

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-DOMINIQUE BOURZAT
and ALAIN COMMERCON

Appeal No. 1999-1685
Application 08/564,345

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and ADAMS Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 9 and 11 through 13, which are all of the claims remaining in the application.

THE INVENTION

Applicants' invention relates to a process for preparing an oxazolidinecarboxylic acid, or derivative thereof, useful for preparing therapeutically active taxoids. The principal step of applicants' process comprises selective iodination carried out on an

oxazolidinecarboxylic acid ester having formula II set forth in claim 1 on appeal. A correct copy of claim 1, which is illustrative of the subject matter on appeal, may be found in Appendix II attached to the Appeal Brief.

THE REFERENCES

The prior art references relied on by the examiner are:

Bourzat et al. (Bourzat)	5,476,954	Dec. 19, 1995
Bouchard et al. (Bouchard)	5,556,877	Sep. 17, 1996
Martin et al. (Martin)	4,240,987	Dec. 23, 1980

THE REJECTIONS

Claims 1 through 5 and 11 through 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Bourzat, Bouchard, and Martin (Examiner's Answer, pages 4-7).

Claims 1 through 9 and 11 through 13 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure. In setting forth this rejection, the examiner points out that variables R_3 and R_4 in claim 1 may be, inter alia, "an aralkyl radical in which the alkyl portion has 1 to 4 carbon atoms and the aryl portion is substituted with one or more alkoxy radicals having 1-4 carbon atoms, or an aryl radical substituted with one or more alkoxy radicals having 1-4 carbon atoms." The examiner also points to the recitation of variable R_3 as "a phenyl radical substituted with a trihalomethyl radical." According to the examiner, applicants' specification does not adequately teach how to carry out selective iodination on an oxazolidinecarboxylic acid

ester having formula (II) in claim 1, in order to prepare an oxazolidinecarboxylic acid, or derivative, having formula (I) without also iodinating the aryl moieties of the above-specified R₃ and R₄ groups. As stated by the examiner, "[r]easonable assurance that R₃, R₄ phenyls aren't also instantly iodinated is lacking" (Examiner's Answer, page 7). The examiner further argues that applicants' specification does not adequately teach how to carry out the claimed process using the reagents specified in claims 6 through 9 (Examiner's Answer, page 8).

The examiner further rejects claims 1 through 9 and 11 through 13 under 35 U.S.C. § 112, first and second paragraphs, in view of the recitation of variable R₁ as "a saturated or unsaturated nitrogen-containing 5-or 6-membered heterocyclic radical" (Examiner's Answer, pages 9 and 10). According to the examiner, that recitation literally embraces alumaborazine, a product which "has never been made" and which constitutes an "impossible" heterocyclic (Examiner's Answer, page 9). The examiner argues that applicants' specification is defective in not adequately teaching requisite starting materials, which would be useful for preparing alumaborazine.

DISPOSITION

On consideration of the record, we find that the examiner's rejections have little merit. For the reasons succinctly stated in applicants' Appeal Brief and Reply Brief, we shall not sustain any of the prior art or non-prior art rejections. We add the following comments for emphasis, respecting the examiner's argument that alumaborazine is literally embraced by the recitation of variable R₁ in claim 1, and that applicants' specification does not adequately teach "how to make" alumaborazine.

As set forth in Atlas Powder Co. v. E.I. Du Pont De Nemours & Co., 750 F.2d 1569, 1576-77, 224 USPQ 409, 414 (Fed. Cir. 1984):

Even if some of the claimed combinations were inoperative, the claims are not necessarily invalid. "It is not a function of the claims to specifically exclude . . . possible inoperative substances . . ." In re Dinh-Nguyen, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974) (emphasis omitted). Accord, In re Geerdes, 491 F.2d 1260, 1265, 180 USPQ 789, 793 (CCPA 1974); In re Anderson, 471 F.2d 1237, 1242, 176 USPQ 331, 334-35 (CCPA 1973). Of course, if the number of inoperative combinations becomes significant, and in effect forces one of ordinary skill in the art to experiment unduly in order to practice the claimed invention, the claims might indeed be invalid. See, e.g., In re Cook, 439 F.2d 730, 735, 169 USPQ 298, 302 (CCPA 1971).

In this case, the examiner has not established that a person having ordinary skill in the art would have had to experiment unduly in order to practice the claimed invention.

Rather, the examiner sets up a "straw man" argument. The examiner argues that a radical derived from alumaborazine fits the recitation of "a saturated or unsaturated nitrogen-containing 5- or 6-membered heterocyclic radical" in claim 1; that alumaborazine "has never been made" and constitutes an "impossible" heterocyclic; that applicants' specification does not teach starting materials which would be necessary for preparing alumaborazine; and, accordingly, that applicants' specification does not teach any person skilled in the art how to make the alumaborazine embodiment covered by the claims on appeal. The argument is manifestly untenable. As stated in Atlas Powder Co. v E.I. Du Pont De Nemours & Co., 750 F.2d at 1576, 224 USPQ at 414, it is not a function of the claims to specifically exclude possible inoperative substances. Likewise, as the court stated in a similar context in In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976), "nobody will use them [inoperative embodiments] and the claims do not cover them." Cf Ex parte Breuer,

1 USPQ2d 1906 (Bd. Pat. App. Int. 1986) (the issue is not whether the examiner can conjure up a substituent group which does not exist. A person having ordinary skill in the art would readily appreciate that compounds containing such substituent group do not exist).

The examiner's decision, rejecting claims 1 through 9 and 11 through 13, is reversed.

REVERSED

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Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
William F. Smith)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Donald E. Adams)	
Administrative Patent Judge)	

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