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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY FISCH,
Patent Owner and Appellant

Appeal 2009-005759
Reexamination Control 90/008,024
Patent 6,391,920 C1
Technology Center 3900

Before ERIC GRIMES, CAROL A. SPIEGEL, and
ROMULO H. DELMENDO, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 begins to run from the "MAIL DATE" shown on the PTOL-90A cover letter attached to this decision.

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Reexamination Control 90/008,024
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Appellant requests rehearing of our August 28, 2009 Decision ("Dec."), in which we affirmed the Examiner's decision to reject claims 1-21 in the above-identified reexamination of U.S. Patent 6,391,920 C1 (Request for Rehearing filed October 27, 2009 ("Req. Reh'g")).

We grant-in-part and deny-in-part Appellant's request to modify our original Decision.

Claims 1 and 4, the only independent claims on appeal, read (App. Br. 31):

1. A method of treating *disorders related to androgen deficiency in men comprising administering a selective antiestrogen to men in need of such treating.*

4. A method of treating disorders related to male menopause in men comprising administering an antiestrogen *to men in need of such treating.*

Dependent claims 5-9 limit the disorder treated in claim 4 to reductions in muscle mass, body performance capacity, bone density, libido, and potency, respectively, while dependent claim 10 limits the disorder treated in claim 4 to benign prostatic hyperplasia.

Appellant contends that the Board overlooked or misapprehended nine points which are addressed below in the order of their presentation.

I. Claim Construction

Appellant contends that the Board's claim construction, while correct, differs from that of the Examiner and therefore due process requires reversal of the Examiner's prior art rejections and denomination of the Board's original Decision as new grounds of rejection under 37 C.F.R. § 41.50(b) (Req. Reh'g 2).

The following findings of fact ("FF") are supported by a preponderance of the evidence of record.

- [1] The Board construed "the claimed treatment methods [to] require the treatment of men who not only present the condition of low androgen/testosterone, but are also suffering from a disorder related to that condition" (Dec. 10).
- [2] According to the '920 patent,

... relative testosterone deficiency per se can be regarded as responsible for a number of age-related disorders. Reduction of muscle mass accompanied by limitation of body performance capacity, reduction of bone density and in individual cases even osteoporosis, ... benign prostatic hyperplasia, reduction of libido and potency, and psycho-vegetative disorders such as depression, which are disorders that are often generically referred to as Male Menopause and are caused by relative androgen deficiency in men. [Spec. 1:45-54.]

- [3] The Examiner found, e.g., that

MacLean recognized that older men exhibiting hypogonadism disorders (or disorders related to androgen deficiency or male menopause) such as bone loss; hip fractures, lower libido and impotence have lower testosterone levels. MacLean teaches administering antiestrogen increases the testosterone levels, which ameliorate the disorders related to low testosterone levels (Ans.² 4, original emphasis).

² Examiner's Answer mailed 12 June 2008 ("Ans.").

[4] In other words, the Examiner found that "older men with low testosterone levels will necessarily have the disclosed disorders" (Ans. 10).

Other findings of fact follow below.

The criterion of whether a rejection is considered "new" in a decision by the Board is whether Appellant has had a fair opportunity to react to the thrust of the rejection. *In re Kronig*, 539 F.2d, 1300, 1303 (CCPA 1976). Here, the Examiner found that MacLean³ teaches treating men with androgen deficiency or male menopause who are suffering from a disorder related to that condition by administering antiestrogen to the men (FF 3-4). The Board construed the claimed invention to require the treatment of men who not only present the condition of low androgen/testosterone, but are also suffering from a disorder related to that condition (FF 1). While Appellant may not agree with the Board's and the Examiner's findings regarding the teachings of MacLean, the thrust of the prior art rejections by the Examiner and the Board's original Decision is the same regardless of whether the Examiner's or the Board's claim construction is used.

In addition, and as Appellant has noted, "the Board agreed with the Patent Owner's overall position on claim construction" (Req. Rhg. 1). Appellant argued that MacLean did not anticipate the claims as construed by Appellant (Appeal Br. 8-14). But even under Appellant's proffered claim construction with which we agree, MacLean anticipates. Although we disagreed with Appellant's conclusion (Dec. 11-12), Appellant has had an opportunity to respond to the claim construction we adopted since it is the

³ US Patent 6,017,964 issued to MacLean et al. ("MacLean").

claim construction that Appellant himself advocated. Since we believe that Appellant has had a fair opportunity to react to the prior art rejections, we will not designate our affirmance as constituting a new grounds of rejection under 37 C.F.R. § 41.50(b).

II. The Law of Anticipation

Appellant contends that MacLean does not specifically describe the patients required by either claims 1 or 4. According to Appellant, and as argued on pages 19-20 of the Appeal Brief, the Board erroneously found otherwise by relying on and combining

- the disclosure of Appellant's '920 patent to define what constitutes the "disorders relating to androgen deficiency/male menopause" treated by the claimed methods (Req. Reh'g 4),
- facts in the Background section of MacLean (*id.* 2-6), and
- MacLean's statement at column 4, lines 1-4, that an "effective amount" according to the MacLean invention is an "amount of compound ... capable of inhibiting the symptoms of the pathological conditions ... described" absent an express definition of those symptoms (*id.* 3).

According to Appellant, and as argued on pages 13-14 of the Appeal Brief and pages 11-12 of the Reply Brief, the Board failed to respond to the argument that not all men presenting with low testosterone will necessarily have any disorder related thereto and vice versa (*id.* 4-5). Appellant specifically refers to the Bar-Chama, Fisch II, and Shabsigh Declarations.⁴

⁴ We refer to Appellant's Corrected Brief on Appeal Pursuant to 37 C.F.R. § 41.37 filed 26 February 2009 ("App. Br."), Appellant's Reply Brief

Appellant also contends the Board may have overlooked or misapprehended that MacLean (a) drew a distinction between treating low testosterone and treating a disorder that may be related to low testosterone and (b) confirmed that the teachings in the 042 patent do not teach treatment of a disorder related to androgen deficiency or a disorder related to male menopause, i.e., andropause, as argued on pages 11-13 of the Appeal Brief, based on the prosecution history of two "other" MacLean applications (*id.* 5).

Appellant further contends "it is error for the Board to rely upon the skill in the art to find *description* of the claimed invention in an alleged anticipatory reference as opposed to taking the skill of the art into account in determining whether the alleged anticipatory reference is enabling in regard to the claimed invention as in *Le Grice and Donohue*" (Req. Reh'g 6). In other words, "[i]t is error for the Board to give any weight to the MacLean prophetic example" referred to in FF 13 of the original Decision (*id.* 8). Appellant still further contends that MacLean is not an enabling reference as shown by Guay II, Guay III, and the Fisch, Bar-Chama, and Shabsigh Declarations, which provide evidence that MacLean failed to provide a reasonable expectation of success, "another way of expressing that MacLean is [not] enabling" (Req. Reh'g 7-8).

[5] It is undisputed that MacLean teaches administering an effective amount of tamoxifen analogs of formula I, preferably droloxifene, for

Pursuant to 37 C.F.R. § 41.41 filed 11 August 2008 ("Reply Br."), the Declaration under 37 C.F.R. § 1.132 by Harry Fisch dated 22 August 2007 ("Fisch II Decl."), the Declaration under 37 C.F.R. § 1.132 by Natan Bar-Chama dated 3 January 2008 ("Bar-Chama Decl."), and the Declaration under 37 C.F.R. § 1.132 by Ridwan Shabsigh dated 3 January 2008 ("Shabsigh Declaration").

- medical therapeutic and/or prophylactic treatment (MacLean 2:31-33; 2:36-3:5; 3:10-46; App. Br. 9).
- [6] It is also undisputed that MacLean defines an "effective amount" as "an amount of compound ... capable of inhibiting the symptoms of the pathological conditions herein described" (MacLean 4:1-4).
- [7] MacLean relates to "methods for increasing serum ... testosterone" and states that "[l]ow testosterone levels, especially in the elderly, may lead to frailty, impotence and lowered libido" (MacLean 2:30-35).
- [8] MacLean describes a study designed to compare two doses of a compound of formula I at 10 and 40 mg/day versus placebo for 14 weeks to determine if the compound is effective in increasing serum testosterone levels over the placebo (MacLean 7:14-24).
- [9] The study designed by MacLean calls for selecting sixty relatively healthy men between the ages of 62 to 75 with serum testosterone levels less than 500 ng/dl (MacLean 6:42-7:12).
- [10] Natan Bar-Chama, M.D., and Ridwan Shabsigh, M.D., both testified that they know Appellant, Dr. Harry Fisch, "personally and ... am friendly with him" (Bar-Chama Decl. ¶¶ 3 and 9; Shabsigh Decl. ¶¶ 3 and 10).
- [11] Neither Dr. Bar-Chama nor Dr. Shabsigh "understand MacLean's reference to either 'medical therapeutic treatment' or 'prophylactic treatment' to mean treatment of manifest frailty, impotence or loss of libido" (Bar-Chama Decl. ¶ 32; Shabsigh Decl. ¶ 33).

- [12] Instead, both Drs. Bar-Chama and Shabsigh "understand ... MacLean's reference to 'pathological conditions herein described' [to] mean[] states of low testosterone levels", not "the symptoms of manifest frailty, impotence or loss of libido" (Bar-Chama Decl. ¶¶ 35-36; Shabsigh Decl. ¶¶ 36-37).
- [13] Both Drs. Bar-Chama and Shabsigh based their understanding upon (i) unsuccessful attempts in the prior art to cure manifest disorders related to low testosterone levels by restoring the testosterone levels to normal and, (ii) a lack of a "clear and unambiguous statement" in MacLean of treating disorders related to low testosterone levels (Bar-Chama Decl. ¶¶ 39-42; Shabsigh Decl. ¶¶ 40-43).
- [14] Appellant, Dr. Harry Fisch, testified/argued that older men with low testosterone levels will not necessarily manifest disorders associated with low testosterone levels (Fisch II Decl. ¶¶ 32-37; App. Br. 19; Reply Br. 11-12).
- [15] Dr. Fisch testified that he sees "no teaching or suggestion anywhere in MacLean that raising serum testosterone levels in a person *already suffering* frailty, impotence or lowered libido would successfully treat these particular disorders" (Fisch II Decl. ¶ 56, original emphasis).
- Claims in a reexamination proceeding are given their broadest reasonable interpretation consistent with the specification. *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002); *In re Yamamoto*, 740 F.2d 1569, 1572 (Fed. Cir. 1984).

A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his

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own knowledge of the particular art and be in possession of the invention. *In re LeGrice*, 301 F.2d 929, 939 (CCPA 1962). *See also In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985). Furthermore, "anticipation does not require actual performance of suggestions in a disclosure. Rather, anticipation only requires that those suggestions be enabling to one of skill in the art." *Bristol-Myers Squibb Co. v. Ben Venue Lab., Inc.*, 246 F.3d 1368, 1369 (Fed. Cir. 2001) (citing *Donohue*, 766 F.2d at 533).

"Enablement requires that 'the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.'" *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003) (citations omitted). However, a prior art reference need not demonstrate utility in order to serve as an anticipating reference under § 102. *See In re Schoenwald*, 964 F.2d 1122, 1124 (Fed. Cir. 1992); *see also In re Donohue*, 632 F.2d 123, 126 n.2 (CCPA 1980); *In re Lukach*, 442 F.2d 967, 969 (CCPA 1071).

First, it is proper to rely upon the underlying specification to determine the meaning and scope of a claimed invention. Therefore, we discern no error in relying on the disclosure of the '920 patent to ascertain the scope and meaning of a "disorder related to androgen deficiency" or a "disorder related to male menopause" as recited in claims 1 and 4. Claim interpretation is crucial to patent examining, i.e., without construing the scope and content of the claimed invention, it cannot be compared to the prior art.

Similarly, we discern no error in relying on the Background section of a patent to provide content for the invention disclosed therein. Here, for example, MacLean describes two types of treatments -- therapeutic and prophylactic -- both of which involve administering an effective amount of tamoxifen analogs of formula I (FF 5), i.e., "an amount of compound ... capable of inhibiting the symptoms of the pathological conditions herein described" (FF 6). MacLean describes a number of symptoms, e.g., frailty, impotence and lowered libido, of pathological conditions, e.g., androgen deficiency (low testosterone) (FF 7). MacLean's description of symptoms and pathological conditions are consistent with the ordinary knowledge in the art as noted in the original Decision (Dec. 11). In other words, MacLean describes prophylactic treatments of men without symptoms and therapeutic treatments of men with symptoms related to a defined underlying pathology, i.e., androgen (testosterone) deficiency or male menopause. It would be nonsensical to suggest that MacLean would be treating disorders not caused by androgen deficiency or male menopause by administering a compound specifically because it increases androgen (testosterone) levels.

Moreover, a prior art reference need not demonstrate utility in order to serve as an anticipatory reference under § 102. Anticipation only requires that the prior art reference teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation. As stated in the original Decision, MacLean teaches administering an antiestrogen of formula I at a dose of 10 mg/day for 14 weeks, while the '920 specification describes administering an antiestrogen at a dose of 5-10 mg once or twice daily for an effective time period (Dec. 13). Thus, MacLean discloses each

and every element of the claimed invention and enables one of ordinary skill in the art to make the invention without undue experimentation. As stated in *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citations omitted),

[a]s long as the reference discloses all of the claim limitations and enables the "subject matter that falls within the scope of the claims at issue," the reference anticipates -- no "actual creation or reduction to practice" is required. This is so despite the fact that the description provided in the anticipatory reference might not otherwise entitle its author to a patent.

Thus, the original Decision only took the skill of the art into account in determining whether the alleged anticipatory reference is enabling in regard to the claimed invention as in *Le Grice* and *Donohue*, contrary to Appellant's contention.

It is irrelevant to anticipation whether attempts to cure manifest disorders related to androgen deficiency were unsuccessful in the prior art, as testified by Drs. Bar-Chama and Shabsigh (FF 13). We noted in the original Decision that rebuttal evidence proffered to demonstrate a lack of reasonable expectation of success, and therefore, a lack of motivation cannot be used to overcome a rejection under § 102 (Dec. 13). Thus, we find Appellant's new assertion that MacLean failed to provide a reasonable expectation of success, "another way of expressing that MacLean is [not] enabling" (Req. Reh'g 7-8), unpersuasive.

We also did not overlook or misapprehend arguments based on evidence not made of record in the Appeal Brief and, therefore, not responded to by the Examiner, i.e., arguments based on the prosecution

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history of two "other" MacLean applications. Moreover, the respective prosecution in each of the "other" MacLean applications was based on another factual record.

Therefore, we do not believe that we have misapplied the law of anticipation.

III. Claim 4

According to Appellant, claim 4 was separately argued on page 21 of the Appeal Brief but not separately addressed by the Board (Req. Reh'g 8).

In the words of the Appeal Brief, "Claim 4 is not anticipated by MacLean for the same reasons that claim 1 is not anticipated by MacLean" (App. Br. 21). According to Appellant, "[t]he only mention of men specifically and who are of sufficient age so as to be capable of suffering from male menopause is in the prophetic Test Method" (*id.*).

Insofar as Appellant argues that claim 4 is not anticipated for the same reasons as claim 1, claim 4 has not been separately argued. Furthermore, as found in the original Decision, the disorders related to androgen deficiency and to male menopause are the same (*see e.g.*, Dec. 11-12). Moreover, MacLean expressly references disorders related to androgen (testosterone) deficiency "in the elderly" (FF 7). Thus, claim 4 was addressed in the original Decision (see Dec. 11-12 and FF 12 therein).

Alternatively, Appellant has not pointed to where the '920 patent defines "male menopause" as occurring in men of a certain age such that the method of claim 4 requires treating men of a certain age.

In summary, claim 4 was addressed to the same extent it was argued.

IV. Claims 2 and 15

As stated in the Appeal Brief (App. Br. 21), claims 2 and 15

require that the antiestrogen [administered in claims 1 and 4, respectively] is clomiphene. The only mention in MacLean of clomiphene is at column 1, lines 45-47, wherein MacLean ... teaches clomiphene is used to treat libido of unspecified origin. MacLean does not teach that the libido discussed there is related to androgen deficiency or to male menopause. Consequently, MacLean cannot anticipate claims 2 and 15. ...

[16] MacLean states that "the antiestrogen clomiphene is used to treat decreased libido, hypogonadotropic hypogonadism and associated infertility" (MacLean 1:45-47).

Upon reconsideration, we agree with Appellant that MacLean does specify the source of the decreased libido and the Examiner has not factually established the source as androgen deficiency or male menopause (Req. Reh'g 8-9). Therefore, we reverse the rejection of claims 2 and 15 under 35 U.S.C. § 102 as anticipated by MacLean.

V. Claims 11 and 19

As stated in the Appeal Brief (App. Br. 22), claims 11 and 19

require that the antiestrogen [administered in claims 1 and 4, respectively] is tamoxifen. The Examiner relies only on the teaching in MacLean at column 1, lines 42-44, that administration of tamoxifen has been shown to increase serum levels of testosterone in both mammals and oligozoospermic men. ...

[17] MacLean states that "[t]reatment with tamoxifen has been shown to increase serum levels of testosterone in both mammals and oligozoospermic men" (MacLean 1:42-44).

Upon reconsideration, we agree with Appellant that the Examiner has not factually shown that the mammals or the oligozoospermic men were suffering from a disorder related to androgen deficiency or male menopause (Req. Reh'g 9). Therefore, we reverse the rejection of claims 11 and 19 under 35 U.S.C. § 102 as anticipated by MacLean.

VI. Claim 20

As stated in the Appeal Brief (App. Br. 22), claim 20 requires that the antiestrogen administered in claim 4 is tamoxifen citrate.

Upon reconsideration, we agree with Appellant that MacLean does not teach increasing testosterone levels with tamoxifen citrate (*see* FF 17) (Req. Reh'g 9). Therefore, we reverse the rejection of claim 20 under 35 U.S.C. § 102 as anticipated by MacLean.

VII. Obviousness Rejection

In the original Decision, we summarily affirmed the rejection of claims 1, 2, 4-9, 11, 15, 19, and 20 under 35 U.S.C. § 103 on the grounds that lack of novelty is the ultimate of obviousness (Dec. 13).

Upon reconsideration, we decline to change the original Decision as to claims 1 and 4-9. Claims 1 and 4-9 are anticipated under 35 U.S.C. § 102 for the reasons given in sections I-III above. Consequently, we conclude that claims 1 and 4-9 are also obvious under 35 U.S.C. § 103 over MacLean. Lack of novelty is the ultimate of obviousness. *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982).

However, we reverse our summary affirmance of claims 2, 11, 15, 19, and 20 under 35 U.S.C. § 103 as obvious over MacLean for the reasons stated in sections IV-VI above. Claims 2, 11, 12, 15, 19, and 20 require administration of clomiphene, tamoxifen, or tamoxifen citrate.

In the obviousness conclusion, the Examiner essentially argues that it would have been obvious to use any antiestrogen to treat disorders related to androgen deficiency or male menopause in older men based upon MacLean's disclosure (Ans. 5). As explained above, MacLean describes therapeutic treatments of men with symptoms (frailty, impotence, and lowered libido) related to a defined underlying pathology, i.e., androgen (testosterone) deficiency or male menopause, by administering a compound of formula I (*see e.g.*, FF 5-9). However, the Examiner has failed to establish that clomiphene, tamoxifen, or tamoxifen citrate are within the scope of formula I compounds defined by MacLean or would have been obvious over those formula I compounds, e.g., would have been reasonably expected to produce the same effect in the same human male population treated by MacLean based on an articulated structure/function relationship. Neither has the Examiner shown that clomiphene, tamoxifen, and tamoxifen citrate are nonpreferred embodiments of MacLean (*see e.g.*, Ans. 12). In other words, the Examiner has failed to set forth a fact-based explanation as to why the subject matter of claims 2, 11, 12, 15, 19, and 20 would have been obvious to one of ordinary skill in the art.

Therefore, upon reconsideration, we reverse the rejection of claims 2, 11, 12, 15, 19, and 20 under 35 U.S.C. § 103 as obvious over MacLean.

VIII. Claims 3, 10, 13, 14, and 16-18

Claims 3, 13, 14, and 16-18 require administration of clomiphene citrate (claims 3 and 16), more specifically as either its cis-isomer (claims 13 and 17) or trans-isomer (claims 14 and 18).

Here, the Examiner relied on Burghardt's⁵ disclosure that cis- and trans-isomers of clomiphene are estrogen receptor binding ligands, i.e., antiestrogens (Ans. 6). Again, the Examiner concludes that it would have been obvious to use any antiestrogen, including clomiphene citrate or either of its isomers, to treat disorders related to androgen deficiency or male menopause in older men based upon MacLean's disclosure (*id.*5-6). However, Burghardt does not establish that clomiphene, its citrate salt, or either of its isomers, are compounds within the scope of formula I compounds defined by MacLean or would have been obvious over those formula I compounds, e.g., would have been reasonably expected to produce the same effect in the same human male population treated by MacLean based on an articulated structure/function relationship. Therefore, upon reconsideration, we reverse the rejection of claims 3, 13, 14, and 16-18 under 35 U.S.C. § 103 as obvious over MacLean in view of Burghardt.

Claim 10 depends from claim 4 and limits the disorder related to male menopause to benign prostatic hyperplasia ("BPH"). The Examiner relied

⁵ Burghardt et al., *Gap Junction Modulation in Rat Uterus III. Structure-Activity Relationships of Estrogen Receptor-Binding Ligands on Myometrial and Serosal Cells*, 36 *BIOLOGY OF REPRODUCTION* 741-751 (1987). ("Burghardt")

on Schweikert⁶ is relied on to teach "that sex steroids (testosterone and related hormones) ... play [an] important role in the pathogenesis of ...BPH ..." (Ans. 6).

[18] Indeed, Schweikert states that "[e]strogens appear to be an important factor in the pathogenesis of BPH" (Schweikert 573, ¶ bridging cols. 1-2).

[19] According to Schweikert, "peripheral aromatization of circulating androgens is the major source of estrogen in men, and the amount of androgens increases with advancing age" (*id.* 575, col. 2, ¶ 1).

[20] Schweikert evaluated "the effect of atamestane, a potent inhibitor of estrogen formation (aromatase inhibitor), on the human hyperplastic prostate" (*id.* 575, col. 2, ¶ 3).

[21] Schweikert reported that "[s]erum estrogen levels decreased markedly during treatment" (*id.* abstract).

The Examiner concluded that it would have been obvious "to use antiestrogens taught by MacLean to increase the testosterone levels in patients suffering from BPH (a disorder related to menopause), since BPH patients have low testosterone levels" (Ans. 6). However, the Examiner's conclusion is at odds with the teachings of Schweikert. Given Schweikert's teaching that peripheral aromatization of circulating androgens is the major source of estrogen in men (FF 19), it would appear that increasing the amount of circulating androgens (testosterone) would lead to an increase in the amount of estrogen and defeat the purpose of using atamestane to inhibit

⁶ Schweikert et al., *Effects of Estrogen Deprivation on Human Benign Prostatic Hyperplasia*, 44 J. STEROID BIOCHEM. MOLEC. BIOL. 573-576 (1993). ("Schweikert").

conversion of testosterone to estrogen (FF 20-21). There is no apparent inconsistency between the teachings of Schweikert and the teaching of MacLean noted by the Examiner (Ans. 6), i.e., "increased estrogen leads to decrease in testosterone levels." Yet, the Examiner has failed to explain why it would have been obvious to administer an antiestrogen to increase the testosterone levels and, thereby, estrogen levels given the combined teachings of MacLean and Schweikert. Therefore, upon reconsideration, we reverse the rejection of claim 10 under 35 U.S.C. § 103 as obvious over MacLean in view of Schweikert.

IX. Anticipation Affirmance

Appellant essentially reiterates his arguments made in Section I above, namely "the Board in effect reversed the Examiner's claim construction yet proceeded to offer a new theory of the case based upon its new claim construction instead of simply reversing the Examiner's rejections as based upon an incorrect claim construction" (Req. Reh'g 11). Thus, Appellant believes the Board's affirmance of the anticipation rejection is a new ground of rejection under 37 C.F.R. § 41.50(b).

We reiterate our response in Section I above, i.e., the thrust of the prior art anticipation rejection by the Examiner and the Board's original Decision is the same regardless of whether the Examiner's or the Board's claim construction is used. Since we believe that Appellant has had a fair opportunity to react to the prior art rejections, we will not designate our affirmance as constituting a new grounds of rejection under 37 C.F.R. § 41.50(b).

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DECISION ON REHEARING

We have reconsidered certain aspects of our original Decision in light of Appellant's arguments and modify our original Decision to the following extent:

the rejection of claims 2, 11, 15, and 19-20 as unpatentable under 35 U.S.C. § 102 or, alternatively, § 103 over MacLean is REVERSED;

the rejection of claims 3, 12-14, and 16-18 as unpatentable under 35 U.S.C. § 103 over MacLean in view of Burghardt is REVERSED; and,

the rejection of claim 10 as unpatentable under 35 U.S.C. § 103 over MacLean in view of Schweikert is REVERSED.

However, we decline to modify our original Decision that claims 1 and 4-9 are unpatentable under 35 U.S.C. § 102 or, alternatively, under 35 U.S.C. § 103 over MacLean. We also decline to denominate our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b).

DENIED-IN-PART; GRANTED-IN-PART

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