



UNITED STATES PATENT AND TRADEMARK OFFICE

AF

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

08/486,070	06/07/1995	JANNIS G. STAVRIANOPOULOS	ENZ-7(P)(C3)	6279
------------	------------	---------------------------	--------------	------

28171 7590 09/29/2005
 ENZO BIOCHEM, INC.
 527 MADISON AVENUE (9TH FLOOR)
 NEW YORK, NY 10022

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 09/29/2005

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

Office Action Summary

Application No.

08/486,070

Applicant(s)

STAVRIANOPOULOS ET AL.

Examiner

Ardin Marschel

Art Unit

1631

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

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 May 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) 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.

Disposition of Claims

- 4) Claim(s) (See attached list.) is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) (See attached list.) is/are allowed.
- 6) Claim(s) (See attached list.) is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
- Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

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

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)

Claim listings from the attached 326 form:

Pending claims 4): 3144-3147, 3150-3155, 3157-3169, 3172-3175, 3179-3183, 3185-3201, 3204-3209, 3211-3224, 3227-3232, 3234-3238, 3240-3248, 3252-3256, 3258-3268, 3271-3277, 3279-3283, and 3287-3407

Allowed claims 5): 3144-3146, 3150-3155, 3157-3169, 3172-3174, 3179-3183, 3185-3197, 3222-3224, 3227-3232, 3234-3238, 3240-3247, 3252-3256, 3259-3268, 3271-3274, 3279-3283, 3287-3291, 3294-3299, 3310-3325, 3328-3361, and 3380-3407

Rejected claims 6): 3147, 3175, 3198-3201, 3204-3209, 3211-3221, 3248, 3258, 3275-3277, 3292, 3293, 3300-3309, 3326, 3327, and 3362-3379

DETAILED ACTION

Applicants' arguments, filed 5/25/05, 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 either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Art Unit: 1631

NEW MATTER

Claims 3147, 3175, 3198-3201, 3204-3209, 3211-3221, 3248, 3302-3309, 3326, 3327, and 3362-3379 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains 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.

The NEW MATTER rejection based on NEW MATTER being amended into instant claim 3147 etc. directed to "beads" is maintained and reiterated from the previous office action, mailed 11/26/04, due to these limitations still being present in certain claims and not supported by written disclosure as filed. Applicants have newly added the limitation "a bead" (e.g., claim 3147, line 4) which also is NEW MATTER due to not being found as filed regarding written description. This "a bead" rejection basis is necessitated by amendment. The NEW MATTER directed to "a bead" or "beads" was not addressed as to written description specifically as filed by applicants in their response, filed 5/25/05. In an appendix applicants point to pages 13-14; page 14, lines 19-20; page 16, lines 10-11; Examples 1-3 and 5-7; and claims 17 and 21 as originally filed; of the specification for written support for claim 3147, for example, but neither a bead or beads is found therein. These NEW MATTER limitations are present in claims 3147, 3175, 3201, and 3248.

The NEW MATTER rejection directed to a lack of written description as filed for a generic "array" comprising "various" nucleic acids is maintained and reiterated from the

Art Unit: 1631

previous office action, mailed 11/26/04. In contrast, the arrays with depressions or wells for depositing of various denatured analytes has written basis in Example 1 as filed.

Thus, the "various" nucleic acids limitation is connected as filed to depressions or wells for depositing of various analytes. Applicants argue that plural sequences in the specification supports generic arrays with various nucleic acids thereon. This has been responded to previously and the response is repeated that plural sequences may either be the same or different and that the phrase "plural sequences" lacks written support for different or various as a particular type of plural sequences. Applicants again also note a Declaration of Dr. Alexander A. Waldrop, III, which has been responded to previously as being non-persuasive. Applicants further argue that the novelty of the invention resides in fixing nucleic acids in hybridizable form to the surface of a substrate regardless of its shape. In response, this NEW MATTER rejection basis is not directed to claims which cite plural sequences or surface(s) of a substrate regardless of shape. This rejection is directed to claims which specifically cite "various" nucleic acids which indicates some type of variation of nucleic acid type which as filed is only described wherein depressions or wells are practiced apparently to separate one variant from another therebetween the depressions or wells. Such a consideration is not required when plural nucleic acid molecules or sequences are utilized without any distinction as to type or variousness. When applicants, as filed, describe various nucleic acids they also reasonably indicate depressions or wells for separation of the various nucleic acid types. Applicants then argue that In re Peters is analogous in that tapered and non-tapered tips has written support and note that the CCPA indicated that the tip

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.