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WYETH I.I.C. PATENT LAW GROUP 5 GIRALDA FARMS MADISON, NJ 07940			SHUKLA, RAM R	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL HAGEN

Appeal 2011-002779
Application 11/544,056
Technology Center 1600

Before FRANCISCO C. PRATS, STEPHEN WALSH, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal¹ under 35 U.S.C. § 134(a) from the rejection of claims directed to an adjuvant formulation. The Patent Examiner rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Appellant notes there is a related appeal in Application No. 10/416,262. (App. Br. 3.) That appeal, Appeal No. 2011-002413, is being decided concurrently.

STATEMENT OF THE CASE

Claims 1-7 are on appeal. Claim 1 is representative and reads as follows:

1. An adjuvant formulation comprising the combination of:
(1) an aminoalkyl glucosamine compound (AGP), and (2) a cytokine or lymphokine, or an agonist to said cytokine or lymphokine.

The Examiner rejected the claims as follows:

- I. claims 1-4 and 6 under 35 U.S.C. § 103(a) as unpatentable over Johnson² and Scott;³
- II. claims 1-5 under 35 U.S.C. § 103(a) as unpatentable over Johnson and Jäger;⁴
- III. claim 7 under 35 U.S.C. § 103(a) as unpatentable over Johnson, Scott, and Reed;⁵ and
- IV. claim 7 under 35 U.S.C. § 103(a) as unpatentable over Johnson, Jäger, and Reed.

OBVIOUSNESS

The same issues are dispositive for all four rejections. We therefore consider them together.

Appellant contends that the rejections failed

[a] “to articulate *why* it would have been motivating to one of ordinary skill in the art to combine the prior art elements to yield Appellant’s claimed invention

² David A. Johnson et al., WO 98/50399, published Nov. 12, 1998.

³ Phillip Scott et al., US 5,976,539, issued Nov. 2, 1999.

⁴ Elke Jäger et al., US 6,096,313, issued Aug. 1, 2000.

⁵ Steven G. Reed et al., US 6,613,337 B1, filed Aug. 14, 2000, issued Sept. 2, 2003.

[b] to articulate *why* someone skilled in the art would have *predicted* the utility of the combination of elements in Appellant's claimed invention

[c] to apply the PTO guidelines regarding the KSR decision
[and]

[d] to properly interpret the concept of art-recognized equivalents as described in *In re Kerkhoven* and in MPEP §2144.06.” (App. Br. 4.)

Principles of Law

“It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose.” *In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980), citing *In re Crockett*, 279 F.2d 274, 276 (CCPA 1960) (the “joint use [of magnesium oxide and calcium carbide] is not patentable” where the prior art teaches “that both magnesium oxide and calcium carbide, individually, promote the formation of a nodular structure in cast iron, and it would be natural to suppose that, in combination, they would produce the same effect and would supplement each other”).

See also Merck & Co., Inc. v. Biocraft Labs, Inc., 874 F.2d 804, 808 (Fed. Cir. 1989) (“Given the prior art teaching that both amiloride and hydrochlorothiazide are natriuretic, it is to be expected that their co-administration would induce more sodium excretion than would either diuretic alone”); *In re Diamond*, 360 F.2d 214, 217 (CCPA 1966) (where the evidence showed that synergy was expected because combined drugs targeted different cellular mechanisms, and no evidence to the contrary was produced, “[w]e are not convinced of [the] non-obviousness of the combination of two drugs, A5MP and a glucocorticoid . . . particularly since

the record supports the [PTO's] contention that the drugs selected are two of the commonly used drugs in the treatment of such collagen diseases”).

Analysis

Upon consideration of the evidence on this record, and each of Appellant's contentions, we find that the preponderance of evidence on this record supports the Examiner's conclusion that the subject matter of Appellant's claims is unpatentable. Accordingly, we sustain the Examiner's rejections for the reasons set forth in the Answer, which we incorporate herein by reference, including the Examiner's responses to Appellant's arguments. We add the following comments for emphasis.

The Examiner relied on the settled principle that it is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. Appellant argues for a limiting gloss on this principle, such that only combinations of mechanistic equivalents are prima facie obvious (*see* App. Br. 6-7). That is, if AGP and GM-CSF do not produce their effect by the same mechanism, their combination cannot be obvious. We disagree.

Neither *Kerkhoven*, nor the earlier *Crockett* case that *Kerkhoven* cited, even mentions “equivalents.” The MANUAL OF PATENT EXAMINING PROCEDURE uses the term “equivalents,” but it does not purport to limit equivalents to things that produce their effect by the same mechanism. *See* MPEP §2144.06. Appellant identifies no authority for the proposed gloss on precedent, and relevant authority weighs against it. *See Diamond*, 360 F.2d at 217.

SUMMARY

We affirm the rejection of claims 1-4 and 6 under 35 U.S.C. § 103(a) as unpatentable over Johnson and Scott.

We affirm the rejection of claims 1-5 under 35 U.S.C. § 103(a) as unpatentable over Johnson and Jäger.

We affirm the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Johnson, Scott, and Reed.

We affirm the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Johnson, Jäger, and Reed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc