

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Guoxian Wu, et al.
Appl. No.: 13/926,959
Title: COMPOUNDS AND METHODS FOR KINASE
MODULATION, AND INDICATIONS THEREFOR
Filing Date: 06/25/2013
Examiner: Wang, Shengjun
Art Unit: 1627
Confirmation Number 1243

STATEMENT OF SUBSTANCE OF INTERVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication provides the following Statement of Substance of Interview in accordance with 37 C.F.R. § 1.133 for telephonic interviews held on January 15, 2016 and February 4, 2016.

Summary of Interview on January 15, 2016

Applicant thanks Examiner Wang and Examiner Padmanabhan for the courtesies extended to Applicant's representatives, Lorna Tanner and Joy Lynn Nemirow, during a telephonic interview conducted January 15, 2016. Possible claim amendments and the pending rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103 were discussed. No exhibit or demonstration was conducted.

Regarding the rejection under 35 U.S.C. § 112, Applicant maintained that the present claims satisfy the written description requirement. Applicant pointed to exemplary disclosure in

the present application that demonstrates that Applicant had clear possession of the claimed compounds at the time of filing. For example, numerous embodiments of the claimed compounds wherein L1 is a bond can be found throughout the specification, including but not limited to paragraphs [0007], [0009], and [0021]. Further, Scheme 2 provides exemplary methods of making compounds where L1 is a bond. The Office agreed that “the application has support for L1 as amide or a bond . . .” Applicant-Initiated Interview Summary dated January 22, 2016.

In discussing potential claim amendments, Applicant further noted paragraph [0091] of the present application provides that “heteroaryl” refers to “a monocyclic aromatic ring structure containing 5 or 6 ring atoms, or a bicyclic aromatic group having 8 to 10 atoms, containing one or more . . . heteroatoms independently selected from the group consisting of O, S, and N.” The Office also acknowledges that the application has support for “Ar as bicyclic nitrogen – containing heteroaryl with the proviso in the claims.” Applicant-Initiated Interview Summary dated January 22, 2016.

Regarding the pending rejection under 35 U.S.C. § 103, Applicant agreed to consider additional claim amendments in view of the cited art.

Applicant was advised of pursuing allowable subject matter in the present application and file a continuation application to claim additional subject matter. Applicant notes that a continuation application, which claims priority to the present application, has been filed on even date herewith.

Summary of Interview on February 4, 2016

Applicant thanks Examiner Wang for the courtesies extended to Applicant’s representatives, Robert Bernstein, Lorna Tanner, and Joy Lynn Nemirow, during a telephonic interview conducted on February 4, 2016. Regarding the Applicant-Initiated Interview Summary dated January 22, 2016 (hereinafter “Interview Summary”), Applicant clarified comments with respect to written description.

In particular, Applicant again re-iterated that paragraph [0091] of the present application provides that “heteroaryl” refers to “a monocyclic aromatic ring structure containing 5 or 6 ring atoms, or a bicyclic aromatic group having 8 to 10 atoms, containing one or more . . . heteroatoms independently selected from the group consisting of O, S, and N.” By contrast, the Interview Summary only mentioned that the “application has support for L1 as amide or a bond, and Ar as bicyclic nitrogen-containing heteroaryl with the proviso in the claims.” The Examiner agreed that the present application provides sufficient support for a nitrogen-containing, monocyclic heteroaryl. The Examiner further clarified the above-quoted statement of the Interview Summary did not merely refer to support but rather referred to allowable subject matter.

It is believed that no fees are due in connection with this Communication. In the event that this is not correct, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application to Deposit Account No. 50-6219.

Respectfully submitted,

Date February 19, 2016

By /Joy Lynn Nemirow/

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<i>Applicant-Initiated Interview Summary</i>	Application No. 13/926,959	Applicant(s) WU ET AL.	
	Examiner SHENGJUN WANG	Art Unit 1627	

All participants (applicant, applicant's representative, PTO personnel):

- (1) SHENGJUN WANG. (3) Lorna Tanner.
 (2) Robert Bernstein. (4) _____.

Date of Interview: 04 February 2016.

Type: ☒ Telephonic ☐ Video Conference
☐ Personal [copy given to: ☐ applicant ☐ applicant's representative]

Exhibit shown or demonstration conducted: ☐ Yes ☐ No.
 If Yes, brief description: _____.

Issues Discussed ☐101 ☒112 ☐102 ☐103 ☒Others
 (For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: All pending Claims.

Identification of prior art discussed: All the prior art cited in prior office action.

Substance of Interview

(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicants question the interview summary of January 15, 2016 in the aspect of written description. Particularly, applicants contend that the application has support for both Ar as nitrogen-contain bicyclic heteroring and monocyclic heteroring, while in the interview summary the examiner only indicate that Ar as nitrogen containing bicyclic heteroring has support from the application. The examiner note, that the interview summery merely indicates that claimed subject matter wherein Ar is nitrogen-containing bicyclic heteroring with the proviso as defined in the claims are allowable. The monocyclic ring is not allowable because of the out standing obvious rejection, not because of written description.

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

☐ Attachment

/SHENGJUN WANG/
 Primary Examiner, Art Unit 1627

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.