

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL JOLICOEUR

Appeal No. 1996-1748
Application 07/747,670

HEARD: MARCH 21, 2000

Before WILLIAM F. SMITH, ELLIS and SPIEGEL, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 7 through 9 and 17 through 19. Claims 1 through 6 and 13 through 16 are pending but have been withdrawn from consideration by the examiner.

Claim 7 and 17 are representative of the subject matter on appeal and read as follows:

7. A recombinant transgene which comprises:

(a) a HIV DNA which is a complete HIV genome except in having deleted therefrom the 5'-LTR, a portion of the 5' leader and a portion but not all of the 3'-LTR, wherein said HIV DNA encodes a substantially complete HIV RNA and said deletions render non-infectious said HIV DNA and RNA and the complementary proteins expressed from said DNA or RNA;

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Rekosh et al. (Rekosh), "Coexpression of human immunodeficiency virus envelope proteins and tat from a single simian virus 40 late replacement vector," Proc. Natl. Acad. Sci. USA, Vol. 85, pp. 334-38 (Jan. 1988).

Khillan et al. (Khillan), "Gene transactivation mediated by the TAT gene of human immunodeficiency virus in transgenic mice," Nucleic Acids Research, Vol. 16, No. 4, pp. 1423-30 (1989).

Leonard et al. (Leonard), "Development of Disease and Virus Recovery in Transgenic Mice Containing HIV Proviral DNA," Science, Vol. 242, pp. 1665-70 (Dec. 1988).

Tremblay et al. (Tremblay), "Transgenic Mice Carrying the Mouse Mammary Tumor Virus ras Fusion Gene: Distinct Effects in Various Tissues," Molecular and Cellular Biology, Vol. 9, No. 2, pp. 854-59 (Feb. 1989).

Bouchard et al. (Bouchard), "Stochastic Appearance of Mammary Tumors in Transgenic Mice Carrying the MMTV/c-neu Oncogene," Cell, Vol. 57, pp. 931-36 (June 1989).

Claims 7 through 9 and 17 through 19 stand rejected under 35 U.S.C. § 103. In a first stated rejection, the examiner relies upon Fisher, Ratner, Leonard, Leder, Bouchard, Tremblay and Southern as evidence of obviousness. In a second stated rejection, the examiner relies upon Khillan, Rekosh, Fisher, Ratner, Leonard, Southern, Leder, Bouchard and Tremblay as evidence of obviousness. We reverse.

DISCUSSION

The claims on appeal are directed to a specific recombinant transgene and a process for preparing such a transgene. As seen from claim 7 on appeal, the claimed transgene must have defined segments arranged in a specific manner.

We will assume without deciding that the multitude of references relied upon by the examiner do describe the various components of the claimed transgene. However, what is

missing from the examiner's statement of either rejection appearing on pages 3-4 of the Examiner's Answer are cogent reasons why one of ordinary skill in the art would have found it obvious at the time of the present invention to arrange the various elements in the manner required by the claims on appeal. In stating the rejections, the examiner only briefly describes what each reference purportedly discloses followed by a perfunctory, pro forma statement of obviousness. However, as set forth in Pro-Mold & Tool Co v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996):

It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references.

Here, the references relied upon to describe the various elements required to form the claimed transgene indicate that the various nucleotide sequences can be used in diverse ways. The examiner has not explained why it would have been obvious to pick and choose the various elements needed in order to arrive at the claimed transgene while ignoring other elements described by the references and combine the selected elements in order to arrive at the claimed subject matter. On this record, the only reason we can find for combining the elements in the manner required to arrive at the claimed invention is from a consultation of appellants' disclosure of the present invention in this application. This, of course, amounts to improper hindsight.

Absent a fact-based explanation from the examiner as to why it would have been obvious to one of ordinary skill in the art to construct a recombinant transgene as required by claim 7 on appeal, we find that the examiner has not properly established her initial burden of providing

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reasons of unpatentability. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Since the examiner has not established a prima facie case of obviousness, we need not consider the Jolicoeur declaration filed under 37 CFR § 1.132 filed on January 28, 1993.

The decision of the examiner is reversed.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
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Joan Ellis)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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Carol A. Spiegel)	
Administrative Patent Judge)	

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Foley & Lardner
Suite 500
3000 K Street, N.W.
Washington, DC 20007-5109