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September 21, 1955

Dr. Selman A. Waksman, Director
Institute of Microbiology
Rutgers University
New Brunswick, New Jersey

Re: TABER, VINING and WAKSMAN -- U.S.
Ser.No. 497,548, filed March 29, 1955
for ANTIBIOTIC COMPOSITION AND METHOD
OF PREPARATION (Candidin) -- Dkt. 3199

Dear Dr. Waksman:

The above application is the one that relates to candidin. Enclosed is copy of a first Office action (dated July 13, 1955) in the application, together with a set of the cited references, which have now been obtained. For the most part, this Office action consists of the usual criticisms of the specification and claims, i.e. with respect to the omission of facts that were actually not available at the time of filing the application. Furthermore, as you know, this Examiner keeps thinking of new requirements for antibiotic cases so that it is almost impossible to know, from one month to the next, what will suit him in such an application.

The following points, however, require attention:

Vining

1. To the extent that further information as to the properties, spectrum, chemical nature, etc. of candidin may now be available, early opportunity should be taken to get them in this application or in a suitable continuation case. It was recognized at the time we filed this application that more information of this sort would be required by the Patent Office and that when such information became available, steps should be taken to present it. Has further work been done with candidin, since March of this year, particularly along the lines of elemental analysis, empirical formula, infra-red spectra, optical rotation of crystalline products, etc.?

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2. The Examiner rejects the claims on the disclosure at the top of page 68 of your and Dr. Lechevalier's book, "Actinomycetes and Their Antibiotics", published in 1953. This book simply states that S. viridoflavus "produces antibiotic substances, one of which is candidin-like material". As recognized at the time we filed this application, this publication which occurred more than a year before the question of a patent application on candidin was brought up, raises a serious problem as to the patentability of candidin. The Patent Office is taking the position that this published disclosure, which because of its date must be considered as prior art, essentially constitutes an anticipation of the claims in the patent application. Our argument will be, of course, that the published disclosure is very vague and should not be taken as leading to any specific antibiotic substance or as leading to the knowledge that a particularly useful one is produced by S. viridoflavus. However, this question of patentability is a very close one and it is hard to predict the ultimate outcome of argument with the Examiner or on appeal, if appeal becomes necessary.

3. The third point for consideration is the usual requirement for medical proof that candidin is a useful and effective product. As you know, we cannot get a patent until some such proof is available.

It is suggested that the foregoing would merit discussion at a conference at an early date, and consideration of the prospective value of candidin, as having a bearing on the further prosecution of this patent application.

Very truly yours,

Robert S. Dunham

Robert S. Dunham

cc
enclosures

copy - Russell E. Watson, Esq.
with copy of action