

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Control Nos.:	90/007,542 90/007,859	Group Art Unit:	3991
Confirmation Nos.:	7585 ('542) 6447 ('859)	Examiner:	B.M. Celsa
Filed:	13 May 2005 ('542) 23 December 2005 ('859)		
Patent Owner:	Genentech, Inc. and City of Hope		
For:	Merged Reexaminations of U.S. Patent No. 6,331,415 (Cabilly <i>et al.</i>)		

RESPONSE UNDER 37 C.F.R. § 1.550(b)

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COMMISSIONER FOR PATENTS
P.O. Box 1450
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Sir:

This communication responds to the final Office action mailed February 16, 2007, setting a two-month period for response. Owners timely requested an extension of time to respond under 37 C.F.R. § 1.550(c), and in a Decision dated March 21, 2007, the Office granted an extension to May 21, 2007. As this reply is filed within the extended period for response, it is timely.

We believe that no fee is required for this response. Should any fee be required for entry or consideration of this paper, the Director is requested to charge the appropriate amount to our Deposit Account No. 18-1260.

Patent Owners ("Owners") respectfully request reconsideration of the claims in view of the following remarks.

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Exhibit List to Response Filed Under 37 C.F.R. § 1.550(b)

-Exhibit A: MedImmune, Inc. v. Genentech, Inc., No. 04-1300/04-1384 (Fed. Cir. Mar. 7, 2007) Order Remanding Case; MedImmune, Inc. v. Genentech, Inc., CV 03-2567 (C.D. Cal. Apr. 12, 2007) Order Setting the Status Conference

-Exhibit B: U.S. Application No. 06/358,414

-Exhibit C: Second Supplemental Examiner’s Answer mailed January 11, 1996 for U.S. Application No. 08/165,530

-Exhibit D: Declaration of Geoffrey T. Yarranton filed during prosecution of U.S. Application No. 08/165,530

-Exhibit E: Office Action mailed May 30, 1997 for U.S. Application No. 08/165,530

I. Preliminary Matters

A. Interview Summary

Representatives of Owners participated in an interview with Examiners Celsa, Jones, and Ponnaluri on March 15, 2007. The interview summary form accurately reflects the subject of the discussions between Owners' representative and the representatives of the Office.

B. Decision on Petition

Owners filed a petition under 37 C.F.R. §§ 1.181 and 1.182 on March 6, 2007, requesting that the Office declare a new reexamination or, in the alternative, withdraw the finality of the outstanding Office Action. In a decision mailed on March 21, 2007, the Office dismissed the petition on procedural grounds. The decision indicated the Owners could file a renewed petition under § 1.182 for a "Request for Continued Reexamination," in accord with the interim policies set forth in the notice regarding changes to reexamination practice published at 1292 Off. Gaz. Pat. & Trademark Office 20 (March 1, 2005). Concurrently with this response, Owners are filing a timely renewed petition under § 1.182, as suggested in the March 21, 2007 decision.

C. Information Disclosure Statements

Owners acknowledge the indication that the materials provided in the information disclosure statements filed on December 14, 2007 and January 16, 2007 have been fully considered. A further information disclosure statement accompanies this response.

Owners also note that the Office has determined that the disclosure in U.S. Patent No. 4,642,334 ("the '334 patent") is cumulative to that of U.S. Patent No. 5,840,545 ("the '545 patent"). See February Office Action, pp. 3-4. The '334 patent was considered during the examination of the application that matured into the patent under reexamination. Thus, the Office fully considered the substance of the '334 and '545 patent disclosures in connection with the original examination of the claims of the '415 patent.

D. Withdrawn Rejections

Owners acknowledge and appreciate the decision of the Office to withdraw all previous grounds of rejection imposed on claims 1 to 36. In particular, the Office no longer is maintaining any rejection based on a determination that the term "or" as it appears in one or

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