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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/486,070	06/07/95	STAVRIANOPULOS	J ENZ-7(F) (03)

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HM31/1208

EXAMINER MARSCHEL, A

ART UNIT 1634	PAPER NUMBER
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DATE MAILED: 12/08/98

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

Commissioner of Patents and Trad marks

Office Action Summary

Application No. 08/486,070	Applicant(s) Stavrianopoulos et al.
Examiner Ardin H. Marschel	Group Art Unit 1634



Responsive to communication(s) filed on 7/24/98, 8/17/98, and 9/21/98

This action is **FINAL**.

Since this application is in condition for allowance 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.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 48-100 and 102-182 is/are pending in the application.

~~Of the above~~, Claim(s) 1-47 and 101 have been canceled. ~~is/are withdrawn from consideration.~~

Claim(s) _____ is/are allowed.

Claim(s) 48-100 and 102-182 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been
 received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

Applicants' arguments; filed 7/24/98, 8/17/98, and 9/21/98, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

Claims 60, 63, 77-99, 114, 118, 133, 136, 141, 144-161, 164, and 180-182 are rejected, as discussed below, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Consideration of the disclosure as filed has failed to reveal the limitation of instant claims 60 and 114 directed to the support and system being composed of different materials. This limitation is therefore NEW MATTER. Consideration of the arguments and Declaration of Dr. Dean Engelhardt reveals that many alternatives were disclosed as filed directed to both porous and non-porous substrates or supports but that the citations pointed to lack any characterization wherein broadly different materials as given now in claims 60 and 114 are disclosed. This rejection is reiterated from the previous office action, mailed 1/21/98.

Claims 63, 86, 118, 146, 152, 164, and 180-182 have been amended to cite "a combination of any of the foregoing" or "combinations thereof" which are directed to DNA etc. This is NEW MATTER as written basis as filed for such combination practice has neither been pointed to by applicants nor been found by consideration of the instant disclosure as filed. This rejection is necessitated by amendment.

Claims 77-85, 87-99, 133, 136, and 141 contain NEW MATTER because the oligonucleotide or polynucleotide is cited as fixed or immobilized to the system rather than being limited to being fixed or immobilized to the solid support within such a system. Consideration of the disclosure as filed has not revealed fixing or immobilizing to a system as now cited in claims 77 etc. Applicants argue that original claims 20 and 23 give written support to said system immobilization of oligonucleotides etc. In response the written basis in these claims clearly contain "means" within devices or apparatus thus not supporting the generic "system" limitation that has been noted above as NEW MATTER. This rejection is therefore maintained and reiterated from the previous office action, mailed 1/21/98, and necessitated by amendment due to newly added claims that contain the NEW MATTER either directly or via dependence from other claims.

Claims 144-161 and 180-182 contain NEW MATTER directed to enhancement of fixation or immobilization with several treatments cited which have not been found as to written basis as

filed either. For example, the written basis for "a dispersive compound" of claim 148 has not been found as filed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 48-50, 53-56, 59, 61, 63-81, 84, 86-100, 102-104, 107-109, 113, and 115-132, 135-143, 152, 155, 156, 158, and 160-182 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Kourilsky et al. (UK 2,019,408).

This rejection is reiterated and maintained from the previous office action, mailed 1/21/98, and necessitated by amendment regarding newly added claims. Applicants argue that ultracentrifugation is not immobilization or fixation. In response it is noted that resuspension as a distinct act is required in order to resuspend the pellet from said

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