



112 Rejections from Licensing
Officer Perspective - Supplemental

In re: Wands factors

- *Breadth of claims*
- *Nature of invention*
- *State of prior art (more prior art being for patentability in this situation?)*
- *Level of one of ordinary skill*
- *Level of predictability*
- *Amount of direction provided by the examiner*
- *Existence of working examples*
- *Quantity of experimentation needed to make or use invention based on content of the disclosure*

Example

- NOTCH4 inhibits milk production in mammals.
- ROBO1 inhibits NOTCH4
- ROBO2 inhibits ROBO1
 - ROBO1 agonists, NOTCH4 and ROBO2 antagonists increase milk production in mammals
- We're claiming *methods* of increasing milk production (not compounds)
- No art rejections
- Examiner is trying to limit our methods to *specific compounds*
 - Individual compounds, individual siRNAs
 - We submitted for a pre-appeal conference

Example

- Claim a *method* of screening compound libraries for inhibition of a complex involved in circadian rhythm regulation
- Describe the method in excruciating detail (first OA, examiner didn't read the Examples section)
 - One of the elements of the method claim: contacting . . . with a test compound
 - We also described a compound that worked – claimed it as a positive control in the dependent claim
- Examiner rejected on written description – said we never ran it with a test compound
- Currently on appeal – we're explaining that a positive control is a test compound before it's known to work

Pushing back

Response after final rejection is worthless

RCE + post filing evidence + declarations + interviews: won't work if examiner is dug in

Get the case in front of other examiners

- Pre Appeal Brief Review Request and Conference Pilot Program
 - 19 year old pilot program
- Full appeal in front of PTAB
 - Advantage over RCE – get to a final resolution
 - Might take a long time (so does RCE)
 - If you win, time spent in appeal tacked on to end of patent term
- Fast track appeal
 - Guaranteed resolution for an extra \$420 (small entity)
 - If you get patent term back, do you need to hurry?
 - Maybe if you're in litigation, but then it's out of the licensing manager's hands



What can we do on the front end?

We often don't have a front end

- We're driven by publication, grant applications, graduation, new jobs
- Limited what's in the manuscript, then add new information at nonprovisional filing

Embrace the limitation to working examples?

- Give up on functional claiming
- More apps with less breadth?
- Will we be hit with obviousness rejections?
 - PHOSITA for enablement \neq PHOSITA for obviousness