

Commissioner=s Decision # 1316
D cision du Commissaire # 1316

TOPIC: B22, C00
SUJET: B22, C00

Application No. : 2,383,007
Demande n . : 2,383,007

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,383,007 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 2,383,007.

[2] The Applicant is Novartis Vaccines and Diagnostics S.R.L. . The invention is entitled
A *HELICOBACTER PYLORI* PROTEINS USEFUL FOR VACCINES AND DIAGNOSTICS. @

[3] The subject application relates to a particular cytotoxic protein derived from a bacterium known as *Helicobacter pylori* B a microorganism associated with chronic gastritis.

PROSECUTION HISTORY

[4] The subject application is a divisional application of parent application 2,131,729 that was originally filed March 2, 1993 and which has now issued to patent.

[5] On July 2, 2010 the application was rejected in a Final Action since certain claims were considered to be indefinite under subsection 27(4) of the *Patent Act*, since certain claims were considered too broad contrary to subsection 138(2) of the *Patent Rules* and subsection 27(3) of the *Patent Act*, and since certain other claims were considered to lack support, also contrary to subsection 138(2) of the Rules and subsection 27(3) of the Act.

[6] The Applicant replied to the Final Action and, according to the Examiner, appropriately amended the claims considered to be indefinite and those considered to be too broad. However, since no amendments were made to the claims considered to lack support, and since those claims were still considered to be defective, a Summary of Reasons was prepared and the application was forwarded to the Board to deal with the outstanding issue. That issue relates to claims 3-8 and 11 and essentially concerns the question of whether the Applicant can rightfully claim vaccines that contain the *H. pylori* cytotoxic protein disclosed in the application.

[7] The Applicant was provided with a copy of the Summary of Reasons and informed that a hearing was scheduled for June 22, 2011. On May 19, 2011 the Applicant declined the invitation to the hearing and voluntarily proposed by email that the defective claims be deleted. During regular prosecution this would effectively end the matter. However, an application that has been rejected cannot be voluntarily amended after the expiry of the time to respond to a Final Action. Therefore, even if a new set of claims were submitted, they could not be formally entered into the application unless the Applicant was formally directed to do so by the Commissioner under the authority of subsection 31(1)(c) of the *Patent Rules*.

DISPOSITION OF THE PRESENT APPLICATION

[8] The outstanding issue will clearly be overcome if the Applicant=s proposal to delete the defective claims could now be effected.

[9] Therefore, given the present circumstances, an option for the Commissioner is to inform the Applicant that the deletion of claims 3-8 and 11 is required under subsection 31(c) of the *Patent Rules* (see *Re Application of SigmaPharm, Inc.* (2008), Commissioner=s Decision no. 1288; *Re Application of Arexis AB* (2010), Commissioner=s Decision no. 1300).

RECOMMENDATION

[10] We recommend that the Commissioner:

(1) invite the Applicant, in accordance with paragraph 31(c) of the *Patent Rules*, to delete claims 3-8 and 11 that were submitted in response to the Final Action and to renumber the remaining claims accordingly; and

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

Ed MacLaurin
Member

Marcel Brisebois
Member

COMMISSIONER=S DECISION

[11] I concur with the recommendation of the Patent Appeal Board. Under subsection 31 (c) of the *Patent Rules*, I invite the Applicant to delete claims 3-8 and 11 that were submitted in response to the Final Action and to renumber the remaining claims accordingly within three months from the date of this decision.

[12] I advise the Applicant that: (i) if the above amendments and only the above amendments are made within the specified time, the outstanding issue will be considered to have been overcome;

and, (ii) if the above amendments, and only the above 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 12 day of July, 2011