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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,621	05/23/2001	H. Ralph Snodgrass	441472000110	3487

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MORRISON & FOERSTER LLP  
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EXAMINER

TON, THAIAN N

ART UNIT PAPER NUMBER

1632

DATE MAILED: 10/02/2002

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

**Office Action Summary**

<b>Application No.</b> 09/864,621	<b>Applicant(s)</b> SNODGRASS, H. RALPH	
<b>Examiner</b> Thaian N. Ton	<b>Art Unit</b> 1632	

-- 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 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  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 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-28 is/are pending in the application.  
    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) 1-28 are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ 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).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
    If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  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.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
    a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 20-28, drawn to a library of molecular profiles of chemical compositions comprising contacting an isolated mammalian embryoid body with a chemical composition having pre-determined toxicities, recording alterations in gene expression in the embryoid body in response to the chemical composition to create a molecular profile of the chemical composition to create a molecular profile of the chemical composition and compiling a library of molecular profiles by repeating the above-described steps with at least two chemical compositions having predetermined toxicities, and a method for creating a molecular profile of a chemical composition suspected of toxicity by detecting and recording alterations in gene expression, classified in class 435, subclass 1.1, 4, 6, for example.
- II. Claims 1-14 and 17-28, drawn to a library of molecular profiles of chemical compositions comprising contacting an isolated mammalian embryoid body with a chemical composition having pre-determined toxicities, recording alterations protein expression in the embryoid body in response to the chemical composition to create a molecular profile of the chemical composition to create a molecular profile of the chemical composition and compiling a library of molecular profiles by repeating the above-described steps with at least two chemical compositions having predetermined toxicities, a method for creating a molecular profile of a chemical composition suspected of toxicity by detecting and recording alterations in protein expression, classified in class 435, subclass 1.1, 4, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are mutually exclusive and independent. The methods of creating a molecular profile of a chemical composition suspected of toxicity by detecting and recording alterations in gene expression and library of molecular

profile of Invention I are not required for the implementation of the methods of creating a molecular profile of a chemical composition suspected of toxicity by detecting and recording alterations in protein expression of Invention II and vice versa. Furthermore, each of the methods steps requires a materially different and separate protocol and requires different technical considerations.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thaian N. Ton whose telephone number is (703) 305-1019. The examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time), with alternating Fridays off. Should the examiner be unavailable, inquiries should be directed to Deborah Reynolds, Supervisory Primary Examiner of Art Unit 1632, at (703) 305-4051. Any administrative or procedural questions should be directed to Patsy Zimmerman, Patent Analyst, at (703) 305-2758. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703)872-9306.

TNT  
Thaian N. Ton  
Patent Examiner  
Group 1632

*Deborah Crouch*

DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1632 1/630