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APPLICATION NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/376,512 01/23/95 LINDBERG

P	1103326-072
EXAMINER	
FAN, J	

12M2/0812

WHITE & CASE  
 PATENT DEPARTMENT  
 1155 AVENUE OF THE AMERICAS  
 NEW YORK NY 10036

ART UNIT	PAPER NUMBER
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*7*

DATE MAILED: 1203

08/12/96

This is a communication from the examiner in charge of your application.  
 COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY**

- Responsive to communication(s) filed on 4/29/96
- This action is FINAL.
- 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 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- Claim(s) 1-34 is/are pending in the application.  
 Of the above, claim(s) 12-18, 20, 23, 32-33 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-11, 19, 21-22, 24-31, 34 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - All  Some\*  None of the CERTIFIED copies of the priority documents have been
    - received.
    - received in Application No. (Series Code/Serial Number) SE 9301830-7 in PCT/SE94/00509
    - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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Applicant's election without traverse of group I in Paper No. 5 is acknowledged.

Claims 7-11,34 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to chiral acyl group being mandeloyl. See M.P.E.P. §§ 706.03(n) and 706.03(z). Deletion of the words "such as" would overcome this rejection.

Claims 7,9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "such as" is indefinite, this term should be deleted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,19,21-22,24-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by DE 4035455. Note page 6, lines 37-38 and Erlandsson et al. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

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the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-6,19,21-22,24-31 are rejected under 35 U.S.C. § 103 as being unpatentable over EP 124,495 or CA 117:90292. EP 124,495 page 3, lines 10-15 and CA 117:90292 ( structures enclosed) encompass the claimed enantiomers. The individual isomers are obvious variants over the corresponding racemate because of their presence in the racemate.

Claims 1-11,24-31,34 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims of copending application Serial No. 08/256,174 . This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-11,19,24-31,34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending application Serial No. 08/256,174. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because of salt being obvious variant of the free compound and composition claim being obvious over the corresponding compound.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' PTO-1449 and the accompany references are noted with appreciation. The references have been placed in the file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF AUGUST 1, 1996

  
JANE FAN  
PRIMARY EXAMINER  
GROUP 1200