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Kilpatrick Townsend & Stockton LLP/ Complete Genomics, Inc. 1100 Peachtree Street, Suite 2800 Mailstop: IP Docketing - 22 Atlanta, GA 30309			THOMAS, DAVID C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FREDRIK DAHL, RADOJE DRMANAC,
and ANDREW SPARKS¹

Appeal 2015-006049
Application 13/021,141
Technology Center 1600

Before ERIC B. GRIMES, RICHARD J. SMITH, and JOHN E.
SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a method for inserting multiple DNA adaptors into targeted DNAs that have been rejected as anticipated. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

The present invention is directed to “methods to provide repeated cycles of nucleic acid cleavage and ligation to insert multiple DNA adaptors

¹ Appellants identify the Real Parties in Interest as Complete Genomics, Inc. (assignee) and Beijing Genomics Institute (parent company). Br. 2.

into a population of circular target DNAs at defined positions with respect to one another.” Spec. ¶ 3.

Claims 18–37 are on appeal. Claim 18 is illustrative and reads as follows:

18. A method for processing a nucleic acid, the method comprising:
- (a) obtaining a plurality of target fragments of a target DNA;
 - (b) preparing initial constructs each comprising one of the target fragments circularized by ligating a first adaptor between both ends of the fragment;
 - (c) cleaving the target fragment in the initial constructs at a defined distance from the first adaptor on both sides thereof, thereby cutting away a portion of the target fragment to form linear constructs in which the first adaptor is interior from both ends;
 - (d) preparing two-adaptor constructs each comprising one of the linear constructs by a method that comprises ligating a second adaptor between both ends of the linear DNA.

The claims stand rejected as follows:

Claims 18–37 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sparks.²

THE REJECTION UNDER 35 U.S.C. § 102(e)

In rejecting claims 18–37, the Examiner finds that the Sparks reference teaches a method for processing a nucleic acid encompassing the same steps as recited in the instant claims. Final Act. 8–10. The Examiner

² Sparks, et al., US 2009/0075343 A1, published Mar. 19, 2009 (“Sparks”). Claims 18–37 were also rejected for non-statutory obviousness-type double patenting over claims 7–17 of US 7,897,344 in view of Sparks and claims 7–17 of US 7,901,890 in view of Sparks. Ans. 5–8. Appellants have filed terminal disclaimers obviating these rejections. Ans. 12.

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also finds that the present application lists Fredrik Dahl, Radoje Drmanac, and Andrew Sparks as inventors, and the Sparks reference lists Andrew Sparks, Steven Huang, Radoje Drmanac, and Arnold Oliphant as inventors. Ans. 15.

In response, Appellants argue that Sparks is not eligible as prior art as it is not a published application of another inventive entity. Br. 3. In support of this argument Appellants have submitted the Declaration of Dr. Drmanac.³ In his Declaration, Dr. Drmanac states that “[t]he inventors named on the ‘343 application [Sparks] were identified based on what is claimed in that application, not what is claimed here. Steven Huang and Arnold Oliphant did not contribute to the making of the invention claimed here.” Drmanac Decl. 3. Appellants argue that Dr. Drmanac’s Declaration is sufficient to establish that Sparks is not a published application by another under 35 U.S.C. § 102(e).

In response, the Examiner finds that the Declaration is not unequivocal regarding inventorship. Ans. 16. In addition, the Examiner states that “even if the inventors Huang and Oliphant were removed from the Sparks application, there is still a difference in the inventive entities, as Fredrik Dahl is listed as an inventor of the current application but is not listed as an inventor in the Sparks application.” *Id.*

The issue with respect to this appeal is whether the Drmanac Declaration is sufficient to establish that the invention claimed in the present application was not described in “an application for patent, published under

³ Declaration of Dr. Radoje T. Drmanac, dated Nov. 17, 2014, filed Nov. 18, 2014 (“Drmanac Decl.”)

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section 122(b), **by another** filed in the United States before the invention by the applicant for patent.” 35 U.S.C. § 102(e) (emphasis added).

To establish that a prior application is not the work of another inventive entity, Appellants must come forward with evidence to support their argument. *In re Katz*, 687 F.2d 450, 455 (CCPA 1982) (It is incumbent on the applicant to provide “a satisfactory showing which would lead to a reasonable conclusion that [applicant] is the . . . inventor” of the subject matter disclosed in the article and claimed in the application.). An “unequivocal declaration” from the applicant that he invented the subject matter disclosed in the prior published application is sufficient to establish inventorship. *In re DeBaun*, 687 F.2d 459, 463 (CCPA 1982).

We agree with the Examiner that the Drmanac Declaration is not sufficient to show that Sparks is not the application of another inventive entity. While Dr. Drmanac states that Messrs. Huang and Oliphant did not invent what is claimed in the instant application, the declaration is devoid of any persuasive evidence regarding who invented subject matter disclosed in Sparks and claimed in the present application. Dr. Drmanac makes no statement as to who is the inventor of the overlapping subject matter. As such his declaration is insufficient to show that Sparks is not available as prior art under 35 U.S.C. § 102(e). *See In re Facius*, 408 F.2d 1396, 1407 (CCPA 1969) (Failure to identify prior disclosure as his invention resulted in finding that applicant had not overcome prima facie availability of a reference.)

In addition, as the Examiner pointed out, even if Messrs. Huang and Oliphant did not invent what is claimed in the instant application, the Sparks reference would still not have the same inventive entity as the present

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application, because the Sparks reference would have an inventive entity of Drmanac and Sparks, while the present application has an inventive entity of Dahl, Drmanac, and Sparks. *See In re Land*, 368 F.2d 866, 881 (CCPA 1966) (“Land and Rogers individually [are] separate legal entities from Land and Rogers as joint inventors. . . . There is no indication that the portions of the references relied on disclose anything they did jointly. Neither is there any showing that what they did jointly was done before the filing of the reference patent applications.”). *See also* MPEP § 2136.05.

Conclusion of Law

We conclude that the Declaration of Dr. Drmanac is insufficient to establish that Sparks is not available as prior art under 35 U.S.C. § 102(e).

DECISION

We affirm the rejection of claims 18–37 under 35 U.S.C. § 102(e).

TIME PERIOD FOR RESPONSE

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