

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK L. COLLINS and DAVID V. MORRISSEY

Appeal No. 95-1178
Application 07/902,517¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge and
WINTERS and WILLIAM F. SMITH, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have chosen to appeal the examiner's decision refusing to allow claims 14 through 18, 22 through 24, 33 through 35, 38 through 40, 48 through 51 and 60. See the Appeal Brief, page 2.

¹ Application for patent filed June 22, 1992. According to appellants, this application is a continuation of application serial no. 07/321,728, filed March 10, 1989, now abandoned.

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The examiner agrees that the appealed claims are 14 through 18, 22 through 24, 33 through 35, 38 through 40, 48 through 51 and 60. See the Examiner's Answer, page 1. However, there appears to be some confusion respecting other claims remaining in the application. Merely by way of example, note that claim 25 (three times amended) was entered in the administrative record in paper no. 18, filed June 17, 1993. Inexplicably, in paper no. 20 mailed September 2, 1993, the examiner indicated that claim 25 has been canceled. Likewise, the INDEX OF CLAIMS in the file wrapper indicates that claim 25 has been canceled. In the Appeal Brief, page 2, appellants state that, according to their records, claim 25 is a pending claim even though that claim does not constitute part of this appeal. In the Examiner's Answer, page 1, the examiner confirms that "the statement of the status of claims contained in the brief is correct".

On return of this application to the examining corps, we recommend that both appellants and the examiner carefully review and clarify the status of every claim in the application not subject to this appeal.

Claim 14, which is illustrative of the subject matter on appeal, reads as follows:

14. A method of determining the presence or amount of a target nucleic

acid sequence in a specimen comprising the steps of:

a. combining the specimen with a quantity of a chaotropic agent sufficient to disrupt molecular structures in cells and to render nucleic acids available for hybridization, thereby obtaining a mixture;

b. combining the mixture obtained in (a) with a capture probe consisting essentially of:

(i) a target binding region which is an oligonucleotide sequence complementary to the target nucleic acid sequence, and

(ii) a tail region which is a nucleotide sequence that is one member of a nucleotide affinity pair,

wherein the capture probe is preimmobilized by means of nucleotide affinity pair binding between the tail region of the capture probe and a complementary polynucleotide affixed to a solid polymeric support;

c. maintaining the product of (b) under conditions sufficient for hybridization of complementary nucleotide sequences to occur, whereby if the target nucleic acid is present in the specimen, said target nucleic acid hybridizes to the target binding region of the preimmobilized capture probe, thereby producing an immobilized target nucleic acid;

d. labeling the immobilized target nucleic acid with a detectable agent capable of selectively binding to the target nucleic acid, whereby a detectably labeled immobilized target nucleic acid is obtained; and

e. detecting the presence or amount of the detectably labeled immobilized target nucleic acid.

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The references relied on by the examiner are:

Falkow et al. (Falkow)	4,358,535	Nov. 09, 1982
Stabinsky	4,751,177	Jun. 14, 1988
Vary, et al. (Vary) (European Patent Application)	0,200,057	May 11, 1986

William I. Wood, et al. (Wood), "Base composition-independent hybridization in tetramethylammonium chloride: A method for oligonucleotide screening of highly complex gene libraries", Proc. Natl. Acad. Sci. USA, Vol. 82, pp 1585-1588, (March 1985).

The issue presented for review is whether the examiner erred in rejecting claims 14 through 18, 22 through 24, 33 through 35, 38 through 40, 48 through 51 and 60 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Stabinsky, Vary, Wood, and Falkow.

On consideration of the record, we reverse the rejection under 35 U.S.C. § 103 for the reasons succinctly stated by appellants in their Appeal Brief (paper no. 22, filed April 11, 1994).

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The examiner's decision is reversed.

REVERSED

BRUCE H. STONER, JR.
Chief Administrative Patent Judge

SHERMAN D. WINTERS
Administrative Patent Judge

WILLIAM F. SMITH
Administrative Patent Judge

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