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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,254	09/29/2006	5164316		2885

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/29/2006

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Public Patent Foundation

1375 Broadway, Suite 600

New York, New York 10018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,254.

PATENT NO. 5164316.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

**Order Granting / Denying Request For
Ex Part Reexamination**

Control No. 90/008,254	Pat nt Und r R examination 5164316
Examin r Sharon L. Turner	Art Unit 3991

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

The request for *ex parte* reexamination filed 29 September 2006 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
b) by credit to Deposit Account No. _____, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

Reexamination

Procedural History

1. A Request for Reexamination was filed 9-29-06 by a third party requestor.

Decision on Reexamination Request

2. A substantial new question of patentability (SNQ) affecting claims 1-4 of U.S. 5,164,316 ('316 patent") to McPherson is raised by the request for reexamination.

Duty to Disclose

3. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No 5,164,316 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly appraise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Substantial New Question of Patentability

4. The presence or absence of "a substantial new question of patentability" (SNQ) determines whether or not reexamination is ordered.

For a "substantial new question of patentability" to be present, it is only necessary that:

A) the prior art patents and/or printed publications raise a substantial new question of patentability for at least one claim, such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim was patentable. A SNQ may be based on newly cited art or even solely on old art where the

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old art is being presented/viewed in a new light, or in a different way, as compared with its use in earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. (MPEP 2242).

B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts, after appeals, or time for such have expired.

Scope of Reexamination

5. The Request states that the "'316 Patent is Causing Significant Public Harm" (see the request page 2).

The reexamination proceeding provides a complete reexamination of the patent claims on the basis of prior art patents and printed publications. 37 CFR 1.552, MPEP 2258. The third party discussion of Harm caused by the '316 Patent (Request page 2) is clearly outside the scope of reexamination and thus has no bearing on the raising of a SNQ.

Priority

6. U.S. Pat. No. 5,164,316 (**McPherson**) issued November 17, 1992 from US Application No. 07/395,155, filed August 17, 1989; which is a continuation of 07/147,887 filed on January 25, 1988; which is a continuation of 07/002,780, filed on January 13, 1987.

The McPherson 5,164,316 Patented Invention

7. The '316 patented claims are as follows:

1. A plant cell comprising: a DNA construct having as components, (a) a duplicated CaMV 35s enhancer sequence comprising an AluI-EcoRV fragment of a CaMV 35S upstream region; and (ii)

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a promoter comprising an RNA polymerase binding site and an mRNA initiation site; (b) a nucleotide sequence of interest for transcription to mRNA; and (c) a termination region wherein said components are operably joined.

2. The plant cell according to claim 1, wherein said promoter is a T-DNA gene 7 or gene 5 promoter or a CaMV 35S promoter.

3. The plant cell according to claim 1, further comprising as component the right T-DNA border.

4. The plant cell according to claim 1, wherein said sequence of interest is an open reading frame with an initiation codon for expressing a protein of interest.

Documents Cited By The Requester

8. US Patent 4,407,956, **Howell**, issued October 4, 1983.

Thus, **Howell** is prior art to the '316 patent under 35 U.S.C. § 102(b).

Howell (US Patent 4,407,956) was not used in rejections during the prosecution of the application that resulted in the present '316 patent.

9. **Guilley** et al., "Transcription of Cauliflower Mosaic Virus DNA: Detection of Promoter Sequences, and Characterization of Transcripts," Cell, 30(3): 763-773 (1982).

Thus, **Guilley** et al., also applies as prior art to the '316 patent under 35 U.S.C. § 102(b).

Guilley was not used in rejections during the prosecution of the application that resulted in the present '316 patent.

Discussion of the Documents Cited in the Request

10. **Howell** (US Patent 4,407,956) in combination with **Guilley** et al., raises a substantial new question of patentability of claims of the present US Patent 5,164,316.

Howell discloses novel methods and compositions for preparing vectors for the introduction of DNA into plant cells for transcription and expression of the DNA. **Howell**

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discloses that cauliflower mosaic virus (CaMV) DNA is inserted into a bacterial cloning vehicle to provide a recombinant plasmid for cloning in a microorganism. The reference teaches that the recombinant plasmid is genetically manipulated to introduce exogenous or heterologous DNA (see abstract). There is a substantial likelihood that a reasonable examiner would consider the teachings of **Howell** reference in combination with the teachings of **Guilley** important in deciding the patentability of claims of the present US Patent 5,164,316.

11. **Guilley et al.**, (1982) in combination with **Howell** raises a substantial new question of patentability of claims of US Patent 5,164,316.

Guilley teaches that cauliflower mosaic virus (CaMV) is a double stranded DNA plant virus, and is a potential vector for the introduction of foreign DNA into plants.

Guilley teaches CaMV (35S) promoter and CaMV (19S) promoter isolated from CaMV protein-encoding DNA sequences. There is a substantial likelihood that a reasonable examiner would consider the teachings of **Guilley et al.**, (1982) in combination with the teachings of **Howell** important in deciding the patentability of claims of the present US Patent 5,164,316.

Conclusion

12. The request for reexamination is **Granted**. Claims 1-4 of US Patent No. 5,164,316 will be reexamined.

Extension of Time

13. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and

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not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that ex parte reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in ex parte reexamination proceedings are provided for in 37 CFR 1.550(c).

Service on the Other Party (3rd Party Request)

14. After the filing of a request for reexamination by a 3rd party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550 (f).

Patent Owner Amendment

15. Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

Future Correspondence

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Turner whose telephone number is 571-272-0894. The examiner can normally be reached on Monday through Thursday from 7:00 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number for the organization where this application is assigned is 571-273-9900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop *Ex Parte* Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


By FAX to: (571) 273-9900
Central Reexamination Unit

By hand to: Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314



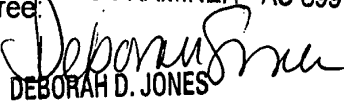
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