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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 11/26/2004
ENZO BIOCHEM, INC.
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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
1631	

1631

DATE MAILED: 11/26/2004

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

PTO 085 (2-10-03)

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) 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 the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- 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 30 June 2004.
- 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) 3144-3286 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 3144-3286 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:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. 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)
- 6) Other: _____

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DETAILED ACTION

Due to the below set forth new grounds of rejection the finality of the office action, mailed 4/7/04, is hereby withdrawn. Also, due to said withdrawl of finality the Notice of Appeal, filed 6/30/04, is deemed moot. The amendment, filed 6/30/04, has been entered.

Applicants' arguments, filed 6/30/04, 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.

NEW MATTER

Claims 3147-3150, 3164-3166, 3170, 3171, 3175-3178, 3192-3194, 3198-3245, 3248-3251, 3265, 3266, 3269, 3270, and 3278 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.

NEW MATTER has been amended into the claims via claim 3147 which cites the following solid supports which have not been found as filed: "a plate", "depressions", "beads", " a set of plates", "a set of...depressions", or "a set of...beads". The closest citation to these is set forth in the bridging paragraph between pages 13 and 14 as filed which cites plastic or glass wells which are not the generic wells as in instant claim

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3147. This citation also cites "arrangements of wells, tubes or cuvettes" which includes an arrangement limitation which is more limited than the above cites sets because the sets of claim 3147 lack any arrangement limitation(s) and thus contain NEW MATTER due to broadening to sets vs. arrangements. On page 16, lines 9-14, cites a glass plate with an array of depressions or wells but not the generic plate or plates as now set forth in claim 3147 nor depressions or wells without their presence in a glass plate as now set forth in claim 3147. On page 23, line 17, conventional microtiter well plates are set forth but not the generic plate or set of plates as now set forth in instant claim 3147. Open plate(s) incubation is cited on page 23, lines 25-27, but are reasonably interpreted as describing said conventional microtiter plates and not generic plate(s) as now claimed in claim 3147. This NEW MATTER is also present in claims 3175, 3201, and 3248.

Although applicants point to a previous claim regarding the "more than one surface" type of solid support in claim 3148, a review of the instant disclosure as filed has failed to reveal any such "more than one surface" limitation. This phrase thus adds NEW MATTER compared to the instant disclosure as filed. This NEW MATTER is also present in claims 3176, 3202, 3249, 3150, and 3278.

Although applicants point to previous claims regarding the "to one of said reactive sites or binding sites" as now set forth in claim 3149, a review of the instant disclosure as filed has failed to reveal any citation regarding the particular "to one of" limitation within said phrase. This "to one of" phrase thus adds NEW MATTER compared to the instant disclosure as filed. It is acknowledged that several chemical

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surface treatments have been disclosed as filed, such as providing alkylamine (page 16, line 1) and epoxy glue (page 23, line 3). Such surface treatment(s), however, lack any localization of nucleic acid attachment "to one of" any sites on the various surfaces or solid supports as now set forth in claim 3149 which therefore contains NEW MATTER due to said "to one of" limitation. This NEW MATTER is also present in claims 3177, 3178, 3250, and 3251.

Although applicants point to previous claims regarding claims 3164 and 3165, a review of the instant disclosure as filed has failed to reveal any written support as filed for the quantitation limitation directed to "proportional to". The specification at page 13, lines 11-28, cite quantitation of signal but not that such quantitation is via a signal which is "proportional to" an amount of label etc. This phrase thus adds NEW MATTER compared to the instant disclosure as filed. This NEW MATTER is also present in claims 3192, 3193, 3218, 3219, 3242, 3243, 3265, and 3266.

Although applicants point to a previous claim regarding claim 3165, a review of the instant disclosure as filed has failed to reveal any written support as filed for quantifiability of a label "in or from a fluid or solution" either "in" or "through" a "non-porous solid support" as now set forth in claim 3165. It is acknowledged that a fluid or solution is cited as filed as well as non-porous solid supports of various types, but not that quantifiability is practiced either "in" or "through" a non-porous support as now set forth in claim 3165. This phrase thus adds NEW MATTER compared to the instant disclosure as filed.

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