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| 14/764,601                                | 07/30/2015  | ANJA VAN DE STOLPE   | 2012P01650WOUS      | 7225             |
| 24737                                     | 7590        | 11/09/2018           | EXAMINER            |                  |
| PHILIPS INTELLECTUAL PROPERTY & STANDARDS |             |                      | CROW, ROBERT THOMAS |                  |
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**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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**FINAL ACTION**

***Notice of Pre-AIA or AIA Status***

1. The present application is being examined under the pre-AIA first to invent provisions.

***Status of the Claims***

2. This action is in response to papers filed 6 August 2018 in which claim 5 was amended, no claims were canceled, and new claims 16-17 were added. All of the amendments have been thoroughly reviewed and entered.

The previous objections to the claims not reiterated below are withdrawn in view of the amendments.

The previous rejections under 35 U.S.C. 112, (a)/pre-AIA first paragraph, and 35 U.S.C. 103(a) are maintained and are reiterated below.

Applicant's arguments have been thoroughly reviewed and are addressed following the rejections necessitated by the amendments.

Claims 1, 3-5, 8-9, 11-14, and 16-17 are under prosecution.

3. This Office Action includes new objections and rejections necessitated by the amendments.

***Claim Objections***

4. Claim 5 is objected to because of the following informalities: claim 5 contains the recitation "oligonucleotides solution," which appears to be a typographical error. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph 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 the first paragraph of pre-AIA 35 U.S.C. 112:

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.

6. Claims 1, 3-5, 8-9, 11-14, and 16-17 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 written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a written description rejection maintained from the previous Office Action and applied to new claims 16-17.

Claim 1 (upon which claims 3-5, 8-9, 11-14, and 16-17 depend) requires a processing circuit that is “configured and arranged for selective application..., and selectively increasing attractive electric potential...to further bind and flattened the attached nanoball...”

Claim 8 requires the processing circuit to be “configured to address electrodes...to specifically attract a plurality of nanoballs...”

Claim 11 requires the circuit to be “configured for measuring the capacitance of each electrode.”

The methodology for determining adequacy of Written Description to convey that applicant was in possession of the claimed invention includes determining whether the application describes an actual reduction to practice, determining whether the invention is complete as evidenced by drawings or determining whether the invention has been set forth in terms of distinguishing identifying characteristics as evidenced by other descriptions of the invention that are sufficiently detailed to show that applicant was in possession of the claimed invention (*Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, p 1 “Written Description” Requirement*; Federal Register/ Vol 66. No. 4, Friday, January 5, 2001; II Methodology for Determining Adequacy of Written Description (3.)). The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof.

### **Limitations Present In the Claim**

In the instant case, the only factor present in the claim is a recitation of function; there is no identification of any structure, let alone any particular portion of the structure, that must be conserved or required to result in the claimed configurations. Accordingly, in the absence of sufficient recitation of the distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

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