

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK SEELA, HEINZ-PETER MUTH, KLAUS KAISER
WERNER BOURGEOIS, KLAUS MUHLEGGER
HERBERT VON DER ELITZ and HANS-GEORG BATZ

Appeal No. 96-1964
Application No. 07/908,513

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and ROBINSON, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 49 and 50. Claims 26 through 29 and 48, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

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Application No. 07/908,513

The appealed claims read as follows:

49. The compound 2-amino-7-deaza-2',3'-dideoxy-9-beta-D-ribofuran-osyl-purine-6-one or a triphosphate thereof, in the form of a solution.

50. Reagent for determining a nucleic acid sequence comprising the compound 2-amino-7-deaza-2',3'-dideoxy-9-beta-D-ribofuranosyl-purine-6-one or a triphosphate thereof and a nucleotide selected from the group adenosine, thymidine, cytosine and guanosine.

The references relied on by the examiner are:

Hobbs, Jr. et al. (Hobbs) 5,047,519 Sep. 10, 1991

Tikam C. Jain, et al. (Jain), J. Org. Chem., Volume 38, No. 18, "Reactions of 2-Acyloxyisobutyryl Halides with Nucleosides. III. Reactions of Tubercidin and Formycin", pgs. 3179-3186 (1973).

Morris J. Robins, et al. (Robins), Can. J. Chem., Volume 55, "Nucleic acid related compounds. 24. Transformation of tubercidin 2',3'-O-orthoacetate into halo, deoxy, epoxide, and unsaturated sugar nucleosides^{1,2}", pgs. 1251-1259 (1977).

Saeko Mizusawa, et al. (Mizusawa), Nucleic Acids Research, Volume 14, No. 3, "Improvement of the dideoxy chain termination method of DNA sequencing by the use of deoxy-7-deazaguanosine triphosphate in place of dGTP", pgs 1319-1324 (1986).

Claims 49 and 50 stand rejected under 35 U.S.C. § 103 as unpatentable over (1) the combined disclosures of Hobbs and Mizusawa; (2) the combined disclosures of Mizusawa and Robins; and (3) the combined disclosures of Mizusawa and Jain.

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ORDER

On consideration of the record, including the Appeal Brief, Reply Brief, Examiner's Answer, Supplemental Answer, and the above-cited references, it is ORDERED that the rejections of claims 49 and 50 under 35 U.S.C. § 103 be reversed. In our considered judgment, these rejections rely on the impermissible use of hindsight and cannot stand.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

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