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.
10/469,063	08/13/2003	Lin Zhen-Man		1357

7590 06/15/2009

Lin Zhen Man
Ava Tower 19 07
10 Ava Road
Singapore, 329949
SINGAPORE

EXAMINER	
PAK, JOHN D	
ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
06/15/2009	PAPER

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.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/469,063	Applicant(s) ZHEN-MAN, LIN
	Examiner John Pak	Art Unit 1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☒ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/John Pak/
Primary Examiner, Art Unit 1616

Continuation of 3. NOTE:

The claim amendments of 5/21/2009 are again non-compliant with respect to 37 CFR 1.121 (Rule 121), and therefore, the claims have not been placed in better form for apeal. In the last Office action applicant was given a copy of parts of Rule 121 and advised to amend the claims in accordance with said Rule. The Rules for amending the claims have not been followed. The non-compliance is too numerous and pervasive to detail each and every instance. For example, no claim identifier is used throughout and deletions are improperly shown with brackets instead of "strike-through" lines. This is not in compliance with 37 CFR 1.121(c) and (c)(2). Also, it appears that the amendment of 5/21/2009 is attempting to use the Preliminary amendment of 2/9/2004 as the basis (i.e. template) from which to show amendment markings. However, applicant had already been advised that this amendment was non-compliant and thus not entered. See the Notice of Non-Compliant Amendment of 11/12/2004. To use an unentered claim set as the base claims to show amendment markings is clearly improper. Applicant's 5/21/2009 amendments are non-compliant for multiple reasons and they cannot be granted entry.

Further, in claim 1, "In the lungs infected disease field" appears grammatically incorrect. "In the field of treating infectious lung disease" could be substituted. Amendment to claim 2 raises indefiniteness issues because "herein described and illustrated with reference to the accompanying examples and figures" is an omnibus claim feature. MPEP 2173.05(r). Regarding claim 5, it was stated in the last Office action that this claim contained new matter for newly encompassing "all liquids of fluorine element." The claim amendments of 5/21/2009 amend claim 5 without curing this deficiency. Amendment of claim 5 therefore continues to raise the issue of new matter. In claims 5 and 6, "states that" and "mentioned includes," respectively, are grammatically confusing and indefinite within the claim sentence context. The same comment appies to "mentioned to" in claim 7.

The Examiner offers this guidance to save applicant from further technical mistakes in amending the claims. Applicant is advised to follow the following procedure (note, no markings such as underlines and strik-throughs are required for NEW claims). The procedure shown below will overcome mistakes in following 37 CFR 1.121. This will NOT HOWEVER OVERCOME other issues in this application such as indefiniteness, written description (new matter), and enablement because these other issues are not related to the technicalities of amending the claims. Applicant may amend the claims as follows in order to at least comply with 37 CFR 1.121 ---

> Claims 1-4. (Canceled).
> Claim 5. (New) In the field of treating infectious lung disease ....
> Claim 6. (New) The Surface Treatment of SARS-Infected Lungs in claim 5 ....
> Claim 7. (New) The Surface Treatment of SARS-Infected Lungs in claim 5 ....
> ....

In providing the above guidance, applicant is again notified in no uncertain terms that ACCURATELY following this guidance will result in only one thing -- no more non-compliance with respect to 37 CFR 1.121. Correctly amended claims CAN STILL BE REFUSED ENTRY at this After-Final stage of examination for other reasons such as new matter, new search or further consideration needed, failing to simplify issues for appeal, etc. In this regard, applicant should note that claims 7 and 8 were not previously examined further because claim 7 depended on itself (indefinite and unclear as to the claim scope) and claim 8 depended on claim 7. See the Office action of 4/1/2009, page 8, item (2). Any After-Final amendment that attempts to correct claim 7 or claim 8 will be refused entry because such an amendment would necessitate new search and/or new consideration of previously unexamined claimed subject matter at this After-Final stage of examination. Applicant should only expect that accurately following the above guidance will only result in compliance with 37 CFR 1.121 as to the technicalities of amending the claims.

Continuation of 11. does NOT place the application in condition for allowance because: none of the arguments can be found persuasive. The new matter objection and rejection not only detailed what was new matter, it contained actual copied parts of what was considered new matter. Applicant greatly confuses what was published and what is actually considered original filings in this application. When the application was published, it was not yet examined by a Patent Examiner who is qualified to determine improper new matter. Keeping in mind that this application was filed under 35 USC 371, a preliminary amendment filed simultaneously with this U.S. National Stage application could still be NEW MATTER with respect to the ORIGINAL application, which is the International Application. In other words, the fact that the new matter information was published in the U.S. Patent Application Publication does not in any way control the ultimate determination of what is or is not new matter. The publication occurred before proper examination could be conducted to remove new matter. New matter determination is controlled by the filing date (6/12/2003 here), the disclosure of the application filed at that date (International application) and the law regarding written description. The Examiner's explanation as to new matter from the previous Office action is still deemed sufficient and incorporated herein by reference.

Regarding the enablement rejection, applicant is basically of the position that the Examiner is wrong on all fronts. Applicant should understand that the enablement rejection laid out in the previous Office action and all of the discussion set forth therein is actually following a standard and required legal analysis for enablement. See MPEP 2164 et seq. The Examiner stands by the analysis set forth in the previous Office action, pages 9-12. Regarding the rejection under 35 USC 112, second paragraph, applicant points to various places in the specification to rationalize satisfying this section of the statute. The Examiner cannot agree. Applicant's arguments show that applicant fails to understand the rejections. For example, claims 1-6 were previously rejected because it could not be understood whether a medical process or a composition of matter was being CLAIMED. A patentable invention in the U.S. must belong to ONE category: process, machine, article of manufacture or composition of matter. 35 USC 101. Neither the amended claims nor applicant's arguments address this issue -- it cannot be determined whether claims 1-6 are directed to a process or a composition of matter. Note, a U.S. patent claim cannot be directed to more than one category of inveniton. For these reasons, applicant's proposed After-Final amendment is refused entry. All outstanding grounds of objection and rejection are maintained and their reasons of record incorporated herein.