

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JANICE K. ALBRECHT and PAUL C. GRINT

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Appeal No. 2000-0460  
Application No. 08/444,584

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ON BRIEF<sup>1</sup>

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

ADAMS, Administrative Patent Judge.

VACATUR and REMAND TO THE EXAMINER

On consideration of the record we find this case is not in condition for a decision on appeal. For the reasons that follow, we vacate<sup>2</sup> the pending rejection

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<sup>1</sup> Pursuant to appellants request (Paper No. 31, received January 25, 1999) an oral hearing for this appeal was scheduled for November 6, 2001. Appellants, however, waived their request for oral hearing. See Paper No. 36, received August 8, 2001. Accordingly, we considered this appeal on Brief.

<sup>2</sup> Lest there be any misunderstanding, the term "vacate" in this context means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists.

under 35 U.S.C. § 103 and remand the application to the examiner to consider the following issues and to take appropriate action.

As set forth at page 2 of the Answer<sup>3</sup>, the references relied upon by the examiner are:

Testa et al. (Testa)	5,676,942	Oct. 14, 1997
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Bizollon et al. (Bizollon), "Benefit of the Combination Interferon (IFN) – Ribavirin in the Treatment of C Viral Reinfections Following Hepatic Transplantation (HT)," French Rev. Gastro-Enterology, Vol. 30, No. 297, Case No. ID0492 (1994)

#### GROUND OF REJECTION

Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16 and 18-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Bizollon in view of Testa.

#### DISCUSSION

As set forth, supra, the Answer presents, for our review, a single ground of rejection under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies on Bizollon and Testa. See Answer, page 3. While, the examiner finds (Answer, page 2), "appellants' statement of the issues in the brief is correct", the issue presented by appellants bears little relationship to the ground of rejection presented for review. Specifically, in contrast to the ground of rejection presented in the Answer, the issue on appeal presented by appellants (Brief, page 4) is "[w]hether [c]laims 1, 3-4, 6-7, 9-10, 12-13, 15-16 and 18-21 are obvious under 35 U.S.C. §

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<sup>3</sup> Paper No. 32, mailed April 13, 1999.

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103 in light of Bizollon, et al., Lai et al.[.]<sup>4</sup> and Cavaletto et al.[.]<sup>5</sup> and further in view of Testa et al.[.] and Kakumu et al.[.]<sup>6</sup> or Brillanti et al.<sup>7</sup>”

The ground of rejection, under 35 U.S.C. § 103, presented in the Final Office Action<sup>8</sup> (see page 3) and the first Advisory Action<sup>9</sup> (see bridging paragraph, pages 2-3) are consistent with appellants’ statement of the issue on appeal. In addition, the second Advisory Action<sup>10</sup> (see page 2) expressly states “[t]he amendment fails to overcome Bizzolon [sic] in view of Testa and other secondary references.” Thus, while the second Advisory Action focuses solely on Bizollon and Testa, and refers collectively to “other secondary references” instead of affirmatively listing Lai, Cavaletto, Kakumu and Brillanti, the rejection maintained is consistent with appellants’ statement of the issue on appeal. Therefore, the ground of rejection up until the Answer was consistent with appellants’ statement of the issue on appeal.

In addition, throughout the Brief, appellants’ arguments are directed at the merits of the examiner’s combination of Bizollon, Lai, Cavaletto, Testa, and

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<sup>4</sup> Lai et al. (Lai), “Treatment of Chronic Active Hepatitis C Infection With a Combination of Roferon®-A and Ribavirin,” 9<sup>th</sup> Biennial Scientific Meeting Asian Pacific Association for the Study of the Liver, abstract (1994).

<sup>5</sup> Calvaletto et al. (Calvaletto), “Randomized Trial Comparing Interferon Alfa or Ribavirin Alone or in Combination for the Treatment of Chronic Hepatitis C,” Italian Association for the Study of the Liver, abstract (1993).

<sup>6</sup> Kakumu et al. (Kakumu), “A Pilot Study of Ribavirin and Interferon Beta for the Treatment of Chronic Hepatitis C,” Gastroenterology, Vol. 105, pp. 507-512 (1993).

<sup>7</sup> Brillanti et al. (Brillanti), “A Pilot Study of Combination Therapy With Ribavirin Plus Interferon Alfa for Interferon Alfa-Resistant Chronic Hepatitis C,” Gastroenterology, Vol. 107, pp. 812-817 (1994)

<sup>8</sup> Paper No. 23, mailed August 24, 1998.

<sup>9</sup> Paper No. 25, mailed September 28, 1998.

<sup>10</sup> Paper No. 27, mailed December 3, 1998.

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Kakumu or Brillanti. Accordingly, the examiner should have been aware that Bizollon and Testa were not the only references at issue. The Answer, however, focuses solely on Bizollon and Testa, and fails to so much as mention Lai, Cavaletto, Kakumu or Brillanti either affirmatively or collectively as “the other secondary references.” The Answer fails to provide an explanation as to why Lai, Cavaletto, Kakumu or Brillanti were no longer included in the ground of rejection. The Answer also fails to identify this ground of rejection as “new.” In addition, neither the Reply Brief, nor the Communication from the Examiner entering the Reply Brief addresses this inconsistency in the statement of the ground of rejection.

Under these circumstances, we think it infelicitous to adjudicate the merits of the examiner’s rejection where, as here, the issue presented for our review by the examiner is inconsistent with the prosecution history in this application. In addition, to the extent the examiner has “switched horses” in the Answer and presents a different ground of rejection than that developed during prosecution, we note, as set forth in 37 C.F.R. § 1.193(a)(2) (1998), “[a]n examiner’s answer must not include a new ground of rejection....” We emphasize that the Answer was mailed after the effective date of this rule.

Accordingly, we vacate the rejection of claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16 and 18-21 under 35 U.S.C. § 103 as being unpatentable over Bizollon in view of Testa, and remand this application to the examiner. On return of this application, the examiner should take a step back and review the administrative file, including the prosecution history, the specification and relevant prior art. If after this review the examiner believes that a rejection is necessary, the examiner should clearly

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articulate any such rejection in an appropriate Office Action, paying special attention to clearly explaining which references are relied upon.

We state that we are not authorizing a Supplemental Examiner's Answer under the provisions of 37 CFR § 1.193(b)(1). Any further communication from the examiner that contains a rejection of the claims should provide appellants with a full and fair opportunity to respond.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

VACATED and REMANDED

William F. Smith	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Douglas W. Robinson	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Donald E. Adams	)	
Administrative Patent Judge	)	

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