

Commissioner=s Decision # 1320  
D cision du Commissaire # 1320

TOPIC: B20  
SUJET: B20

Application No. : 2,336,717  
Demande n  : 2,336,717



IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,336,717 having been rejected under Subsection 30(3) of the *Patent Rules*, has been referred to the Patent Appeal Board for review. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for the Applicant:

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## INTRODUCTION

- [1] This decision deals with a review of the rejection of patent application number 2,336,717.
- [2] The Applicant is the Wisconsin Alumni Research Foundation and the invention is entitled *AIMMORTALIZED HUMAN KERATINOCYTE CELL LINE*.
- [3] The subject application relates to a human cell line that is able to proliferate indefinitely B something that makes it useful for evaluating candidate anti-cancer compounds and for preparing artificial skin-like structures. Before filing their application, the Applicant placed the cell line in a biological material repository under the accession number ATCC CRL-12191.
- [4] The issues in the present case largely centre on the use of certain claim language that the Examiner considers either vague or too broad in view of the inventors= discovery and the specification=s limited description of the ATCC CRL-12191 cell line. For instance, the Applicant has used language such as *Adescended from*, *Aderived from* and *Amodified* to describe the claimed subject-matter.

## PROSECUTION HISTORY

- [5] On December 22, 2008 the application was rejected in a Final Action since certain claims were considered to be too broad contrary to section 84 of the *Patent Rules* and subsection 27(3) of the *Patent Act*, and since certain claims were considered to be ambiguous contrary to subsection 27(4) of the *Patent Act*.
- [6] The Applicant replied to the Final Action and amended the wording of the rejected claims, but not, as explained in a Summary of Reasons, to the satisfaction of the Examiner. The application was therefore referred to the Patent Appeal Board. The Applicant was informed of the referral and provided with a copy of the Summary of Reasons on February 25, 2010.
- [7] On January 18, 2011 the Applicant, having reviewed the Summary of Reasons, volunteered certain claim amendments that it hoped would address the Examiner=s outstanding concerns. The Applicant was advised that, according to section 31 of the *Patent Rules*, an application that has been rejected cannot be voluntarily amended after the expiry of the time to respond to a Final Action. Therefore, the proposed claim amendments could not be formally entered into the application. Nonetheless, it is possible that proposed amendments can form the basis of a formal directive from the Commissioner.
- [8] A brief review of the proposed claim amendments by the Board revealed that three of the proposed claims still appeared to use wording that the Examiner had previously indicated to be problematic. Notwithstanding the Applicant=s efforts to advance the application to allowance, the language in claims 10, 13 and 14 indicated to the Board that a further review of the application was required.

[9] The Applicant was therefore invited to a hearing that was scheduled for June 23, 2011. The Applicant was advised that, if no hearing was desired and if the Applicant wished to expedite allowance of the application, the Applicant may wish to consider proposing further amendments.

[10] In an email dated May 18, 2011 the Applicant declined the hearing invitation but did address the problematic language by proposing further amendments to proposed claims 10, 13 and 14. The proposed amendments of May 18, 2011 also included the amendments proposed on January 18, 2011.

#### **DISPOSITION OF THE APPLICATION**

[11] The Applicant=s latest attempt to rectify the claims, if accepted, would result in the removal of all of the problematic claim language. As such, any outstanding issues would be overcome if the Applicant=s proposals could now be effected.

[12] Therefore, given the present circumstances, it is open to the Commissioner to inform the Applicant that the amendments proposed in the correspondence of May 18, 2011 are required under subsection 31 (c) of the *Patent Rules* (see *Re Application of Novartis Vaccines and Diagnostics S.R.L.* (2011), Commissioner=s Decision no. 1316; *Re Application of Arexis AB* (2010), Commissioner=s Decision no. 1300).

#### **RECOMMENDATION**

[13] I recommend that the Commissioner:

(1) invite the Applicant, in accordance with paragraph 31(c) of the *Patent Rules*, to make the claim amendments outlined in the correspondence dated May 18, 2011; and

(2) advise the Applicant that: (i) if the amendments, and only those amendments, are made within the specified time, the outstanding issues will be considered to have been overcome; and, (ii) if those amendments, and only those amendments, are not made within the specified time, further review of the rejected application will take place in due course.

Ed MacLaurin  
Member

#### **COMMISSIONER=S DECISION**

[14] I agree with the recommendation. Under subsection 31 (c) of the *Patent Rules*, I invite the Applicant to make the amendments outlined in the correspondence dated May 18, 2011 within three months from the date of this decision.

[15] I advise the Applicant that: (i) if the amendments, and only those amendments, are made within the specified time, the outstanding issues will be considered to have been overcome; and, (ii) if the amendments, and only those amendments, are not made within the specified time, further review of the rejected application will take place in due course.

Sylvain Laporte  
Commissioner of Patents

Dated at Gatineau, Quebec,  
this 27 day of October, 2011