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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,247	10/04/2004	6573099	023004.0103X1US	6310

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EXAMINER

Bennett Celsa

ART UNIT	PAPER NUMBER
<i>3991</i>	<i>IFW</i>

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CSHL EXHIBIT 2008
BENITEC V. CSHL
IPR2016-00016



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,247.

PATENT NO. 6573099.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/007,247	Patent Under Reexamination 6573099	
	Examiner Bennett Celsa	Art Unit 3991	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a Responsive to the communication(s) filed on 28 November 2005. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 3. Interview Summary, PTO-474.
2. Information Disclosure Statement, PTO-1449. 4. _____.

Part II SUMMARY OF ACTION

- 1a. Claims 3-7 and 9-22 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims 1, 2 and 8 have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 3-7 and 9-22 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of the certified copies have

- 1 been received.
2 not been received.
3 been filed in Application No. _____ .
4 been filed in reexamination Control No. _____ .
5 been received by the International Bureau in PCT application No. _____ .

* See the attached detailed Office action for a list of the certified copies not received.

9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

DETAILED ACTION: Reexamination

Non-Final Rejection

Applicant's amendment, terminal disclaimer and 132 Declaration dated Nov. 28, 2005 is hereby acknowledged.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Claims

Claims 3-7 and 9-22 are currently pending and under consideration.

Claims 1, 2 and 8 are cancelled.

Withdrawn Objection (s) and/or Rejection (s)

Patentee's amendment canceling claims 1, 2 and 8 and amending the remaining claims to require that the genetic construct comprise structural genes in the sense and antisense orientation under promoter control has obviated the anticipation rejection of claims 1, 6-7, 13-18 and 20-22 under 35 U.S.C. 102(b) by Cohli et al., *Antisense Research & Development* Vol. 4 (1994) pages 19-26.

Patentee's argument that Inouye fails to exemplify a construct comprising both sense and antisense, including consideration of the Coleman reference, was considered and deemed persuasive regarding the anticipation rejection of Claims 1, 3, 6-8 and 11-22 Inouye U.S. Patent No. 5,272,065 as well as the obviousness rejections of claims 1-22 over Inouye U.S. Patent No. 5,272,065 (the Inouye '065 patent) and Jendrisak et al. US 4,766,072 (the '072 patent).

Upon further consideration, the obviousness rejection over the Cohli et al. Antisense Research & Development Vol. 4 (1994) pages 19-26 in view of Jendrisak et al. U.S. Patent No. 4,766,072 (the '072 patent) and if necessary further in view of Fire et al. Nature Vol. 391 (Feb. 19, 1998) pages 806-811 is hereby withdrawn in lieu of the new grounds of rejection cited below.

Patentee's submission of a terminal disclaimer has obviated the obviousness double patenting rejections over copending Applications: 10/821,726; 11/180,928; 10/346,853; 10/759,841; 10/646,070.

New Objection(s) and/or Rejection (s)

Claim Rejections - 35 USC § 102

1. Claims 3, 4, 6, 7 and 10-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Fire et al (USPN 6,506,559).

Fire et al (USPN 6,506,559) disclose and claim methods for regulating gene expression in cells, including plant and animal cells, comprising introducing into a cell a nucleic acid comprising a first and second DNA sequence which expresses in the cell a sense RNA fragment of a target gene which is optionally stably integrated into the genome of the cell (and which target gene is homologous or heterologous) and a second sequence that is complementary to the first sequence, which sense and antisense strands are optionally linked in a single nucleic acid sequence. The nucleic acid construct comprising these sense and antisense sequences is an expression cassette further comprising a selectable marker gene and regulatory sequences, including intron processing signals and promoter(s), which is further capable of

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