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Faegre Baker Daniels LLP- Dow AgroSciences 300 North Meridian Street, Suite 2700 Indianapolis, IN 46204			EXAMINER KOVALENKO, MYKOLA V	
			ART UNIT	PAPER NUMBER
			1638	
			NOTIFICATION DATE	DELIVERY MODE
			04/10/2013	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):

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Office Action Summary	Application No. 13/032,142	Applicant(s) CUI ET AL.	
	Examiner MYKOLA KOVALENKO	Art Unit 1638	

-- 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 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, 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 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 14 March 2013.
- 2a) ☐ This action is **FINAL**. 2b) ☒ 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 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

- 5) ☒ Claim(s) 1-39 is/are pending in the application.
- 5a) Of the above claim(s) 7,8 and 10-24 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-6,9 and 25-39 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 application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 22 February 2011 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).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☐ 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.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/14/2013</u> . | 4) ☐ Other: ____. |

DETAILED ACTION

1. Claims 1-39 are pending.
2. Claims 1-6, 9, and 25-39 are examined herein.

Election/Restrictions

3. Applicant's election of Group I, claims 1-6 and 25-39 in the reply filed on March 14, 2013 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant requests that claim 9, which depends from the elected claim 4, be included with elected Group. Because claim 9 requires SEQ ID NO: 29, claim 9 is included with the elected group. Claims 1-6, 9, 25-39 are examined herein.

Claims 7-8, 10-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 14, 2013.

Sequence Rules Compliance

4. The application contains sequence disclosures that are encompassed by the definitions of nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). In the drawings submitted on February 22, 2011 (amended on August 9, 2011), Figure 6 fails to comply with the Sequence Rules, because it recites nucleotide

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sequences sequences that are at least 10 base pairs long without identifying them by a SEQ ID No.

A complete response to this Office action must include the compliance with the sequence rules, including the corrected figure. An updated sequence list is required as well. Failure to fully comply with both of these requirements in the time period set forth in this office action will be held to be non-responsive.

Claim Objections

5. Claims 2, 25, 27, 31, and 39 are objected to because of the following informalities:

At claim 2, the designation "AAD-1" should be spelled out at its first use.

At claim 2, the phrase "present in seed deposited" should be changed to "present in the seed deposited."

At claim 25, the phrase "for presence of SEQ ID NO:29" requires the definite article and should be changed to "for the presence of SEQ ID NO:29."

At claim 27, the phrase "a plant of claim 1" should be changed to "the plant of claim 1."

At claim 31, the phrase "a seed of claim 3" should be changed to "the seed of claim 3."

Claim 39 should read "jointly with or separately from a second herbicide." The currently used phrase "separately with" is not proper English.

The claims should be consistent with regard to the use of the term “aryloxyalkanoate.” For example, at claims 27 and 31, the term is spelled “aryloxy alkanoate,” while at claim 36, it is spelled as a single word.

Appropriate corrections are required.

Specification

6. The disclosure is objected to because there appears to be an unlabeled table on page 9. Further, Table 10 on pg. 67; Table 11 on pg. 68; Table 12 on pg. 69; and Table 14 on pg. 72 are unlabeled.

Claim Rejections - 35 USC § 112 – Fourth Paragraph

7. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the [fifth paragraph of 35 U.S.C. 112], a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

8. Claim 26 is rejected under 35 U.S.C. 112, fourth paragraph for failing to further limit Claim 25, from which it depends. Claim 26 is drawn to “the method of claim 25 wherein said method is used for breeding a corn plant and/or for introgressing a herbicide tolerance trait into a corn plant.” Claim 25 recites a method of crossing a first corn plant comprising SEQ ID NO: 29 with a second corn plant and assaying the resulting third plant for the presence of SEQ ID NO: 29. The clause following the “wherein” in claim 26 recites an intended use for the product of the method of claim 25,

without setting forth any additional method steps or other limitations (See MPEP 2173.05). As a result, claim 26 fails to limit the scope of claim 25 and is thus rejected under 25 USC 112, fourth paragraph.

Claim Rejections - 35 USC § 112

9. The following is a quotation 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 35 U.S.C. 112 (pre-AIA), first paragraph:
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.

10. Claims 2-5, and 31, 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 enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are directed to novel plants. Since the plants are essential to the claimed invention, they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the plants are not so obtainable or available, a deposit of the plant may satisfy the requirements of 35 USC 112. A deposit of 2,500 seeds of each of the claimed embodiments is considered

sufficient to ensure public availability. The specification does not disclose a repeatable process to obtain the plants and it is not apparent whether the plants are readily available to the public. It is noted that Applicants have deposited the plants with the American Type Tissue Culture Collection under ATCC Deposit No. PTA-10244, but the specification is not adequate to enable the instant claims, because it lacks an affirmative statement as to irrevocable public availability (see pg. 7, line 29 through pg. 8, line 10 of the specification for the deposit statement).

If a deposit is made under the terms of the Budapest Treaty, then a statement, affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, or someone empowered to make such a statement, stating that the instant invention will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If a deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809 and MPEP 2402-2411.05, Applicant may provide assurance of compliance by statement, affidavit or declaration, or by someone empowered to make the same, or by a statement by an attorney of record over his or her signature and registration number showing that:

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;
- (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,
- (e) the deposit will be replaced if it should ever become inviable.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.801 - 1.809 [MPEP 2401-2411.05] for additional explanation of these requirements.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1-6, 9, and 25-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6, 9, and 24-25 of copending Application No. 13/390,969 (US. Publication No. US 20120222153, published on August 30, 2012). Instant claims 1-6 and 9 are directed to a transgenic corn plant comprising SEQ ID NO: 29, herbicide-tolerant progeny of that plant, and a part of that plant; a corn seed of AAD-

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1 event DAS-40278-9; a plant grown from that seed; and the progeny of that plant.

Instant claims 25 and 26 are directed to a method comprising crossing a corn plant that comprises SEQ ID NO: 29 with another plant, and assaying the progeny for the presence of SEQ ID NO: 29. Claims 1-6, 9, and 25-26 of the co-pending application are drawn to identical subject matter. The SEQ ID NO: 29 of the co-pending application is 100% identical to the instant SEQ ID NO: 29. The designation of the event (DAS-40278-9) and the Accession Number of the deposited seed (PTA-10244) of the co-pending application are also identical to the event designation and the Accession Number of the instantly claimed event and seed.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, and 11-18 of copending Application No. 13/390,988 (US Publication No. 20120220460, published August 30, 2012). Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant claims are drawn to a method of controlling weeds in a field comprising the plant of claim 1, wherein the plant comprises SEQ ID NO: 29. The co-pending application 13/390,988 claims a method of controlling AAD-1 volunteer plants wherein the volunteer plants comprise SEQ ID NO: 4 of that application (claims 1 and 6) or wherein the plants are grown from seeds deposited with the ATCC under Accession No. PTA-10244 (claims 1 and 5). The co-pending application claims a method of controlling said AAD-1 volunteer plants, wherein the

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volunteer further comprises a glyphosate and/or glufosinate tolerance gene (claims 1, 11, and 16). The co-pending application claims a method of controlling monocot volunteer plants in a field that comprises dicot plants, wherein said method comprises applying a herbicide to which the volunteer plants are susceptible, but to which the dicot plants are resistant (claims 11-18). The instant SEQ ID NO: 29 (which corresponds to the sequences of the event transgene and the flanking regions) has 100% sequence identity to SEQ ID NO: 4 of the co-pending application. The instant claims are directed to the controlling weeds and volunteers other than the AAD-1 event plants, while the co-pending claims are directed at controlling the AAD-1 volunteers. As one skilled in the art would recognize, however, the methods of the co-pending application are used in conjunction with the instantly claimed methods. As a result, the instant claims 27-39 render obvious the invention of claims 1, 5, 6, and 11-19 of the co-pending application and the co-pending application renders obvious the weed control methods of the instant claims.

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

Conclusion

14. No claims are allowed

15. Claims 1-6, 9 and 25-39 appear to be free of prior art which neither teaches nor renders obvious the instant SEQ ID NO: 29 or a corn plant or seed of event DAS-

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40278-9, the representative seed of which was deposited with the ATCC under Accession No. PTA-10244.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MYKOLA KOVALENKO whose telephone number is (571) 272-6921. The examiner can normally be reached on Monday-Friday 8:30 am - 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, ANNE MARIE GRUNBERG and ZHOU (JOE) SHUBO can be reached at (571) 272-0975 and (571) 272-0724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mykola Kovalenko/
Examiner, Art Unit 1638

/DAVID H KRUSE/
Primary Examiner, Art Unit 1638

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