



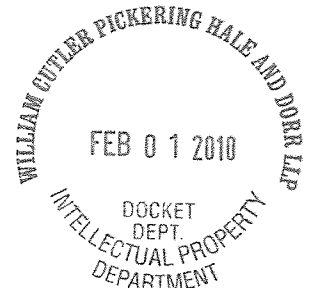
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/ BOSTON
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BOSTON, MA 02109

Date:



**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000443
PATENT NO. : 6833252
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

*WILMER CUTLER PICKERING
HALE And DORR LLP DOCKETING*
RE: 2 000706.135 US1
Action Date: 2.27.10
Action to be Taken: PO Resp Due
Docketed By: JAL On: 2/1/10



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/000,443	03/18/2009	6833252	2000706.00135US1	9804
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22852 7590 01/28/2010
 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
 LLP
 901 NEW YORK AVENUE, NW
 WASHINGTON, DC 20001-4413

EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
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3991

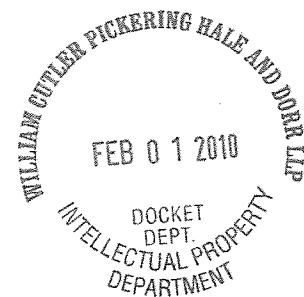
MAIL DATE	DELIVERY MODE
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01/28/2010

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.





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60 STATE STREET
BOSTON, MA 02109

Date:

MAILED

JAN 28 2010

CENTRAL REEXAMINATION UNIT

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Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination	
	95/000,443	6833252	
	Examiner	Art Unit	
	PADMASHRI PONNALURI	3991	

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

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

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**ACTION CLOSING PROSECUTION
(37 CFR 1.949)**

Control No.	Patent Under Reexamination	
95/000,443	6833252	
Examiner	Art Unit	
PADMASHRI PONNALURI	3991	

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

Responsive to the communication(s) filed by:

Patent Owner on 27 August 2009

Third Party(ies) on 28 September 2009

Patent owner may once file a submission under 37 CFR 1.951(a) within 1 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-19 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims 19 are confirmed. [Unamended patent claims]
4. Claims _____ are patentable. [Amended or new claims]
5. Claims 1-18 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 been received. not been received. been filed in Application/Control No _____
10. Other _____

***Inter Partes Reexamination
Action Closing Prosecution (ACP)
Procedural Posture***

The Third Party Request was filed on 3/18/09 for *Inter partes* reexamination of claims 1-19 of United States Patent Number 6,833,252 B1 (Dujon *et al.*).

The Order Granting Reexamination and the First Office Action on the Merits were mailed on 5/27/09.

The Patent Owner's response, Dr. Belfort declaration and Information Disclosure statement were filed on 8/27/09.

The Third Party Requester's response, Dr. Derbyshire declaration and Information Disclosure statement were filed on 9/28/09.

Status of Claims

Claims 1-19 are present in the '252 patent.

Claims 1-19 are currently subject to reexamination proceedings.

Priority

US Patent 6,833,252 B1 (Dujon *et al.*) is issued from US Application 09/492,697, filed on January 27, 2000;

Which is a Continuation of application No. 09/244,130, filed on February 4, 1999, now US Patent 6,822,137;

Which is a Division of application No. 09/119,024, filed on July 20, 1998, now US Patent 5,948,678;

Which is a Continuation of application 08/336,241, filed on November 7, 1994, now US Patent 5,792,632;

Which is a Continuation-in-part of application 07/971,160, filed on November 5, 1992, now US Patent 5,474,896;

Which is a Continuation-in-part of application 07/897,689, filed on May 5, 1992, now abandoned.

Art Unit: 3991

The present `252 patent application 09/492,697 is a continuation of application 09/244,130, which is a division of application 09/119,024, which is a continuation of application 08/336,241, filed on November 7, 1994. Since the specification of the present `252 patent, the `130 application and the `024 application and the `241 application are identical, the present `252 patent claims are entitled to the priority date of November 7, 1994, the filing date of the 08/336,241 application.

The parent application 08/336,241 is CIP of application 07/971,160 filed on November 5, 1992, which is a CIP of application 07/879,689, filed on May 5, 1992.

A review of the application 07/971,160 (the `896 patent) showed that the `160 application specification discloses isolated DNA sequence encoding I-SceI enzyme (SEQ ID NO: 1, columns 3-4), a vector comprising the I-SceI enzyme sequence (see the `896 patent columns 8, 12-14), a transgenic animal containing the DNA sequence encoding the I-SceI enzyme and transgenic organism in which at least one restriction enzyme site for the I-SceI enzyme has been inserted in a chromosome of the organism (see the `896 patent column 18). The `160 application specification discloses that enzyme I-SceI is one of a number of endonucleases with similar properties. The `160 application specification lists the Group I intron encoded endonucleases and the related enzymes (see the `896 patent column 10). Figure 6 in the `160 application depicts the Recognition sequence, Cleavage site, and the Intron site of the Group I Intron encoded endonucleases and related endonucleases. Thus the `160 application (the `896 patent) has written description support for the presently claimed Group I intron encoded endonucleases. Therefore, the present claims 1-19 are entitled to the benefit of the priority to the filing date of the `160 application.

A further review of the application 07/879,689 (the `689 application) showed that the `689 application specification discloses isolated DNA sequence encoding I-SceI enzyme (page 4 and claim 1), a vector comprising the I-SceI enzyme sequence (for example, see the `689 application specification page 10, 16 and 21), a transgenic animal containing the DNA sequence encoding the I-SceI enzyme and transgenic organism in which at least one restriction enzyme site for the I-SceI enzyme has been inserted in a chromosome of the organism (for example, see the `689 application pages 25-26, and claim 22). The `689 application specification discloses that enzyme I-SceI is one of a number of endonucleases with similar properties. The `689 application specification lists the Group I intron encoded endonucleases and the related enzymes (see the `689 application page 13 and figure 5). The `689 application depicts the Recognition sequence, Cleavage site, and the Intron site of the Group I Intron encoded endonucleases and related endonucleases (see page 7). Thus the `689 application has written description support for the presently claimed Group I intron encoded endonucleases. Therefore, the present claims 1-19 are entitled to the benefit of the priority to the filing date of the `689 application.

In response to the denial of the priority to the `689 application in the previous office action mailed on 5/27/09, the Patent Owner asserted that the present patent claims are entitled to the benefit of priority to the May 5, 1992 filing date of the `689 application. The Patent Owner asserted that on November 5, 1992, a response to the notice to file missing parts was filed in the

