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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL CHAPLIN, PAUL HOWLEY,
and CHRISTINE MEISINGER-HENSCHL¹

Appeal 2014-006561
Application 13/588,217
Technology Center 1600

Before DONALD E. ADAMS, JOHN G. NEW, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

NEW, *Administrative Patent Judge*.

DECISION ON APPEAL

¹Appellants state the real party-in-interest is Bavarian Nordic A/S. App. Br. 3.

SUMMARY

Appellants file this appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 26–41.² Specifically, claims 34–41 stand rejected as unpatentable under the doctrine of nonstatutory obviousness-type double patenting as being obvious over claims 1 and 2 of US 7,807,146 B2; claims 1 and 7 of US 8,268,327 B2; and claims 1, 4, and 9 of US 8,268,328 B2.

Claims 34–41 also stand rejected as unpatentable under the doctrine of nonstatutory obviousness-type double patenting as being obvious over claims 1, 7, 16, and 19 of US 6,924,137 B2; claims 1, 4, and 15 of US 7,056,723 B2; claims 1, 15, and 17–20 of US 7,695,939 B2; claims 1 and 6 of US 7,964,395 B2; claims 1, 2, 14, and 24 of US 7,964,396 B2; and claims 1 and 5–10 of US 7,964,398 B2.

Claims 34–41 stand further rejected as unpatentable under the doctrine of nonstatutory obviousness-type double patenting as being obvious over claims 1, 6, 7, and 11 of US 7,628,980 B2; claims 1, 11, and 12 of US 7,892,533 B2; claims 1–4 of US 7,897,156 B2; and claims 1, 2, 3, 10, and 11 of US 8,372,622 B2.

Claims 34–41 stand further rejected as unpatentable under the doctrine of nonstatutory obviousness-type double patenting as being obvious over claims 1, 8, and 9 of US 7,300,658 B2; claims 1, 9, and 11 of US 7,338,662 B2; and claim 1 of US 7,759,116 B2.

²Claims 1–25 are cancelled. App. Br. 41.

Claims 26–41 stand rejected as unpatentable under the doctrine of nonstatutory obviousness-type double patenting as being obvious over claims 1–17 of US 7,445,924 B2.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

NATURE OF THE CLAIMED INVENTION

Appellants' invention is directed to an attenuated virus, MVA-BN, which is derived from Modified Vaccinia Ankara virus, wherein the MVA-BN virus, or a derivative thereof, induces at least substantially the same level of immunity in vaccinia virus prime/vaccinia virus boost regimes when compared to DNA prime/vaccinia virus boost regimes. Abstract.

REPRESENTATIVE CLAIM

Claim 34 is representative of the claims on appeal and recites:

34. A modified vaccinia Ankara (MVA) virus prepared by:

- a) culturing an MVA virus;
- b) isolating an MVA virus that reproductively replicates in chicken embryo fibroblast cells; and
- c) selecting for an MVA virus that is unable to reproductively replicate in the human keratinocyte cell line HaCaT, in the human bone osteosarcoma cell line 143B, in the human cervix adenocarcinoma cell line HeLa, and in the human embryo kidney cell line 293.

App. Br. 42.

ISSUES AND ANALYSES

We agree with, and adopt, the Examiner's findings and conclusion that the appealed claims are obvious under the nonstatutory doctrine of obviousness-type double patenting. We address the arguments raised by Appellants on appeal below.

Issue

Appellants argue the Examiner erred in failing to explicitly construe both the claims on appeal and the claims of the patents cited by the Examiner and then further failed to determine whether the claims on appeal would have been obvious to a person of ordinary skill in the art over the claims of the cited patents. App. Br. 14–15.

Analysis

As an initial matter, Appellants' application claims the benefit of the filing date of international application PCT/EP01/13628, filed November 22, 2001 (published on May 30, 2002), through a series of continuation applications. App. Br. 18. Appellants assert that none of the cited patents have an earlier effective U.S. filing date than the application on appeal. *Id.* However, Appellants do not argue that the patents cited by the Examiner are the results of restrictions imposed by the Examiner on the parent applications. Thus, the appealed claims are not subject to the safe harbor provisions of 35 U.S.C. § 121. Consequently, the question before us is whether Appellants' claims on appeal would be obvious to a person of ordinary skill in the art over the various patents cited by the Examiner.

According to Appellants, the pending claims are not “merely obvious variants of what has been patented” in the patents cited by the Examiner. Rather, Appellants argue, the claims of the cited patents are directed to completely different, separate, and distinct inventions from that recited by claims 26–41 and, therefore, the double patenting rejections are not appropriate. App. Br. 13 (citing *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1280–81 (Fed. Cir. 1992)).

Appellants argue further that the Examiner failed to make the requisite analysis set forth by our reviewing court in *Eli Lilly and Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001). App. Br. 14. Appellants argue that the Examiner has failed to explicitly define the scope of the claims at issue. *Id.* Appellants also assert that the Final Action neither identifies the differences between the inventions, as defined by the scope of the conflicting claims, nor provides any reason why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent. *Id.* at 14–15. Rather, Appellants argue, the Examiner erroneously treated the recitation of the term “MVA-BN” within the cited patented claims as if it were a prior art disclosure. *Id.* at 17. Appellants contend the Examiner’s approach ignores the rules of claim interpretation and uses the patented claims as though they are a prior art disclosure for everything recited in the claims. *Id.*

Appellants also argue that none of the cited patents have an earlier effective U.S. filing date earlier than the claims on appeal and, therefore, there can be no unjustified timewise extension of the right to exclude by a patent granted on the pending application. App. Br. 18. Moreover,

Appellants assert that, even if the present application were entitled to any patent term adjustment or extension, these would not be unjustified extensions, but would be justified. *Id.* (citing *In re Braat*, 937 F.2d 589, 595 (Fed. Cir. 1991)).

Nor, Appellants contend, would a patent granted on the pending application promote multiple infringement suits by different assignees asserting essentially the same patented invention. App. Br. 19. According to Appellants, a comparison of claims 26–41 with those of the cited patents demonstrates that they do not claim “essentially the same patented invention” and, therefore, this justification for a conclusion of obviousness-type double patenting is not present in the current case. *Id.*

We are not persuaded by Appellants’ arguments. In their Appeal Brief, Appellants detail, at considerable length, the differences between the claims on appeal and each of the prior patent claims cited by the Examiner. Appellants argue that each of the different inventions claimed by the prior patents are patentably distinguishable from Appellants’ instant claims and would, therefore, not be obvious over those claims. *See* App. Br. 20–39. We do not agree that this is the correct analytical approach to this issue.

The instant appeal is, with respect to its prosecution history, peculiar in that the claims on appeal are directed to the MVA-BN virus, which has certain properties defined by the claim, whereas the cited claims of the cited prior-issued patents are all directed, in one way or another, to various methods of using that same virus. Appellants do not argue to the contrary. As we see it, the question at issue before us, then, is not whether the cited prior patents claim inventions that are patentably distinct from Appellants’ instant claims. Rather, it is whether Appellants’ instant claims, reciting the

MVA-BN virus that possesses certain defined properties, would have been obvious to a person of ordinary skill in the art with knowledge of the prior patents cited by the Examiner.

We conclude that it would. For to practice any of the methods set forth in the claims of the prior patents, which require the use of MVA-BN, it would have been, *a priori*, necessary and obvious for the practitioner to have knowledge of the very virus that is to be used in the claims recited by the prior patents, as well as a method for making and selecting for that virus. Indeed, without that knowledge of the MVA-BN virus, it would not have been possible for an ordinary artisan to practice the methods recited in the prior patents.

We conclude, therefore, that the MVA-BN virus recited in the appealed claims would have been obvious to a person of ordinary skill based on the inherent teachings of the prior art. Put differently, a skilled artisan would have had to have knowledge and possession of the MVA-BN virus (as currently claimed) in order to be able to practice the methods of employing the MVA-BN virus (as claimed by the prior patents). *See, e.g., In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (stating that inherency is established when the cited art “necessarily functions in accordance with, or includes, the claimed limitations”).

Consequently, we conclude that Appellants’ claims 26–41 would have been obvious to a person of ordinary skill in the art over the prior patents cited by the Examiner.

Appeal 2014-006561
Application 13/588,217

DECISION

The Examiner's rejection of claims 26–41 as unpatentable under the nonstatutory doctrine of obviousness-type double patenting is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED