcellulose) as well as other excipients (povidone, purified water, magnesium stearate). Appellant has not explained how this particular composition is representative of the broader claimed subject matter of claim 1.

Appellant directs us also to example 4 of the '106 disclosure. (Brief at 20 and '106 at 7:39-67). However, example 4 does not cure the deficiencies of the Vilkov declaration. Appellant has not explained how

(Vilkov declaration at ¶ 4). We determine that the examiner has not shown that ethyl cellulose can act as a hydrocolloid forming retarding agent.

the example 4 composition, which is said to have a 2.8% residual moisture content and to contain polyacrylic acid as the hydrocolloid-forming agent, is commensurate in scope with the broader claimed subject matter of claim 1.

The examiner's rejection under 35 USC § 103(a) in view of Abdallah, Evenstad, and Otaya is AFFIRMED.

Evenstad

The examiner relies upon Evenstad for a teaching of controlled release tablets comprising water soluble drugs and having hydroxypropyl cellulose as a sustained release agent. The examiner notes that the tablets of Evenstad are made by wet granulation and have a residual moisture content of "less than about 7%, or less than 5%." According to the examiner "it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to adjust the moisture content during the wet granulation of metformin tablets of Abdallah, ... because Evenstad suggests preparing tablets of water soluble medicaments containing release retarding agent with a final moisture content of less than 7% (preferably <5%) for controlled release of the drug." (Answer at 7).

In our view, the Evenstad teaching of less than 5% residual moisture content, without more, would not have made it obvious to one skilled in the art to select 0.5-3% residual moisture content for the metformin tablet of Abdallah. We note that the examiner has not pointed out whether either Abdallah or Evenstad recognized moisture content as a variable that relates to capping. The examiner does not point out where Abdallah discusses residual moisture content at all. We have not been directed to any portion of Evenstad explaining why less than 5% moisture content was selected or

otherwise indicating that moisture content matters such that it would have been obvious for one skilled in the art to vary the moisture content to achieve a certain result.

The examiner's rejection under 35 USC § 103(a) under Abdallah in view of Evenstad is REVERSED.

New ground

Based on the reasoning and art relied upon by the examiner we are persuaded that the claims are unpatentable as being obvious over the combination of Abdallah, Evenstad, and Otaya. We note however, that the examiner did not specifically reply upon Otaya in her rejection of claims 1-33, 37-59, 62-94, 96, 97, 100-122, and 127-138. While we believe that the examiner intended to reject all the claims over the combination of Abdallah, Evenstad, and Otaya, we will designate the rejection of claims 1-33, 37-59, 62-94, 96, 97, 100-122, and 127-138 as a new ground of rejection.

IV. Order

Upon consideration of the record and for reasons given, it

ORDERED that the rejection of claims 1-4, 8-11, 20-23, 30-38, 40, 41, 45, 68, 69, 72, 73, 82-101, 104, and 105 under 35 USC §102(b) as being anticipated by the Red List is AFFIRMED;

FURTHER ORDERED that the rejection of claims 34-36, 60, 61, 95, 98, 99 and 123-126 under 35 USC § 103(a) as being obvious over Abdallah, Evenstad, and Otaya is AFFIRMED;

FURTHER ORDERED that the rejection of claims 1-33, 37-59, 62-94, 96, 97, 100-122, and 127-138 under 35 USC § 103(a) as being obvious over Abdallah, Evenstad, and Otaya is designated as a NEW GROUNDS OF REJECTION; and

FURTHER ORDERED that the examiner's rejection of claims 1-33, 37-59, 62-94, 96, 97, 100-122, and 127-138 under 35 USC § 103(a) as being obvious over Abdallah in view of Evenstad is REVERSED.

AFFIRMED-IN-PART

_____)	
RICHARD TORCZON)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
_____)	APPEALS
)	AND
SALLY G. LANE)	INTERFERENCES
Administrative Patent Judge)	
)	
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_____)	
MICHAEL P. TIERNEY)	
Administrative Patent Judge)	

Appeal No. 2006-3234
Application No. 90/006,410