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for publication and is not binding precedent of the Board.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

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# BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte SARA L. ZAKNOEN

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Appeal No. 2004-1974
Application No. 09/767,424

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REQUEST FOR REHEARING

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Before WILLIAM F. SMITH, SCHEINER, and MILLS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant requests rehearing of our decision of September 22, 2004, in which we affirmed the examiner's decision that claims 1-22 were unpatentable under 35 U.S.C. § 103(a). Appellant argues that we overlooked arguments from the Reply Brief regarding pegylated interferon alpha, non-pegylated interferon alpha, and the varying molecular and pharmacokinetic properties that exist between the two compounds. Request, page 5.

We did not overlook the arguments made in the Reply Brief. See slip opinion, pages 3 and 5. Failure to specifically address an argument does not mean that that argument was overlooked.

We have reviewed the arguments once more and again we do not find them persuasive. Appellant argues that the total drug exposure and peak plasma level of pegylated interferon alpha and nonppegylated interferon alpha are different and that one of skill in the art could not predict the effect the use of pegylated interferon alpha would have in treating cancer.

First, a conclusion of obviousness need only rest on a reasonable expectation of success, not absolute predictability. In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); In re Longi, 759 F.2d 887, 897, 225 USPQ2d 645, 652 (Fed. Cir. 1985). Second, we stated that Kline describes pegylated interferon alpha as being useful in treating renal cell carcinoma and AIDS-related Kaposi's sarcoma. Slip opinion, page 3. Thus, the evidence of obviousness relied upon by the examiner suggests the use of pegylated interferon alpha in treating cancer.

We also note that appellant renews the argument regarding synergistic combination of the claimed active ingredients. Request, page 7. However, as previously pointed out, the arguments based upon synergism are not supported by objective evidence of non-obviousness. Slip opinion, page 4.

We have considered appellant's request to the extent indicated but decline to change our decision in any manner.

REHEARING DENIED

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| William F. Smith | ) |
| Administrative Patent Judge | ) |
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| | ) BOARD OF PATENT |
| Toni R. Scheiner | ) |
| Administrative Patent Judge | ) APPEALS AND |
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| | ) INTERFERENCES |
| Demetra J. Mills | ) |
| Administrative Patent Judge | ) |

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