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Oslo, 2017.10.24

Your ref.: P19752NOPC01
Application no.: 20160483 (please include in your reply)
Søker: Bioverativ Therapeutics Inc.
Due date: 2018.01.24

Office action in patent application no. 20160483

The application is processed according to Fast track, see "patentretningslinjene (pr.) del A, kap. VII, 1"

Basis of the opinion

Description: received 2016.03.22
Claims: received 2016.12.06
Drawings: received 2016.03.22

Summary of the assessment

The application discloses a patentable invention. We find that the claims can not be accepted in their present state, but we will accept claims that correspond to the claims of EP 237196 B1.

Results of the novelty search

Reference is made to the following documents (D):
D1: FR 2641468 A
D2: GLENNIE MJ. and STEVENSON GT. Univalent antibodies kill tumour cells in vitro and in vivo. Nature. 1982, vol. 295, no. 5851, side 712-714.
D3: STEVENSON GT. ET AL. Chimeric univalent antibodies for treating lymphoid malignancies. Med Oncol Tumor Pharmacother. 1984, vol. 1, no. 4, side 275-278.
D4: WO 9210209 A
D5: WO 9311162 A
D6: EP 0325262 A2
D7: WO 0136637 A
D8: WO 0246208 A2
D9: US 6310180 B1
D10: XU D. ET AL. Mimetic ligand-based affinity purification of immune complexes and immunoconjugates.J Chromatogr B Biomed Sci Appl. 1998, vol. 706, no. 2, side 217-229.
D11: KETAS TJ. ET AL. Human immunodeficiency virus type 1 attachment, coreceptor, and fusion inhibitors are active against both direct and trans infection of primary cells. J Virol. 2003, vol. 77, no. 4, side 2762-2767
D12: US 6030613 A
D13: WO 0183526 A2
D14: WO 9622024 A1
D15: EP 2077121 A1
D16: WO 0102439 A1
D17: WO 9610582 A1

D18: WO 9959643 A2
D19: WO 0066173 A2

Assessment of patentability
We are aware that a patent application based on the same priority as the present application has led to a patent in European Patent Office (EPO) published as EP 2357196 B1. Our novelty search has not revealed documents more relevant than those cited during search and examination at EPO.

We regard D1 as being the closest prior art to the claimed invention. It is our opinion, like the EPO, that the claimed invention does not fulfil the patentability requirements.

We do however find that the invention according to the approved claims of EP 2357196 B1 is both new and inventive according to Norwegian Patents Act, section 2, first paragraph. A new set of claims that correspond to the claims of EP 2357196 B1 may therefore be approved for grant of patent.

Certain defects and observations
The description shall mention any background art useful for understanding the invention and its relationship to prior art, and a reference to the relevant prior art, must be inserted into the description of background art, see «pr. del C, kap. II, 3.2.1» (guidelines for examination) and Patent Regulations, section 9.

Claim 1 is broader than the approved claim 1 in EP 2357196 B1.

Instructions
A Norwegian translation of the approved B1 claims that is written according to Norwegian practise will be approved for grant. Any deficiencies must be corrected or explained and the description must be amended in accordance with the accepted claims. The filed documents must be prepared for publication of the patent.

Should you disagree with our assessments, you may submit new claims together with convincing arguments as to why the invention according to the new set of claims are patentable. In that case you have to state where in the application as originally filed support for the amendments may be found, see Patent Regulations, section 20.

If an amended description is filed, you have to specify which parts of the description that are not in accordance with the description as originally filed and specify in which way the amendments imply anything new in respect of the substantive content, see Patent Regulations, section 21.

Time limit for response
You are invited to submit a written response within the due date above. If you fail to submit observations or to take steps to correct a defect which has been pointed out, the application shall be shelved. However, the processing of the application may be resumed, see Norwegian Patents Act, section 15, third paragraph and Regulation relating to payments etc. to the Norwegian Industrial Property Office and the Board of Appeal for Industrial Property Rights, section 26 (Regulation on fees). The due date may be extended, see Regulation on fees, section 6, fourth paragraph, see also «pr. del A, kap. I, punkt 5.1», (guidelines for examination). For submitting of documents see Regulation on fees, sections 1 and 2.

Cited documents which are not linked from the search report, are not enclosed either, because we assume that you have received these documents during the examination at EPO.

Norwegian Patents Act, Patent Regulations, Regulation on fees and «patentretningslinjene» are available at the Norwegian Industrial Property Office's webpage, www.patentstyret.no

Sincerely

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Enclosures: Search Report