20110118346

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/738,626	12/20/2010	Jae Kwan Hwang	86152(307161)	3063

90238 7590 12/24/2012

Edwards Wildman Palmer LLP
P.O. Box 55874
Boston, MA 02205

EXAMINER	
KAROL, JODY LYNN	
ART UNIT	PAPER NUMBER
1627	

NOTIFICATION DATE	DELIVERY MODE
12/24/2012	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):

patent@edwardswildman.com

Office Action Summary	Application No.	Applicant(s)	
	12/738,626	HWANG ET AL.	
	Examiner	Art Unit	
	JODY KAROL	1627	

-- 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 *03 December 2012*.

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) *1-10* is/are pending in the application.

5a) Of the above claim(s) *1-8 and 10* is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *9* 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 *16 April 2010* 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)

2) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/14/2010 and 7/21/2010*.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

4) ☐ Other: _____.

DETAILED ACTION

Applicant's response to the Election/Restriction Requirement filed on 11/2/2012 has been received and entered into the Application. Claims 1-10 are pending.

Election/Restrictions

1. Applicant's election of Group III, claim 9, directed to a method of inhibiting melanin production of a lignin-type compound selected form the group consisting of the compounds represented by Chemical Formula 1 to 3 or an extract of nutmeg or aril of nutmeg comprising the lignan-type compound and the species election of Chemical Formula 1 as the lignin-type compound in the reply filed on 12/3/2012 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)).

Claims 1-8 and 10 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. Accordingly, claim 9 is examined on the merits herein, and prior art is applied in so much as it reads on the elected species.

Information Disclosure Statement

2. The information disclosure statements (IDS) filed on 6/14/2010 and 7/21/2011 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered.

Priority

3. This Application is a 371 of PCT/KR08/06143 International Filing Date: 10/17/2008 which claims foreign priority based on Application No. 10-2007-0104783 filed on 10/17/2007 in the Republic of Korea.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

5. The following is a quotation of 35 U.S.C. 112(b):

(B) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

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

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

The recitation of "a method for inhibiting melanin production of a lignan-type compound" renders the claim indefinite because it is unclear how the melanin production of the lignan-type compound is inhibited (i.e. no active, positive steps).

Since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

For examination purposes and in the interest of compact prosecution, the claim will be interpreted as inhibiting melanin production by using a lignan-type compound as described in claim 9.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) 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 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 negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over BhavamiSra; Bhavaprakaga (Edited & translated by Brahmasankara Misra, Part-II: Chaukhamba Sanskrit Sansthan, Varanasi, Edn. 7th, 2000. [Time of origin 16th century], pg 589; Formulation Id: RG/2838A; Formulation Name: Jatiphalalepah; Publication (Prior art): pg No.03; English Translation including Terminology Conversion (TKDL Extracts): pg No.04-05 – cited on IDS) in view of Hwang et al. (KR

1020050073027 A). It is noted that US 2009/0192217 A1 is used as the English language equivalent of the KR publication for citation purposes.

The formulation Jatiphalalepah is a therapeutic single compound formulation consisting of the useful parts of the nutmeg tree *Myristica fragrans* Houtt, wherein the ingredients are made into a fine power and mixed with liquid to form a paste. The paste is locally applied, such as to the face, for the treatment of freckles and cholasma/melasma/melanoderma (i.e. abnormal darkening of the skin caused by excess melanin).

The formulation does not specifically teach that a lignan-type compound of Chemical Formula 1 (macelignan) is used to inhibit melanin production.

However, Hwang et al. teach lignan compound such as macelignan (Chemical Formula 1) are found in the seeds, fruits, or arils of *Myristica fragrans* wherein said lignans can be obtained from pressing the seeds to extract the oil (see pages 2 and 3, sections [0019]-[0024]).

It would have been obvious to of ordinary skill in the art at the time of the invention that the macelignan taught by Hwang et al. to be present in *Myristica fragrans* (i.e. nutmeg) would be released in the pressing of the useful parts of the nutmeg tree into a powder and in the addition of water as taught by the Jatiphalalepah formulation. One of ordinary skill in the art would have had a reasonable expectation of success that the macelignan taught by Hwang et al. to be present in *Myristica fragrans* (i.e. nutmeg) would be released in the pressing of the useful parts of the nutmeg tree into a powder and in the addition of water as taught by the Jatiphalalepah formulation because

extraction is typically carried by macerating the dried ingredients followed by exposure to a solvent such as water as taught by Hwang et al.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention that in applying the Jatiphalalepah formulation to the face of a person with freckles or cholasma/melasma/melanoderma, melanin production would be inhibited. Increased melanin production is considered to be a mechanism of action for freckles or cholasma/melasma/melanoderma. The mechanism of action does not have a bearing on the patentability of the invention if the invention was already known or obvious. Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 201 USPQ 658 (CCPA 1979).

Thus, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention.

Conclusion

No claims are allowed.

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.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JODY KAROL whose telephone number is (571)270-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JLK

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1627