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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542 90/007859 47554	05/13/2005 7590 02/16/2007	6331415	22338-10230	7585
SIDLEY AUSTIN LLP ATTN: DC PATENT DOCKETING 1501 K STREET, NW WASHINGTON, DC 20005				
			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2007

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/007,542 (901007, 859)

PATENT NO. 6331415.

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)).

<b>Office Action in Ex Parte Reexamination</b>	<b>Control No.</b> 90/007,542 (901007,859)	<b>Patent Under Reexamination</b> 6331415	
	<b>Examiner</b> Bennett Celsa	<b>Art Unit</b> 3991	

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

- a  Responsive to the communication(s) filed on 30 October 2006.      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. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statement, PTO/SB/08.     | 4. <input type="checkbox"/> _____.                      |

**Part II SUMMARY OF ACTION**

- 1a.  Claims 1-36 are subject to reexamination.  
1b.  Claims \_\_\_\_\_ are not subject to reexamination.  
2.  Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.  
3.  Claims \_\_\_\_\_ are patentable and/or confirmed.  
4.  Claims 1-36 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: \_\_\_\_\_

cc: Requester (if third party requester)

U.S. Patent and Trademark Office  
PTOL-466 (Rev. 08-06)

Office Action in Ex Parte Reexamination

Part of Paper No. 20070123

**Reexamination: Final Office Action**

**Reexamination of US Patent No. 6,331,415 (Cabilly 2 patent).**

**Status of the Claims**

Claims 1-36 are pending and under reexamination. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Procedural Posture:**

*Merger of 3<sup>rd</sup> Partly Requests 90/007,542 and 90/007,859*

i. 90/007542 ('7542 Proceeding):	ii. 90/007859 ('7859 Proceeding)
Reexamination request filed:	5/13/05      12/23/05
Reexamination ordered:	7/7/05      1/23/06
Patent Owner Statement:	none      none
First Office Action mailed:	9/13/05      N/A
Patent Owner Response dated	1/25/05      N/A
'7542 AND '7859 merged:	6/6/06

Following the merger of the 90/007,542 and 90/007,859 proceedings, the First Office Action dated September 13, 2005 in the '7542 proceeding was withdrawn in light of the Non-Final Office Action dated August 16, 2006.

Patentee's November 25, 2005 response (with Declarations) and the November 30, 2006 response (with Declarations) to the September 13, 2005 and subsequent August 16 2006 office actions, respectively in the 90/007,542 proceeding are considered in this office action.

Additionally, the submitted December 14, 2006 and January 16, 2007 information disclosure statement have been considered in this office action.

**Information Disclosure Statement (IDS)**

Examiner-initialed copies of the December 14, 2006 IDS (four pages) and the

January 16, 2007 IDS (thirty pages) submitted under Rule 1.97(c), (requiring 1.17(p) fees), accompany this office action. The newly submitted Moore 5,840,545 Patent reference presented in the Dec. 14<sup>th</sup> IDS necessitated the making of the new grounds of rejection found in this office action.

There is a substantial new question of patentability raised by the Moore 5,840,545 patent. The Moore patent was cited by the Examiner in an anticipation rejection in a related co-pending application (U.S.S.N. 08/422,187) but is now being viewed in a new light since the claims addressed in 08/422,187 were drawn to different subject matter (e.g. process for producing altered antibody heavy or light chain or fragments thereof).

***Priority***

The 6,331,425 (Cabilly 2) patent undergoing reexamination issued on December 18, 2001 from application 07/205,419 (filed 6/10/88) which was a continuation of 06/483,457 (filed 4/8/83) now 4,816,567 (Cabilly 1) patent.

***Cumulative Prior Art :***

The 1982 Valle and Deacon references are cumulative in their teaching of microinjection of mRNA encoding light and heavy immunoglobulin chains into *Xenopus* oocyte cells to produce secreted active antibody. Accordingly, only the Deacon reference was utilized in the obviousness double patenting rejection(s) recited below.

Additionally, the Oi and Ochi references are cumulative in their teaching of restoring hybridoma cell antibody expression by vector transformation with a light chain

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