United States Patent and Trademark Office



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

г					
L	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
_	15/568,266	10/20/2017	Hyeon-A YIM	068374-000052	1285
		7590 02/26/201 eymour and Pease LLP		EXAMINER	
	1909 K St., NW	•		SONG, JIANFENG	
	9th Floor WASHINGTON, DC 20006-1152			ART UNIT	PAPER NUMBER
				1613	
				NOTIFICATION DATE	DELIVERY MODE
				02/26/2019	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patlaw@vorys.com



	15/568,266	YIM et al.	YIM et al.				
Office Action Summary	Examiner	Art Unit	AIA Status				
	JIANFENG SONG	1613	Yes				
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 $\underline{3}$ MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.							
 Extensions of time may be available under the provisions of 37 CFR 1.13 date of this communication. If NO period for reply is specified above, the maximum statutory period w Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing adjustment. See 37 CFR 1.704(b). 	rill apply and will expire SIX (6) MONTHS fro cause the application to become ABANDON	m the mailing date o IED (35 U.S.C. § 133	f this communication.				
Status							
1) Responsive to communication(s) filed on	<u>.</u>						
A declaration(s)/affidavit(s) under 37 CFR 1.1	• • • • • • • • • • • • • • • • • • • •						
\cdot	This action is non-final.						
3) An election was made by the applicant in response to a restriction requirement set forth during the interview on; the restriction requirement and election have been incorporated into this action.							
4) ☐ Since this application is in condition for allowan closed in accordance with the practice under E	•		o the merits is				
Disposition of Claims*							
5) Claim(s) 1-15 is/are pending in the application	ation.						
5a) Of the above claim(s) is/are withdraw	vn from consideration.						
6) Claim(s) is/are allowed.							
7) ✓ Claim(s) 1-15 is/are rejected.							
8) Claim(s) is/are objected to.							
9) Claim(s) are subject to restriction and	or election requirement						
If any claims have been determined allowable, you may be eligible to benefit from the Patent Prosecution Highway program at a							
participating intellectual property office for the corresponding ap							
http://www.uspto.gov/patents/init_events/pph/index.jsp or send	an inquiry to PPHfeedback@uspt	o.gov.					
Application Papers							
10) ☐ The specification is objected to by the Examine							
11) ☑ The drawing(s) filed on 10/20/2017 is/are: a) ☑ accepted or b) □ objected to by the Examiner.							
Applicant may not request that any objection to the dr		• •					
Replacement drawing sheet(s) including the correction	n is required if the drawing(s) is obj	ected to. See 37	CFR 1.121(d).				
Priority under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign Certified copies:	priority under 35 U.S.C. § 119(a)-(d) or (f).					
a)☑ All b)☐ Some** c)☐ None of the	e:						
 Certified copies of the priority docume 	ents have been received.						
Certified copies of the priority docume	ents have been received in Appl	ication No	·				
 Copies of the certified copies of the prapplication from the International Bure 		ceived in this N	lational Stage				
** See the attached detailed Office action for a list of the certified copies not received.							
Attachment(s)							
1) Notice of References Cited (PTO-892)	3) Interview Summa	ry (PTO-413)					
Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/Sl Paper No/s)/Mail Date 10/20/2017	Paner No(s)/Mail						

Application No.

Applicant(s)



Application/Control Number: 15/568,266 Page 2

Art Unit: 1613

Notice of Pre-AIA or AIA Status

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

DETAILED ACTION

Claims 1-15 are pending and under examination.

Priority

Acknowledge is made that this application is national stage of international application PCT/KR2016/004084, filed on 04/20/2016; which claims priority from Korean patent application KR1020150056977, filed on 04/23/2015.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/20/2017 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.



Application/Control Number: 15/568,266 Page 3

Art Unit: 1613

Claims 1-15 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), 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 or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

The factors considered in the Written Description requirement are (1) level of skill and knowledge in the art, (2) partial structure, (3) physical and/or chemical properties, (4) functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the (5) method of making the claimed invention.

While all of the factors have been considered, only those required for a *prima* facie case are set forth below.

The specification discloses a process for preparing a polyurethane foam dressing in which an anti-inflammatory agent is homogeneously dispersed, the process comprising: (a) mixing **dexibuprofen**; one or more dispersing agents selected from the group consisting of methanol, ethanol, n-propanol, isopropanol, ethyl acetate and n-hexane; and a polyurethane prepolymer comprising a polyol and an isocyanate to obtain a drug-containing polyurethane prepolymer.

The claims are drawn to a process for preparing a polyurethane foam dressing in which an anti-inflammatory agent is homogeneously dispersed, the process comprising:

(a) mixing an alkaline anti-inflammatory agent having a pKa value more than pKa 7

(interpreted as sodium dexibuprofen); one or more dispersing agents selected from



Application/Control Number: 15/568,266 Page 4

Art Unit: 1613

the group consisting of methanol, ethanol, n-propanol, isopropanol, ethyl acetate and n-hexane; and a polyurethane prepolymer comprising a polyol and an isocyanate to obtain a drug-containing polyurethane prepolymer.

Vas-Cath Inc. V. Mahurka, 19 USPQ2d 1111, states that applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention, for purposes of the written description inquiry, is whatever is now claimed (see page 1117). A review of the language of the claim indicates that these claims are drawn to a process for preparing a polyurethane foam dressing in which an anti-inflammatory agent is homogeneously dispersed, the process comprising: (a) mixing an alkaline anti-inflammatory agent having a pKa value more than pKa 7 (**interpreted as sodium dexibuprofen**); one or more dispersing agents selected from the group consisting of methanol, ethanol, n-propanol, isopropanol, ethyl acetate and n-hexane; and a polyurethane prepolymer comprising a polyol and an isocyanate to obtain a drug-containing polyurethane prepolymer.

There is substantial difference regarding solubility and reactivity between antiinflammatory agent **dexibuprofen** and the corresponding sodium **dexibuprofen** in the
polymerization process. The disclosure of a process for preparing a polyurethane foam
dressing from anti-inflammatory agent **dexibuprofen** does not provide an adequate
description of the claimed invention of a process for preparing a polyurethane foam
dressing from sodium **dexibuprofen**.

Weighing all the factors, the breadth of the claims reading on alkaline antiinflammatory agent yet to be discovered, the difference in solubility and reactivity in the



DOCKET

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.

