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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
Row 1: 16/150,191, 10/02/2018, Jingyue Ju, 0575/62239-BZA6AE/JPW/BI, 8204
Row 2: 23432, 7590, 03/12/2019, COOPER & DUNHAM, LLP, 30 Rockefeller Plaza, 20th Floor, NEW YORK, NY 10112, EXAMINER RILEY, JEZIA
Row 3: ART UNIT 1637, PAPER NUMBER
Row 4: MAIL DATE 03/12/2019, DELIVERY MODE PAPER

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

The time period for reply, if any, is set in the attached communication.

Illumina Ex. 1065

First Action Interview Pilot Program Pre-Interview Communication	Application No. 16/150,191	Applicant(s) Ju et al.	
	Examiner JEZIA RILEY	Art Unit 1637	AIA (FITF) Status No

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

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

This time period for reply is extendable under 37 CFR 1.136(a) for only ONE additional MONTH.

This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

Applicant must, within the time period for reply, file: (1) A letter requesting not to have a first action interview; (2) A reply under 37 CFR 1.111 waiving the first action interview and First Action Interview Office Action; or (3) An Applicant Initiated Interview Request Form (PTOL-413A) electronically via EFS-Web, accompanied by a proposed amendment or arguments, and schedule the interview within 2 months from the filing of the request. A failure to respond to this communication will be treated as a request not to have an interview. If applicant waives the First Action Interview Office Action, the instant Pre-Interview Communication is deemed the first Office Action on the Merits. The next subsequent Office action may be made final if appropriate. See MPEP 706.07(a).

Status

- 1) Responsive to communication(s) filed on _____ .
- A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____ .

Disposition of Claims

- 2) Claim(s) 1-4 is/are pending in the application.
 - 2a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 3) Claim(s) _____ is/are allowed.
- 4) Claim(s) 1-4 is/are rejected.
- 5) Claim(s) _____ is/are objected to.
- 6) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 7) The specification is objected to by the Examiner.
- 8) The drawing(s) filed on 10/2/18 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).

Priority under 35 U.S.C. § 119

- 9) 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.

Contact Information

Examiner's Telephone Number: (571)272-0786
 Examiner's Typical Work Schedule: 7:30-6:00pm
 Supervisor's Name: Gary Benzion

Supervisor's Telephone Number:
571-272-0782

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet .
- 3) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
- 4) Other: _____ .

Continuation of Attachment(s) 2) 2/7/19;11/15/18;10/2/18

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Notification of Rejection(s) and/or Objection(s)

#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection
1	1-4	US 9868985	Double Patenting	Claims 1-4 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-2 of U.S. Patent No.9868985. Although the claims at issue are not identical, they are not patentably distinct from each other (see below)
2	1-4	N/A	35 USC § 112(b)	The term "small" in claims 1 and 3 is a relative term which renders the claim indefinite. The term "small" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably (see below)
3	1-4	N/A	35 USC § 112(a)	Variables R and Y in claims 1 and 3 are defined functionally but lack a clear-cut indication of the scope of the subject matter embraced by the claims. In this case, the specification does not provide the particular structures that accomplish the functions recited in the claims (see below)

Expanded Discussion/Commentary

1		because they both claim a method for sequencing a nucleic acid which comprises detecting the identity of a nucleotide analogue incorporated into the end of a growing strand of DNA in a polymerase reaction, wherein the nucleotide analogue are of identical formula where R can be MOM (see Figure 7) and therefore not CH ₂ CH=CH ₂ group; and OR is not a methoxy group, and an ester group; and comprising identical steps.
2		apprised of the scope of the invention. The specification does not define "small" and provides only two examples: MOM ether and allyl. The skilled artisan would not know which other groups meet the limitation "small." The definition of R in claim 49 is unclear. The claim also recites some functional characteristics for R and Y. These functional limitations do not set forth well-defined boundaries of the invention because they only state a problem solved or a result achieved.
3		with the exception of two examples of R and one example of Y. The skilled artisan would not be apprised that the inventors had possession of the full scope of the claimed invention at the time the application was filed because the scope of the claims is much larger than the examples given and the specification does not provide structure-function relationships or guidance for compounds other than those exemplified.
DATE: 11 March 2019		/JEZIA RILEY/ Primary Examiner, Art Unit 1637

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